

**From:** Trials trials@uspto.gov  
**Subject:** RE: Apple v. Parus; IPR Nos. 2020-  
**Date:** July 9, 2020 at 11:14 AM  
**To:** Adam Seitz adam.seitz@eriseip.com, Trials Trials@USPTO.GOV  
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Counsel,

Petitioner is authorized to file, in each of IPR2020-00686 and IPR2020-00687, a seven (7) page reply to the Preliminary Response limited to addressing the arguments in the Preliminary Response regarding the *Fintiv* factors. The replies are due by July 23, 2020. Patent Owner is authorized to file, in each case, a seven (7) page sur-reply to Petitioner's reply. The sur-replies are due August 6, 2020. The parties are not authorized to brief any other issues, such as claim construction, in the replies or sur-replies.

Regards,

Andrew Kellogg,  
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**From:** Adam Seitz <adam.seitz@eriseip.com>  
**Sent:** Wednesday, July 8, 2020 4:56 PM  
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**Subject:** Apple v. Parus; IPR Nos. 2020-

To the Board:

I am writing on behalf of Petitioner Apple Inc. regarding IPR Nos. 2020-00686 and 2020-00687. Apple seeks leave to file a 12-page reply to both of Patent Owner Preliminary Responses (Paper 6 in both proceedings). Specifically, Apple seeks leave to file 10 pages addressing the Board's recent precedential decision in *Apple v. Fintiv*, IPR2020-0019, Paper 11 (March 20, 2020). Apple also requests an additional 2-pages addressing Parus' claim construction argument on "instruction set" ascribing actions taken in the district court by another defendant to Apple.

Apple submitted its petitions in both proceedings on March 18, 2020. The precedential *Fintiv* decision subsequently issued on March 20, 2020. Given this timing, Apple was unable to address the *Fintiv* factors in its original petition. Parus, in its POPR, devotes 18 pages to arguing why the Board should exercise its discretion and deny the petition under the *Fintiv* factors. Parus also faults Apple for not addressing any of the *Fintiv* factors—an impossibility given the timing of Apple's petition and the *Fintiv* decision. It would have

been impossible for Apple to foresee and guess the Board's decision and analysis in *Fintiv* when drafting its original petition. As such, Apple requests 10 pages in a reply for both petitions to respond to Parus' 18-page *Fintiv* argument in its POPR.

Apple also separately requests leave to file an additional two-pages in its reply directed towards Parus' claim construction argument on the term "instruction set." In its POPR, Parus argues Apple's proposed construction of "instruction set" is incorrect because "it [Apple] and the other defendants submitted a claim construction brief" that is inconsistent with the position Apple advanced with the Board. (IPR2020-00686, at 48; IPR2020-00687, at 49). This is incorrect. In the co-pending litigation, another defendant (Amazon.com) submitted those arguments, not Apple, and Apple would use its additional two pages in the reply to explain this mischaracterization and correct the record on the lack of any inconsistencies in Apple's claim construction positions before the Board and the district court. Apple could not have foreseen that Parus would ascribe another defendant's claim construction position to Apple. As such, Apple additionally requests two pages in the replies to address this issue.

Parus opposes both of these requests.

Counsel for Parus is on vacation this week but has indicated his availability starting Monday, July 13. Counsel for Apple can be available at any time next week for a phone call with the Board.

Sincerely,

Adam Seitz  
Erise IP  
Counsel for Petitioner