

From: [Trials](#)
To: [Nicholas Stephens](#); [Trials](#)
Cc: [IPR50095-0045IP1](#); [Karl Renner](#); [Andrew Patrick](#); [Dan Smith](#); [2Bcc](#); [AppleIPR745-1](#); [Daniel Kiang](#); [AppleIPR745-2@knobbe.com](#); [AppleIPR745-3@knobbe.com](#); [AppleIPR745-4@knobbe.com](#)
Subject: RE: IPR2022-01291, -01292, -01465, -01466 - Request for Leave to File Motions to Correct and Corrected Petitions
Date: Tuesday, October 4, 2022 12:16:19 PM

Counsel,

Petitioner's unopposed request for leave in the above identified proceedings to file corrected petitions, as specified in its September 29, 2022, email to the Board, is granted by the Panel. The Panel appreciates the cooperation of the Parties in reaching agreement on the request and finds a written motion is not necessary under the circumstances. Accordingly, in each proceeding Petitioner may file as a "Corrected Petition," no later than October 7, 2022, a paper to correct the clerical errors identified by Petitioner in its September 29, 2022, email to the Board. No additional alteration of the original petitions is authorized in the corrected petitions to be filed. No teleconference with the Board will be scheduled at this time and a copy of this email exchange will be entered by the Board as an exhibit in each proceeding to document the relief authorized.

Thank you,

Megan Carlson
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Nicholas Stephens <nstephens@fr.com>
Sent: Thursday, September 29, 2022 12:10 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Karl Renner <renner@fr.com>; Andrew Patrick <patrick@fr.com>; Dan Smith <dsmith@fr.com>; 2Bcc <2Bcc@knobbe.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; Daniel Kiang <Daniel.Kiang@knobbe.com>; AppleIPR745-2@knobbe.com; AppleIPR745-3@knobbe.com; AppleIPR745-4@knobbe.com
Subject: IPR2022-01291, -01292, -01465, -01466 - Request for Leave to File Motions to Correct and Corrected Petitions

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Honorable Board,

Petitioner respectfully requests leave under 37 CFR § 42.104(c) to file motions to correct inadvertent clerical errors within petitions identified by the subject of this email, and to submit a corrected petition accompanying the respective motion in each proceeding. The parties have conferred, and Patent Owner indicates that it does not oppose this request.

Specifically, Petitioner proposes to strike the following clauses from the respective petition in each proceeding. These clauses incorrectly indicate that the '745 patent issued after IPRs were filed on a parent of the '745 patent in IPR2020-01722 and -01723.

- IPR2022-01291
 - “, and approximately seven months after Apple filed IPRs challenging claims of related U.S. Patent No. 10,470,695 (“695 Patent”)” (Petition, p. 3)
 - “art applied in Apple’s IPRs, including” (Petition, p. 4)
- IPR2022-01292
 - “, and approximately seven months after Apple filed IPRs challenging claims of related U.S. Patent No. 10,470,695 (“695 Patent”)” (Petition, p. 3)
 - “, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ‘695 Patent based on those same references. *See, generally*, IPR2020-01722, -01723” (Petition, p. 78)
 - “art applied in Apple’s IPRs, including” (Petition, p. 4)
- IPR2022-01465
 - “, and approximately seven months after Apple filed IPRs challenging claims of related U.S. Patent No. 10,470,695 (“695 Patent”)” (Petition, p. 3)
 - “, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ‘695 Patent based on those same references. *See, generally*, IPR2020-01722, -01723” (Petition, p. 77)
 - “art applied in Apple’s IPRs, including” (Petition, p. 3)
- IPR2022-01466
 - “, and approximately seven months after Apple filed IPRs challenging claims of related U.S. Patent No. 10,470,695 (“695 Patent”)” (Petition, p. 3)
 - “, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ‘695 Patent based on those same references. *See, generally*, IPR2020-01722, -01723” (Petition, pp. 68-69)
 - “art applied in Apple’s IPRs, including” (Petition, p. 3)

Additionally, Petitioner proposes to replace the last paragraph on page 46 of the petition in IPR2022-01291 with the following paragraph:

There is no indication in the '745 Patent's file history that the examiner was even aware of, let alone substantively considered, Sarantos, Venkatraman, or Shie prior to allowing the '772 Application. See, generally, APPLE-1002. Iwamiya is cited on the face of the '745 patent, but was not relied on by the Examiner.

The substitute paragraph would correct a clerical error that was made when the -01291 petition was filed concurrently with the -01292 petition on the same day (July 22, 2022). Upon further review, Petitioner found that the last paragraph on page 46 of the -01291 petition was inadvertently reproduced from pp. 77-78 of the -01292 petition, and as a result, identifies the prior art applied in the -01292 petition rather than the -01291 petition.

To the extent the Board would like to discuss the request on a call, the parties are available at the following times:

- Fri. 9/30 – 1:30pm-2:30pm ET
- Tues. 10/4 – 1pm-2pm ET

Respectfully submitted,
Nick

Counsel for Petitioner

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