

From: [Trials](#)
To: [Brett Cooper](#); [Trials](#)
Cc: [Google-Scramoge-IPR](#); rak_scramoge@raklaw.com
Subject: RE: IPR2022-00603: Request for Extension
Date: Thursday, July 7, 2022 2:50:16 PM

Counsel,

In IPR2022-00603 Patent Owner has requested an extension of the due date for filing a Patent Owner Preliminary Response from July 8, 2022 to July 29, 2022. The basis for Patent Owner's request is that on June 30, 2022 the parties executed a settlement agreement settling all matters in controversy between them, but that additional time is required for the parties to perform their obligations under the agreement and to file a motion to terminate the IPR. Patent Owner does not provide a reason why an extension of 3 weeks is required. We also note that, notwithstanding that the parties having executed a settlement agreement over a week ago, Patent Owner did not transmit its request for an extension until this morning – one day before its Preliminary Response is due.

Under the circumstances, we extend the date for the filing of a Patent Owner Preliminary Response to July 29, 2022. As a Patent Owner Preliminary Response is optional, there will be no further extension of this due date. We also remind the parties to avoid transmitting such last minute requests to the Board, as a panel may be unavailable to act on such short notice.

We further authorize the parties to file a Joint Motion to Terminate the IPR. Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding made in connection with, or in contemplation of the termination shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of such proceeding as between the parties. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). The Joint Motion to Terminate must update the Board concerning the status of any litigation or proceeding, including, but not limited to proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion to Terminate also must include a copy of any agreement and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding.

A party to a settlement may request that any written agreement be treated as business confidential information and be kept separate from the files of an involved patent. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). The request must be filed with the settlement. *Id.* The parties are also authorized to file a Joint Request That The Settlement Agreement Be Treated As Business Confidential Information and kept separate from the files of the involved patent.

The parties should refer to this e-mail authorization when filing a Motion to Terminate or Preliminary Response.

Thank you,

Megan Carlson
Supervisory Paralegal Specialist
Patent Trial and Appeal Board
(571) 272-1650
Megan.Carlson@uspto.gov

From: Brett Cooper <bcooper@raklaw.com>
Sent: Thursday, July 7, 2022 9:55 AM
To: Trials <Trials@USPTO.GOV>
Cc: Google-Scramoge-IPR <PH-Google-Scramoge-IPR@paulhastings.com>;
rak_scramoge@raklaw.com
Subject: IPR2022-00603: Request for Extension

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

On June 30, 2022, the parties executed an agreement settling all matters in controversy between the parties.

Accordingly, the parties jointly request an extension until July 29, 2022 for Patent Owner's Preliminary Response to permit the parties time to perform their obligations set forth by the agreement and file a motion to terminate the IPR.

The parties can make themselves available for a conference call, should the Board find it helpful.

Respectfully submitted,
Brett Cooper
Counsel for Patent Holder

Brett E. Cooper
Russ August & Kabat
Office (310) 826-7474 x281
Mobile (516) 359-9668
Facsimile (310) 826-6991
bio | email | vCard