

From: Usman Khan <khan@fr.com>

Sent: Tuesday, September 29, 2020 10:15 PM

To: Trials <Trials@USPTO.GOV>

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Subject: IPR2020-00999 & PGR2020-00066: Request for Leave to File Pre-Institution Reply

Re IPR2020-00999 & PGR2020-00066

Your Honors,

Petitioner, Apple, respectfully requests leave to file a pre-institution reply to each of the POPRs filed by Pinn in the above-noted proceedings. Following is a list of the issues raised in the POPRs to which Apple will seek a brief, focused reply:

- (i) Apple's Stipulation: Apple has good cause to request briefing to address Pinn's assertion that Apple violated terms of its stipulation.
- (ii) Discretionary denial pursuant to 35 U.S.C. 314(a): Apple has good cause to request briefing to address Pinn's representations relating to *Fintiv* factors, such as Pinn's representation that grounds being asserted in litigation are the same as those being advanced in the petition, and Pinn's characterization of Apple's motives for challenging claim 2 in the 491 IPR and claim 7 in the 066 PGR.
- (iii) Discretionary denial pursuant to 35 U.S.C. 325(d): Apple has good cause to request briefing to demonstrate why prior art cited by Pinn from within the prosecution history fails to support discretionary denial under 325(d) when properly applying *Advanced Bionics*.
- (iv) Prior Art Disclosure of and Pinn's Construction of "wireless pairing": Apple has good cause to request briefing to demonstrate why Pinn's arguments and characterization related to the prior art's disclosure (e.g., Rabu) of pairing are not consistent with the Special Master Report and the disclosure in the prior art.

Apple's counsel has conferred with Pinn's counsel, who opposes these requests. Apple's counsel requests a call at any of the following times:

Thurs, Oct 1 at 3-4 PM EST

Friday, Oct 2 at 12-2 PM EST or 2-5 PM EST

If these times do not work, please suggest other times that are convenient for the Board. Pinn's counsel was requested to provide their availability this week for a call with the Board. As of the time of this email, Apple's counsel has not received information regarding the availability of Pinn's counsel for a call with the Board.

Please let us know if the Board requires anything further.

Sincerely,

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