

Zhong, Annita

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, July 7, 2020 1:00 PM
To: Cavanaugh, David; Trials
Cc: Zhong, Annita; Sheasby, Jason; Wells, Maclain; #PanOptisIPRs [Int/Ext]; Kipnis, Jason; Haag, Joseph; Goldenberg, Richard; Sooter, Mindy; Deol, Ravi; Nemtzow, Alex
Subject: RE: IPR2020-00642, IPR2020-00465, IPR2020-00466

Counsel,

Patent Owner is authorized to file a 6-page sur-reply in IPR2020-00642 and an 8-page sur-reply in each of IPR2020-00465 and IPR2020-00466, due on July 10, 2020. Each sur-reply shall only (1) address the *Apple v. Fintiv* factors the Board considers in determining whether to exercise its discretion to institute review when there is a related proceeding pending in district court, and (2) respond to arguments raised in Petitioner's reply. The parties are reminded that the Board will not consider any arguments regarding the merits that were not raised in the Petition or the Preliminary Response. This authorization supersedes the Board's June 25 authorization for sur-replies in these cases. No further briefing or expanded page limits will be authorized.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Cavanaugh, David <David.Cavanaugh@wilmerhale.com>
Sent: Friday, July 3, 2020 9:23 PM
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>; 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: IPR2020-00642, IPR2020-00465, IPR2020-00466

Your Honors:

Petitioner opposes Patent Owners' request for additional pages. Should the Board find it helpful, Petitioner is prepared to explain why it opposes Patent Owners' request, either in an email or on a conference call.

Respectfully,

David L. Cavanaugh
Counsel for Petitioner

David L. Cavanaugh
WilmerHale
1875 Pennsylvania Ave. NW

Washington, DC 20006

On Jul 3, 2020, at 1:59 PM, Zhong, Annita <HZhong@irell.com> wrote:

EXTERNAL SENDER

Your Honors:

Patent Owner requests the Board to authorize 6 additional pages for each of its sur-replies (for a total of 10 pages each) to address improper content in Apple's replies filed yesterday in IPR2020-00465, -00466 and -00642. Patent Owner is available at the Board's convenience if the Board deems a call is necessary.

Specifically, when the Board authorized the replies, the Board specifically limited their "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." Petitioner Apple clearly exceeded the scope of reply authorized by Board, using the reply to: (1) address the constitutionality of the *Fintiv* decision; (2) responding substantively to the POPRs on the technical merits, in effect using the POPRs as a roadmap; (3) creating "new" facts, including announcing that it would alter the grounds of the IPR2020-00466 petition by dropping one of the asserted grounds in the petition and announcing in a cryptic letter sent less than 30 minutes before it filed the replies that it was going to drop certain grounds of invalidity in the district court for the patents involved in IPR2020-00465 and IPR2020-00466.

Patent Owner is entitled to fully address these new arguments, including the attempt to alter the petition long after the 315(b) statutory deadline. This would, however, require more than the 4 pages that the Board previously authorized. For example, Patent Owner needs the additional pages to fully explain (i) why Petitioner's technical counter-arguments are not found anywhere in the petition, (ii) why they are incorrect, (iii) why the grounds that Petitioner is now trying to abandon in the district court are actually cumulative of the remaining ground(s), (iv) why the tactic that Apple is attempting at the last minute of dropping grounds in the Petition and in the district court violates both the statute and Board regulations in addition to being ineffectual in the district court, where Patent Owner has not agreed to the removal of the relevant prior art from the case; and (v) why the constitutional argument has no merit.

Patent Owner has asked Petitioner whether it would object to the request for additional pages, and it has not responded. Given the deadline for the sur-replies (7/9/2020), Patent Owner has no choice but to seek Your Honors' guidance at the earliest opportunity.

Respectfully,

H. Annita Zhong
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067-4276
Telephone: (310) 203-7183
Fax: (310) 556-5385

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, June 25, 2020 12:40 PM
To: Zhong, Annita <HZhong@irell.com>; 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.Nemtzw@wilmerhale.com>
Subject: RE: Petitioner's Request for Reply to POPR in IPR2020-00642, IPR2020-00465, IPR2020-00466

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
andrew.kellogg@uspto.gov
(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.Nemtzw@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.

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
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90067-4276
Telephone: (310) 203-7183
Fax: (310) 556-5385

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

David L. Cavanaugh | WilmerHale

60 State Street 1875 Pennsylvania Avenue NW

Boston MA 02109 Washington, DC 20006 USA

+1 617 526 6036 (t) +1 202 663 6025 (t)

+1 617 526 5000 (f) +1 202 663 6363 (f)

david.cavanaugh@wilmerhale.com

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