

From: Jeffrey Liang <JLiang@sheppardmullin.com>

Sent: Friday, July 12, 2024 4:06 PM

To: Trials <Trials@USPTO.GOV>

Cc: Scott W. Hejny <shejny@McKoolSmith.com>; Eric Hansen <ehansen@McKoolSmith.com>;

Nokia_IPRs_Amazon_HP <Nokia_IPRs_Amazon_HP@mcckoolsmith.com>; Harper Batts

<HBatts@sheppardmullin.com>; Chris Ponder <CPonder@sheppardmullin.com>; LegalTM-Amazon-

Nokia-IPRs <LegalTM-Amazon-Nokia-IPRs@sheppardmullin.com>; Warren Lipschitz

<wlipschitz@mcckoolsmith.com>; Mitch Verboncoeur <mverboncoeur@McKoolSmith.com>; Steven

Udick <sudick@McKoolSmith.com>

Subject: Amazon v. Nokia, IPR2024-00626, IPR2024-00627 - Request for Authorization for Preliminary Reply

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Petitioner respectfully requests authorization to file a preliminary reply in each of IPR2024-00626 and IPR2024-00627, with the same reply being filed in both proceedings. The proposed reply brief would be limited to the following issues: (1) Patent Owner's implicit claim construction arguments regarding the interpretation and scope of the claim term "prediction" (POPR, 46-56) and (2) Patent Owner's argument that the Petition should be discretionarily denied under *Advanced Bionics* (POPR, 28-45). Good cause exists for a preliminary reply because Petitioner could not have anticipated Patent Owner's arguments that improperly seek to narrow the claims and mischaracterize the intrinsic evidence. Nor could Petitioner have anticipated Patent Owner's reasoning for arguing that the asserted references are somehow cumulative when none of the asserted prior art was substantively analyzed during prosecution.

To avoid including unnecessary argument in this email to the Board, Petitioner does not detail the substantive arguments supporting this request. If the Board deems additional detail necessary to determine whether to authorize a preliminary reply, Petitioner can provide those details on a conference call.

Petitioner requests a 12-page preliminary reply and to file it within two weeks of receiving authorization. Petitioner believes that the requested page limit comports with the length of Patent Owner's arguments at issue, with the POPR having 18 pages on *Advanced Bionics* (POPR, 28-45) and over 10 pages related to the claim term "prediction" (POPR, 46-56). Petitioner does not oppose Patent Owner being authorized to file a preliminary sur-reply of equal length to be filed within two weeks of the preliminary reply being filed and limited to the issues raised in the preliminary reply.

Petitioner has conferred with Patent Owner (cc'd). Patent Owner opposes this request and asked to include the below arguments. However, it is Petitioner's understanding that the Board disfavors substantive arguments in email requests, and therefore Petitioner has not included a substantive response here. If the Board wishes to have a conference call, the parties can confer and propose times of mutual availability.

Patent Owner's Arguments:

First, the issues that Amazon seeks to address in the Reply should have been addressed in the Petitions, and Amazon is seeking another chance to argue the merits of its Petitions in the requested Reply, which is improper. Specifically, Amazon complains of “Patent Owner’s claim construction arguments,” yet it was Amazon that proposed the only claim construction in its Petition (for “precision”; Paper 1, 12), and despite Amazon’s suggestion Nokia did not propose a construction for “prediction.” Paper 1, 12. Second, Amazon addressed Advanced Bionics in its Petition but failed to provide substantive argument despite addressing the prosecution history. Paper 1, 86. Neither of these issues gives rise to good cause because each was foreseeable and addressed in the Petitions (or should have been addressed in the Petitions). Finally, Amazon’s Request for 12 pages (approximately 3000 words) in which to address the issues raised in its email to the Board is excessive and will substantially add to the word count already used by Amazon in its Petitions (13,382 words in IPR2024-00626; Paper 1, 97), which creates an incentive to use Preliminary Replies to violate the Rules stated in the Trial Practice Guide. If, for example, Amazon felt that it needed more room to address Advanced Bionics, it could have done so in the Petitions and still complied with word count limitations.

Best regards,

Jeff

SheppardMullin

1540 El Camino Real Suite 120

Menlo Park, CA 94025-4111

+1 650-815-2600 | main

+1 650-815-2685 | direct

JLiang@sheppardmullin.com | [Bio](#)

Attention: This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments.