

From: Trials [<mailto:Trials@USPTO.GOV>]  
Sent: Thursday, October 19, 2017 1:22 PM  
To: Trials; Victor Hardy; Heidi Keefe  
Cc: Weinstein, Mark; David Silbert; Minghui Yang; Sharif E. Jacob; Mead, Lowell; Nancy Linck  
Subject: RE: IPR2013-00480 and IPR2013-00481 Request for Conference Call

Counsel:

In light of the Federal Circuit's decision to affirm-in-part and reverse-in-part, the panel did not take further action, as the further actions proposed by Patent Owner are not consistent with the Federal Circuit's mandate.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
Direct: 571-272-5366

-----Original Message-----

From: Trials  
Sent: Friday, December 02, 2016 5:09 PM  
To: Victor Hardy <[vhardy@dpelaw.com](mailto:vhardy@dpelaw.com)>; Keefe, Heidi <[hkeefe@cooley.com](mailto:hkeefe@cooley.com)>  
Cc: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Weinstein, Mark <[mweinstein@cooley.com](mailto:mweinstein@cooley.com)>; David Silbert <[DSilbert@KVN.com](mailto:DSilbert@KVN.com)>; Minghui Yang <[myang@dpelaw.com](mailto:myang@dpelaw.com)>; [SJacob@kvn.com](mailto:SJacob@kvn.com); Mead, Lowell <[lmead@cooley.com](mailto:lmead@cooley.com)>; Nancy Linck <[nancylinck@outlook.com](mailto:nancylinck@outlook.com)>  
Subject: RE: IPR2013-00480 and IPR2013-00481 Request for Conference Call

Counsel,

The Board has received the Federal Circuit's mandate, and will issue any necessary orders in due course. No further briefing or conference calls are necessary at this time.

Thanks,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
Direct: 571-272-5366

SRA - Exhibit 2127  
Facebook, Inc. et al. v. SRA, LLC  
IPR2013-00480

-----Original Message-----

From: Victor Hardy [<mailto:vhardy@dpelaw.com>]

Sent: Thursday, December 01, 2016 12:51 PM

To: Keefe, Heidi <[hkeefe@cooley.com](mailto:hkeefe@cooley.com)>

Cc: Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Weinstein, Mark <[mweinstein@cooley.com](mailto:mweinstein@cooley.com)>; David Silbert <[DSilbert@KVN.com](mailto:DSilbert@KVN.com)>; Minghui Yang <[myang@dpelaw.com](mailto:myang@dpelaw.com)>; [SJacob@kvn.com](mailto:SJacob@kvn.com); Mead, Lowell <[lmead@cooley.com](mailto:lmead@cooley.com)>; Nancy Linck <[nancylinck@outlook.com](mailto:nancylinck@outlook.com)>

Subject: RE: IPR2013-00480 and IPR2013-00481 Request for Conference Call

The Federal Circuit did not conclude that claims 1 and 5 of the '494 patent and claim 21 of the '571 patent were unpatentable but rather merely concluded that the grounds relied on by the Board to determine those claims had not been proven unpatentable were in error. The Board did not make any findings regarding the other limitations (and arguments of SRA) of the claims and neither did the Federal Circuit. Thus, on remand, the Board should consider those other limitations and arguments. As the PTAB recognizes, all appeals from the PTAB decided by the Federal Circuit are in fact remands to the PTAB to take action consistent with the Federal Circuit's opinion. This one is no exception.

Since the opinion did not find the claims unpatentable, but merely found the grounds relied upon for the Board's for patentability in error, the Board must take up the remaining adjudicated issues and limitations in a manner consistent with the opinion.

-----Original Message-----

From: Keefe, Heidi [<mailto:hkeefe@cooley.com>]

Sent: Monday, November 28, 2016 11:58 PM

To: Victor Hardy

Cc: [trials@uspto.gov](mailto:trials@uspto.gov); Weinstein, Mark; David Silbert; Minghui Yang; [SJacob@kvn.com](mailto:SJacob@kvn.com); Mead, Lowell

Subject: Re: IPR2013-00480 and IPR2013-00481 Request for Conference Call

Petitioners respectfully disagree with Patent Owner. The Federal Circuit has issued its mandate and there is no further action to be taken by the Board in this matter beyond effectuating that mandate.

On September 9, 2016, the Federal Circuit issued its judgment reversing the determination that claims 1 and 5 of the '494 patent and claim 21 of the '571 patent were not proven invalid (and confirming the invalidity of the remaining claims at issue, so that all claims at issue are invalid). The Federal Circuit did not remand the cases to the Board for any further proceedings. Patent Owner subsequently filed petitions for rehearing by the Federal Circuit. The Federal Circuit denied those petitions.

The Federal Circuit has issued its mandate. The arguments Patent Owner raises in its email below were not raised during the merits briefing. The Federal Circuit explicitly considered and rejected all of the arguments Patent Owner raised in its merits briefing, and denied Patent Owner's petitions for rehearing and rehearing en banc that attempted to raise untimely new arguments. Nothing remains for the Board or the Patent Office to do in these IPR proceedings except to cancel the invalid claims.

Respectfully, Heidi Keefe.

On Nov 23, 2016, at 11:27 AM, Victor Hardy <[vhardy@dpelaw.com](mailto:vhardy@dpelaw.com)<<mailto:vhardy@dpelaw.com>>> wrote:

Your honors,

Patent Owner requests a conference call to discuss whether the Appellate decision has addressed all outstanding factual issues in IPR Nos. IPR2013-00480 and IPR2013-00481. The Federal Circuit's opinion did not address arguments made by Patent Owner to the Board and make factual finding as to all of the limitations with respect to claims 1 and 5 of the '494 patent and claim 21 of the '571 patent.

Importantly, the Court's Opinion never states that all of the limitations are present of any of the above claims in the cited art, nor does it ever explicitly find that any of these claims is unpatentable. For example, the Board found dependent claim 5 of the '494 patent patentable because independent claim 1 was patentable. The Final Written Decision never addressed the elements of claim 5 and the Board's Decision explicitly states that it did not reach the limitations of claim 5. The Federal Circuit never addressed claim 5's limitations in its opinion or made factual findings with respect to the claim-thus claim 5 remains completely unadjudicated.

Similar issues remain outstanding for claim 1 of the '494 patent and claim 21 of the '571 patent-particularly with respect to the claimed alignment of steps (especially, the deriving step) with respect to a specific selected node. See Petitions for Rehearing. Patent Owner therefore requests the Board's consideration of these issues before final resolution of these IPRs.

Patent Owner requests permission to file supplemental briefing identifying unaddressed issues among the voluminous filings and discussion of these issues in light of the Court's opinion. Patent Owner is available the week of November 28.

Victor Hardy