

Date:

Tuesday, April 9, 2024 11:13:46 AM

From: Kenneth Darby <kdarby@fr.com>

Sent: Friday, April 5, 2024 6:21 PM

To: Andrew Patrick <patrick@fr.com>; Trials <Trials@USPTO.GOV>; AXF-PTAB <AXF-PTAB@fr.com>; Todd <todd@fitziplaw.com>

Cc: Usman Khan <khan@fr.com>; Gregory Cordrey <GCordrey@JMBM.com>; Matthew.Satchwell@dlapiper.com; brent.yamashita@dlapiper.com; chris.duerden@us.dlapiper.com; erika.arnier@finnegan.com; cory.bell@finnegan.com; yanyi.liu@finnegan.com; yinan.liu@finnegan.com

Subject: RE: IPR2023-00242, -00343, -0344 = re Reexams 90/019,353, 90/019,351, 90/019,352

Your Honors:

In response to the Board's email of March 28, 2024, the parties have twice met and conferred to discuss how the Office should proceed with respect to the reexaminations of the '048, '654, and '868 patents (90/019,353, 90/019,351, 90/019,352). The parties jointly provide the following reply.

Specifically, and with respect to each of the three proceedings:

- Patent Owner SpaceTime3D's position is that the reexaminations should be immediately stayed at least up to the issuance of the Final Written Decisions of the corresponding IPRs. Accordingly, SpaceTime3D seeks the Board's authorization to file a motion to request an immediate stay of the reexaminations.
- Petitioner Apple opposes an immediate stay of all reexaminations, but would support a stay of a given reexamination if, and only if, the Board's corresponding Final Written Decision renders unpatentable all challenged claims. Apple does not oppose SpaceTime3D's request to file a motion to stay if Apple is similarly authorized to submit an opposition to that motion consistent with 37 CFR §§ 42.23 and 42.24.
- Google joins Apple's position.

Should the Board wish to conduct a call, the parties are jointly available at the following times:

- Tuesday (4/9) after 11:00 am Eastern;
- Wednesday (4/10) after 3:30 pm Eastern;
- Thursday (4/11) after 4:00 pm Eastern; and
- Friday (4/12) after 11:00 am Eastern.

Respectfully,

Karl Renner (lead counsel), Kenneth Darby, Andrew Patrick, Usman Khan on behalf of

Petitioner Apple
Greg Cordrey on behalf of Patent Owner SpaceTime3D
Cory Bell on behalf of Joint Petitioner Google

From: Andrew Patrick <patrick@fr.com>
Sent: Thursday, March 28, 2024 4:35 PM
To: Trials <Trials@USPTO.GOV>; AXF-PTAB <AXF-PTAB@fr.com>; Todd <todd@fitziplaw.com>
Cc: Kenneth Darby <kdarby@fr.com>; Usman Khan <khan@fr.com>; Gregory Cordrey <GCordrey@JMBM.com>; Matthew.Satchwell@dlapiper.com; brent.yamashita@dlapiper.com; chris.duerden@us.dlapiper.com; erika.arnier@finnegan.com; cory.bell@finnegan.com; yanyi.liu@finnegan.com; [yanan.liu@finnegan.com](mailto:yinan.liu@finnegan.com)
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Thank you your Honors. The parties will meet and confer and offer times of joint availability upon doing so.

Respectfully,

Andrew Patrick
Counsel for Petitioner Apple

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, March 28, 2024 11:28 AM
To: AXF-PTAB <AXF-PTAB@fr.com>; Todd <todd@fitziplaw.com>
Cc: Andrew Patrick <patrick@fr.com>; Kenneth Darby <kdarby@fr.com>; Usman Khan <khan@fr.com>; Gregory Cordrey <GCordrey@JMBM.com>; Matthew.Satchwell@dlapiper.com; brent.yamashita@dlapiper.com; chris.duerden@us.dlapiper.com; erika.arnier@finnegan.com; cory.bell@finnegan.com; yanyi.liu@finnegan.com; [yanan.liu@finnegan.com](mailto:yinan.liu@finnegan.com); Trials <Trials@USPTO.GOV>
Subject: IPR2023-00242, -00343, -0344 = re Reexams 90/019,353, 90/019,351, 90/019,352

[This email originated outside of F&R.]

Counsel,

The Board has been made aware of the following three Reexams Orders, mailed on March 25, 2024, involving patents that are the subject of IPR2023-00242, -00343, -0344 as follows:

- 90/019,351** [US 9,304,654]
 - IPR2023-00343 joined with IPR2023-00579
- 90/019,352** [US 9,696,868]
 - IPR2023-00344 joined with IPR2023-00578
- 90/019,353** [US 8,881,048]
 - IPR2023-00242 joined with IPR2023-00577

The parties should confer and respond to this email with dates and times they are available to discuss with the Board how the Office should proceed with these reexams.

Also, the parties shall update their mandatory notices.

Regards,

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

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