

From: [Trials](#)
To: [Andrew Baluch](#)
Cc: [Jason Linger](#); [Stephen Underwood](#); [Lawrence Hadley](#); [Matthew Smith](#); [kirstin.stolldebell](#); [carrie.beyer](#); [Trials](#)
Subject: RE: Google/Microsoft v. Hafeman, IPR2022-01188, -01189, -01190, -01191, -01192, -01193
Date: Monday, March 20, 2023 11:21:31 AM
Attachments: [image002.png](#)

Counsel,

From the Board –

First, Patent Owner’s request to file a rehearing request out of time is denied. The Institution Decisions in these cases address discretionary denial in light of a *Sotera* stipulation. *See, e.g.*, IPR2022-01188, Paper 16 at 4–7. The referenced precedential decision addresses requirements for the Board when declining to exercise discretion to deny based on a “compelling merits” analysis. *CommScope Techs. LLC. v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (February 27, 2023) (precedential). Thus, the issuance of this precedential decision does not impact these proceedings.

Second, any dispute regarding the scope or alleged violation of stipulations should be addressed in the district court proceedings in which such stipulations are to have effect.

Third, the parties may stipulate to extensions for certain due dates, including the date for the Patent Owner Response, as provided in the Scheduling Orders in these proceedings. *See, e.g.*, IPR2022–01188, Paper 17 at 9–10. If the parties cannot agree on extensions, the parties may email the Board and ask for a conference call, providing times that the parties are available.

This email will be entered in the record.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Andrew Baluch <baluch@smithbaluch.com>
Sent: Monday, March 20, 2023 9:57 AM
To: Trials <Trials@USPTO.GOV>
Cc: Jason Linger <jlinger@glaserweil.com>; Stephen Underwood <sunderwood@glaserweil.com>; Lawrence Hadley <lhadley@glaserweil.com>; Matthew Smith <smith@smithbaluch.com>; kirstin.stolldebell <kirstin.stolldebell@faegredrinker.com>; carrie.beyer <carrie.beyer@faegredrinker.com>
Subject: Re: Google/Microsoft v. Hafeman, IPR2022-01188, -01189, -01190, -01191, -01192, -01193

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Dear Honorable Board,

For completeness, Petitioners provide their position on Patent Owner's Issue #2 (requesting 6-month extension under § 316(a)(11), or alternatively, 50-day extension of Due Dates 1-3). **First**, a 6-month extension under § 316(a)(11) of all deadlines and FWD is not warranted here. The district court trial date is in flux. Currently, the parties are third in line for the week of April 24th, and the court offered to push back the pretrial conference date. The court has not yet had an opportunity to respond to the parties' alternative proposals regarding scheduling the pre-trial conference and trial. As for Patent Owner's argument regarding potential "conflicting decisions and duplicative efforts," this argument sounds in Patent Owner's previously raised *Fintiv* argument for discretionary denial and does not warrant a § 316(a)(11) extension for the same reasons. **Second**, regarding an extension of Due Dates 1-3, Petitioners wish to avoid creating a new conflict with the district court schedule that is currently in flux, and therefore believe that waiting another week to potentially receive greater clarity from the court on the parties' alternative schedule proposals will allow the parties to better avoid a scheduling conflict. After receiving clarity from the court, and assuming it avoids a conflict with either Due Date 1 and Due Date 2, Petitioners are open to an equal 30-day net enlargement of both Due Date 1 and Due Date 2 in accordance with the chart below. Patent Owner previously seemed receptive to the dates in the chart below. Waiting one week before stipulating to these dates is prudent and feasible, given that Patent Owner still has more than five weeks before its currently scheduled Response deadline.

Due Date	Current Deadline	Petitioner Proposal
1	4/26/23	5/26/23 (30 day ext.)
2	7/19/23	9/17/23 (60 day ext.)
3	8/30/23	10/20/23 (51 day ext.)
4	9/20/23	9/20/23 (cannot extend)
5	10/11/23	10/13/23 (2 day ext.)
6	10/18/23	10/20/23 (2 day ext.)
7	10/25/23	10/25/23 (cannot extend)
8	11/2/23	11/2/23 (cannot extend)

Counsel for Petitioners

Andrew Baluch

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From: Jason Linger <jlinger@glaserweil.com>

