



IPR2021-01413 - Petitioner's Request for Authorization to File Reply to Preliminary Response

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Thu, Dec 23, 2021 at 1:48 PM

To: Ellyar Barazesh <ellyar@unifiedpatents.com>

Cc: Ashraf Fawzy <afawzy@unifiedpatents.com>, "Hayes, Jennifer" <jenhayes@nixonpeabody.com>, "Dandalides, George" <gdandalides@nixonpeabody.com>

Counsel,

Petitioner's unopposed request for additional briefing for both it and Patent Owner as outline below is granted. The parties should reference this email as authorization for the additional briefing.

Thank you,

Eric W. Hawthorne

Supervisory Paralegal Specialist

Patent Trial and Appeal Board

From: Ellyar Barazesh <ellyar@unifiedpatents.com>

Sent: Thursday, December 23, 2021 8:09 AM

To: Trials <Trials@USPTO.GOV>

Cc: Ashraf Fawzy <afawzy@unifiedpatents.com>; Hayes, Jennifer <jenhayes@nixonpeabody.com>; Dandalides, George <gdandalides@nixonpeabody.com>

Subject: IPR2021-01413 - Petitioner's Request for Authorization to File Reply to Preliminary Response

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Dear Honorable Board,

Petitioner respectfully requests authorization to file a reply to the Patent Owner Preliminary Response (POPR) (Paper 8) filed December 17, 2021 to address Patent Owner's arguments regarding real party in interest (RPI) and discretionary denial. Good cause exists for the requested briefing because Petitioner could not have anticipated Patent Owner would argue for denial on these bases.

With respect to RPI, for example, Petitioner could not have anticipated Patent Owner would include an argument that the Board need not consider at this stage, as set forth by the Board's precedential decision in *SharkNinja*, given the Board's explicit characterization of *SharkNinja*'s holding ("no RPI analysis necessary at institution absent allegation of time bar or estoppel based on unnamed RPI"). No time bar or estoppel issues exist in the current proceeding.

With respect to Patent Owner's discretionary denial arguments, Petitioner could not have anticipated that: (1) Patent Owner would argue for denial based on *General Plastic* and other inefficiency theories because the Petition in this proceeding was the first challenge filed against the subject '228 Patent (Petition, 1-2); (2) Patent Owner would argue for denial under 325(d) where the asserted references were not cited or applied (alone or in combination) during prosecution of the '228 patent or its family members, and differ from references cited or applied (Petition, 3; POPR, 34-35); and (3) Patent Owner raises facts and circumstances that did not exist at the time Petitioner filed its Petition (e.g., arguments regarding Apple and Samsung's IPR petitions challenging the '228 patent, filed after Petitioner's challenge; see, e.g., POPR, 1, 24, 31, 32, 33).

To the extent the Board would find additional briefing on these issues helpful, Petitioner respectfully requests authorization to file a ten page reply to address these issues, due one week from the Board's authorization. Petitioner consents to Patent Owner being permitted a sur-reply of seven pages to respond, due one week after Petitioner's due date.

Petitioner and Patent Owner have conferred. Based on the parties' agreement to this briefing arrangement, Patent Owner does not oppose Petitioner's request.

The parties are available for a conference call with the panel on December 23, 27, and 28 between 11:00 AM - 3:00 PM ET on each day.

Best,

Ellyar Y. Barazesh

Lead Counsel for Petitioner Unified Patents

Ellyar Y. Barazesh

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