From: Trials
To: Milch, Erik
Cc: Mace, Andrew; Weinstein, Mark; Chen, Reuben; Chen, Kyle; Albridge III, Kenneth M (23067); Best, J. Donald (22272); Moran, Kevin P (46510); Marstall, Brian J. N (59563)
Subject: RE: IPR Case Nos. 2019-00144 to -00147, -00333 to -00334, and -00337 to -00338

Counsel:

The Board denies Petitioner Cooler Master's request for leave to file a reply to Patent Owner's Preliminary Response in each of IPR2019-00144, -00145, -00146, -00147, -00333, -00334, -00337, and -00338. Patent Owner raised the issue of whether Nakamura is prior art over six weeks ago in the Patent Owner Preliminary Responses filed in IPR2019-00145 and IPR2019-00147 on February 21, 2019. Petitioner has not provided any reason for the delay in its request for leave to file a reply. Petitioner also has improperly provided substantive arguments supporting its request via email. In particular, Petitioner has directed our attention to case law purporting to support its position that Nakamura is a printed patent application published in 1975 under Japanese law. Upon review of the information provided by Petitioner, we find that Petitioner has not shown good cause to file a reply to the POPR (see 37 C.F.R. § 42.108(c)). Further, our initial review of the Petition and Preliminary Response in each case does not reveal any issues on which we currently believe further briefing would be necessary or beneficial. Thus, supplemental briefing is not necessary prior to our decision on institution.

For future reference, Petitioner is reminded that emails to the PTAB should not contain substantive arguments. *See* Technical Issue No. 3 on our website http://www.uspto.gov/ip/boards/bpai/prps.jsp ("Unless otherwise authorized, do not include attachments in the email and do not use the Trials@uspto.gov email address for substantive communications to the Board.").

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Milch, Erik <emilch@cooley.com>
Sent: Monday, April 8, 2019 7:31 PM
To: Trials <Trials@USPTO.GOV>
Cc: Mace, Andrew <amace@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Chen, Reuben <rchen@cooley.com>; Chen, Kyle <kyle.chen@cooley.com>; Albridge III, Kenneth M (23067) <kmalbridge@michaelbest.com>; Best, J. Donald (22272) <JDBest@michaelbest.com>; Moran, Kevin P (46510) <KPMoran@michaelbest.com>; Marstall, Brian J. N (59563) <bjmarstall@michaelbest.com>
Subject: IPR Case Nos. 2019-00144 to -00147, -00333 to -00334, and -00337 to -00338

Dear Board,

Under 37 C.F.R. §§ 42.108(c), 42.208(c), Petitioner Cooler Master ("Petitioner") in the following IPR cases, all related, respectfully requests leave to file a short reply brief of no more than three (3) pages in response to the Patent Owner's Preliminary Responses ("POPRs"):

- IPR 2019-00144
- IPR 2019-00145

- IPR 2019-00146
- IPR 2019-00147
- IPR 2019-00333
- IPR 2019-00334
- IPR 2019-00337
- IPR 2019-00338

Good cause exists to file a reply brief in response to the POPRs, which have essentially raised the same arguments throughout. The POPRs incorrectly assert that a prior-art reference, Nakamura (Ex. 1004), commonly relied upon by all of the above-referenced petitions, is not a "printed publication," even though such reference is a printed patent application published in 1975 under Japanese law. *See, e.g., Honeywell, Inc. v. Minolta Camera Co.*, Civil Action Nos. 87-4847 and 88-2624, 1991 U.S. Dist. LEXIS 20746, at *24 (D.N.J. Aug. 8, 1991) ("Under Japanese law, these applications were automatically published 18 months after they were filed."); *see also* https://www.uspto.gov/sites/default/files/ip/global/18_months_publication.pdf at 15 ("Japan revised its Patent Law in 1970 and introduced the '18 Month Publication System' from 1971."); *see also* https://wipolex.wipo.int/en/text/188310) ("[a]fter a lapse of one year and six months from the date of the filing of a patent application, the Commissioner of the [Japanese] Patent Office shall lay open the patent application"); *accord.* http://www.japaneselawtranslation.go.jp/law/detail/?id=42&vm=04&re=01. Based on the incorrect assertion above, the POPRs argue that institution in all cases should be denied, even though four of the eight petitions separately and additionally relied upon another prior art reference for invalidity grounds, Morikawa (Ex. 1003 in IPR Nos. 2019-00333, -00334, -00337 and Ex. 1013 in 2019-00338), *similarly published under Japanese law, a point undisputed by the POPRs*. The POPRs unfoundedly argue that institution of the petitions, filed over a mere two-week period, should be denied in consideration of completely unexplained and unsubstantiated "undue inequities and prejudices to" the Patent Owner.

For at least the above reasons, Petitioner respectfully submits that good cause exists to grant leave to file a short reply brief of no more than three (3) pages in response to the POPRs filed in the above-referenced IPR cases. Patent Owner opposes this request.

Sincerely,

Erik Milch

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