

## Petravick, Meredith

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**Subject:** FW: IPR2023-00890, IPR2023-01017, and IPR2023-00934

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**From:** Specht, Kara <[Kara.Specht@finnegan.com](mailto:Kara.Specht@finnegan.com)>

**Sent:** Tuesday, January 9, 2024 10:39 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Fred Fabricant <[ffabricant@fabricantllp.com](mailto:ffabricant@fabricantllp.com)>; Peter Lambrianakos <[plambrianakos@fabricantllp.com](mailto:plambrianakos@fabricantllp.com)>; John Rubino <[jarubino@rubinoip.com](mailto:jarubino@rubinoip.com)>; 'kurt@truelovelawfirm.com' <[kurt@truelovelawfirm.com](mailto:kurt@truelovelawfirm.com)>; BMW-NorthStar-IPRs <[BMW-NorthStar-IPRs@finnegan.com](mailto:BMW-NorthStar-IPRs@finnegan.com)>; Vincent Rubino <[vrubino@fabricantllp.com](mailto:vrubino@fabricantllp.com)>; Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>

**Subject:** RE: IPR2023-00890, IPR2023-01017, and IPR2023-00934

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Dear Board –

Thank you for your email.

As to your question on a potential motion to amend, Patent Owner has requested the following position be included: “At present we do not plan to file a motion to amend, however, our client would like to reserve the right to make that decision promptly after the deposition of your expert.”

As for the schedule, the Parties request a short extension to the oral hearing date scheduled for August 8, 2024 to August 16, 2024 or after at the Board’s convenience to accommodate the proposed schedule modification to Due Dates 5-7 in IPR2023-00934 and IPR2023-01017.

- Due Date 5 – August 5, 2024
  - Petitioner’s Sur-Reply to opposition to motion to amend
  - Motion to exclude evidence
- Due Date 6 – August 9, 2024
  - Opposition to motion to exclude
  - Request for pre-hearing conference
- Due Date 7 – August 13, 2024
  - Reply to opposition to motion to exclude

Petitioner is available for a call at the Board’s convenience, and would be happy to submit a formal request to modify the schedules accordingly should the Board request.

Best regards,  
Kara Specht  
Counsel for Petitioner

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Sent:** Monday, January 8, 2024 10:58 AM

**To:** Specht, Kara <[Kara.Specht@finnegan.com](mailto:Kara.Specht@finnegan.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Fred Fabricant <[ffabricant@fabricantllp.com](mailto:ffabricant@fabricantllp.com)>; Peter Lambrianakos <[plambrianakos@fabricantllp.com](mailto:plambrianakos@fabricantllp.com)>; John Rubino <[jarubino@rubinoip.com](mailto:jarubino@rubinoip.com)>; 'kurt@truelovelawfirm.com' <[kurt@truelovelawfirm.com](mailto:kurt@truelovelawfirm.com)>; BMW-NorthStar-IPRs <[BMW-NorthStar-IPRs@finnegan.com](mailto:BMW-NorthStar-IPRs@finnegan.com)>; Vincent Rubino <[vrubino@fabricantllp.com](mailto:vrubino@fabricantllp.com)>; Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>  
**Subject:** RE: IPR2023-00890, IPR2023-01017, and IPR2023-00934

Counsel,

The judge panel responds as follows:

We are not opposed to having a joint oral hearing for IPR2023-00890, -00934, and -01017 on August 8, 2024. However, the Scheduling Orders for IPR2023-00934 and IPR2023-01017 set DUE DATES 5-7 after August 8, 2024. If the oral hearing date is reset to August 8, 2024, how do the parties propose to accommodate DUE DATES 5-7? Please confer and, if needed, propose a new schedule for IPR2023-00934 and -01017. If needed and subject to availability, we will consider alternative dates for the oral argument in August of 2024. The parties reply to this email should indicate whether Patent Owner intends to file a motion to amend or not.

A conference call could be held if necessary.

Regards,

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

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**From:** Specht, Kara <[Kara.Specht@finnegan.com](mailto:Kara.Specht@finnegan.com)>  
**Sent:** Friday, January 5, 2024 4:20 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Fred Fabricant <[ffabricant@fabricantllp.com](mailto:ffabricant@fabricantllp.com)>; Peter Lambrianakos <[plambrianakos@fabricantllp.com](mailto:plambrianakos@fabricantllp.com)>; John Rubino <[jarubino@rubinoip.com](mailto:jarubino@rubinoip.com)>; 'kurt@truelovelawfirm.com' <[kurt@truelovelawfirm.com](mailto:kurt@truelovelawfirm.com)>; BMW-NorthStar-IPRs <[BMW-NorthStar-IPRs@finnegan.com](mailto:BMW-NorthStar-IPRs@finnegan.com)>; Specht, Kara <[Kara.Specht@finnegan.com](mailto:Kara.Specht@finnegan.com)>; Vincent Rubino <[vrubino@fabricantllp.com](mailto:vrubino@fabricantllp.com)>; Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>  
**Subject:** IPR2023-00890, IPR2023-01017, and IPR2023-00934

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Dear Board –

The Parties to IPR2023-00890, IPR2023-00934, and IPR2023-01017, respectfully request the Board's guidance on a proposed schedule modification to the Oral Hearing dates set in IPR2023-00934 and IPR2023-01017. The Board's Scheduling Order in IPR2023-00934, Paper No. 12, page 2, and IPR2023-01017, Paper No. 13, page 2, instructs the Parties to contact the Board "within one month of the Order [(January 7, 2024)] if there is a need to discuss proposed changes" to the schedule.

The Parties have agreed to request a single oral hearing for IPR2023-00890, IPR2023-01017, and IPR2023-00934, and would request the hearing take place on August 8, 2024 (the date set by the Board in IPR2023-00890). Having a single hearing on August 8, 2023, will not affect the statutory deadlines for Final Written Decision of any of the proceedings.

The Parties are comfortable proceeding with this understanding until each submits its respective Requests for Oral Argument. However, if the Board would prefer a formal request to modify the Oral Hearing dates set in IPR2023-00934 and IPR2023-01017 at this time, the Parties would certainly accommodate the Board's preference.

Best regards,  
Kara Specht  
Counsel for Petitioner

**Kara Specht**  
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP  
271 17<sup>th</sup> Street, NW, Suite 1400, Atlanta, GA 30363-6209  
404.653.6481 | fax 404.653.6444 | [kara.specht@finnegan.com](mailto:kara.specht@finnegan.com) | [bio](#) | [www.finnegan.com](http://www.finnegan.com)

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