

From: [Trials](#)
To: [Andrew Patrick](#)
Cc: [Karl Renner](#); [Usman Khan](#); [Kenneth Darby](#); [Todd](#); [gxc@jmbm.com](#); [Trials](#)
Subject: RE: Request for Reply briefing in Apple Inc. (Petitioner) v. SpaceTime3D, Inc. (Patent Owner), Case Nos. IPR2023-00242, -00343, -00344
Date: Thursday, May 4, 2023 1:45:42 PM

Counsel,

From the Board –

We grant Petitioner’s request for authorization to file a Reply in each of IPR2023-00242, IPR2023-00343, and IPR2023-00344 directed to Patent Owner’s arguments in its Patent Owner’s Preliminary Response (“POPR”) related to discretionary denial of institution under 35 U.S.C. § 325(d) and the claim term “replacing.” We also grant Patent Owner permission to file a Sur-reply responding to Petitioner’s Reply.

Petitioner states that Patent Owner indicates “without further explanation that ‘Patent Owner would oppose such a request as there is no ‘good cause’ for the same.’” However, after reviewing the records in each of said IPRs, we find that clarification of the parties’ positions on the two matters - discretionary denial of institution under 35 U.S.C. § 325(d) and the claim term “replacing” – would facilitate the Board’s determination on whether to institute. For that reason, sufficient good cause exists to grant Petitioner’s request.

Accordingly:

Petitioner is authorized to file a 10-page Reply in each of IPR2023-00242, IPR2023-00343, and IPR2023-00344 directed to Patent Owner’s arguments in its POPR related to discretionary denial of institution under 35 U.S.C. § 325(d) and the claim term “replacing” within 5 business days from the date of this communication.

Patent Owner is authorized to file a 10-page Sur-reply in each of IPR2023-00242, IPR2023-00343, and IPR2023-00344 directed to Petitioner’s Reply within 5 business days from the date the Reply is filed.

If there are any questions, please contact the Board.

Regards,

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

From: Andrew Patrick <patrick@fr.com>
Sent: Tuesday, May 2, 2023 8:05 PM
To: Trials <Trials@USPTO.GOV>
Cc: Karl Renner <renner@fr.com>; Usman Khan <khan@fr.com>; Kenneth Darby <kdarby@fr.com>; Todd <todd@fitziplaw.com>; gxc@jmbm.com
Subject: Request for Reply briefing in Apple Inc. (Petitioner) v. SpaceTime3D, Inc. (Patent Owner), Case Nos. IPR2023-00242, -00343, -00344

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Your Honors,

Petitioner respectfully requests authorization for briefing in the form of a 10-page Reply to Patent Owner’s Preliminary Response (“POPR”) in each of IPR2023-00242, IPR2023-00343, and IPR2023-00344. If Petitioner’s request is granted, Petitioner does not oppose Patent Owner’s submission of equivalent Sur-Replies, and Petitioner respectfully submits that no new evidence should accompany either the Replies or Sur-Replies.

If this request is granted, the Replies would address POPR arguments urging discretionary denial of institution under 35 U.S.C. § 325(d), as well POPR arguments related to the “replacing” features recited by the challenged claims (e.g., as recited by the ‘048 patent’s independent claim 1, “replacing the first and second objects within the 3D space with a window within a two-dimensional (2D) space”). Petitioner respectfully submits that good cause for further briefing on these issues exists, at least because briefing would clarify the record of each implicated proceeding and aid the Board in deliberations on issues that are potentially dispositive to institution. For example, while the petitions preemptively address aspects of Patent Owner’s arguments, further briefing is warranted by Patent Owner’s reliance on implicit constructions related to the “replacing” features, and by Patent Owner’s arguments for discretionary denial based on art and arguments not previously addressed by the USPTO in connection with the challenged patents. If requested by the Board, Petitioner will provide further explanation of good cause.

In connection with this request, Petitioner proposes the briefing schedule outlined below:

IPR Proceeding	Preliminary Response Filed	Institution Deadline	Petitioner’s Reply Deadline	Patent Owner’s Sur-Reply Deadline
IPR2023-00242	3/23/23	6/23/23	Within 5 business days of the Board’s authorization	Within 5 business days of Petitioner’s Reply
IPR2023-00343	4/10/23	7/10/23	Within 5 business days of the Board’s authorization	Within 5 business days of Petitioner’s Reply
IPR2023-00344	4/19/23	7/19/23	Within 5 business days of the Board’s authorization	Within 5 business days of Petitioner’s Reply

Petitioner and Patent Owner have conferred, and Patent Owner opposes this request. More specifically, counsel for Patent Owner indicated without further explanation that “Patent Owner would oppose such a request as there is no ‘good cause’ for the same.”

Should the Board desire a call to discuss this request, the parties will confer and offer times of availability.

Respectfully,

Andrew Patrick
Counsel for Petitioner

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