

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>
Sent: Tuesday, October 17, 2023 7:12 PM
To: Trials <Trials@USPTO.GOV>
Cc: matt@rhmttrial.com; jim@rhmttrial.com; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>; Mauldin, R. Maxwell <R.Maxwell.Mauldin@finnegan.com>; Specht, Kara <Kara.Specht@finnegan.com>
Subject: IPR2023-00815, IPR2023-00816, IPR2023-00817

Dear Board:

Petitioners request a call with the Board to seek guidance on how to address Patent Owner's improper motion for sanctions within its sur-replies in each of IPR2023-00815, -00816, -00817.

In its sur-replies, Patent Owner states that "Petitioners failed to comply with 37 C.F.R. § 11.803." Paper No. 10 at 4. This was a new argument because Patent Owner had previously only mentioned 37 C.F.R. § 11.803 in framing its own counsel's legal duties, not as a sword against Petitioners' counsel. *See* Paper No. 7 at 11. Patent Owner similarly moves from alleging it was "feeling as if it was being extorted" in the Preliminary Response, Paper No. 7 at 10, to specifically accusing Petitioners of "attempting to extort a free license" in its sur-reply. Paper No. 10 at 3 (citing 18 U.S.C. § 875).

Without using the word "sanction," Patent Owner requests a sanction against Petitioners in the form of denial of institution. This sanctions argument should have been properly brought as a separate motion for sanctions under 37 C.F.R. § 42.11(d)(2), particularly since Patent Owner's reliance on an alleged violation of 37 C.F.R. § 11.803 and federal extortion statutes falls under items that should be addressed separately in a motion for sanctions. *See* 37 C.F.R. § 11.18(c)(2).

Petitioners submitted evidence to Patent Owner in the parallel District Court case, including two legal opinions, directly rebutting Patent Owner's allegations of violations of professional rules and extortion. Should the Board entertain Patent Owner's motion for sanctions, Petitioners request that it be able to submit those two legal opinions here.

Patent Owner asked that their position be included with Petitioners' requests. In response to Petitioners asking for a call with the Board and to submit responsive material evidence, Patent Owner stated the following:

We expressly mentioned 37 CFR § 11.803 by number in several sentences in the original POPR. Your firm's violation of that regulation was not newly raised in the Sur-Reply. *See, e.g.*, p. 11 of the POPR in IPR2023-00815. The original POPR also expressly requested that the Board exercise its general discretion to deny institution due to your clients' (and your firm's) abuse of process. *Id.*, p. 14. Finally, our Sur-Reply does not request sanctions, it requests discretionary denial. So, we are honestly confused about where you're coming from with this request.

We do not believe you have any basis to file yet another document in this case. We oppose.

In view of the disagreement between the Parties' of whether Patent Owner's arguments in the Sur-Replies amount to an improper motion for sanctions, Petitioners respectfully request a call with the Board to address the proper conduct of these proceedings. Petitioners are available for a call at the Board's convenience.

Regards,

Lionel

From: Trials <Trials@USPTO.GOV>

Sent: Wednesday, September 20, 2023 12:23 PM

To: Specht, Kara <Kara.Specht@finnegan.com>; Trials <Trials@USPTO.GOV>; Lavenue, Lionel <lionel.lavenue@finnegan.com>; Mauldin, R. Maxwell <R.Maxwell.Mauldin@finnegan.com>

Cc: matt@rhmttrial.com; jim@rhmttrial.com; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>

Subject: RE: IPR2023-00815, IPR2023-00816, IPR2023-00817

EXTERNAL Email:

Counsel,

The Board finds good cause for the requested briefing and authorizes Petitioner to file a 15-page pre-institution reply in each of IPR2023-00815, IPR2023-00816, and IPR2023-00817 limited to (1) Patent Owner's 314(a) arguments regarding *Fintiv*; (2) Patent Owner's arguments regarding alleged abuse of the IPR process; and (3) Patent Owner's claim construction of requiring the door lock to be activated immediately upon receiving a reservation certificate (i.e., IPR2023-00815, Paper No. 7, at 18–23, IPR2023-00816, Paper No. 7 at 18–21, IPR2023-00817, Paper No. 7, at 21–24). The Board also authorizes Patent Owner to file a 15-page pre-institution sur-reply. Petitioner's briefs are due on or before October 4, 2023, and Patent Owner's briefs are due on or before October 12, 2023.

Regards,

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

From: Specht, Kara <Kara.Specht@finnegan.com>

Sent: Wednesday, September 20, 2023 6:34 AM

To: Trials <Trials@USPTO.GOV>

Cc: matt@rhmttrial.com; jim@rhmttrial.com; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>

Subject: IPR2023-00815, IPR2023-00816, IPR2023-00817

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Dear Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioners ASSA ABLOY and HID requests authorization to file a 15-page pre-institution reply in each of 15-page pre-institution replies in

IPR2023-00815, IPR2023-00816, and IPR2023-00817 to respond to three arguments that could not have been addressed in the respective Petitions:

- (1) Patent Owner's 314(a) arguments regarding Fintiv;
- (2) Patent Owner's arguments regarding alleged abuse of the IPR process; and
- (3) Patent Owner's unforeseeable and incorrect construction of requiring the door lock to be activated immediately upon receiving a reservation certificate (i.e., IPR2023-00815, Paper No. 7, at 18-23, IPR2023-00816, Paper No. 7 at 18-21, IPR2023-00817, Paper No. 7, at 21-24).

Good cause exists for pre-institution briefing on these issues because (1) factual circumstances before the district court have changed since the Petitions' filing date; (2) Petitioners could not have foreseen Patent Owner's abuse of process argument; and (3) Patent Owner's construction of timing requirements is contrary to the claims and specification and thus unforeseeable.

Patent Owner has indicated that it opposes.

Petitioners are available for a call with the Board at the Board's convenience.

Best regards,

Kara Specht
Counsel for Petitioner

Kara Specht
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
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