From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, March 25, 2025 2:28 PM
To: James Zak <jzak@hechtpartners.com>; David Hecht <dhecht@hechtpartners.com>; Monté T. <MTSquire@duanemorris.com>; D. Stuart <DSBartow@duanemorris.com>; Paul H. <PHBelnap@duanemorris.com>; Philip <PWWoo@duanemorris.com>
Cc: Trials <Trials@USPTO.GOV>
Subject: RE: IPR2024-00232, IPR2024-01333 - Parties' Joint Request for Conference Call with the Board

Counsel,

A conference call has been scheduled for noon eastern on Thursday. The dial in number is +1 540-566-5633 and the conference ID is 447933357#.

The parties should be prepared to explain why the '052 reexam should or should not be stayed. The parties are directed to refrain from any further improper email briefing.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Woo, Philip <PWWoo@duanemorris.com>
Sent: Tuesday, March 25, 2025 11:39 AM
To: Trials <Trials@USPTO.GOV>
Cc: James Zak <jzak@hechtpartners.com>; David Hecht <dhecht@hechtpartners.com>; Squire, Monté T. <MTSquire@duanemorris.com>; Bartow, D. Stuart <DSBartow@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>; Woo, Philip <PWWoo@duanemorris.com>
Subject: IPR2024-00232, IPR2024-01333 - Parties' Joint Request for Conference Call with the Board

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To the Honorable Board,

The parties in the above-identified proceeding jointly request a conference call seeking the Board's guidance on an important issue.

This proceeding challenges claims 1–6 and 8–17 of U.S. Patent No. 8,352,730 ("the '730 Patent claims").

The '730 Patent is also the subject of a currently pending ex parte reexamination proceeding – Control No. 90/015,052 ("the '730 reexam"). In the '730 reexam, the Examiner has proposed an Examiner's amendment to the claims. To date, the Examiner has not entered her Examiner's amendment, but it is expected she will. If the Examiner's amendment is entered, the claims of the '730 patent will recite *inter alia*:

> "receiving an access message ***by an application*** from the agent allowing the user to access the application, wherein the application is selected from a group consisting of a casino machine, a keyless lock, a garage door opener, an ATM machine, a hard drive, computer software, a web site and file."

'730 reexam, Office Action dated March 3, 2025.

Petitioner believes the Examiner's amendment, if entered, would add an additional limitation to the claims.

Patent Owner believes the Examiner's amendment, if entered, would remove one of two alternatives from the claims.

Because the claims of the '730 Patent pending before the Office may be changed if the Examiner enters her Examiner's amendment, the parties jointly request a conference call to notify the Board of this potential development and seek the Board's guidance on how to address this issue in the current proceeding. The Board has set oral argument for April 22, 2025. Petitioner further requests that the Board allow the parties to submit additional briefing on the limited issue of the amendments to the '730 Patent claims. Proxense offered Petitioner additional briefing at the end of January. Petitioner states that it declined because no specific amendment had been proposed by the Examiner in the '730 reexam at that time. Patent Owner states that the Examiner, at that time, had proposed two alternative amendments and not made a final decision as to which she would enter.

The parties are available for a conference call with the Board on the following dates:

- Thursday, March 27: 12 pm - 5 pm ET
- Friday, March 28: 2 pm – 5 pm ET

Patent Owner believes a summary of the EPR proceedings provided ahead of time would be a benefit to the Board. Petitioner believes such a summary would violate the Scheduling Order. *See* Paper 11 at 2 ("The email may not contain substantive argument and, unless otherwise authorized, may not include attachments.") (citing Consolidated Trial Practice Guide at 9-10). As the parties are at an impasse with regards to providing the Board a summary of the EPR proceedings, Patent Owner will provide a summary in a subsequent email.

Philip W. Woo
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Counsel for Petitioner Apple Inc.

James A. Zak
Reg. No. 60,190
Counsel for Patent Owner Proxense, LLC

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