From: Nguyen, Jean
Sent: Monday, September 8, 2025 8:26 PM
To: Stach, Jason; Yap, Alex S.; Arjomand, Mehran; Jumio_Facetec_IPRs
Cc: Goldberg, Joshua; Johns, Christopher; FaceTec-Jumio-IPRs; Berlenbach, Anthony; Zang, Chen
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

The only time we are available this week is Thursday, Sept. 11 at 1 pm PT.

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Monday, September 8, 2025 5:49 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: Re: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

We will be contacting the Board tomorrow morning to set up a conference call. Please let us know your availability, as we requested. We agree to speak on Wednesday at 1 p.m. PT about the redactions, but we do not intend to delay in setting up the conference call since we have an impasse on at least one issue.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Monday, September 8, 2025 8:38 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher

<Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

There are two separate issues listed below.

- **Indemnity Payment**: As we have stated below, we believe we have more than answered the Board's question on "whether there have been such payments or whether there haven't been such payments." (Ex. 2031, 35:5-11.) As we have noted, we will not continue this deposition via email. If you are not satisfied with our response, we are available for a conference call with the Board.

- **Redactions**: We provided you with the unredacted headings of the Partner Agreement. You did not respond on why FaceTec would need these other irrelevant sections of the Partner Agreement. If FaceTec's position is that it is entitled to other (non-indemnity) provisions of Partner Agreement, please identify them and we can consider your request.

We are available to meet and confer with you on Wednesday, Sept. 10 at 1 pm PT.

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Monday, September 8, 2025 1:14 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

We are simply trying to understand whether Jumio has complied with the Board's guidance and provided the correspondence and other documents called for in our requests. Since you are now referring us to the Board, we will request a conference call this week via the message below. Please let us know your availability for a Board call by the end of the day.

> Dear Honorable Board,
>
> Patent Owner requests a conference with the Board to address an ongoing discovery dispute concerning indemnification between Petitioner Jumio and its indemnifier, iProov. The parties discussed this discovery dispute with the Board in a conference on August 5. Petitioner has provided a redacted copy of the indemnification agreement, but disputes remain about whether Petitioner has complied with the Board's August 5 guidance. The parties are generally available for a call with the Board this week.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Friday, September 5, 2025 2:48 AM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

IProov has not voided prior amounts owed by Jumio to iProov or provided discounts on iProov products or services or delayed payment as some form of indemnification.

We have more than answered the Board's question on "whether there have been such payments or whether there haven't been such payments." (Ex. 2031, 35:5-11.) We will not continue this deposition via email. If you are not satisfied with our response, we are available for a conference call with the Board.

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Thursday, August 28, 2025 12:45 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

We agree to abide by the modified protective orders while Petitioner's motion for entry is pending. Please produce the indemnification agreement.

Regarding payment information, your message suggests that iProov may not be fulfilling its obligations under the indemnification agreement, is delaying payment (perhaps due to a dispute over Perkins' fees or for other reasons), or is fulfilling its obligations in another way, such as by voiding prior amounts owed by Jumio to iProov or by providing discounts on iProov's products/services. Please let us know of any consideration that has been

exchanged or may be exchanged related to either the PTAB proceedings or the district court proceedings, or any associated appeals, as these would still constitute payments.

Regarding Ms. Kaiser's deposition, she is Jumio's witness and it is Jumio's obligation to provide her for deposition or receive an adverse inference, as the Board mentioned during our call. Your message implies that she should be treated as a third party, stating that we should work with Perkins' counsel to arrange the deposition. But Jumio chose to submit her declaration after Perkins had already been disqualified, and it is not now appropriate to put the burden on FaceTec to ensure that she sits for deposition. We ask again that Jumio identify deposition dates for its witness.

