

From: [Trials](#)
To: [Stephen Zinda](#); [Trials](#)
Cc: [James Hall](#); [PH-Samsung-AMRH-IPR](#); [John Watkins](#)
Subject: RE: [External] URGENT MATTTTER IN IPR2024-01349 and IPR2024-01350
Date: Tuesday, March 4, 2025 10:40:17 AM

Counsel,

In view of the withdrawal of the Director's June 21, 2022 memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," Patent Owner contends that good cause exists for allowing the parties to address whether IPR2024-01349 and IPR2024-01350 warrant discretionary denial under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Patent Owner contends that the withdrawal of that memorandum was an "important new and unforeseeable development." We agree with Patent Owner that good cause exists for the relief requested. Therefore, Patent Owner is granted leave to file a 5-page brief strictly limited to addressing the *Fintiv* factors, which must be filed no later than March 7, 2025; Petitioner is likewise granted leave to file a 5-page reply brief strictly limited to addressing the *Fintiv* factors, which must be filed no later than March 12, 2025.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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From: Stephen Zinda <stephen@chzfirm.com>
Sent: Tuesday, March 4, 2025 9:57 AM
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Subject: URGENT MATTTTER IN IPR2024-01349 and IPR2024-01350

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Dear Honorable Board,

Patent Owner reaches out regarding an **urgent** matter in IPR2024-01349 and IPR2024-01350. The urgency exists because: (1) the Board's decision on institution in both IPR proceedings will issue on or before March 27, 2025; and (2) new and unforeseeable developments have

occurred that necessitate additional briefing on an issue that could substantially impact the Board's decision on whether to institute.

On February 28, 2025, the United States Patent and Trademark Office rescinded its June 21, 2022 memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("Interim Procedure"). Pursuant to the Interim Procedure, the Board was required to decline to exercise jurisdiction to deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) when a petitioner offers a stipulation pursuant to *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). Because Petitioner submitted *Sotera* stipulations in both IPR petitions, and because the Interim Procedure was binding on the Board at the time Patent Owner filed its preliminary responses on December 27, 2024, Patent Owner did not address the *Fintiv* factors. In other words, because the *Sotera* stipulations foreclosed any possibility of *Fintiv* denial, there was no reason for Patent Owner to address *Fintiv* in its preliminary responses.

Given that the Interim Procedure has now been rescinded by the USPTO, the Board is no longer required to decline the exercise of jurisdiction under *Fintiv* when a *Sotera* stipulation is submitted. In light of this important new and unforeseeable development, Patent Owner respectfully requests leave to file a 5-page brief addressing the *Fintiv* factors. Patent Owner believes that the factors heavily favor discretionary denial, and Patent Owner would have advanced arguments advocating for discretionary denial if the then-binding Interim Procedure had not foreclosed that possibility.

Patent Owner does not oppose Petitioner being permitted to submit 5-pages of briefing in response to the arguments raised by Patent Owner's 5-page brief.

Petitioner has indicated it opposes Patent Owner's request. Given the fast-approaching due date for the Board to issue its institution decisions, any briefing schedule at this juncture would be impractical and prejudicial. Moreover, given Petitioner's *Sotera* stipulation in IPR Nos. 2024-01349 and -1350, any suggestion by Patent Owner that the *Fintiv* factors heavily favoring discretionary denial is simply not accurate. To the extent the Board grants Patent Owner's request, Petitioner requests a responsive brief of equal length.

To the extent the Board decides to set a telephonic hearing on the issue, the parties are available anytime tomorrow (3/5), except 2-3:30pm ET, anytime Thursday (3/6), except from noon-2pm ET and after 4pm ET.

Regards,

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