Ex. 3006
IPR2022-01006

From: Devkar, Andrew V. <andrew.devkar@morganlewis.com>
Sent: Monday, December 12, 2022 3:38 PM
To: Trials <Trials@USPTO.GOV>
Cc: HID-IPRs <HID-IPRs@morganlewis.com>; Coyle, Steve <Scoyle@CantorColburn.com>; Ryan, Andrew <aryan@cantorcolburn.com>; Geiger, Nicholas <NGeiger@CantorColburn.com>
Subject: IPR2022-01006 -- Institution Decision

Your Honors,

Last Friday, December 9, Patent Owner informed Petitioners of an error in the Institution Decision issued in this case on December 1, 2022 (Paper 23). The "Mathiassen" reference relied on by Petitioners as a secondary reference in the present Petition is WO 02/28067 to Camilla Mathiassen ("Mathiassen-067"). This reference was correctly identified on page 10 of the Institution Decision, which sets forth the grounds in the Petition. However, in the background of prior art section (pages 50-51), it appears that the Board inadvertently included a background excerpt regarding a different Mathiassen reference that is included in Apple's petition (IPR2022-00602)—that reference is US Pub 2004/0123113 to Svein Mathiassen et al. ("Mathiassen-113"). On page 15, the Institution Decision also mentions that "Mathiassen is the only reference common to both the '602 Apple petition and the Petition in the case now before us," which is not correct because the Mathiassen references are different.

Petitioners' Position: Petitioners believe this is an inadvertent and harmless error that can be easily addressed by issuance of a corrected institution decision that corrects the references to the incorrect Mathiassen reference. The background section that mentioned the incorrect Mathiassen reference (pages 50-51) did not include any substantive analysis of the Mathiassen reference, nor did Patent Owner challenge the merits of the Petition's grounds in its Preliminary Response. The Institution Decision also relied upon Petitioners' "clause-by-clause analysis of claim 1" for the Bianco and Mathiassen combination (page 51).

Patent Owner's Position: Patent Owner does not agree that the Board's reliance on a reference not cited in the Petition is harmless, even if inadvertent. Patent Owner respectfully submits that institution must be assessed in light of the correct Mathiassen reference. If the Board prefers, Patent Owner is willing to address this issue in a request for rehearing. Patent Owner would not address the merits of institution in light of Mathiassen-067 as it did not do so in its Preliminary Response.

Rather, Patent Owner would simply note that institution must be assessed based on the references cited in the Petition.

If needed, the parties are available for a conference call with the Board within the following times: Tuesday (12/13): noon-1 pm, 1:30-4 pm EST; Wednesday (12/14): 10-12 pm EST.

Thank you,

Andrew
Counsel for Petitioners

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