

From: [Trials](#)
To: [Best, Timothy P.](#)
Cc: [Brian Eutermoser](#); [Russell Blythe](#); [Mikaela Stone](#); [Trials](#)
Subject: RE: Request for Leave to File Reply to Patent Owner's Preliminary Response in IPR2023-00491
Date: Monday, July 31, 2023 8:20:45 AM

Counsel,

The panel has considered, and denies, Petitioner's requests.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Best, Timothy P. <TBest@gibsondunn.com>
Sent: Thursday, July 27, 2023 3:01 PM
To: Trials <Trials@USPTO.GOV>
Cc: Brian Eutermoser <BEutermoser@KSLAW.com>; Russell Blythe <RBlythe@KSLAW.com>; Mikaela Stone <Mikaela.Stone@KSLAW.com>
Subject: Request for Leave to File Reply to Patent Owner's Preliminary Response in IPR2023-00491

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Your Honors,

Petitioner respectfully requests authorization for briefing in the form of a 3-page Reply to Patent Owner's Preliminary Response ("POPR") in IPR2023-00491 and authorization for entry into evidence a stipulation by Petitioner consistent in scope with the stipulation offered in *Apple, Inc. v. AliveCor, Inc.*, IPR2021-00970, Paper 10 (Dec. 8, 2021). If Petitioner's request is granted, Petitioner does not oppose Patent Owner's submission of an equivalent Sur-Reply.

If this request is granted, the Reply would address the POPR arguments related to the "central server" recited in the challenged claims (e.g., as recited by the '721 patent's independent claim 1, "providing contents of the second database to at least one database associated with a central server"). Petitioner respectfully submits that good cause for further briefing on this issue exists, at least because briefing would clarify the record and aid the Board in deliberations on issues that are potentially dispositive to institution. For example, while the petition preemptively address aspects of Patent Owner's arguments, further briefing is warranted by Patent Owner's reliance on an implicit construction related to the "central server." Petitioner respectfully submits that good cause for entry of an *AliveCor* stipulation exists because the stipulation would aid the Board in deliberations on an issue potentially dispositive to institution: namely, discretionary denial of institution under *Fintiv*. If requested by the Board, Petitioner will provide further explanation of good cause. Although Petitioner believes

substantive argument should be made on a call with the board rather by email, Petitioner offers the following response to Patent Owner's position as stated below: There is ample time for Patent Owner to respond to a three-page reply consistent with the content proposed above, and Petitioner proposes below a briefing schedule that makes good advantage of that time. Patent Owner is benefited--not prejudiced--by Petitioner filing a stipulation consistent with *AliveCor* that is broader in scope than the narrower *Sand Revolution* stipulation that Petitioner previously offered in connection with this Petition. Petitioner is not aware of any rule or practice requiring the filing of a stipulation consistent with *AliveCor* at any particular time, and Patent Owner identifies none. The Board already has rejected Patent Owner's argument concerning the presence of other defendants in the district court proceedings in IPR2022-01522 (Paper 16).

In connection with this request, Petitioner proposes the briefing schedule outlined below:

1. Petitioner's Reply Deadline – Within 5 business days of the Board's authorization
2. Patent Owner's Sur-Reply Deadline – Within 5 business days of Petitioner's Reply

Petitioner and Patent Owner have conferred. Patent Owner opposes this request and provides the following position: Petitioner has not shown good cause for its proposed reply brief or stipulation. Even when asked directly, Petitioner's counsel offered no justification for waiting more than two months after Patent Owner's preliminary response before requesting additional pre-institution briefing. And with less than three weeks until the August 16 deadline for an institution decision, Petitioner's proposed briefing schedule would leave Patent Owner insufficient time to respond to, and for the Board to consider, Sophos's new arguments.

Moreover, Petitioner has not explained its failure to offer its new stipulation along with its petition, or at any point before Patent Owner submitted its preliminary response. Fairness dictates that Petitioner not be allowed to change positions now, after Patent Owner invested resources in *Fintiv* arguments based on the narrower stipulation referenced in not only this petition, but also others filed by Petitioner and still awaiting institution decisions. Moreover, Petitioner has not shown that its proposed stipulation would aid the Board's *Fintiv*-related deliberations. To the contrary, this new proposed stipulation is still narrower than a *Sotera*-style stipulation and, in any event, would not bar Petitioner's co-defendant from litigating the same invalidity challenges in the district court, and thus would not mitigate concerns of duplicative proceedings.

Should the Board desire a call to discuss this request, the parties have conferred and offer times of availability.

1. **July 28, 3-4 ET**
2. **August 1, 1-3 ET**
3. **August 2, 2-4 ET**

Respectfully,
Tim Best

Timothy P. Best

Partner

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