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**From:** Jensen, Travis <tjensen@orrick.com>  
**Sent:** Tuesday, December 3, 2019 4:32 PM  
**To:** John Downing  
**Cc:** Jonathan K. Waldrop; Rodney R. Miller; Herman, K. Patrick; Fintiv  
**Subject:** RE: IPR2020-00019

**Follow Up Flag:** Follow up  
**Flag Status:** Flagged

Hi John,

On our call today you asked about any PTAB rules, etc. that support Apple's request. Section II.B.6 of the July 2019 Trial Practice Guide Update is informative on this subject and instructs that parties should submit district court *Markman* rulings "as soon as that determination becomes available. Preferably, the prior claim construction determination should be submitted with the petition, preliminary response, or response, along with explanations." Apple believe its request is consistent with the PTAB's guidance to submit *Markman* rulings, "along with explanations," at the earliest opportunity. Absent further input from Fintiv, Apple will send the email below to the Board at 6pm PT today. Thanks, Travis

#####

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.

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**From:** John Downing <JDowning@kasowitz.com>  
**Sent:** Tuesday, December 03, 2019 11:37 AM  
**To:** Jensen, Travis <tjensen@orrick.com>  
**Cc:** Jonathan K. Waldrop <JWaldrop@kasowitz.com>; Rodney R. Miller <RMiller@kasowitz.com>; Herman, K. Patrick <pherman@orrick.com>; Fintiv <Fintiv@kasowitz.com>  
**Subject:** RE: IPR2020-00019

Travis,

I will circulate a dial in shortly. We can make ourselves available Wednesday, Thursday and Friday, except 12-2pm pacific Thursday.

John

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**From:** Jensen, Travis [<mailto:tjensen@orrick.com>]  
**Sent:** Monday, December 2, 2019 2:20 PM

**To:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>  
**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; Fintiv <[Fintiv@kasowitz.com](mailto:Fintiv@kasowitz.com)>  
**Subject:** RE: IPR2020-00019

John,

Although we do not believe an additional meet and confer is necessary since the Board's email raised no new issues and you have not identified anything new or different that we haven't already discussed in the prior meet and confer, we are willing to join another call tomorrow at noon PT. Please circulate a calendar invite.

In the meantime, in view of Fintiv's stated opposition to Apple's proposal, we renew our request that you provide availability for a call with the Board this Wednesday-Friday. Thanks, Travis

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**From:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>  
**Sent:** Monday, December 02, 2019 2:56 PM  
**To:** Jensen, Travis <[tjensen@orrick.com](mailto:tjensen@orrick.com)>  
**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; Fintiv <[Fintiv@kasowitz.com](mailto:Fintiv@kasowitz.com)>  
**Subject:** RE: IPR2020-00019

Travis,

We believe another meet-and-confer is necessary in view of the Board's email. Please let us know if Apple disagrees.

John

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**From:** Jensen, Travis [<mailto:tjensen@orrick.com>]  
**Sent:** Friday, November 29, 2019 12:58 PM  
**To:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>  
**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; Fintiv <[Fintiv@kasowitz.com](mailto:Fintiv@kasowitz.com)>  
**Subject:** RE: IPR2020-00019

Hi John,

We now have the *Markman* order from the district court. We've already met and conferred and you have stated that Fintiv opposes Apple's proposal. Is there anything new or different that you believe we need to meet and confer about? If so, please let us know what it is and we can talk about it Tuesday at noon PT. What is your availability for a call with the Board next Wednesday-Friday? Thanks, Travis

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**From:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>  
**Sent:** Wednesday, November 27, 2019 10:06 AM  
**To:** Jensen, Travis <[tjensen@orrick.com](mailto:tjensen@orrick.com)>  
**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; Fintiv <[Fintiv@kasowitz.com](mailto:Fintiv@kasowitz.com)>  
**Subject:** RE: IPR2020-00019

Travis,

Fintiv opposes Apple's request for leave to amend its petition.

Per the Court's order below, we are free to meet and confer again Tuesday of next week between 11-2 PST. Please let us know if this works for you.

Thanks,

John

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**From:** Trials [<mailto:Trials@USPTO.GOV>]

**Sent:** Tuesday, November 26, 2019 12:11 PM

**To:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>; Jensen, Travis <[tjensen@orrick.com](mailto:tjensen@orrick.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; T61PTABDocket <[T61PTABDocket@orrick.com](mailto:T61PTABDocket@orrick.com)>; P52PTABDocket <[P52PTABDocket@orrick.com](mailto: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  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
Direct: 571-272-5366

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**From:** John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>

**Sent:** Sunday, November 24, 2019 10:38 PM

**To:** Jensen, Travis <[tjensen@orrick.com](mailto:tjensen@orrick.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; T61PTABDocket <[T61PTABDocket@orrick.com](mailto:T61PTABDocket@orrick.com)>; P52PTABDocket <[P52PTABDocket@orrick.com](mailto: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  
Kasowitz Benson Torres LLP  
333 Twin Dolphin Drive, Suite 200  
Redwood Shores, CA 94065  
Tel. (650) 453-5426  
Fax. (650) 362-9430  
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**From:** Jensen, Travis [<mailto:tjensen@orrick.com>]  
**Sent:** Friday, November 22, 2019 1:53 PM  
**To:** [Trials@uspto.gov](mailto:Trials@uspto.gov)  
**Cc:** Jonathan K. Waldrop <[JWaldrop@kasowitz.com](mailto:JWaldrop@kasowitz.com)>; Rodney R. Miller <[RMiller@kasowitz.com](mailto:RMiller@kasowitz.com)>; John Downing <[JDowning@kasowitz.com](mailto:JDowning@kasowitz.com)>; Herman, K. Patrick <[pherman@orrick.com](mailto:pherman@orrick.com)>; T61PTABDocket <[T61PTABDocket@orrick.com](mailto:T61PTABDocket@orrick.com)>; P52PTABDocket <[P52PTABDocket@orrick.com](mailto:P52PTABDocket@orrick.com)>  
**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**  
Partner, IP Litigation

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Silicon Valley   
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