

**From:** Trials Trials@USPTO.GOV  
**Subject:** RE: Apple v. Maxell; IPR No. 2020-00597  
**Date:** July 9, 2020 at 10:35 AM



**To:** Adam Seitz adam.seitz@eriseip.com, Trials Trials@USPTO.GOV  
**Cc:** FW-CLIENT-Maxell-Apple-Service Maxell-Apple-Service@mayerbrown.com, Siddiqui, Saqib SSiddiqui@mayerbrown.com, Barrow, William J. WBarrow@mayerbrown.com, Miranda, Luiz LMiranda@mayerbrown.com, Bonner, Amanda Streff ASBonner@mayerbrown.com, Fussell, Tripp JFussell@mayerbrown.com, Bakewell, Clark S. CBakewell@mayerbrown.com, Nese, Bryan BNese@mayerbrown.com, Paul Hart paul.hart@eriseip.com, Jennifer Bailey jennifer.bailey@eriseip.com, Chalynda Giles chalynda.giles@eriseip.com, ptab@eriseip.com, Robin Snader robin.snader@eriseip.com, Pluta, Robert G. RPluta@mayerbrown.com

Counsel,

A conference is not necessary. Petitioner is authorized to file a Reply of no more than 12-pages limited to addressing the *Fintiv* factors and the *Hulu* argument regarding Etchells and Casio, which must be filed no later than July 20, 2020. When addressing the *Finitiv* factors, the panel invites Petitioner to specifically address Patent Owner's contention that "there is no substantial difference between *Casio* used [in the Petition] and Sony used in the District Court Action." Paper 6, 11. In addition, when addressing the *Finitiv* factors, the panel invites Petitioner to address what, if any, material differences exist between the facts presented in this case and those presented in the related IPR2020-00203 matter. Patent Owner is authorized similarly to file a Sur-Reply of no more than 12-pages limited to addressing the arguments made in Petitioner's Reply, which must be filed no later than July 31, 2020. Finally, Petitioner's Reply should refer to this email as authorization for the filing and the email should be included as an exhibit.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
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**From:** Adam Seitz <adam.seitz@eriseip.com>  
**Sent:** Wednesday, July 8, 2020 4:55 PM  
**To:** Trials <Trials@USPTO.GOV>  
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To the Board:

I am writing on behalf of Petitioner Apple Inc. regarding IPR No. 2020-00597. In nine prior

In its between Apple and Maxell, the Board permitted the parties to file 10-page replies and sur-replies to the Patent Owner Preliminary Responses (POPRs) addressing the *Fintiv* factors. Apple seeks leave in this IPR to file a reply to Maxell's POPR addressing *Fintiv* and for Maxell to file a sur-reply as has been permitted previously. Maxell does not oppose this portion of Apple's request.

Apple also separately requests leave to file an additional two-pages in its reply directed towards Maxell's argument in its POPR relating to the Etchells Declaration (Ex. 1007). In its POPR, Maxell advances an argument that the Board's precedential decision in *Hulu* requires Apple to submit communications from Casio to Etchells to meet its burden establishing the Casio reference is prior art. POPR, 38-40. Because Maxell's argument rests on a legal requirement that does not exist within *Hulu* or elsewhere, Apple could not have foreseen this argument when drafting its petition. As such, Apple additionally requests two pages in the reply and sur-reply to address this issue. Maxell does not oppose this portion of Apple's request.

In sum, both parties agree 12-page replies and sur-replies to the POPRs should be permitted to address the *Fintiv* factors and the *Hulu* argument regarding Etchells and Casio.

The Parties are available for a call with the Board at the following times:

Thursday, July 9 – Any time  
Monday, July 13 – Afternoon

Sincerely,

Adam Seitz  
Erise IP  
Counsel for Petitioner