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Subject: RE: Microsoft v. LiTL, IPR2024-00457 - Request for Authorization for Preliminary Reply
Date: Tuesday, June 25, 2024 8:28:55 AM

Counsel:

The panel will accept the parties' proposed stipulation that the outcome on the privity issue in IPR2024-00456 will also apply to this proceeding. Such a stipulation would allow efficiency of Board resources. Please file a stipulation in the record.

With regard to 325(d), the panel determines that additional briefing on the issue would be helpful. Petitioner may file a 10 page reply within ten days of this authorization addressing only the Section 325(d) issues that the Patent Owner's preliminary response raised. Patent Owner may file a 10 page sur-reply within ten days of Petitioner's reply. Petitioner should include this authorizing e-mail as an exhibit to the reply brief.

Regards,

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

From: Kaiser, Jessica (Perkins Coie) <JKaiser@perkinscoie.com>
Sent: Monday, June 24, 2024 5:12 PM
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Subject: Microsoft v. LiTL, IPR2024-00457 - Request for Authorization for Preliminary Reply

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Dear Honorable Board,

Petitioners respectfully request authorization to file a preliminary reply limited to the issues of privity (POPR, 2–13) (to the extent the Board prefers briefing over the parties' proposed stipulation

on privity explained below) and discretionary denial under 35 USC § 325(d) (POPR, 17–31). Good cause exists for a preliminary reply because, for example, Petitioners could not have anticipated (1) the privity arguments Patent Owner would make, particularly when Microsoft explained in the Petition that Lenovo did not request indemnity for the patent at issue in this proceeding (Pet., 11), and (2) Patent Owner’s characterization of the prior art used in previous challenges to the ’715 Patent by a different entity, particularly when Microsoft explained in the Petition that none of the same or substantially the same art or arguments were previously presented to the Office for consideration (Pet., 14-15).

To avoid including unnecessary argument in this email to the Board, Petitioners do not detail here the specific unanticipated privity and § 325(d) arguments or the merits of them, but Petitioners can discuss further on a conference call if the Board deems additional detail necessary to determine whether to authorize a preliminary reply.

Petitioners note that the Board authorized a 10-page preliminary reply in IPR2024-00456 to address a similar privity issue and a 10-page preliminary reply in IPR2024-00458 to address relevance of the ’715 Patent proceedings. Both of those issues are implicated here (with the prior ’715 proceedings now discussed in the context of Section 325(d)).

As to privity, if the Board prefers, the parties have conferred and are willing to stipulate that the outcome on privity in IPR2024-00456 will also apply to this proceeding. Under this approach, no further briefing on privity would be necessary. Alternatively, if the Board prefers additional briefing on privity in this proceeding, Petitioners seek 10 pages to address privity in a preliminary reply and do not oppose Patent Owner being authorized the same number of pages as to this issue in a preliminary sur-reply. Patent Owner opposes Petitioners’ request for briefing on the privity issue because another round of briefing on the privity issue is unnecessary given that the facts and issues are the same as in the IPR2024-00456 proceeding where briefing on the privity issue is complete, and given that the parties have agreed to stipulate that the outcome on privity in IPR2024-00456 will apply to this proceeding. Patent Owner believes it would be a waste of resources for the parties and the Board to have another round of duplicative briefing, which would require the filing of sealed and public/redacted versions of Petitioners’ reply and Patent Owner’s surreply as well as motions to seal both briefs.

As to 325(d), Petitioners seek 10 pages to address Section 325(d) in this proceeding (the same number of pages the Board authorized in IPR2024-00458 to address the relevance of the prior ’715 patent proceedings) and do not oppose Patent Owner being authorized the same number of pages as to this issue in a preliminary sur-reply. Patent Owner opposes Petitioners’ request as to Section 325(d) because, according to Patent Owner, there is no good cause for Petitioners to belatedly seek to meet their burden of demonstrating that “substantially the same” art and arguments were not previously presented to the Office during the prior reexamination of the ’715 Patent. According to Patent Owner, Petitioners should have addressed this in the Petition, which never addresses the prior art and arguments presented to the Office during the reexamination.

In sum:

- If the Board agrees the privity issue will be governed by the result on that issue in the -456

matter without additional privity briefing in this proceeding, Petitioners seek 10 pages for their preliminary reply limited to Section 325(d) and to file it within two weeks of receiving authorization. Petitioners do not oppose Patent Owner being authorized to file a preliminary sur-reply of equal length to be filed within two weeks of the preliminary reply being filed and limited to the issue raised in the preliminary reply. Patent Owner opposes additional briefing for the reasons above.

- If the Board prefers privity briefing here (so the record in this proceeding stands alone), Petitioners seek 20 pages for their preliminary reply limited to privity and Section 325(d) and to file it within two weeks of receiving authorization. Petitioners do not oppose Patent Owner being authorized to file a preliminary sur-reply of equal length to be filed within two weeks of the preliminary reply being filed and limited to the issues raised in the preliminary reply. Patent Owner opposes additional briefing on Section 325(d) for the reasons above.

If the Board wishes to have a conference call, the parties can confer and propose times of mutual availability.

Best regards,

Jessica Kaiser | Perkins Coie LLP

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