

From: [Trials](#)
To: [O'Brien, David](#); [Trials](#)
Cc: [Richard Kamprath](#); [George T. Fishback, Jr.](#); [Ehmke, Andrew S.](#); [Lyle, Kelly Gehrke](#); [Shi, Hong](#)
Subject: RE: Authorization for Replies in IPRs IPR2024-00329, -00330, and -00331
Date: Tuesday, May 14, 2024 10:16:43 AM

Counsel,

From the Board –

In response to the May 13, 2024, email from Petitioner's counsel concerning IPR2024-00329, IPR2024-00330, and IPR2024-00330, in each proceeding the Board authorizes (1) Petitioner to file within five business days of this email a Preliminary Reply no longer than five pages that addresses the issues identified in the May 13 email and (2) Patent Owner to file within ten business days of this email a Preliminary Sur-reply no longer than five pages that responds to the Preliminary Reply.

Regards,

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

From: O'Brien, David <David.O'Brien@haynesboone.com>
Sent: Monday, May 13, 2024 4:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: Richard Kamprath <rkamprath@McKoolSmith.com>; George T. Fishback, Jr. <gfishback@McKoolSmith.com>; Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>
Subject: Authorization for Replies in IPRs IPR2024-00329, -00330, and -00331

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Honorable Board,

Apple respectfully requests authorization from the Board for replies to POPRs recently filed by Carbyne Biometrics in the above-identified proceedings. More specifically, Apple requests reply in opposition to Carbyne's advocacy for:

1. a finding of insufficient **motivation to combine** and/or no **reasonable expectation of success**, including Carbyne's premise that the Board should give **no probative weight** to expert testimony notwithstanding its detailed analysis and underlying factual support and its premise that Stone is not **analogous art**.

Apple's basis for reply on issue (1) includes mischaracterization of law and fact in manner unforeseeable at the time of the petition because of Carbyne's departure from established legal principles.

The parties have met and conferred. Carbyne opposes. More specifically, Carbyne states that it “does not oppose an identical five-page reply on *Fintiv* grounds given that Patent Owner’s *Fintiv* argument is largely the same with respect to each petition. Patent Owner requests a five page surreply. Patent Owner opposes a reply on all other grounds.” For avoidance of doubt, Apple made a *Sotera* stipulation in each of the above-identified proceedings on 17-April-2024 which, per the Director’s Memorandum, is dispositive. The *Sotera* stipulations have already been made of record in filings authorized by the Board. Accordingly, Apple has not requested reply on *Fintiv* issues.

The parties are available for a conference call with the Board immediately after Memorial Day. Counsel for Carbyne is unavailable this week due to conflicts, while lead counsel for Apple will be out of the country for the entirety of the following week.

HAYNES BOONE

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