

From: [Trials](#)
To: [Specht, Kara](#); [Trials](#)
Cc: vrubino@fabricantllp.com; jarubino@rubinoip.com; [PTAB](#); [BMW-NorthStar-IPRs](#)
Subject: RE: IPR2023-01017 and IPR2023-00934
Date: Monday, September 18, 2023 9:34:03 AM

Counsel,

From the Board –

Petitioner's email of September 15, 2023 (below) requests authorization to file a 7-page Reply to Patent Owner's Preliminary Response to address Patent Owner's Section 314(a) "*Fintiv*" arguments and its construction of "OVI" in the '527 and '943 patent. Regarding the *Fintiv* issue, Petitioner states that "the factual circumstances before the district court have changed since the Petition's filing date. Petitioner indicates that Patent Owner does not oppose this request, but that Petitioner would not oppose giving Patent Owner an opportunity to submit a sur-reply of equal length.

Petitioner's request is granted. In each proceeding, Petitioner may submit a seven page Reply to address Patent Owner's request for discretionary denial under Section 314(a) and Patent Owner's construction of "OVI." In each proceeding, Patent Owner may file a seven-page Sur-reply to Petitioner's reply.

Petitioner's Replies are due September 22, 2023.

Patent Owner's Sur-Replies are due no later than September 29, 2023.

This email will be entered into the record as Board's Exhibit 3001. No conference call is believed necessary on this issue, but if the parties disagree or have any questions, they should contact the Board.

Regards,

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

From: Specht, Kara <Kara.Specht@finnegan.com>
Sent: Friday, September 15, 2023 8:05 PM
To: Trials <Trials@USPTO.GOV>
Cc: vrubino@fabricantllp.com; jarubino@rubinoip.com; [PTAB](#) <PTAB@fabricantllp.com>; [BMW-NorthStar-IPRs](#) <BMW-NorthStar-IPRs@finnegan.com>
Subject: IPR2023-01017 and IPR2023-00934

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Dear Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioner BMW requests authorization to file a 7-page pre-institution reply in each of IPR2023-01017 and IPR2023-00934, similar to the granted pre-institution reply in related proceeding IPR2023-00890, to respond to Patent Owner's 314(a) arguments regarding *Fintiv* and to address Patent Owner's construction "OVI" in the '527 and '943 patent as requiring a magnitude associated with the indicator. Good cause exists for pre-institution briefing on these issues because the factual circumstances before the district court have changed since the Petition's filing date and Patent Owner's claim construction arguments were unforeseeable given the clear meaning of the term "OVI" in the claims as requiring only "distance and travel-related information."

These are the same issues for which the Board granted a 7-page reply in related proceeding IPR2023-00890, and Patent Owner has indicated it does not oppose. Petitioner does not oppose sur-replies by Patent Owner of equal length.

Petitioner is available for a call with the Board at the Board's convenience.

Best regards,

Kara Specht
Counsel for Petitioner

Kara Specht
Partner

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