

From: [Thomas Lee](#)
To: [Trials](#)
Cc: [Amol Kavathekar](#); [Yang, Stephen](#); [Greenleaf, Kevin R.](#); [Bickham, Timothy C.](#); [Gothia, Forrest](#); [IPT Docket CHI](#)
Subject: IPR2024-01436, -1437, -1438, & -01439\\Request to file motion to consider Fintiv factors
Date: Wednesday, March 26, 2025 4:25:39 PM

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board,

I am counsel for Patent Owner in the above identified IPRs. Patent Owner filed its Preliminary Patent Owner Responses in two of the above IPRs (IPR2024-1436 and -1439) approximately six weeks before the recent change in guidance on discretionary denial on February 28, 2025 (<https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>) and did not file responses in IPRs -1437 and -1438. Patent Owner requests the opportunity to submit the scheduling order from the underlying district court action, which sets a trial date of September 9, 2025, and to request a two page paper to argue the Fintiv factors, including the proximity to trial and the fact that any Final Written Decision would not issue until almost six months after the completion of trial. Patent Owner does not oppose a similar two page paper by Petitioner to respond.

Petitioner opposes this request because: (1) Patent Owner waited nearly a month after the USPTO's February 28, 2025, change in guidance to make this request; (2) the district court schedule Patent Owner now cites, including the September 9, 2025, trial date, is not new but has been in place since April 9, 2024, and has remained unchanged; (3) the statutory deadline for institution is in two weeks, making it difficult to draft and consider new briefing; and, importantly (4) Petitioner provided a precedential *Sotera* stipulation and has waived prior-art-based invalidity arguments in the district court. *See, e.g., Samsung Electronics Co., Ltd. v. Headwater Research LLC*, IPR2024-01407, Paper 9, 8 (PTAB Mar. 20, 2025) (finding *Sotera* stipulation weighs strongly against discretionary denial). Should the Board grant Patent Owner's request, Petitioner requests a two-page response.

Best regards,

Tom

Thomas Lee | Intellectual Property Attorney | HSML P.C.

45 South Seventh Street, Suite 2700 | Minneapolis, MN 55402 | (ph) 612-455-3844 | ✉: tle@hsml.com |
(main) 612-455-3800 | (fax) 612-455-3801

Warning: In rare cases, our e-mail filtering software may eliminate legitimate email from clients unnoticed. Therefore, if your mail contains important instructions, please make sure that we acknowledge receipt of those instructions.

This is a transmission from the law firm of HSML PC and may contain information which is privileged, confidential, and protected by the attorney-client or attorney work product privileges. It is intended for use only by the person to whom it is directed. If you are not the intended recipient, note that any disclosure, copying, distribution, or use of the contents of this message is prohibited. If you have received this transmission in error, please destroy it and notify us immediately at our telephone number 612.455.3800. Thank you.

Ex. 3001
IPR2024-01437
IPR2024-01438