Finally, we have attached draft stipulations to extend Due Dates 1, 2, and 3. Please let us know if you have any comments.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Tuesday, August 26, 2025 7:18 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,
We do not agree with your statement that the Board often waits to decide protective order issues and related motions to seal until after the final written decision, but Petitioner is willing to produce the documents subject to Patent Owner abiding by the modified protective orders as if they were entered. Please confirm.
Regarding the payment information, as we have stated below, iProov neither paid nor reimbursed Jumio's legal fees—either to Jumio or its counsel--for either the PTAB proceedings or the district court proceeding.
As for Ms. Kaiser's deposition, please reach out to her (JKaiser@perkinscoie.com) and Perkins's counsel (Angela Jones, AJones@perkinscoie.com) for her availability and include us on the correspondence.
Lastly, as a courtesy, we agree to your request to move Due Date 3 to February 24. We expect the same courtesy should Petitioner need to request an extension on a due date.
Regards,

Jean Nguyen, Ph.D.
Of Counsel
jnguyen@mofo.com
T: +1 (213) 892-5295

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Los Angeles, CA 90017-3543

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From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Friday, August 22, 2025 2:02 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

We do not oppose your motion, but we do oppose waiting to produce the documents until the Board has granted the motion. The Board often waits to decide protective order issues and related motions to seal until later in a proceeding, often after it issues a final written decision. Please confirm that Jumio will produce the documents upon filing the motion.

It also appears that Jumio is taking an unduly narrow view of the payment information we requested and the Board's guidance regarding that request. We are seeking information regarding all payments under the indemnification agreement. Due to the overlap between the litigation arguments and the IPRs, it is not appropriate to completely segregate payments related to the district court. It is also not appropriate to limit the request to payments made directly from iProov to Jumio, as the request expressly calls out payments made to third parties (e.g., law firms) under the indemnification agreement. If Jumio refuses to provide the full scope of this information, please let us know times this coming week when you are available to speak with the Board.

As we previously mentioned, we intend to depose Ms. Kaiser after Jumio fully complies with the discovery guidance provided by the Board. Please let us know of potential deposition dates.

Regarding the schedule, we can agree to your proposed additional extension to Due Date 2 if you'll agree to move Due Date 3 to February 24. However, if Jumio does not timely produce the discovery discussed above, we may approach you and the Board (if necessary) to further revise the schedule to account for Jumio's delay.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Wednesday, August 20, 2025 9:08 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,
Thank you for confirming that the proposed changes to the protective order are acceptable to FaceTec. Attached is a motion for entry of the protective order for the ’471 IPR. Please confirm that Patent Owner does not oppose the motion.
Petitioner will produce the Partner Agreement between Petitioner and iProov containing the indemnity agreement after the Board enters the protective order. There have not been any payments from iProov to Petitioner under the indemnity agreement or otherwise in the IPRs. We note that the IPRs are unrelated to the defense of the claims in the district court action and, in any case, iProov is not, and has not at any point been, involved in the IPRs. iProov has obviously intervened directly in the district court litigation and does not control Jumio’s defense in the litigation.
As a courtesy, we are willing to agree to moving Due Date 1 (POR deadline) to September 23 and Due Date 3 (PO’s Sur-reply) to February 10, provided that Due Date 2 (Petitioner’s Reply) is moved to January 14 to avoid the winter holidays.
Regards,

Jean Nguyen, Ph.D.
Of Counsel
jnguyen@mofo.com
T: +1 (213) 892-5295

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707 Wilshire Boulevard
Los Angeles, CA 90017-3543

MORRISON FOERSTER

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From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Monday, August 18, 2025 9:55 AM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio-Facetec-IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

The proposed changes to the default protective order are acceptable to us. Below, you mentioned providing the agreement. Please confirm that you will also be providing the payment information and related correspondence,

per the Board's guidance. And please confirm when Jumio intends to produce the documents, as requested below.

Also, FaceTec does not intend to move to amend its claims, which leaves additional time in the schedule. We propose that FaceTec and Jumio evenly divide this additional time, with both receiving an additional two weeks for their next filings. This would move FaceTec's Patent Owner's Response deadline from September 9 to September 23, and would move Jumio's Reply deadline from December 2 to December 30 (pushing it back four total weeks). The Sur-Reply deadline would then be pushed back four weeks to February 10. If you agree, we will prepare a stipulation for each case.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Wednesday, August 13, 2025 11:13 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

Attached are the clean and redlined versions of the revised protective order.