Date: Friday, March 17, 2023 at 5:00 PM

To: trials@uspto.gov <trials@uspto.gov>

Cc: Stephen Underwood <sunderwood@glaserweil.com>, Lawrence Hadley <lhadley@glaserweil.com>, Andrew Baluch <baluch@smithbaluch.com>, Matthew Smith <smith@smithbaluch.com>, kirstin.stolldebell <kirstin.stolldebell@faegredrinker.com>, carrie.beyer <carrie.beyer@faegredrinker.com>

Subject: Google/Microsoft v. Hafeman, IPR2022-01188, -01189, -01190, -01191, -01192, -01193

Dear Honorable Board,

Patent Owner respectfully requests authorization, in the six IPR matters referenced above, (1) to file a request for rehearing of the institution decisions to address two changes in circumstances; and (2) for an extension of the deadlines in the Scheduling Order.

Patent Owner's Position

Issue 1: Patent Owner requests authorization to file a request for rehearing of the institution decisions to address two developments: (1) the Director's February 27, 2023 precedential decision in *CommScope v. Dali Wireless*; and (2) LG's February 6, 2023 motion for summary judgment of invalidity ("MSJ") in the District Court that violates LG's *Sotera* stipulation by making the same invalidity challenge, based on an alleged lack of priority/written description, in both IPR and District Court.

There is good cause to extend the time to seek rehearing, and consideration would be in the interests of justice, because LG's MSJ raises serious "concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB," and the *CommScope* decision issued after the rehearing deadline had passed.

Issue 2: Patent Owner's Response is currently due on April 26, 2023, the same day that trial is scheduled to begin in the District Court. Patent Owner believes an extension of the POR deadline (and a corresponding extension for the remaining briefing) is warranted so that counsel can adequately prepare for trial and prepare its POR. An extension is also warranted because there is near-complete overlap in the IPR and District Court on the priority/written description challenge, and the District Court's ruling on this issue in the next couple of months will impact this IPR, including how Patent Owner would address this issue in its POR.

Thus, Patent Owner respectfully requests a six-month extension of all deadlines, including

the final written decision, pursuant to 35 U.S.C. § 316(a)(11). Given the facts above, there is good cause for the extension to avoid “conflicting decisions and duplicative efforts.” Alternatively, Patent Owner requests a 50-day extension of Due Dates 1-3, a 5-day extension for Due Date 5, and a 2-day extension for Due Date 6.

The parties have met and conferred, and Petitioners oppose both requests. Petitioners stated that they would not “entertain[] any adjustments to the IPR schedule” unless Patent Owner would agree to push back the pretrial conference, currently scheduled for April 5, until May or June, and delay the district court trial, currently scheduled for April 26, until Q4 of 2023. Patent Owner cannot accept the request to push back the District Court’s pretrial conference and trial date—not only because it would delay a trial that has been scheduled for years, but also because extending both the IPR deadlines and trial date would simply push the same conflicts to a later date.

Petitioners’ Position

Patent Owner’s rehearing request was due February 14. 37 C.F.R. 42.71(d)(1). Petitioners oppose authorization for a belated rehearing request. First, the *CommScope* decision is not a “change[] in circumstances” because it did not change the law or analytical framework involving *Sotera* stipulations. Rather, *CommScope* involved only the “compelling merits” factor (factor 6 of *Fintiv*). In the instant proceedings, the Board declined to exercise its discretion under *Fintiv* in view of a *Sotera* stipulation (factor 4 of *Fintiv*) and thus did not violate *CommScope*’s directive to address factor 6 last. Second, LG’s MSJ is not a “change[] in circumstances” at least because it was filed on February 6, more than a week before Patent Owner’s rehearing deadline of February 14. In any event, LG’s MSJ does not violate LG’s *Sotera* stipulation because the stipulation is limited to “grounds” that were raised or reasonably could have been raised in these IPRs, whereas the “priority/written description” issues in LG’s MSJ are relevant to prior art defenses in the litigation based solely on system prior art (not printed prior art).

The Parties’ Availability for a Conference Call

Monday, March 20, 12-5 Eastern
Tuesday, March 21, 12-3 pm Eastern

Please let me know me if the Board would like additional dates and times in which the parties are available for the conference call.

Respectfully submitted,
Jason Linger
Counsel for Patent Owner Carolyn W. Hafeman

Glaser Weil

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