

Strang, Jonathan (DC)

From: Strang, Jonathan (DC)
Sent: Wednesday, December 04, 2019 9:15 AM
To: Colletti, Robert; Rosen, Lauren (LA); BentleyIPR
Cc: Naples, Clement (NY); Ghrist, Diane (DC); Moore, Matthew (DC); LaHatte, Gabrielle (SF)
Subject: RE: IPR2019-01502 and -01539 (Bentley v. JLR)

Bob,

You are correct, JLR does not oppose a 4-page Reply (addressing the *NHK Spring* issue) submitted with the September 14 transcript, so long as JLR is given the opportunity to submit a 4-page Surreply.

JLR opposes Bentley's other requests, namely further briefing and/or evidence on public availability in either of the two IPRs. If the Board grants such briefing, however, we agree that a corresponding Surreply of the same length is warranted.

We are available for a conference call with the Board as follows:

Thursday, 12/5, before noon and after 3pm (ET)
Friday, 12/6 (any time)
Monday, 12/9 (any time) (not available the rest of that week)
Tuesday, 12/17 (any time)
Wednesday, 12/18 (any time)

Best,

Jon

From: Colletti, Robert <RColletti@haugpartners.com>
Sent: Tuesday, December 03, 2019 3:45 PM
To: Strang, Jonathan (DC) <Jonathan.Strang@lw.com>; Rosen, Lauren (LA) <Lauren.Rosen@lw.com>; BentleyIPR <BentleyIPR@haugpartners.com>
Cc: Naples, Clement (NY) <Clement.Naples@lw.com>; Ghrist, Diane (DC) <Diane.Ghrist@lw.com>; Moore, Matthew (DC) <Matthew.Moore@lw.com>; LaHatte, Gabrielle (SF) <Gabrielle.LaHatte@lw.com>
Subject: RE: IPR2019-01502 and -01539 (Bentley v. JLR)

Jon,

Thanks for your prompt response, which is appreciated. It seems that the parties agree to a process for addressing the § 314(a) issue in a requested 4-page Reply and 4-page Sur-Reply.

As for the British Library and Japanese National Diet Library public availability declarations, there has been no delay in providing these documents to you.

With regard to the Porsche ATZ articles (Exs. 1002A-D) in IPR2019-1502, we contacted the British Library at the end of July to request public availability date information for each article. We received the letter dated August 7, 2019 from Mr. Ziaad Khan of the British Library Research Service, which confirmed the "British Library Public Availability Date (PAD)" for each article, and the PAD letter was served and filed on August 16th as Ex. 1002E. We were advised that the British Library has its own process for issuing formal Statutory Declarations, and we did not receive the British Library Statutory Declarations until August 20th, after the August 16th filing date of IPR-1502. On August 23, 2019, three days after receipt, we served the British Library Statutory Declarations on your firm and filed them as Exs. 1002A-D in related IPR2019-

01539. We raised the issue in our email of November 27th, and attached additional pdf copies of the Statutory Declarations, after reading JLR's November 25th Preliminary Response in IPR-1502. JLR's POPR (pages 38-42) challenged the public availability of the Porsche ATZ articles without mentioning the British Library Statutory Declarations that already had been provided.

With regard to the Japanese National Diet Library public availability declarations for Exhibits 1059 and 1060, we contacted a Japanese translation service in August to translate the relevant portions of the documents, which we received on August 22nd. The translated documents, which include the relevant publication dates, were served and filed on August 23, 2019 in IPR-1539 (Exs. 1059 and 1060). We were advised that the Japanese National Diet Library has its own process for issuing formal "Apostille" declarations through Japan's Ministry of Foreign Affairs, which we did not receive until mid-September. In view of JLR's challenge to public availability in IPR-502, we provided the Apostille declarations to you in our email dated November 26 so that you could consider them prior to filing JLR's preliminary response in IPR-1539, due on December 12th.

In our view, the British Library Statutory Declarations (Exs. 1002A-D), PAD letter (Ex. 1002E), and Japan National Diet Library translations and Apostille Declarations (Exs. 1059/1059A and 1060/1060A) remove any doubt about the public availability dates of the Porsche ATZ articles and Mitsubishi Levo VII articles.

Please confer with your client and provide us with a prompt response.

Best regards,

Rob

From: Jonathan.Strang@lw.com [<mailto:Jonathan.Strang@lw.com>]
Sent: Tuesday, December 03, 2019 12:46 PM
To: Colletti, Robert; Lauren.Rosen@lw.com; BentleyIPR
Cc: Clement.Naples@lw.com; Diane.Ghrist@lw.com; Matthew.Moore@lw.com; Gabrielle.LaHatte@lw.com
Subject: IPR2019-01502 and -01539 (Bentley v. JLR)

Hi Rob,

In response to your two emails in the subject IPRs received just before Thanksgiving, we agree that a four-page Reply and corresponding Surreply of the same length to address the § 314(a) / *NHK Spring* issue in IPR2019-01502 is appropriate. Both parties should have a fair opportunity to address the current state of the litigation. For the same reason, we do not oppose Bentley submitting the September 14 transcript as evidence with its Reply, so long as we are entitled to the previously mentioned corresponding Surreply.

As for the other requests in both IPRs, we do not yet have enough information to help our client make an informed decision. Please provide a detailed explanation for Bentley's delay for each document/issue so that we may properly advise our client on whether to oppose.

Best,

Jon

From: Strang, Jonathan (DC)
Sent: Tuesday, December 03, 2019 11:54 AM
To: 'Colletti, Robert' <RColletti@haugpartners.com>; Rosen, Lauren (LA) <Lauren.Rosen@lw.com>; BentleyIPR <BentleyIPR@haugpartners.com>
Cc: Naples, Clement (NY) <Clement.Naples@lw.com>
Subject: RE: IPR2019-01502

We apologize for the delay, but given the holiday, we think it is understandable. We will send a response this afternoon.

Best,

Jon

From: Colletti, Robert <RColletti@haugpartners.com>
Sent: Tuesday, December 03, 2019 11:29 AM
To: Rosen, Lauren (LA) <Lauren.Rosen@lw.com>; BentleyIPR <BentleyIPR@haugpartners.com>
Cc: Strang, Jonathan (DC) <Jonathan.Strang@lw.com>; Naples, Clement (NY) <Clement.Naples@lw.com>
Subject: RE: IPR2019-01502

Dear Counsel,

We have not heard from you regarding our email below. Please let us know JLR's position as we intend to contact the Board later this afternoon.

Thank you,
Rob

Robert E. Colletti
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From: Colletti, Robert
Sent: Wednesday, November 27, 2019 11:13 AM
To: 'Lauren.Rosen@lw.com'; BentleyIPR
Cc: Jonathan.Strang@lw.com; Clement.Naples@lw.com
Subject: RE: IPR2019-01502

Dear Counsel,

We have reviewed JLR's Preliminary Response. At pages 38-42 JLR argues that Bentley did not proffer any evidence that the Porsche ATZ articles were publicly available. Attached below please find a Sharefile link with four sworn declarations provided by the British Library Service, one for each of the ATZ articles Exhibits 1002A-1002D. Each of the declarations was previously provided to you on August 23, 2019 in IPR2019-01539 as Exhibits 1002A-D.

We intend to seek Board authorization to file the attached documents as new Exhibits 1002A-D in IPR2019-01502. We also intend to seek Board authorization to file a 4-page Reply to JLR's public availability argument regarding the ATZ articles appearing at pages 38-42 of the Preliminary Response. We would agree that JLR also should be authorized to file a 4-page Sur-Reply addressing Bentley's public availability arguments in the Reply. 37 CFR § 42.108(c); see *Power Integrations, Inc. v. Semiconductor Components Indus., LLC*, IPR2018-00379 Paper 8, 7 (PTAB June 19, 2018).

In addition, Patent Owner argues for discretionary denial of the petition under 35 U.S.C. § 314(a) at pages 48-51 of its Preliminary Response. At pages 49-50, Patent Owner cites *Next Caller Inc. v. TRUSTID*, IPR2019-

Bentley filed its Petition. Therefore, Petitioner Bentley has good cause to submit a brief Reply on the issue of discretionary denial under § 314(a). See *Samsung Electronics Co. v. M&K Holdings Inc.*, IPR2018-00696 Paper 7 (PTAB June 29, 2018) (patent owner's reliance on "intervening decisions by this Board ... establishes good cause for us to grant leave to file a reply"). We suggest 4 pages to address this issue in the Reply and 4 pages in Patent Owner's Sur-Reply.

Finally, in connection with the § 314(a) discretionary denial issue, we also intend to request Board authorization to submit the September 17, 2019 transcript of the status hearing before Judge Davis in the Eastern District of Virginia.

Please consider this proposal and let us know early next week if you will agree, or if you would like to discuss the matter with us before we contact the Board.

Sincerely,
Rob

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| Haug Partners LLP Sharefile Upload | Expires December 03, 2019 |
|--|---------------------------|
| Ex. 1002A ATZ Issue 5 (May 1986).pdf | 8 MB |
| Ex. 1002B ATZ Issue 6 (June 1986).pdf | 6.7 MB |
| Ex. 1002C ATZ Issue 7 and 8 (July-August 1986).pdf | 8.7 MB |
| Ex. 1002D ATZ Issue 9 (September 1986).pdf | 7.4 MB |

[Download Attachments](#)

Kevin Mascarinus uses ShareFile to share documents securely. [Learn More.](#)

From: Lauren.Rosen@lw.com [<mailto:Lauren.Rosen@lw.com>]
Sent: Monday, November 25, 2019 3:03 PM
To: BentleyIPR

Cc: Jonathan.Strang@lw.com; Clement.Naples@lw.com
Subject: IPR2019-01502 - SERVICE

Counsel:

Attached please find service of Patent Owner's Preliminary Response, filed today in the above-referenced action. The exhibits filed today will be sent to you in a separate email via Latham Secure Transfer.

Best,
Lauren

Lauren M. Rosen
Senior Paralegal

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