

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, June 25, 2020 3:40 PM
To: Zhong, Annita; Cavanaugh, David; Trials
Cc: Sheasby, Jason; Wells, Maclain; #PanOptisIPRs [Int/Ext]; Kipnis, Jason; Haag, Joseph; Goldenberg, Richard; Sooter, Mindy; Deol, Ravi; Nemtzow, Alex
Subject: RE: Petitioner's Request for Reply to POPR in IPR2020-00642, IPR2020-00465, IPR2020-00466

EXTERNAL SENDER

Counsel,

A call is not necessary at this time. In light of the designation of the decision in *Apple v. Fintiv* as precedential, Petitioner is authorized to file an 8-page Reply to Patent Owner's Preliminary Response in each case on or before Thursday, July 2, 2020. Patent Owner is authorized to file a 4-page Sur-Reply in each case on or before Friday, July 10, 2020. Both the Reply and Sur-Reply shall be limited in scope to the issue addressed in *Apple v. Fintiv*, i.e., the six factors the Board considers in determining whether to exercise its discretion to institute review when there is a related proceeding pending in district court.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
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(571)272-7822

From: Zhong, Annita <HZhong@irell.com>
Sent: Wednesday, June 24, 2020 12:20 PM
To: Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Trials <Trials@USPTO.GOV>
Cc: Sheasby, Jason <JSheasby@irell.com>; Wells, Maclain <MWells@irell.com>; #PanOptisIPRs [Int/Ext] <PanOptisIPRs@irell.com>; Kipnis, Jason <Jason.Kipnis@wilmerhale.com>; Haag, Joseph <Joseph.Haag@wilmerhale.com>; Goldenberg, Richard <Richard.Goldenberg@wilmerhale.com>; Sooter, Mindy <Mindy.Sooter@wilmerhale.com>; Deol, Ravi <Ravi.Deol@wilmerhale.com>; Nemtzow, Alex <Alex.Nemtzow@wilmerhale.com>
Subject: RE: Petitioner's Request for Reply to POPR in IPR2020-00642, IPR2020-00465, IPR2020-00466

Dear Board,

As Patent Owner informed Petitioner, *Fintiv* factors were not new. This is made clear by the *Fintiv* decision, which cites to Consolidated Trial Practice Guide November 2019, *NHK* and a number of other cases issued before the petition filing date when summarizing the six factors. IPR2020-00019, Paper 11 at 5 ("When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board's decision have balanced the following factors") & n.7. Thus, it was foreseeable at the time of filing that such factors should be fully addressed. And Petitioner did attempt to address them, though half-heartedly. See IPR2020-00465 Pet. 8-9; IPR2020-00466 Pet. 5-6; IPR2020-00642 Pet. 6-7.

IPR2020-00465

In its email, Petitioner does not assert that any changed circumstance in the parallel proceeding justifies its request—as was the case in *Fintiv*. Nor can it, because if anything, the accelerated trial schedule would put the final written decisions even further after the end of the trial: Currently the trial is to start on August 3, 2020, making the FWDs due 13 months after the end of trial.

Nor is it fair for to Patent Owner that Petitioner should be able to give short shrift to the factors already enumerated in the trial practice guide and *NHK* (which was designated precedential long before the petitions were filed) and then give 8 pages to address those shortfalls. This would encourage petitioners to withhold arguments, review Patent Owner's responses and then craft answers to them. In this particular case, it would also allow Petitioner to add 8 pages to each of its petitions whose word counts were all near the 14,000 limit (13,995; 13,998; 13914 respectively). That is not how the whole IPR framework is intended to work.

Nevertheless, if the Board grants Petitioner's request, Patent Owner requests that it be also given the same page numbers in each proceeding to address Petitioner's arguments raised in the Replies.

Respectfully,

H. Annita Zhong
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From: Cavanaugh, David <David.Cavanaugh@wilmerhale.com>

Sent: Wednesday, June 24, 2020 7:42 AM

To: Trials <Trials@USPTO.GOV>

Cc: Zhong, Annita <HZhong@irell.com>; Sheasby, Jason <JSheasby@irell.com>; Wells, Maclain <MWells@irell.com>; #PanOptisIPRs [Int/Ext] <PanOptisIPRs@irell.com>; Kipnis, Jason <Jason.Kipnis@wilmerhale.com>; Haag, Joseph <Joseph.Haag@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Goldenberg, Richard <Richard.Goldenberg@wilmerhale.com>; Sooter, Mindy <Mindy.Sooter@wilmerhale.com>; Deol, Ravi <Ravi.Deol@wilmerhale.com>; Nemtzow, Alex <Alex.Nemtsov@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>

Subject: Petitioner's Request for Reply to POPR in IPR2020-00642, IPR2020-00465, IPR2020-00466

Dear Honorable Board:

The Patent Owner recently filed Patent Owner Preliminary Responses (POPRs) in the identified IPRs. In light of the recent precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB, March 20, 2020) (precedential), Petitioner respectfully requests leave to submit replies to the POPRs in the following proceedings to address the issue of discretionary institution denials under 35 U.S.C. § 314(a):

- IPR2020-00642
- IPR2020-00465
- IPR2020-00466

Petitioner has good cause for a Reply to address the *Fintiv* decision, which was decided and designated precedential after the Petitions were filed. Because Petitioner could not predict that the Board would issue such an intervening decision, basic fairness and due process provides good cause for a response. The Board has already permitted Replies to address *Fintiv* in other proceedings, and Petitioner believes the Board would benefit from supplemental briefing here.

Patent Owners oppose Petitioner's request, and state that the *Fintiv* factors were not new and Petitioner knew or should have known the need to address these factors. In addition, Patent Owners allege that the request amounts to a surreptitious attempt to evade the word limit on the Petitions.

Petitioner requests 8 pages, which would be due 5 business days after the request is authorized.

If the Board would like to schedule a conference call relating to this request, counsel for Petitioner and Patent Owner are available on Thursday, June 25th from 10:00 a.m. - 11:30 a.m. or 3:00 p.m. - 5:00 p.m. and Friday, June 26th from 10:00 a.m. - 12:00 p.m. (all Eastern Time).

Respectfully,

David Cavanaugh
Counsel for Petitioner

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