Regards,

Jean Nguyen, Ph.D.
Of Counsel
jnguyen@mofo.com
T: +1 (213) 892-5295

Morrison Foerster
707 Wilshire Boulevard
Los Angeles, CA 90017-3543

MORRISON FOERSTER

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From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Tuesday, August 12, 2025 10:14 AM
To: Stach, Jason <Jason.Stach@finnegan.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>;

FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

We intend to follow the Board's guidance. Note that Petitioner needs to first provide notice to iProov of the production. Further, we will be providing the agreement under the outside counsel only designation. We will send you revisions to the default protective order for your review.

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Saturday, August 9, 2025 12:50 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

Please confirm whether Jumio intends to follow the Board's guidance last week and will produce documents responsive to Request Nos. 1 and 2 below. If so, please confirm when Jumio intends to complete its production, as we would like to schedule Ms. Kaiser's deposition for shortly after that production. If Jumio does not intend to follow the Board's guidance, please let us know times when you are available for a follow-up call with the Board this coming week.

Best regards,

Jason

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Tuesday, August 5, 2025 12:56 PM
To: Nguyen, Jean <JNguyen@mofo.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

We have retained a court reporter for today's call with the Board.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Tuesday, July 29, 2025 11:59 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

We are available during the following dates and times (PDT) this week:

Thursday, July 31 10-11a, 2-3:30p
Friday, Aug 1 10a-10:30a

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Tuesday, July 29, 2025 9:29 AM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>; Kehrer, Chelsea Caylin <CKehrer@mofo.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

Thank you for speaking with us this morning. As we discussed, to further streamline FaceTec's requests, we intend to not pursue requests 7 and 8 against Jumio, and plan to revise request 9 slightly to read: "Documents reflecting Jumio's use of the information learned about FaceTec's liveness software as a licensee when Jumio was creating, revising, or updating Jumio's liveness assurance software." We do not understand this to alter Jumio's position, but please let us know today if you disagree.

We intend to send the following message to the Board later today. Please let us know your team's availability.

Honorable Board,

Patent Owner seeks authorization to file a motion for routine and additional discovery from Petitioner regarding privity/real party in interest and objective indicia of nonobviousness. The parties have conferred and Petitioner opposes. The parties have refrained from including argument here, but if the Board would like additional details, Patent Owner is available for a call at the Board's convenience any time this week.

Respectfully submitted,

Jason Stach
Counsel for Patent Owner

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Sunday, July 27, 2025 9:42 AM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>; Kehrer, Chelsea Caylin <CKehrer@mofo.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

We are available before 9:30 am PDT on Tuesday to discuss these issues.

Regards,
Jean

From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Friday, July 25, 2025 12:56 PM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

The parties have conferred and it appears that they disagree. We intend to approach the Board no later than Tuesday afternoon. If you think additional conferring may be of value and you are available before then, we would be glad to further discuss these issues with you. Please let us know times you are available to confer on Monday and Tuesday, and times you are available to speak with the Board later in the week.

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Thursday, July 24, 2025 11:20 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

We disagree that your extensive discovery requests are routine discovery. We also do not believe that the law supports such requests for additional discovery.

Privity Requests

FaceTec's first four requests for "privity" documents do not fall within routine discovery, a fact that FaceTec appears to have previously admitted. IPR2025-00106, Paper 14 at 1; IPR2025-00106 Paper 19 at 2. Jumio did not cite to any of these documents in its Petition, nor did it "discuss its view of the substance" of the indemnification agreement as FaceTec contends. Jumio's single-line reference that "iProov and Jumio have an arms-length business relationship with a standard indemnity agreement" does not constitute an "exhibit cited in a paper or in testimony." Such a reading of 37 C.F.R. § 42.51(b)(1)(i) is overly broad. *See Corning Incorporated v. DSM IP Assets B.V.,* IPR2013-00043, Paper 27, at 3-4 (PTAB Jun. 21, 2013) (rejecting the argument that mere reference to "the creation of samples and the results of testing those samples" required the information be produced as "routine discovery"). These document requests also do not contain "relevant information that is inconsistent with a position advanced by the party" as such documents, to the extent they even exist, are not inconsistent with Jumio's position that it is not in privity with iProov.

