

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, December 27, 2018 10:33 AM
To: Lindner, David <dlindner@brinksgilson.com>
Cc: Sobieraj, James <jsobieraj@brinksgilson.com>; Beaupre, Jon <jbeaupre@brinksgilson.com>; Chen, Gang <gchen@brinksgilson.com>; ZTE_FractusIPRs <ZTE_FractusIPRs@brinksgilson.com>; Patrick Finnan <PJF@usiplaw.com>; Jason Shapiro <js@usiplaw.com>; 'Mark J. DeBoy' <mjd@usiplaw.com>
Subject: RE: ZTE v. Fractus: Petitioner's Request for Reply -- IPRs IPR2018-01451, -01455, -01456, -01457, and -01461

Counsel, the panels for the respective proceedings have considered Petitioner's request to file Replies to the Preliminary Responses, and deny the requests.

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

From: Lindner, David <dlindner@brinksgilson.com>
Sent: Friday, December 21, 2018 3:09 PM
To: Trials <Trials@USPTO.GOV>
Cc: Sobieraj, James <jsobieraj@brinksgilson.com>; Lindner, David <dlindner@brinksgilson.com>; Beaupre, Jon <jbeaupre@brinksgilson.com>; Chen, Gang <gchen@brinksgilson.com>; ZTE_FractusIPRs <ZTE_FractusIPRs@brinksgilson.com>; Patrick Finnan <PJF@usiplaw.com>; Jason Shapiro <js@usiplaw.com>; 'Mark J. DeBoy' <mjd@usiplaw.com>
Subject: ZTE v. Fractus: Petitioner's Request for Reply -- IPRs IPR2018-01451, -01455, -01456, -01457, and -01461

Dear Your Honors,

Petitioner hereby seeks leave from the Board to file a Reply to the Patent Owner Preliminary Response in each of IPR2018-01451, IPR2018-01455, IPR2018-01456, IPR2018-01457 and IPR2018-01461, pursuant to 37 CFR §§ 42.108(c), 42.23, and 42.24(c). The Reply would be limited to responding to Patent Owner's arguments that the petitions should be denied (1) under 35 U.S.C. §325(d) in view of Patent Owner's reliance on arguments related to different grounds and arguments related to prior art presented to the patent office by other parties in unrelated non-IPR proceedings that Petitioner could not have reasonably anticipated, and (2) 35 U.S.C. §314(a) in view of Patent Owner's reliance on the Board's decision in *NHK Spring Co. v. Intri-Plex Techs.*, IPR2018-00752, Paper 8 (Sept. 12, 2018), that issued after Petitioner filed its petitions in the above-referenced matters, that the Office should decline institution because the IPRs are cumulative of the district court litigation.

Given the "case-dispositive" nature of Patent Owner's arguments under §§ 314(a) and 325(d), and because the *NHK Spring* decision issued after the filing of Petitioner's petitions, there is good cause for Petitioner's Reply request. *See, e.g.*, IPR2016-01357, Paper 10 at 2 (granting Petitioner a Reply to Patent Owner's Preliminary Response where patent owner sought denial of the petition under §325(d), recognizing the "case-dispositive nature of the issues.").

Counsel for Petitioner sought Patent Owner's consent to this request, and consent was not provided. It is Patent Owner's position that good cause does not exist for replies because Petitioner did anticipate and address the issues under 35 U.S.C. § 325(d) in the petitions, and Petitioner should have anticipated Patent Owner's arguments under 35 U.S.C. § 314 based on case law that predates the *NHK* decision and the petitions.

Should the Board desire a teleconference to discuss this request, Counsel for the Petitioner and Patent Owner are both available Wednesday, December 26 10:00 am – 12:00 pm ET (9:00 am – 11:00 am CT) and Thursday, December 27 10:00 am – 12:00 pm ET (9:00 am – 11:00 am CT).

Respectfully submitted,
David Lindner
Counsel for Petitioner

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