

From: Jensen, Travis <tjensen@orrick.com>
Sent: Tuesday, December 3, 2019 8:04 PM
To: Trials; John Downing
Cc: Jonathan K. Waldrop; Rodney R. Miller; Herman, K. Patrick; T61PTABDocket; P52PTABDocket
Subject: RE: IPR2020-00019

Patent Trial and Appeal Board,

The district court issued its *Markman* order on Nov. 27, 2019 for U.S. Pat. 8,843,125 (the challenged patent in IPR2020-00019). The parties met and conferred on Nov. 25 and Dec. 3 regarding Apple's request to file a 5-page paper (and accompanying exhibits) that address how Apple contends the prior art satisfies one claim construction issued by the district court that was not proposed by either party. Fintiv opposes Apple's request. Apple requests a conference call with the Board to address this issue. The parties are available for a call with Board on Wednesday (Dec. 4), Thursday (Dec. 5), and Friday (Dec. 6) before 3pm ET. Thanks, Travis

Travis M. Jensen
Partner, IP Litigation

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From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, November 26, 2019 12:11 PM
To: John Downing <JDowning@kasowitz.com>; Jensen, Travis <tjensen@orrick.com>; Trials <Trials@USPTO.GOV>
Cc: Jonathan K. Waldrop <JWaldrop@kasowitz.com>; Rodney R. Miller <RMiller@kasowitz.com>; Herman, K. Patrick <pberman@orrick.com>; T61PTABDocket <T61PTABDocket@orrick.com>; P52PTABDocket <P52PTABDocket@orrick.com>
Subject: RE: IPR2020-00019

Dear Counsel,

The panel does not view this as a matter requiring immediate attention such that normal procedures for requesting a call with the Board cannot be followed. See Consolidated Trial Practice Guide 9-10. Accordingly, the panel instructs the parties to meet and confer and attempt to reach agreement on Petitioner's request so that further communications with the panel on this issue can be as productive as possible. In future communications, the parties should indicate whether there is agreement on the request or not, and what times both parties are available to meet should a call be necessary. In complying with these instructions the parties are directed to 37 C.F.R. 42.100(b), which states that the Office will consider any claim construction determination in a civil action that is timely made of record in the proceeding

Regards,

Andrew Kellogg,
Supervisory Paralegal

Patent Trial and Appeal Board
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From: John Downing <JDowning@kasowitz.com>
Sent: Sunday, November 24, 2019 10:38 PM
To: Jensen, Travis <tjensen@orrick.com>; Trials <Trials@USPTO.GOV>
Cc: Jonathan K. Waldrop <JWaldrop@kasowitz.com>; Rodney R. Miller <RMiller@kasowitz.com>; Herman, K. Patrick <pherman@orrick.com>; T61PTABDocket <T61PTABDocket@orrick.com>; P52PTABDocket <P52PTABDocket@orrick.com>
Subject: RE: IPR2020-00019

Patent Trial and Appeal Board:

Patent Owner in the below referenced action, Fintiv, is available for a call with the Board on Tuesday (12/3) before 2:30pm EST, Wednesday (12/4), Thursday (12/5), and Friday (12/6).

We are not available on the days referenced by Apple's counsel below. Our team has reached out to Apple's counsel to schedule a meet-and-confer to coordinate mutually agreeable times for a conference with the Board and learn about the scope of Apple's proposed amendments.

Thanks,

John

John Downing
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From: Jensen, Travis [<mailto:tjensen@orrick.com>]
Sent: Friday, November 22, 2019 1:53 PM
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Subject: IPR2020-00019

****EXTERNAL EMAIL****

Patent Trial and Appeal Board,

Petitioner Apple Inc. wishes to notify the Board that the district court in *Fintiv, Inc. v. Apple Inc.*, Case No. 6:18-CV-372-ADA (W.D. Tex.) issued oral claim constructions for the claim terms at issue in IPR2020-00019. Apple requests a conference call with the Board to seek leave to file the forthcoming *Markman* Order as well as a 5-page paper (and accompanying exhibits) that address how Apple contends the prior art satisfies one claim construction issued by the district court that was not proposed by either party.

Apple is available Monday, Tuesday, and Wednesday of next week (Nov. 25-27) for a call. Despite Apple's requests, Fintiv has not provided its availability for a call with the Board. Thanks, Travis

Travis M. Jensen

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