Albright, Jeremy

From: Albright, Jeremy
Sent: Wednesday, December 2, 2020 12:22 PM
To: 'joshua.goldberg@finnegan.com'; 'kathleen.daley@finnegan.com'; 'justin.loffredo@finnegan.com'
Cc: Robinson, Eagle; Pohl, Michael
Subject: IPRs2020-01477, -01478, -01479, and -01480 | Motions to File Corrected Petitions and Requests to File Replies to Patent Owner's Preliminary Responses

Counsel,

Petitioner intends to contact the Board tomorrow seeking leave to file:

1. Motions under 37 C.F.R. § 42.104(c) to file a corrected petition in each of the '1477, '1478, '1479, and '1480 Proceedings that:

    a. for the '1477 Proceeding, removes references to claims 11 and 15 in Ground 13's headings and introduction (consistent with the Petition's mappings, as Patent Owner recognized (*see* POPR at 12, n.12)), replaces the citation to Section VIII.A.1 with a citation to Section VIII.A.2 on Petition page 71 (as Patent Owner understood was intended (*see* POPR at 11)), and makes the same correction on Petition pages 43, 44, 74, 77, 82, and 86.

    b. for the '1478 Proceeding, replaces the citations to "30[c][5], 3-[d][1]-[2]" with "28[c][5] and 28[d][1]-[2]" consistent with the surrounding citations, replaces the citation to Limitation 4 with a citation to Limitation 3 on Petition page 75 and the citation to Limitation 3 with a citation to Limitation 2 on Petition page 76, consistent with their parentheticals, and makes the headings and introductory paragraph to Section VIII.A.2 consistent with its mappings.

    c. for the '1479 Proceeding, replaces the citation to Section VIII.B.2 with a citation to Section VIII.B.3 on Petition page 86 to refer to claim 5's mapping as Patent Owner understood was intended (*see* POPR at 11, n.2) and makes similar corrections on Petition pages 90, 93, and 94 (replacing "§VIII.B.2" with "§VIII.B.3").

    d. for the '1480 Proceeding, replaces the citation to Section VIII.A.2 for Limitation 1[b][2] on Petition page 75 with a citation to Section VIII.B.2 as Patent Owner understood was intended (*see* POPR at 11), replaces "§VIII.A.2" with "§VIII.A.3" for Limitations 21[a][3] and 21[b][4] on Petition pages 81 and 82 (consistent with the cited Limitations 16 and 19), and replaces "Limitation 1[a][1]" with "Limitation 1[a][2]" on Petition page 74 (consistent with the introductory paragraph and mapped claim limitation).

    Petitioner first became aware of these issues upon reviewing Patent Owner's Preliminary Responses, and there is no prejudice to Patent Owner in allowing Petitioner to address them, given that, for each, Petitioner's intention was understood by Patent Owner or was clear from the Petition's context as evidenced by the POPR and Petition cites above.

2. A reply under 37 C.F.R. § 42.108(c) to Patent Owner's Preliminary Responses in each of the '1477, '1478, '1479, and '1480 Proceedings to respond to Patent Owner's Section 314(a) arguments. There is good cause for granting these requests because t
dispositive, and "fairness, along w
to § 314[] dictate[s the same]." *G*

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    b. for the '1478 Proceeding, replaces the citations to "30[c][5], 3-[d][1]-[2]" with "28[c][5] and 28[d][1]-[2]" consistent with the surrounding citations, replaces the citation to Limitation 4 with a citation to Limitation 3 on Petition page 75 and the citation to Limitation 3 with a citation to Limitation 2 on Petition page 76, consistent with their parentheticals, and makes the headings and introductory paragraph to Section VIII.A.2 consistent with its mappings.

    c. for the '1479 Proceeding, replaces the citation to Section VIII.B.2 with a citation to Section VIII.B.3 on Petition page 86 to refer to claim 5's mapping as Patent Owner understood was intended (*see* POPR at 11, n.2) and makes similar corrections on Petition pages 90, 93, and 94 (replacing "§VIII.B.2" with "§VIII.B.3").

    d. for the '1480 Proceeding, replaces the citation to Section VIII.A.2 for Limitation 1[b][2] on Petition page 75 with a citation to Section VIII.B.2 as Patent Owner understood was intended (*see* POPR at 11), replaces "§VIII.A.2" with "§VIII.A.3" for Limitations 21[a][3] and 21[b][4] on Petition pages 81 and 82 (consistent with the cited Limitations 16 and 19), and replaces "Limitation 1[a][1]" with "Limitation 1[a][2]" on Petition page 74 (consistent with the introductory paragraph and mapped claim limitation).

    Petitioner first became aware of these issues upon reviewing Patent Owner's Preliminary Responses, and there is no prejudice to Patent Owner in allowing Petitioner to address them, given that, for each, Petitioner's intention was understood by Patent Owner or was clear from the Petition's context as evidenced by the POPR and Petition cites above.

2. A reply under 37 C.F.R. § 42.108(c) to Patent Owner's Preliminary Responses in each of the '1477, '1478, '1479, and '1480 Proceedings to respond to Patent Owner's Section 314(a) arguments. There is good cause for granting these requests because those arguments were not foreseeable to Petitioner, Section 314(a) issues are dispositive, and "fairness, along with developing a complete record as to both parties' arguments with respect to § 314[] dictate[s the same]." *Gen. Elec. Co. v. Pratt and Whitney Can. Corp.*, IPR2020-00083, slip op. at 2-3

(PTAB Feb. 25, 2020) (Paper 8) (addressing Section 314(a) arguments that, like Patent Owner's, were based on alleged redundancy, an alleged lack of particularity, and alleged word count violations).

Please let us know if you oppose these requests, and, if so, times when you are available for a call with the Board.

Sincerely,

Jeremy

Jeremy Albright | Senior Associate
Norton Rose Fulbright US LLP
98 San Jacinto Boulevard, Suite 1100, Austin, Texas 78701-4255, United States
Tel +1 512 536 3111 | Fax +1 512 536 4598
jeremy.albright@nortonrosefulbright.com