

**From:** Usman Khan <[khan@fr.com](mailto:khan@fr.com)>

**Sent:** Monday, December 7, 2020 8:12 AM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; Karl Renner <[renner@fr.com](mailto:renner@fr.com)>

**Cc:** Kim Leung <[Leung@fr.com](mailto:Leung@fr.com)>; Andrew Patrick <[patrick@fr.com](mailto:patrick@fr.com)>; [Cab@connorkudlaclee.com](mailto:Cab@connorkudlaclee.com); [dskeels@whitakerchalk.com](mailto:dskeels@whitakerchalk.com); [cbrooks@whitakerchalk.com](mailto:cbrooks@whitakerchalk.com); [kevin@connorkudlaclee.com](mailto:kevin@connorkudlaclee.com); [IPR39521-0091IP1@fr.com](mailto:IPR39521-0091IP1@fr.com); [PGR39521-0092PS1@fr.com](mailto:PGR39521-0092PS1@fr.com); Kasha Law LLC <[john.kasha@kashalaw.com](mailto:john.kasha@kashalaw.com)>; Chris Marchese <[marchese@fr.com](mailto:marchese@fr.com)>

**Subject:** RE: IPR2020-00999, PGR2020-00066, & PGR2020-00073: Request for Leave to File Notice from Concurrent Litigation

Your Honors,

Petitioner, Apple, has filed its motion to dismiss the declaratory judgment counterclaim of invalidity of the '491 patent in the district court proceeding. Pinn opposes Apple's motion and will file a response by Wednesday, December 9. Consistent with Your Honors' instructions noted in the email below, the parties, having met and conferred, now jointly request leave to submit their district court filings, separately after filing (meaning Apple can submit its motion to the Board today and Pinn when it files its response), or if the Board prefers, together upon Pinn filing its response by Wednesday.

Should the Board wish to conduct a teleconference regarding this request, counsel for Petitioner and Patent Owner are jointly available at the following times:

Monday, December 7, 2020 at 1-3 pm ET

Tuesday, December 8, 2020 at 9 am – noon ET

Should the Board require anything further, please let us know.

Sincerely,

Usman A. Khan  
Counsel for Petitioner

**Usman A. Khan, Ph.D., Esq.**

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

**Sent:** Wednesday, December 02, 2020 12:01 PM

**To:** Karl Renner <[renner@fr.com](mailto:renner@fr.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Usman Khan <[khan@fr.com](mailto:khan@fr.com)>; Kim Leung <[Leung@fr.com](mailto:Leung@fr.com)>; Andrew Patrick <[patrick@fr.com](mailto:patrick@fr.com)>;  
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[This email originated outside of F&R.]

Counsel,

Petitioner's request is noted. If Apple files a motion to dismiss the declaratory judgment counterclaim of invalidity of the '491 patent in the district court proceeding and Petitioner wishes to submit the motion to the Board, Petitioner may contact the Board via email to request leave to submit the motion. The email must indicate whether Patent Owner opposes the request and, if Patent Owner does oppose the request, provide dates and times both parties are available for a conference call with the Board.

Regards,

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

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**From:** Karl Renner <[renner@fr.com](mailto:renner@fr.com)>

**Sent:** Friday, November 27, 2020 2:18 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

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**Subject:** IPR2020-00999, PGR2020-00066, & PGR2020-00073: Request for Leave to File Notice  
from Concurrent Litigation

Your Honors,

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During the teleconference held Tuesday (11/24), your honors asked questions regarding Petitioner Apple's district court declaratory judgment claim of invalidity of the '491 patent. Your honors asked, for example, whether Apple would withdraw that claim. Having further considered the issue, Apple on Wednesday (11/25) filed in the district court a Notice of intent to file a motion to withdraw its declaratory judgment claim of invalidity of the '491 patent ("Notice"). Consistent with the district court's local rules, Apple will be able to file that Motion next week. Apple hereby respectfully requests leave to submit, to the Board, the above-described Notice.

On Wednesday (11/25), Apple notified Patent Owner Pinn of its intent to make this request, and asked Pinn's counsel whether Pinn opposes the request. Pinn has since communicated with Apple, but had not indicated whether it opposes. Given the impending statutory bar, Apple furnishes this request without further delay.

Should the Board wish to conduct a teleconference regarding this request, Apple will be happy to work with Pinn to identify availability.

With best regards,

Karl Renner  
Counsel for Petitioner

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