

From: Usman Khan <khan@fr.com>
Sent: Tuesday, May 30, 2023 9:25 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR19688-0196IP1 <IPR19688-0196IP1@fr.com>; IPR19688-0196IP2 <IPR19688-0196IP2@fr.com>; IPR19688-0197IP1 <IPR19688-0197IP1@fr.com>; IPR19688-0197IP2 <IPR19688-0197IP2@fr.com>; Michael Stanwyck <stanwyck@fr.com>; Jeremy Monaldo <Monaldo@fr.com>; Andy Schwentker <schwentker@fr.com>; Ben Christoff <christoff@fr.com>; MTRenaud@mintz.com; WAMeunier@mintz.com; kcamendt@mintz.com
Subject: IPR2023-00228, IPR2023-00229, IPR2023-00319, IPR2023-00320 (LGE v Constellation IPRs) - Requesting Authorization for submitting pre-institution brief

Your Honors:

Petitioner requests authorization to submit a pre-institution Petitioner Reply in response to Patent Owner's Preliminary Responses in IPR2023-00228, IPR2023-00229, IPR2023-00319, IPR2023-00320 with respect to the '700 and '509 patents. Petitioner reached out to Patent Owner, who has indicated that Patent Owner objects.

Good cause exists for requesting additional briefing in IPR2023-00228 because Petitioner could not have reasonably anticipated that Patent Owner would rely on testimony of Dr. Guillén i Fàbregas that is inconsistent with the DeGaudenzi reference. Similarly, good cause exists for requesting additional briefing in IPR2023-00229 because Petitioner could not have reasonably anticipated that Patent Owner would rely on testimony of Dr. Bauch that is inconsistent with Dr. Bauch's other paper (EX2017) introduced by Patent Owner. With the benefit of additional briefing, the Board will be in a better position to determine the merits of the arguments and evidence presented by both sides. Petitioner believes 7 pages of briefing in each of IPR2023-00228 and IPR2023-00229 would be sufficient, and would not oppose a responsive briefing by Patent Owner of the same length, if the Board grants Petitioner authorization to file a Petitioner pre-institution reply brief.

Good cause exists for requesting additional briefing in IPR2023-00319 and IPR2023-00320 because it was not possible for Petitioner to foresee how Patent Owner would mischaracterize the 777 Patent disclosure (particularly 12:11-37) and to address Patent Owner's conflation of the obviousness and written description requirements. Petitioner believes 5 pages of briefing in each of IPR2023-00319 and IPR2023-00320 would be sufficient, and would not oppose a responsive briefing by Patent Owner of the same length, if the Board grants Petitioner authorization to file a Petitioner pre-institution reply brief.

Petitioner's counsel has conferred with Patent Owner's counsel who provide the remarks in the paragraphs below.

Patent Owner opposes Petitioner's request. Further, Petitioner's email improperly includes arguments regarding whether there is good cause for this additional briefing. *See, e.g., Polygroup Ltd v. Willis Elec. Co.*, IPR2016-01610, Paper 39, 3 (PTAB Feb. 27, 2017) ("Email correspondence between the parties and the Board is for administrative purposes only" and "must not include arguments"). To the extent the Board considers these substantive arguments, Patent Owner responds as follows.

IPR2023-00228, -00229, -000319. -00320
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With respect to IPR2023-00228 and IPR2023-00229, to the extent that Petitioner asserts that declarants Dr. Guillén i Fàbregas and Dr. Gerhard Bauch mischaracterize their own respective publications, the Board has the underlying exhibits and can easily discern the voracity of that assertion themselves. No alleged “mischaracterization” of references supports additional briefing. Dell Inc. v. Neo Wireless LLC, IPR2021-01468, Paper 10, 3 (Jan. 27, 2022) (“The Board routinely determines whether a party mischaracterizes the asserted references or the other party’s arguments without the need for additional briefing.”).

With respect to IPR2023-00319 and IPR2023-00320 to the extent that Petitioner asserts that it was unforeseen that Patent Owner would provide argument on the challenged patents’ disclosure, Petitioner had ample opportunity to provide its characterization of the challenged patents’ disclosure. Indeed, Petitioner devoted no less than 22 pages of each Petition to characterizing the challenged patents. See IPR 2023-00319, Paper 3, 3-27; IPR2023-00320, Paper 3, 3-25. No further opportunity is necessary now. Further, the Board has the underlying exhibits and is well suited to assess the disclosure of the challenged patents such that no further briefing is required.

If the Board grants additional briefing, Patent Owner respectfully requests the same number of pages as Petitioner, that is Patent Owner requests 7 pages of briefing in each of IPR2023-00228 and IPR2023-00229, and 5 pages of briefing in each of IPR2023-00319 and IPR2023-00320.

If the Board would like to schedule a call to discuss this request, the parties are available at the following times:

- Wednesday, May 31, 2023 at 3:00-4:00 pm ET
- Thursday, June 1, 2023 at 10:00am – 11:00am or 3:00-4:00 pm ET
- Friday, June 2, 2023 at 2:30 pm – 4:00 pm ET

Sincerely,

Usman A. Khan, Ph.D., Esq.

Fish & Richardson P.C.
1000 Maine Ave., SW
Suite 1000
Washington, DC 20024
202.626.6383 direct :: khan@fr.com
fr.com :: [Bio](#) :: [LinkedIn](#)

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