

From: Trials <Trials@USPTO.GOV>
Sent: Monday, June 26, 2023 1:36 PM
To: Usman Khan; Amendt, Kevin; Trials
Cc: IPR19688-0196IP1; IPR19688-0196IP2; IPR19688-0197IP1; IPR19688-0197IP2; Michael Stanwyck; Jeremy Monaldo; Andy Schwentker; Ben Christoff; Renaud, Michael; Meunier, William
Subject: RE: (IPR2023-00228, IPR2023-00229, IPR2023-00319, IPR2023-00320) LGE v Constellation 700 and 509 Patent IPRs - Patent Owner Outreach to the Board for Authorization to Submit Supplemental Pre-institution Brief

Dear Counsel,

From the Board –

Patent Owner is authorized to file, in the above referenced cases, any documents from the related district court litigation relevant to a *Fintiv* analysis. These documents should be filed as exhibits. Patent Owner may also file a 1 page *Fintiv* Paper, **limited** to identifying in bullet-points: the *Fintiv* factor and a citation to relevant evidence. Thus, the *Fintiv* Paper **may not** include any argument or discussion of the *Fintiv* factors, characterizations of the evidence, etc.

All filings authorized by this email are due by Thursday, June 29, 2023.

Regards,

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

From: Usman Khan <khan@fr.com>
Sent: Friday, June 23, 2023 4:55 PM
To: Amendt, Kevin <KCAmendt@mintz.com>; 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
Subject: RE: (IPR2023-00228, IPR2023-00229, IPR2023-00319, IPR2023-00320) LGE v Constellation 700 and 509 Patent IPRs - Patent Owner Outreach to the Board for Authorization to Submit Supplemental Pre-institution Brief

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Your Honors:

Pursuant to Petitioner's remarks in Patent Owner's email request yesterday, Petitioner hereby provides its response to Patent Owner's request for authorization to submit a supplemental pre-institution brief.

Petitioner opposes Patent Owner's request for at least the following reasons.

- (1) Patent Owner's request is untimely. Patent Owner has been aware of the change in the trial schedule since at least April 25 when the court issued its second amended docket control order. Between April 25 and June 14 (the date when Patent Owner's counsel reached out to Petitioner's counsel), the parties reached out to the Board regarding Petitioner's request for additional briefing and even conducted a conference call with the Board on June 1 to discuss the same. Patent Owner never raised this issue when approached by Petitioner or during the call with the Board. By waiting nearly two months and seeking briefing less than a month prior to the institution deadline, Patent Owner's conduct has prejudiced Petitioner and leaves the parties and the Board inadequate time to consider Patent Owner's request.

Patent Owner attempts to justify its delay by pointing to a June 8 filing in which Petitioner continued to assert the same invalidity grounds that were previously included in Petitioner's expert report submitted in March 2023. The June 8 filing did not introduce any changes in the district court proceedings that would support **Patent Owner's incorrect assertion that** "Petitioner/Defendant LG recently informed Patent Owner for the first time (on June 8, 2023) that it intends to assert and rely on at trial prior art that falls within the scope of its stipulation despite the new earlier trial date." In the district court proceedings, Patent Owner has yet to disclose its final election of asserted claims and Petitioner has until June 28 to identify its final invalidity theories to be presented at trial. **Until June 28, the grounds and claims that will be at issue in the district court trial remain in flux.**

- (2) Any request to disregard the *Sotera* stipulation and encourage the Board to discretionarily deny the petitions directly contradicts Director Vidal's guidelines (see USPTO Memo dated June 21, 2022), which explicitly noted that the Board cannot discretionarily deny a petition when Petitioner submits a *Sotera* stipulation. Petitioner's stipulation is the same as the stipulation in *Sotera* and Director Vidal's guidance had no exceptions.

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

- 1. Monday, June 26 at 10AM-1PM ET
- 2. Tuesday, June 27 at 10-11AM, 2-3PM, 430-5PM ET

Sincerely,

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

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From: Amendt, Kevin <KCAmendt@mintz.com>

Sent: Thursday, June 22, 2023 4:24 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; Amendt, Kevin <KCAmendt@mintz.com>

Subject: (IPR2023-00228, IPR2023-00229, IPR2023-00319, IPR2023-00320) LGE v Constellation 700 and 509 Patent IPRs - Patent Owner Outreach to the Board for Authorization to Submit Supplemental Pre-institution Brief

[This email originated outside of F&R.]

Your Honors:

Patent Owner requests authorization to submit a supplemental pre-institution brief in IPR2023-00228, IPR2023-00229, IPR2023-00319, and IPR2023-00320 to address *Fintiv* due to changed circumstances. Patent Owner first reached out to Petitioner June 14th about this request. After numerous correspondence and a meet and confer, Petitioner will provide a response tomorrow for the reasons explained by Petitioner below.

The request for additional briefing in each IPR is to address *Fintiv* and is warranted because of changed circumstances. The scheduled trial date of the related district court litigation has moved to July 5, 2023, which is before the deadline for decisions on institution in these IPRs. The Petitioner's prior *Sotera*-style stipulations not to pursue, in the District Court proceedings, the grounds asserted in these IPR petitions or any other ground that was or could have been reasonable raised by LG in an IPR are thus rendered meaningless by these changed circumstances because Petitioner/Defendant LG recently informed Patent Owner for the first time (on June 8, 2023) that it intends to assert and rely on at trial prior art that falls within the scope of its stipulation despite the new earlier trial date. (See LG Stipulations, IPR2023-00228, EX1012; IPR2023-00229, EX1021; IPR2023-00319, EX1012; IPR2023-00320, EX1021). Accordingly, prior to any institution decision in these IPRs, LG will have already presented in the earlier District Court trial the grounds it had stipulated it would not be pursuing in that trial, including art specifically relied upon in some of LG's asserted IPR grounds.

Since this change in schedule of the District Court trial that renders Petitioner's *Sotera*-style stipulations meaningless occurred after Patent Owner submitted its Preliminary Responses (POPR), Patent Owner did not have the opportunity to address *Fintiv* in the POPRs and respectfully requests authorization to submit a 5 page brief in each of IPR2023-00228, IPR2023-00229, IPR2023-00319, and IPR2023-00320 to address *Fintiv*.

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

Petitioner's counsel received an email from Patent Owner's counsel on June 22 including the contents above with an indication that Patent Owner's counsel intends to send the Board an email *less than three hours after sending an email to Petitioner's counsel.* The imposed deadline did not allow Petitioner to develop a full response to Patent Owner's email particularly in light of a meet and confer conducted earlier the same day between the parties in which Petitioner raised concerns over Patent Owner's incorrect representations to the Board and the untimeliness of Patent Owner's request. Petitioner had provided an initial response as early as June 16 to Patent Owner's initial email on June 14. Responsive to Petitioner's email, Patent Owner modified its email draft to the Board to include what Petitioner believes is an incorrect characterization of the litigation proceedings. Petitioner then responded to Patent Owner's modified email draft with a request for a meet and confer to discuss the incorrect characterization, and the meet and confer was finally conducted today. The same day (today) after the meet and confer, Patent Owner emailed Petitioner with a partial draft of this email and informing Petitioner that Patent Owner will email the Board by 4 pm EST (less than three hours

later). Consequently, and unless the Board objects, Petitioner will send a responsive email by tomorrow, June 23, 2023 in which Petitioner provides its position in response to Patent Owner's request for additional briefing.

Sincerely,

Kevin Amendt
Member

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