

Mace, Andrew

From: Mace, Andrew
Sent: Tuesday, May 9, 2023 2:54 PM
To: 'Stein, Alexander B.'
Cc: Keefe, Heidi; Weinstein, Mark; Mead, Lowell; HID-VectorFlow-IPR
Subject: RE: IPR2023-00353 ('704) – preliminary reply

Alex, thanks. Because the Board has repeatedly stated that emails to the Board should not include argument, we are not going to include “because Patent Owner respectfully submits that the parties have both already been heard on these same foreseeable issues (*see, e.g.,* Pet. at 8, 11 (*Fintiv*) and 14, 23 (claim construction)) and further briefing would prejudice Patent Owner (*see Preliminary Response at 18-19*)” in our email.

- Andrew

Andrew Mace

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From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Tuesday, May 9, 2023 2:25 PM
To: Mace, Andrew <amace@cooley.com>
Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>
Subject: RE: IPR2023-00353 ('704) – preliminary reply

[External]

Andrew,

After explaining the positions that you provided yesterday to our client, they do not believe that there is good cause for extra briefing here. As such, we oppose. Below are our additions (*in blue*) to the Board email.

Dear PTAB:

Petitioner in IPR2023-00353 requests permission to file a preliminary reply of no more than 3 pages to respond to Patent Owner’s arguments in its preliminary response regarding (1) discretionary denial under section 314(a), and (2) alleged inconsistencies in claim construction positions taken in the pending litigation. The parties have conferred, and Patent Owner opposes the request because Patent Owner respectfully submits that the parties have both already been heard on these same foreseeable issues (*see, e.g.,* Pet. at 8, 11 (*Fintiv*) and 14, 23 (claim construction)) and further briefing would prejudice Patent Owner (*see Preliminary Response at 18-19*). To the extent the Board does grant leave, Patent Owner requests a 3-page sur-reply to respond to Petitioner’s preliminary reply. If a conference call is needed, the parties will confer and provide their availability.

Best,

-Alex

Alexander B. Stein

Morgan, Lewis & Bockius LLP (Seattle and Silicon Valley Offices)

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From: Stein, Alexander B.

Sent: Monday, May 8, 2023 7:21 PM

To: 'Mace, Andrew' <amace@cooley.com>

Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>

Subject: RE: IPR2023-00353 ('704) – preliminary reply

Thanks, Andrew. We will sync up with our client and will get back to you very soon.

Best,

-Alex

Alexander B. Stein

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From: Mace, Andrew <amace@cooley.com>

Sent: Monday, May 8, 2023 7:05 PM

To: Stein, Alexander B. <alexander.stein@morganlewis.com>

Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>

Subject: RE: IPR2023-00353 ('704) – preliminary reply

[EXTERNAL EMAIL]

Alex,

Thanks for talking with us earlier. As discussed, a draft email to the Board is below. Please let us know whether PO opposes our request or if PO would not oppose if a 3-page PO preliminary surreply was also requested. To the extent any exhibits would be submitted, the exhibits would be only papers previously filed and/or served in the litigation.

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Dear PTAB:

Petitioner in IPR2023-00353 requests permission to file a preliminary reply of no more than 3 pages to respond to Patent Owner's arguments in its preliminary response regarding (1) discretionary denial under section 314(a), and (2) alleged inconsistencies in claim construction positions taken in the pending litigation. The parties have conferred, and Patent Owner opposes the request. If a conference call is needed, the parties will confer and provide their availability.

--

Thanks,
Andrew

Andrew Mace

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From: Mace, Andrew
Sent: Thursday, May 4, 2023 7:51 PM
To: 'Stein, Alexander B.' <alexander.stein@morganlewis.com>
Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>
Subject: RE: IPR2023-00353 ('704) – preliminary reply

Alex,
Let's talk on Monday at 2pm PT. We can use 1 (877) 369-0926, conference ID 4011634272.

Thanks,
Andrew

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From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Thursday, May 4, 2023 5:40 PM
To: Mace, Andrew <amace@cooley.com>
Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>
Subject: RE: IPR2023-00353 ('704) – preliminary reply

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Andrew,

After discussing this with our client, we are unable to determine whether to oppose without hearing your reasons as to any good cause underlying this request (see 37 C.F.R. § 42.108(c)). Do you have time for a meet and confer either tomorrow (Friday) or on Monday to discuss? We are available Friday (5/5) after 3 pm PT or Monday (5/8) between 10-11:30 am and 2-3:30 PT. Please let us know what works on your end or if you need us to provide additional dates/ times for our availability.

Talk to you soon.

Best,

-Alex

Alexander B. Stein
Morgan, Lewis & Bockius LLP (Seattle and Silicon Valley Offices)

From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Thursday, May 4, 2023 5:02 AM
To: Mace, Andrew <amace@cooley.com>
Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>
Subject: RE: IPR2023-00353 ('704) – preliminary reply

Hi Andrew,

We are discussing your request with our client and will have a response for you later today.

Best,

-Alex

Alexander B. Stein

Morgan, Lewis & Bockius LLP (Seattle and Silicon Valley Offices)

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From: Mace, Andrew <amace@cooley.com>
Sent: Tuesday, May 2, 2023 4:28 PM
To: Stein, Alexander B. <alexander.stein@morganlewis.com>; HID-VectorFlow-IPR <HID-VectorFlow-IPR@morganlewis.com>
Cc: Keefe, Heidi <hkeefe@cooley.com>; Weinstein, Mark <mweinstein@cooley.com>; Mead, Lowell <lmead@cooley.com>
Subject: IPR2023-00353 ('704) – preliminary reply

[EXTERNAL EMAIL]

Counsel,

Petitioner intends to contact the Board to request permission to file a preliminary reply of no more than 3 pages to respond to Patent Owner's arguments in its preliminary response in IPR2023-00353 regarding (1) discretionary denial under section 314(a), and (2) alleged inconsistencies in claim construction positions taken in the pending litigation. Please let us know whether Patent Owner would oppose the request.

Thanks,
Andrew

Andrew Mace

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