The "privity" requests also are not appropriate for additional discovery. FaceTec's citation to *Semiconductor Components Indus., LLC et al. v. Greenthread, LLC* is inapposite. In that case, the Director found that additional privity discovery was needed "*given that Petitioner was a supplier of a time-barred party, Intel.*" IPR2023-01242, Paper 94 (PTAB Apr. 24, 2025) (emphasis added). Jumio is not iProov's supplier, and the reasoning in *Semiconductor* does not apply here.

Objective Indicia Requests

Similarly, FaceTec's requests 5-9 that it claims relate to objective indicia of non-obviousness are not appropriate for routine or additional discovery, particularly where FaceTec never raised objective indicia in its response or sur-reply. FaceTec did not identify any case law to support its contention that evidence of objective indicia of non-obviousness must be produced as part of routine discovery. In fact, the PTAB has explicitly found otherwise. *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.,* IPR2017-00573, Paper 11 at 2 (PTAB Aug. 10, 2017) (secondary considerations does not fall under routine discovery). The PTAB has also "decline[d] to make additional discovery on secondary considerations available as a matter of right, given that all other types of additional discovery may be obtained only upon a showing based on the *Garmin* factors." (*See* Federal Register: Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board.) FaceTec's cited case, *Wiz, Inc. v. Orca Security Ltd.*, does not support its requests here. In *Wiz, inc.,* the Patent Owner sought specific documents produced in a prior case that the Patent Owner showed would support its specific claims of copying and commercial success. IPR2024-00863, Paper 29 (P.T.A.B. Mar. 28, 2025). FaceTec's requests, by contrast, are not specific to any particular document, and do not appear to support any factor of non-obviousness, which FaceTec never alleged in the first instance.

I am out of office this week, but we are available next week to meet and confer. If FaceTec continues to demand this overbroad and unnecessary discovery, please provide your availability next week to meet and confer.

Regards,

Jean Nguyen, Ph.D.
Of Counsel
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From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Monday, July 21, 2025 8:05 AM
To: Nguyen, Jean <JNguyen@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

The requests are all routine discovery under 37 C.F.R. § 42.51(b)(1). Among other things, that regulation states:

> (i) Unless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.
> . . .
> (iii) Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.

The requests all fall under one or both of these provisions. As we explained below, for example, Jumio discussed its indemnification agreement with iProov in its replies. *See, e.g.*, IPR2025-00106, Paper 10 at 2 ("iProov and Jumio have an arms-length business relationship with a standard indemnity agreement."). Despite addressing its view of the substance of that agreement, Jumio has not produced it in the IPRs and FaceTec's IPR counsel does not otherwise have access to it. Request No. 1, which seeks production of this agreement, is therefore routine discovery.

Similarly, payments made by iProov to fund Jumio's IPRs are relevant to whether iProov is in privity with Jumio or is a real party in interest. *See, e.g.*, IPR2025-00106, Paper 6 at 14-22 (discussing how indemnification is relevant to the privity and real-party-in-interest inquiries, including citing case law); *see also* Consolidated Trial Practice Guide at 17 ("a party that funds and directs and controls an IPR or PGR petition or proceeding constitutes a 'real party-in-interest'"). Jumio has argued that iProov is not in privity and is not a real party in interest, but to the extent iProov is funding Jumio's IPRs, that fact is inconsistent with Jumio's arguments. Request No. 2 is therefore directed to documents that Jumio should have produced as routine discovery. Requests 3 and 4 likewise seek documents that are inconsistent with Jumio's arguments against privity and real party in interest, with FaceTec's preliminary responses explaining how the requested information is factually and legally relevant to those issues. *See, e.g.*, IPR2025-00106, Paper 6 at 5, 9-10, 15, 20-21. And as we noted below, if the Board deems any of these requests not to be routine discovery, we believe the information should be produced as additional discovery.

The Acting Director has taken steps to ensure that patent owners obtain discovery relevant to privity and real party in interest, even going so far as to vacate final written decisions so the proper discovery is provided. *See Semiconductor Components Indus., LLC et al. v. Greenthread, LLC*, IPR2023-01242, Paper 94 (P.T.A.B. Apr. 24, 2025). And in related cases, the Board thought it was so important for it to learn the relevant facts that it sua sponte ordered discovery despite the patent owner stating that it would forgo that discovery. *See Semiconductor Components Indus., LLC et al. v. Greenthread, LLC*, IPR2024-00263, Paper 61 (P.T.A.B. June 27, 2025). In light of this, we are hoping that Jumio will agree to provide the requested information without the need to burden the Board with motions practice.

