From: Trials
Sent: Friday, September 14, 2018 1:08 PM
To: Brett Mangrum; Parsons, Michael
Cc: Ryan Loveless; sean.burdick@unilocusa.com; Jim Etheridge; Jeff Huang; Ehmke, Andrew S.; Blikshteyn, Dina; Clements, Calmann
Subject: RE: IPR2018-01026, -01027, -01028

Counsel:

The Board has received 1) Petitioner's request for authorization to file a Reply to the Patent Owner's Preliminary Response in each of the subject cases, and 2) Patent Owner's opposition to Petitioner's request.

Petitioner states the reason for its request is "to brief the Board as to the application of the factors for discretionary denial as set forth in the Trial Practice Guide Update and [the Institution Decision in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00366, Paper 11 (Jul. 6, 2018)] to the facts in each case."

Regarding the August 2018 Trial Practice Guide Update, Petitioner states the Update "outlines factors considered for the application of discretionary denial under [35 U.S.C.] § 314(a) and § 325(d)." The August 2018 Trial Practice Guide Update includes a section entitled "Considerations in Instituting a Review" that, in large part, discusses the factors set forth in *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential), regarding § 314(a), and *Becton Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative), regarding § 325(d). Each of these decisions was issued well before Petitioner filed the subject requests for *inter partes* review. Petitioner could have addressed the factors set forth in the decisions in its Petitions.

Regarding the *Hulu* decision, which is neither precedential nor informative, Petitioner states that the decision "applies the Supreme Court's decision in *SAS Institute* [*Inc.*] *v. Iancu*[, 138 S. Ct. 1348 (2018),] to follow-on petitions." The only mention of *SAS* in the *Hulu* decision is in support of the unremarkable statement that the Board no longer issues partial institutions: "Denying as to only some challenged claims while instituting on others, however, is not an option." IPR2018-00366, Paper 11, 10 (citing *SAS*, 138 S. Ct. 1359–60). Furthermore, we note that *SAS* is not a factor in IPR2018-01026 and IPR2018-1028, which only seek review of a single claim under a single challenge. Additionally, IPR20018-01027 seeks review of only two claims under a single challenge.

A petitioner seeking leave to file a reply to a preliminary response must show good cause for filing a reply. 37 C.F.R. § 42.108(c). We deny Petitioner's request for authorization to file a Reply to the Preliminary Response. Assessment of the evidence of record and application of the law to the facts of the case are core functions of the Board, and not unique to these proceedings. Based on the facts of these cases, we determine that Petitioner has failed to show good cause to file a Reply simply because Petitioner did not address in its Petition previously enumerated factors the Board considers in conjunction with a discretionary denial to institute *inter partes* review or because the Board no longer issues partial institutions.

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

From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Thursday, September 13, 2018 10:25 AM
To: Parsons, Michael <Michael.Parsons@haynesboone.com>; Trials <Trials@USPTO.GOV>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; sean.burdick@unilocusa.com; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Blikshteyn, Dina <Dina.Blikshteyn@haynesboone.com>; Clements, Calmann <Calmann.Clements@haynesboone.com>
Subject: RE: IPR2018-01026, -01027, -01028

Honorable Board:

To clarify Patent Owner's position: While Patent Owner opposes Petitioner's request, if granted, Patent Owner hereby requests that it also be given the opportunity to address the same authority in a sur-reply. Petitioner has not indicated any opposition to Patent Owner's sure-reply request.

Best regards,
Brett Mangrum
Lead Counsel for Patent Owner
Reg. No. 64,783

From: Parsons, Michael <Michael.Parsons@haynesboone.com>
Sent: Thursday, September 13, 2018 9:20 AM
To: Trials@uspto.gov
Cc: Brett Mangrum <brett@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; sean.burdick@unilocusa.com; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Blikshteyn, Dina <Dina.Blikshteyn@haynesboone.com>; Clements, Calmann <Calmann.Clements@haynesboone.com>
Subject: IPR2018-01026, -01027, -01028

Honorable Board,

In the Patent Owner Preliminary Response for each of IPR2018-01026, -01027, and -01028, Patent Owner, Uniloc, argues that the Board should exercise its discretion and deny these petitions under 35 U.S.C. § 325(d). Since the filing of these petitions, the Board issued its decision in *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00366, Paper 11 (Jul. 6, 2018), which applies the Supreme Court's decision in *SAS Institute v. Iancu* to follow-on petitions, and the August 2018 Trial Practice Guide Update, which outlines factors considered for the application of discretionary denial under § 314(a) and § 325(d).

In light of these developments, Petitioner requests authorization to file a Reply to the Patent Owner Preliminary Response in each of the above referenced cases to brief the Board as to the application of the factors for discretionary denial as set forth in the Trial Practice Guide Update and *Hulu* to the facts in each case. The parties have conferred and Patent Owner opposes this request but may seek a sur-reply should this be granted. The parties are available for a call should the Board deem it necessary.

Best regards,
Michael S. Parsons
Counsel for Petitioner Apple Inc.