

From: [Trials](#)
To: [Bernstein, Ph.D., David P.](#); [Trials](#)
Cc: [Bregman, Dion M.](#); [Metco-KleinTools-IPRs](#); [Jim Glass](#); [Michael Labas](#); [Brienne Straka](#); josephmilowic@quinnemanuel.com
Subject: RE: IPR2024-01400 / Request for Additional Pre-Institution Briefing
Date: Tuesday, March 11, 2025 9:29:33 AM

Counsel:

The Board *grants* Patent Owner's request for authorization to file an additional five-page brief on application of the *Fintiv* factors in light of the recent rescission of the June 2022 Memorandum. Patent Owner must file its brief on or before March 18, 2025.

Petitioner is authorized to file a responsive five-page brief on or before a week after Patent Owner's filing. The issues in both briefs are limited to the *Fintiv* factors.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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From: Bernstein, Ph.D., David P. <david.p.bernstein@morganlewis.com>
Sent: Monday, March 10, 2025 11:34 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; Metco-KleinTools-IPRs <Metco-KleinTools-IPRs@morganlewis.com>; Jim Glass <jimglass@quinnemanuel.com>; Michael Labas <michaellabas@quinnemanuel.com>; Brienne Straka <briennestraka@quinnemanuel.com>; josephmilowic@quinnemanuel.com
Subject: IPR2024-01400 / Request for Additional Pre-Institution Briefing

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Your Honors,

Patent Owner respectfully requests authorization to submit a pre-institution brief addressing the impact of the USPTO's February 28, 2025, rescission of the June 2022 Memorandum on discretionary denial. This unexpected policy change directly affects the application of the *Fintiv*

factors in this case, particularly given the parallel ITC proceeding involving the '206 patent, which already concluded its trial in early February.

In particular, Patent Owner requests permission to submit a five-page brief within one week of authorization, and does not oppose Petitioner filing a sur-reply of equal length, due one week after Patent Owner's submission.

Patent Owner has conferred with Petitioner's counsel, who does not oppose this request.

Should the Board wish to hold a conference call to discuss, both parties are available at the following times:

Friday, March 14, 12:00-2:00 PM ET

Monday, March 17, 3:30-4:00 PM ET

Respectfully submitted,
David
Patent Owner, Back-up Counsel

David P. Bernstein Ph.D.

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