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To: [Eagle Robinson](#); [Sujeeth Rajavolu](#); eovcina@azalaw.com; jeffrey.wright@azalaw.com; [Daniel Leventhal](#); [Brett McKean](#); [Susan Lien](#); [cdeng](#); [Colin Phillips](#)
Cc: [Trials](#)
Subject: RE: Request for Preliminary Reply | IPR2025-00089
Date: Tuesday, May 6, 2025 11:50:30 AM

Counsel,

Petitioner's request for authorization to file a preliminary reply is denied. Petitioner has not demonstrated that good cause exist to file a preliminary reply in accordance with 37 C.F.R. § 42.108(c) because the asserted prior art references at issue in this proceeding (i.e. Stringfellow, Kloster, Carlson) are different from the asserted prior art references previously considered by the Board in IPR2024-01159 (i.e. PayPal, Schlessner). Given the differences in prior art, the panel in this proceeding does not believe it would benefit from Petitioner addressing how the Board's Decision Denying Institution in IPR2024-01159 purportedly implicates Petitioner's claim mapping with respect to the limitation 'the secure server does not provide the non-sensitive electronic data token to the payer.'

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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From: Eagle Robinson <eagle.robinson@nortonrosefulbright.com>
Sent: Friday, May 2, 2025 5:23 PM
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Dear Board:

Petitioner respectfully requests leave to file a Preliminary Reply of no more than 5 pages addressing events arising after filing of the Petition, specifically, the Institution Decision in IPR2024-01159 and

Patent Owner's characterization (see Paper 8 at 44-49) of the import of that decision to Petitioner's (a) "call back URL" mapping (Paper 1 at 34-35, 51), and (b) "API call" mapping (See Paper 1 at 34-35, 51) for the claim limitation "the secure server does not provide the non-sensitive electronic data token to the payer."

Petitioner believes that good cause exists because the Institution Decision in IPR2024-01159 issued after the instant Petition was filed (to avoid even the appearance of "road mapping," Petitioner intentionally did not review the corresponding POPR before filing the instant Petition), meaning Patent Owner was able to comment on that decision in its POPR here and Petitioner should in fairness be afforded the opportunity to respond.

On April 21, Counsel for Petitioner promptly advised counsel for Patent Owner of the intent to request this leave from the Board, and the parties since have conferred on the scope of the request, including a proposal to agree to a claim construction in the Litigation and withdrawal here of a corresponding one of Petitioner's two mappings. The parties have been unable to reach agreement, though Petitioner has narrowed its request through the process.

If Petitioner's request is granted, Petitioner is not opposed to Patent Owner's submission of an equivalent Sur-Reply.

Patent Owner Statement: Patent Owner respectfully opposes. Patent Owner contends that Petitioner has not established good cause under 37 CFR § 42.108(c), including because Petitioner's rationales are based on events that arose prior to the filing of the Petition: Patent Owner first made the arguments Petitioner is referencing in its Preliminary Response to IPR2024-01159 (Paper 10), which Patent Owner filed on October 31, 2024. Patent Owner views Petitioner's request as an attempt re-write its old arguments to create a position which it did not argue in the Petition. However, if Petitioner's request is granted, Patent Owner respectfully requests that it be allowed to file a sur-reply with the same page count limit as granted to Petitioner.

If a conference call is needed, the parties are available at the following times:

- Wednesday (May 7): 9-10, 11-2, 5-6 EDT
- Thursday (May 8): 9-12, 3-6 EDT

Respectfully,

Eagle Robinson
Reg. No. 61,361
Lead Counsel for Petitioner

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