

From: [Trials](#)
To: [Specht, Kara](#); [Trials](#)
Cc: [Vincent Rubino](#); [PTAB](#); [jarubino@rubinoip.com](#); [Michael Mondelli](#); [Fred Fabricant](#); [Peter Lambrianakos](#); [kurt@truelovelawfirm.com](#); [BMW-NorthStar-IPRs](#)
Subject: RE: IPR2023-01049 and IPR2023-01191
Date: Tuesday, January 9, 2024 10:43:56 AM

Counsel,

From the Board –

A reply would be helpful to the Board and to simplify the *Fintiv* issue. Petitioner is authorized for file a 5-page reply no later than January 17, 2024. The reply is limited to the claim construction and *Fintiv* issue discussed in Petitioner’s email. Patent Owner may file a 5-page sur-reply no later than January 25, 2023. No conference call will be held.

Regards,

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

From: Specht, Kara <Kara.Specht@finnegan.com>
Sent: Wednesday, January 3, 2024 6:11 PM
To: Trials <Trials@USPTO.GOV>
Cc: Vincent Rubino <vrubino@fabricantllp.com>; PTAB <PTAB@fabricantllp.com>; jarubino@rubinoip.com; Michael Mondelli <mmondelli@rubinoip.com>; Fred Fabricant <ffabricant@fabricantllp.com>; Peter Lambrianakos <plambrianakos@fabricantllp.com>; kurt@truelovelawfirm.com; BMW-NorthStar-IPRs <BMW-NorthStar-IPRs@finnegan.com>
Subject: IPR2023-01049 and IPR2023-01191

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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 requests authorization from the Board to file 10-page pre-institution replies in each of IPR2023-01049 and IPR2023-01191 to respond to the following unforeseeable arguments from Patent Owner that could not have been addressed in the Petitions:

1. Patent Owner’s 314(a) arguments regarding *Fintiv*; and
2. Patent Owner unforeseeably construes the claim limitation “information about a current location of the mobile communication device ... include[ing] global positioning system (GPS) information” to exclude the current location of the mobile communication device (i.e. Paper

No. 7, at 3-5).

Good cause exists for pre-institution briefing on these issues because 1) factual circumstances before the district court concerning the *Fintiv* analysis have changed since the Petitions' filing dates, and Petitioner intends to enter a Sotera stipulation, and 2) Patent Owner's interpretation of the claim is contrary to the plain language of the claim as well as the specification. These issues were thus unforeseeable.

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

Petitioner intends to enter a Sotera Stipulation. Patent Owner has indicated it will not oppose Petitioner entering a Sotera stipulation, and agreed to withdraw its *Fintiv* arguments given this stipulation. Patent Owner opposes Petitioner's requested reply on claim construction, and has requested the following position be included: "Patent Owner disagrees with Petitioner's characterization. Patent Owner contends that there is no new 'claim construction' argument, let alone an unforeseen claim construction argument. Accordingly, Petitioner should not be entitled to a re-do of its Petition."

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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