

From: [Trials](#)
To: [Jeremy Monaldo](#); [Buroker, Brian M.](#); [IPR58281-0002IP1](#); [Kathir, Allen](#); [Reiter, Mark](#); [bhershkwitz@gibsondunn.com](#)
Cc: [Trials](#)
Subject: RE: IPR2024-01376 and -01377 - Request for Position on Supplemental POPR to Address Fintiv In Light of PTO Rescission of 2022 Guidance
Date: Wednesday, March 5, 2025 1:41:29 PM

Counsel,

The panel determines that further briefing in view of the 2/28/25 rescission of the 2022 Guidance would be helpful to the panel.

The panel authorizes Patent Owner to file a Supplementary Patent Owner Response of up to five pages in IPR2024-01376 and 01377. The Response may address *Fintiv* discretionary denial in view of the pending ITC proceeding. Patent Owner may, if necessary, file additional exhibits related to the ITC proceeding, but Patent Owner should not incorporate any arguments by reference. The Supplementary Patent Owner Response shall be due March 6, 2025.

The panel authorizes Petitioner to file a Reply to the Supplementary Patent Owner Response of up to five pages in IPR2024-01376 and 1377. Petitioner may similarly file additional exhibits related to the ITC proceeding if necessary. The Reply to the Supplementary Patent Owner Response shall be due March 11, 2025.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Jeremy Monaldo <Monaldo@fr.com>
Sent: Tuesday, March 4, 2025 5:15 PM
To: Buroker, Brian M. <BBuroker@gibsondunn.com>; Trials <Trials@USPTO.GOV>
Cc: bhershkwitz@gibsondunn.com; Reiter, Mark <MReiter@gibsondunn.com>; Kathir, Allen <AKathir@gibsondunn.com>; IPR58281-0002IP1 <IPR58281-0002IP1@fr.com>
Subject: RE: IPR2024-01376 and -01377 - Request for Position on Supplemental POPR to Address Fintiv In Light of PTO Rescission of 2022 Guidance

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IPR2024-01377

responding, clicking on links, or opening attachments.

Your Honors,

Because Patent Owner did not state Petitioner's opposition in its email to the Board, Petitioner reproduces below Petitioner's statement of opposition provided to Patent Owner earlier today:

Petitioner opposes because introducing a new argument for discretionary denial at this late stage of the pre-institution phase of this proceeding would be highly prejudicial to Petitioner, particularly given that Petitioner relied on the 2022 Guidance when filing its petition and devising its strategy for challenging the validity of the '227 and '602 patents.

Patent Owner also did not apprise Petitioner of its proposal for a 24 hour briefing period prior to its email to the Board, which increases the prejudice to Petitioner and does not afford adequate time to fully analyze and brief the *Fintiv* factors.

Respectfully submitted,
Jeremy Monaldo

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Washington, DC

From: Buroker, Brian M. <BBuroker@gibsondunn.com>

Sent: Tuesday, March 04, 2025 4:50 PM

To: Trials@uspto.gov

Cc: bhershkowitz@gibsondunn.com; Reiter, Mark <MReiter@gibsondunn.com>; Kathir, Allen <AKathir@gibsondunn.com>; IPR58281-0002IP1 <IPR58281-0002IP1@fr.com>

Subject: IPR2024-01376 and -01377 - Request for Position on Supplemental POPR to Address *Fintiv* In Light of PTO Rescission of 2022 Guidance

[This email originated outside of F&R.]

To the Honorable Board,

Patent Owner requests permission from the Board to file a Supplemental Preliminary Patent Owner Statement in each of the above-referenced IPRs to address the *Fintiv* factors in light of the rescission by the PTO on 2/28/25 of the 2022 Guidance. Under that 2022 Guidance, the pendency of an ITC proceeding was not considered a factor for discretionary denial. Now, the fact

that the Petitioner is asserting overlapping invalidity arguments in an ITC proceeding that is in trial this week should be a factor for discretionary denial on these petitions. Patent Owner requests leave to file a three-page briefing on that issue and that briefing can be filed within 24 hours of leave being granted. If the Board would like to have a call to discuss this request, Patent Owner is available any time and Petitioner indicated that it was only available on Thursday between 11:30 AM – 5 PM ET and Friday between 9-10 AM, 1:30-2:30 PM, and 3-4 PM ET.

Respectfully submitted,
Brian M. Buroker
Reg. No. 39,125
Counsel for Patent Owner

Brian M. Buroker

Partner

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