
From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, April 8, 2025 8:21 AM
To: Inge.Osman@lw.com; Jensen, Travis; Kevin.Wheeler@lw.com; brenda.danek@lw.com; Steven.Peters@lw.com; Amit.Makker@lw.com; Lang, Jason; Bobrow, Jared; Bonini, Matthew
Cc: Trials
Subject: RE: IPR2025-00118 - Preliminary Reply Request

[EXTERNAL]

Counsel,

Petitioner is authorized to file a three-page preliminary reply to the Preliminary Response, limited to responding to Patent Owner's *Fintiv* arguments. The preliminary reply is due on or before April 15, 2025.

Patent Owner is authorized to file a three-page preliminary sur-reply to Petitioner's preliminary reply. The preliminary sur-reply is due on or before April 22, 2025.

Regards,

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

From: Inge.Osman@lw.com <Inge.Osman@lw.com>
Sent: Monday, April 7, 2025 4:08 PM
To: Trials <Trials@USPTO.GOV>; tjensen@orrick.com
Cc: Kevin.Wheeler@lw.com; brenda.danek@lw.com; Steven.Peters@lw.com; Amit.Makker@lw.com; jlang@orrick.com; jbobrow@orrick.com; mbonini@orrick.com
Subject: RE: IPR2025-00118 - Preliminary Reply Request

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Dear Honorable Board,

Patent Owner is not withdrawing its *Fintiv* arguments from consideration. In view of the recent guidance from the Board on discretionary denial and the application of *Fintiv*, Patent Owner would not oppose a 3-page preliminary reply limited to *Fintiv* issues from Petitioner and an equal length sur-reply from Patent Owner.

Respectfully,

Inge Osman
Counsel for Patent Owner

Inge A. Osman

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From: Trials <Trials@USPTO.GOV>
Sent: Monday, April 7, 2025 10:38 AM
To: Jensen, Travis <tjensen@orrick.com>; Trials <Trials@USPTO.GOV>
Cc: Osman, Inge (DC) <Inge.Osman@lw.com>; Wheeler, Kevin (DC) <Kevin.Wheeler@lw.com>; ~Naples, Clement <Clement.Naples@lw.com>; Danek, Brenda (CH) <brenda.danek@lw.com>; ~Yeh, Thomas <Thomas.Yeh@lw.com>; Peters, Steven (DC) <Steven.Peters@lw.com>; Makker, Amit (Bay Area) <Amit.Makker@lw.com>; Lang, Jason <jlang@orrick.com>; Bobrow, Jared <jbobrow@orrick.com>; Bonini, Matthew <mbonini@orrick.com>
Subject: RE: IPR2025-00118 - Preliminary Reply Request

Counsel,

Patent Owner is requested to advise the Board whether it is withdrawing its *Fintiv* arguments from consideration in the proceeding.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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From: Jensen, Travis <tjensen@orrick.com>
Sent: Tuesday, March 25, 2025 10:54 PM
To: Trials <Trials@USPTO.GOV>
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<jbobrow@orrick.com>; Bonini, Matthew <mbonini@orrick.com>

Subject: IPR2025-00118 - Preliminary Reply Request

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Your Honors:

Petitioner requests authorization in IPR2025-00118 to file a 4-page preliminary reply to address Patent Owner's mischaracterizations of the Petition's proposed combinations and one *Fintiv* issue.

First, Patent Owner asserts the Petition relied on a ground bus configuration shown in Yoshinaga's Figure 3. See POPR, 20-24. But the Petition relies on the bus connections shown in Yoshinaga's Figure 2. *E.g.*, Pet., 34-35.

Second, Patent Owner mischaracterizes the blue lines in Saint's Figure 7-7 as "showing 'pins'" instead of buses. POPR, 3, 24-26. The Petition showed these are buses, including when referencing Saint's Figures 7-3 (showing pins 1, 5, 7, 9 connected to buses VCC1 and GND1) and 7-6 (showing pins outside the black rectangle rather than the blue buses inside the rectangle as Figure 7-7 shows). See Pet., 70-74. There is good cause for a preliminary reply as Petitioner could not reasonably have anticipated that Patent Owner would mischaracterize the Petition.

Third, Patent Owner argues for discretionary denial under the *Fintiv* factors. POPR, 31-38. Petitioner wishes to respond and update the Board concerning the district court's recent order staying the district court litigation pending completion of IPR proceedings. If the Board authorizes a preliminary reply, Patent Owner does not object to a sur-reply of the same length.

Petitioner and Patent Owner met and conferred regarding this request, and Patent Owner opposes Petitioner's request as follows:

None of Petitioner's three points constitute good cause for a Reply because they either dispute substantive arguments in the POPR or are moot.

First, PO does not dispute that Petitioner relied on Figure 2. To the contrary, the POPR explains that Petitioner ignores Figure 3 in its proposed combination for Ground 2 and explains why Figure 3 would have led a POSITA away from Petitioner's proposed combination. POPR 20-24 (addressing Ground 2). Petitioner should not be permitted to belatedly address Figure 3 in a sur-reply, having failed to do so in the Petition.

Second, the POPR notes that the Petition provides no explanation about how or why Saint's figure titled "Pin-out simplification" showing pins "close to each other" purportedly shows "buses" instead of "pins." POPR, 3, 24-26. Petitioner's sur-reply seeks to improperly supplement the Petition in order to belatedly address this deficiency. There is no good cause for a reply here. The Board is well-equipped to evaluate the merits of these issues, including any purported "mischaracterizations," without further briefing, which would merely waste the Board's time and resources.

Third, no Reply is warranted as to *Fintiv* because, as Patent Owner informed the Board on March 21, the district court recently stayed the case pending IPR. Patent Owner's *Fintiv* arguments therefore no longer apply, and a Reply would waste the Board's resources. However, if the Board grants Petitioner's Request, Patent Owner requests a Sur-Reply of equal length.

The parties are available for a telephone conference at the Board's convenience. Respectfully submitted, Travis Jensen (counsel for Petitioner)

Travis M. Jensen
Partner, IP Litigation

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