

From: [Trials](#)
To: [Specht, Kara](#); [Vincent Rubino](#)
Cc: [Trials](#); [Peter Lambrianakos](#); [BMW-NorthStar-IPRs](#)
Subject: RE: IPR2023-01190
Date: Wednesday, November 15, 2023 11:41:18 AM

Counsel,

From the Board -

Petitioner's email of October 26, 2023 (below) requests authorization to file a 10-page Reply to Patent Owner's Preliminary Response to address Patent Owner's Section 314(a) "*Fintiv*" arguments and its construction of "wireless communication options" as used in the '432 patent. Regarding the *Fintiv* issue, Petitioner states that "the factual circumstances before the district court have changed since the Petition's filing date." We understand from Patent Owner's subsequent emails of November 6, 2023 (below), that Petitioner intends to submit a *Sotera* stipulation, which, Patent Owner agrees, would moot Patent Owner's *Fintiv* contentions. Regarding the claim-construction issue, Petitioner contends that Patent Owner's construction was "unforeseeable." Patent Owner responds that its claim construction was not unforeseeable and that no additional briefing is necessary.

Petitioner's request is granted in part. Petitioner may file, as an exhibit, its *Sotera* declaration. Petitioner may also file a Preliminary Reply, not to exceed two pages, addressing the relevance of the *Sotera* declaration to Patent Owner's *Fintiv* arguments, and Patent Owner's construction of "wireless communication options" as used in the '432 patent. Patent Owner may file a two-page Preliminary Surreply to Petitioner's Preliminary Reply.

Petitioner's Preliminary Reply must be filed no later than November 21, 2023.

Patent Owner's Preliminary Surreply must be filed no later than November 28, 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: Monday, November 6, 2023 9:39 AM
To: Vincent Rubino <vrubino@fabricantllp.com>
Cc: Trials <Trials@USPTO.GOV>; Peter Lambrianakos <plambrianakos@fabricantllp.com>; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>
Subject: RE: IPR2023-01190

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Dear Honorable Board –

As the Parties discussed during the meet and confer, Petitioner requests authorization to file its

Sotera stipulation with the Board, even if Patent Owner is allowed to withdraw its Fintiv arguments.

Best regards,
Kara Specht
Counsel for Petitioner

From: Vincent Rubino <vrubino@fabricantllp.com>
Sent: Monday, November 6, 2023 9:22 AM
To: Specht, Kara <Kara.Specht@finnegan.com>
Cc: Trials <Trials@USPTO.GOV>; Peter Lambrianakos <plambrianakos@fabricantllp.com>; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>
Subject: Re: IPR2023-01190

EXTERNAL Email:

Honorable Board,

In the time since Petitioner's original email, Patent Owner and Petitioner have conferred regarding Patent Owner's Fintiv arguments. Petitioner has indicated that it intends to serve a *Sotera* stipulation. Patent Owner has agreed that service of a *Sotera* stipulation will moot Patent Owner's Fintiv contentions in this proceeding and thus eliminate the need for further briefing on the Fintiv factors.

Petitioner maintains its position that additional briefing is necessary for the claim construction issue below. Patent Owner maintains that its positions were not unforeseeable and that no additional briefing is necessary.

Respectfully
Vincent Rubino
Lead Counsel for Patent Owner

On Nov 6, 2023, at 9:13 AM, Specht, Kara <Kara.Specht@finnegan.com> wrote:

Dear Honorable Board –

A gentle reminder that Petitioner remains available for a call at the Board's convenience, if necessary.

Best regards,
Kara Specht

Counsel for Petitioner

From: Specht, Kara <Kara.Specht@finnegan.com>
Sent: Thursday, October 26, 2023 12:34 PM
To: Trials <Trials@USPTO.GOV>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>; Vincent Rubino <vrubino@fabricantllp.com>
Subject: IPR2023-01190

Dear Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioner requests authorization from the Board to file a 10-page pre-institution reply in IPR2023-01190 to respond to two arguments that could not have been addressed in the Petition:

- (1) Patent Owner's 314(a) arguments regarding Fintiv; and
- (2) Patent Owner's unforeseeable and incorrect comments on the construction of "wireless communication options" (i.e., Paper No. 6, at 2-3, 6, 12-13).

Good cause exists for pre-institution briefing on these issues because (1) factual circumstances before the district court have changed since the Petition's filing date; and (2) Patent Owner's construction of "wireless communication options" are contrary to the specification and the prosecution history and are thus unforeseeable.

If granted, Petitioner will not oppose a sur-reply by Patent Owner of equal length.

Patent Owner has requested its following position be included: "The arguments were not unforeseeable and Petitioner should have been able to ascertain these arguments by reading and analyzing the File History, which it did not do."

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

Best regards,

Kara Specht
Counsel for Petitioner

Kara Specht
Partner

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