
From: Lesovitz, Jeffrey <JLesovitz@bakerlaw.com>
Sent: Wednesday, October 30, 2019 6:16 PM
To: Trials
Cc: Goettle, Daniel; Rocci, Steven; Guest-TekIPR; BoxNomadix; 2dgm; Amy.Rodriguez; William.Shreve
Subject: IPR2019-01191 -- Request to Submit Petitioner's Reply to Patent Owner Preliminary Response

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Dear Board,

Petitioner Guest Tek Interactive Entertainment Ltd. respectfully requests authorization from the Board to promptly file a short reply to Patent Owner's October 11, 2019 preliminary response. Specifically, Guest Tek requests authorization to file a reply limited to addressing Patent Owner's newly raised arguments as to the priority date of the challenged claims and Patent Owner's backup argument under 35 U.S.C. § 314(a), and believes that there is good cause for submitting a reply.

First, Guest Tek intends to briefly address Patent Owner's first argument that the challenged claims are entitled to an October 20, 2000 priority date. Guest Tek believes there is good cause for a reply addressing the specific applications relied upon by Patent Owner because the 917 patent claims priority to over 14 different patent applications, which in turn incorporate numerous other patent applications. In its proposed reply, Guest Tek intends to briefly address why: (1) the 060 application/890 provisional's general disclosure of comparing an attribute received from a source device with profiles does not amount to performing that comparison specifically based on a source IP address as recited in limitations 1.C and 11.C (see Patent Owner's prelim. resp. § VI.B.4); (2) why the Federal Circuit's *Knowles* case is exactly on point as a result of that general, rather than specific, disclosure (prelim. resp. at 20); (3) why mere reference in the 890 provisional to "pass-through IP addresses," for example, is far from disclosing the specific requirements of limitations 1.D and 11.D (prelim. resp. § VI.B.6); and (4) why block 220 in Figure 2's reference to determining authorization based on an attribute associated with a "source, destination or content" (prelim. resp. § VI.B.6) does not disclose authentication based on both a source IP address and destination IP address (let alone the other requirements of combined limitations 1.C/11.C and 1.D/11.D).

Second, Guest Tek also intends to briefly address Patent Owner's backup argument that the Board should deny institution under Section 314(a). There is good cause because Guest Tek could not have reasonably predicted Patent Owner raising this argument in view of the *correct* facts regarding the district court case. In its proposed reply, Guest Tek intends to explain why: (1) Guest Tek did not delay in filing the IPR petition (prelim. resp. § VII.A.1) at least because the proceedings in the district court case were stayed for close to a year, Guest Tek diligently prepared its petition, and Guest Tek timely filed the petition after the stay was lifted; (2) the district court case is irrelevant to this inter partes review at least because invalidity of the 917 patent is not likely to be decided at the district court; even if it were, the district court would not reach a final decision until well after the Board's decision; and the district court is also in the process of possibly rescheduling the trial date, which Guest Tek has requested be no earlier than the end of 2020; and (3) certain PTAB decisions that Patent Owner cites are inapposite, while other decisions in which the PTAB refused to deny institution under Section 314(a) apply.

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In sum, Guest Tek respectfully requests the Board's authorization to file the foregoing reply. If authorized, Guest Tek's reply will only respond to arguments raised in the Patent Owner preliminary response as outlined above, will be promptly filed, and will comply with 37 C.F.R. §§ 42.23 and 42.24(c).

Counsel for Patent Owner has stated that it opposes Petitioner's request. Counsel for the parties are available for a conference call with the Board on Monday, November 4 at 2-5pm EST or the same time on Tuesday, November 5.

Sincerely,
Jeff

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