

From: Kaiser, Jessica (Perkins Coie) <JKaiser@perkinscoie.com>

Sent: Wednesday, December 4, 2024 5:29 PM

To: Trials <Trials@USPTO.GOV>

Cc: Scott W. Hejny <shejny@McKoolSmith.com>; Eric Hansen <ehansen@McKoolSmith.com>; Brewer, Robin (Perkins Coie) <RBrewer@perkinscoie.com>; Carter, Jon R. (Perkins Coie) <JCarter@perkinscoie.com>; Amazon-NokiaIPR@perkinscoie.com; Rose, Kate (Perkins Coie) <KateRose@perkinscoie.com>; Mitch Verboncoeur <mverboncoeur@McKoolSmith.com>; Emily Tannenbaum <etannenbaum@McKoolSmith.com>

Subject: RE: IPR2024-01139, IPR2024-01140, and IPR2024-01141: Request for Authorization for Preliminary Reply

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Thank you. The parties have conferred and are available at the following times:

- Wednesday (Dec. 11): 9-11 and 2-4 ET
- Friday (Dec. 13): 1-2:30 ET

Best regards,

Jessica Kaiser
PARTNER

Perkins Coie

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From: Trials <Trials@USPTO.GOV>

Sent: Wednesday, December 4, 2024 11:46 AM

To: Kaiser, Jessica (DEN) <JKaiser@perkinscoie.com>; Trials <Trials@USPTO.GOV>

Cc: Scott W. Hejny <shejny@McKoolSmith.com>; Eric Hansen <ehansen@McKoolSmith.com>; Brewer, Robin (SFO) <RBrewer@perkinscoie.com>; Carter, Jon R. (NYC) <JCarter@perkinscoie.com>; *Amazon-NokiaIPR <Amazon-NokiaIPR@perkinscoie.com>; Rose, Kate (PAO) <KateRose@perkinscoie.com>; Mitch Verboncoeur <mverboncoeur@McKoolSmith.com>; Emily Tannenbaum <etannenbaum@McKoolSmith.com>

Subject: RE: IPR2024-01139, IPR2024-01140, and IPR2024-01141: Request for Authorization for Preliminary Reply

Counsel,

Please confer and propose times of mutual availability for a conference call this Friday (Dec. 6), next Wednesday (Dec. 11), or next Friday (Dec. 13). The parties are reminded that any email requesting a conference call with the Board should include multiple times when all parties are available. See IPR2024-01139, Paper 8 at 3 (providing guidance on requesting a conference call with the Board).

Ex. 3001
IPR2024-01139
IPR2024-01140
IPR2024-01141

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Kaiser, Jessica (Perkins Coie) <JKaiser@perkinscoie.com>

Sent: Wednesday, December 4, 2024 11:57 AM

To: Trials <Trials@USPTO.GOV>

Cc: Scott W. Hejny <shejny@McKoolSmith.com>; Eric Hansen <ehansen@McKoolSmith.com>; Brewer, Robin (Perkins Coie) <RBrewer@perkinscoie.com>; Carter, Jon R. (Perkins Coie) <JCarter@perkinscoie.com>; Amazon-NokiaIPR@perkinscoie.com; Rose, Kate (Perkins Coie) <KateRose@perkinscoie.com>; Mitch Verboncoeur <mverboncoeur@McKoolSmith.com>; Emily Tannenbaum <etannenbaum@McKoolSmith.com>

Subject: IPR2024-01139, IPR2024-01140, and IPR2024-01141: Request for Authorization for Preliminary Reply

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Dear Honorable Board,

Petitioner respectfully requests authorization to file preliminary replies in IPR2024-01139, IPR2024-01140, and IPR2024-01141 regarding two specific issues that Patent Owner newly raised in its Preliminary Responses: (1) Patent Owner's arguments for discretionary denial under *Fintiv*, and (2) Patent Owner's mischaracterizations of Petitioner's positions—i.e., that Petitioner makes no argument regarding how the functionality of the TML6 source code is relevant to patentability (-01139 POPR, 31-32; -01140 POPR, 32; -01141 POPR, 33) and that Petitioner did not provide a motivation to combine the TML6 source code files (-01139 POPR, 38-40; -01140 POPR, 38-40; -01141 POPR, 39-41)—based on Patent Owner's apparent copying of arguments from prior preliminary responses in IPRs brought by a different petitioner (IPR2020-01685, Paper 14 at 28, 46-48; IPR2021-00035, Paper 12 at 28, 47-49; IPR2021-00036, Paper 11 at 29, 47-49; IPR2021-00037, Paper 11 at 27-28, 46-48; IPR2021-00038, Paper 10 at 29, 47-49; IPR2021-00039, Paper 10 at 27-28, 46-48; IPR2021-00040, Paper 11 at 28, 47-49; IPR2021-00041, Paper 11 at 27, 47-49; IPR2021-00042, Paper 13 at 27, 47-49; IPR2021-00043, Paper 11 at 29, 50-52) without regard to Petitioner's express arguments and analyses in *these* proceedings. Good cause exists for a preliminary reply because Petitioner could not have anticipated Patent Owner's new arguments and should have a fair opportunity to address them. To avoid including unnecessary argument in this email to the Board, Petitioner does not detail here the specific unanticipated arguments or their merits, but Petitioner can discuss these arguments further on a conference call if the Board deems additional detail necessary to determine whether to authorize preliminary replies.

Petitioner requests a 5-page preliminary reply in each of IPR2024-01139, IPR2024-01140, and IPR2024-01141 and to file it within two weeks of receiving authorization. Petitioner does not oppose Patent Owner being authorized to file a preliminary sur-reply of equal length within two weeks of the filing of the preliminary reply and limited to the issues discussed in the preliminary reply.

Petitioner has conferred with Patent Owner, and Patent Owner opposes its request in part.

Patent Owner does not oppose additional briefing on *Fintiv*. Patent Owner opposes additional briefing on the second issue raised by Petitioner in its request above because Patent Owner's arguments were foreseeable and Petitioner has failed to show good cause. First, the Board is capable of reading the Petition and POPR and determining for itself whether mischaracterizations have been made. Second, Patent Owner did not mischaracterize Petitioner's arguments because while Petitioner suggests in its briefing that the TML6 source code files were publicly available (and should be considered as a single reference), Petitioner and its experts failed to offer any reasoning as to why a POSITA would be motivated to combine the disparate source code files as a single reference (to the extent the Board determines the TML6 source code files are not a single reference).

To the extent the Board is inclined to grant Petitioner's request, Patent Owner respectfully requests a reply brief of equal length in each case to address Petitioner's arguments.

If the Board wishes to have a conference call, the parties can confer and propose times of mutual availability.

Best regards,

Jessica Kaiser
PARTNER

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