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Subject: Request for Reply briefing in Apple Inc. (Petitioner) v. Smith Interface Technologies (Patent Owner), Case No. IPR2024-01085
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Your Honors,

Petitioner respectfully requests authorization for (1) leave to file a corrected “Listing of Claims” and (2) briefing in the form of a 2-page Reply to Patent Owner’s Preliminary Response (POPR) in IPR2024-01085. If Petitioner’s request for Reply is granted, Petitioner does not oppose Patent Owner’s submission of an equivalent Sur-Reply. Petitioner respectfully submits that no new evidence should accompany either the Reply or Sur-Reply.

If the request for leave to file a corrected “Listing of Claims” is granted, Petitioner would provide a corrected Listing of Claims that addresses a clerical error, where the corrected Listing of Claims reflects the proper claim listing, consistent with the element-by-element analysis of the Petition and consistent with the expert declaration.

If the request for briefing is granted, the Reply would address arguments in the POPR related to independent claims 1, 22, and 58 regarding the second half of the last element of claim 1 ([1k] in the correct Listing of Claims, which states “and the at least portion of the second virtual display layer is at least partially translucent so that a result of the zoom operation on the at least portion of the contents of the first virtual display layer is visible through the at least portion of the second virtual display layer”), which Patent Owner alleged Petitioner’s mapping does not address. *See, e.g.*, POPR at 9–11. For example, the Reply would address the POPR’s statement that “nowhere does Petitioner’s mapping to Limitation [1k] address the second half of Limitation [1l].” POPR at 11.

Petitioner respectfully submits that good cause for further briefing on these issues exists, at least because briefing would clarify the record and aid the Board in deliberations on issues that are potentially dispositive to institution. For example, Petitioner could not have reasonably anticipated Patent Owner’s mischaracterization of the Petition as not addressing a limitation for which Petitioner offered evidence in the prior art (e.g., figures in the prior art showing the recited claim language). If requested by the Board, Petitioner will provide further explanation of good cause but limits the present narrative out of respect for the Board’s consistent request for emails to be limited to defining issues and thus omit argumentative content.

In connection with this request, Petitioner proposes the briefing schedule outlined below:

Preliminary Response Filed	Institution Deadline	Petitioner’s Reply Deadline	Patent Owner’s Sur-Reply Deadline
10/30/24	1/30/25	Within 1 business days of the Board’s authorization	Within 5 business days of Petitioner’s Reply

With this schedule—with Petitioner’s abbreviated Reply Deadline of 1 business day—the Board would have over a month after receipt of Patent Owner’s Sur-Reply to issue its Institution Decision. If approved, Petitioner would file its corrected Listing of Claims upon authorization.

Petitioner and Patent Owner have met and conferred.

Patent Owner opposes the request to “correct” the claim listing. While characterized as merely clerical, its effect would be to substantively re-organize and re-allocate Petitioner’s mapping to nearly two-thirds (by word count) of claim 1. This would grossly prejudice Patent Owner because it comes six weeks after the filing of the POPR, and would therefore deprive Patent Owner of the opportunity to fully respond to the “corrected” mapping.

Patent Owner also opposes the request for a preliminary reply because the POPR, filed October 30, responded directly to Petitioner’s grounds based on the plain language of the claims, “[e]ven giving the Petitioner the benefit of the doubt [on the Petition’s Limitation [1l]].” Pet., 10-11. Setting aside the timing of this request, Patent Owner does not believe the requested briefing to be necessary for the Board to determine whether the Petition addresses all claim limitations with sufficient particularity.

Should the Board desire a call to discuss this request, the parties are available Friday (12/13) from 10 am – 1 pm or 3-6 pm EST, Monday (12/16) from 1-6 pm EST, or Tuesday (12/17) from 9 am – 12 pm or 1-3:30 pm EST.

Respectfully,

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