

Ankenbrand, Michelle

From: Trials
Sent: Friday, March 5, 2021 2:11 PM
To: David Holt
Cc: Tiffany.miller@dlapiper.com; Jim.heintz@dlapiper.com; IPR50095-0015IP1; IPR50095-0016IP1; Robert Asher; Bruce D. Sunstein; Wendy J. Demoracski
Subject: RE: IPR2021-00144 or IPR2021-00145: Petitioner's Request to File Relevant Documents From Co-Pending Litigation

Counsel,

The Board has considered Petitioner's request to file certain documents from the co-pending litigations and a 5-page brief to address how the documents may impact the Board's *Fintiv* analysis in these proceedings. The Board also has considered Patent Owner's non-opposition under certain conditions. The Board has determined that the documents and briefing may be useful to the Board. Accordingly, the Board authorizes Petitioner to file the documents and a 5-page brief, as outlined in Petitioner's email to the Board, no later than March 10, 2021. The Board also authorizes a 1-week extension to Patent Owner's Preliminary Response, to March 17, 2021, and an additional 1200 words for a total of 15,200 words. The Board will memorialize these authorizations in an Order, which will issue in due course. The Board appreciates that the parties were able to come to agreement, and a conference call is not necessary at this time.

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

From: David Holt <DTH@fr.com>
Sent: Thursday, March 4, 2021 3:14 PM
To: Trials <Trials@USPTO.GOV>
Cc: Tiffany.miller@dlapiper.com; Jim.heintz@dlapiper.com; IPR50095-0015IP1 <IPR50095-0015IP1@fr.com>; IPR50095-0016IP1 <IPR50095-0016IP1@fr.com>; Robert Asher <RAsher@sunsteinlaw.com>; Bruce D. Sunstein <BSunstein@sunsteinlaw.com>; Wendy J. Demoracski <WDemoracski@sunsteinlaw.com>
Subject: IPR2021-00144 or IPR2021-00145: Petitioner's Request to File Relevant Documents From Co-Pending Litigation

Honorable Board,

In order to keep the Board apprised of ongoing developments in the co-pending litigations related to the above-referenced IPRs, Petitioner respectfully requests leave to file the following documents with the Board:

- "Amended Agreed Scheduling Order" filed 11/13/20 in *Neonode Smartphone LLC v. Apple Inc.*, 6:20-cv-00505 (W.D. Tex.)
- "Order Staying Case Pending Completion of Venue Discovery" filed 12/08/20 in *Neonode Smartphone LLC v. Apple Inc.*, 6:20-cv-00505 (W.D. Tex.)

- “Text Order GRANTING [36] Motion to Stay Case” filed 12/11/20 in *Neonode Smartphone LLC v. Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.*, 6:20-cv-00507 (W.D. Tex.)
- “Plaintiff Neonode Smartphone LLC’s Unopposed Motion to Extend Venue Discovery Deadlines” filed 02/16/21 in *Neonode Smartphone LLC v. Apple Inc.*, 6:20-cv-00505 (W.D. Tex.)

Because these developments arose after Petitioner filed the above-referenced IPRs against the ‘879 and ‘993 patents, Petitioner also respectfully requests a 5-page brief to explain how these developments impact the Board’s *Fintiv* analysis with respect to the petitions.

Patent Owner does not oppose this request under the following conditions: (1) Petitioner’s 5-page brief should be filed before Patent Owner’s Preliminary Response, which is currently due next Wednesday, March 10; and (2) Patent Owner should be given an extension to allow filing of its Preliminary Response one week after the filing of the 5-page brief; and (3) in view of Petitioner’s additional pages, the Preliminary Response should be given an additional 1200 words for a total of 15,200 words.

Petitioner is agreeable to these conditions, and would be ready to file its 5-page brief no later than Wednesday, March 10.

The parties counsel are available for a teleconference to discuss this request on Friday (3/5) at 12:30a-2:30pET or Monday (3/8) at 4-6pET. If your honors require additional availability, please let us know.

Sincerely

David Holt
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