Requests 5 through 9 are relevant to objective indicia of nonobviousness, including at least nexus, commercial success, skepticism, long-felt need, and copying. The requested information is inconsistent with Jumio's arguments that the challenged claims are obvious, so it qualifies as routine discovery. And like with the privity/real-party-in-interest requests, if the Board were to deem them not to be routine, we seek production as additional discovery. *See, e.g.*, *Wiz, Inc. v. Orca Security Ltd.*, IPR2024-00863, Paper 29 (P.T.A.B. Mar. 28, 2025) (Baer, APJ, granting additional discovery on objective indicia of nonobviousness). We hope that Jumio will also provide this category of information without the need to burden the Board.

If Jumio declines to produce any of the requested information, please let us know times this week when you are available to speak with the Board about authorizing a motion for routine discovery and additional discovery (if the Board were to deem any of the above not to fall within routine discovery).

Best regards,

Jason

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Friday, July 18, 2025 10:01 PM
To: Stach, Jason <Jason.Stach@finnegan.com>; EXT- AYap@mofo.com <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: RE: IPR2025-00106, -00107, -00108, and -00109: Request for Information

Counsel,

For us to evaluate your request, please let us know which document requests relate to "routine" discovery and which are additional discovery. Please also provide a legal basis and case law support on why the document request(s) are considered "routine" discovery.

Regards,

Jean Nguyen, Ph.D.
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From: Stach, Jason <Jason.Stach@finnegan.com>
Sent: Thursday, July 17, 2025 5:15 PM
To: Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MArjomand@mofo.com>; Nguyen, Jean <JNguyen@mofo.com>; Jumio_Facetec_IPRs <Jumio_Facetec_IPRs@mofo.com>
Cc: Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Johns, Christopher <Christopher.Johns@finnegan.com>; FaceTec-Jumio-IPRs <FaceTec-Jumio-IPRs@finnegan.com>; Berlenbach, Anthony <Anthony.Berlenbach@finnegan.com>; Zang, Chen <Chen.Zang@finnegan.com>
Subject: IPR2025-00106, -00107, -00108, and -00109: Request for Information

External Email

Counsel,

We request that Jumio produce the following information in IPR2025-00106, -00107, -00108, and -00109.

1. Any sales or indemnification agreements between Jumio and iProov Ltd. related to the accused products in *FaceTec, Inc. v. iProov Ltd.*, Case No. 2:21-cv-02252 (D. Nev.) and *FaceTec, Inc. v. Jumio Corp.*, Case No. 3:24-cv-03623 (N.D. Cal.) (the Nevada and California litigations, respectively).
2. Documents sufficient to show any payments made by iProov to Jumio or any third party (e.g., a law firm) under any agreements responsive to Request No. 1, and correspondence identifying the specific expenses being paid or reimbursed.
3. Correspondence between Jumio and iProov regarding prior art or invalidity, including correspondence regarding these inter partes reviews.
4. Documents supporting the statements attributed to Jumio's Chief Revenue Officer in Exhibit 2001.
5. Documents concerning the market for the accused products in the Nevada and California litigations, including but not limited to any analysis of product benefits, features, price, advertising, promotion, or discounts of the accused products or any other products that compete with the accused products.

6. Sales data for the accused products in the Nevada and California litigations sufficient to show the accused products' sales, market share, price, and sales and marketing costs from launch through present.
7. Documents discussing FaceTec's Spoof Bounty program or its 3D Liveness software.
8. Documents reflecting the information collected by Jumio employees who participated in FaceTec's Spoof Bounty program.
9. Documents reflecting Jumio's use of the information sought in Request No. 8 in creating, revising, or updating Jumio's liveness assurance software.

Much of the above information constitutes routine discovery under 37 C.F.R. § 42.51(b)(1) because Jumio either discussed it in a paper but did not produce it (e.g., the indemnification agreement discussed in Jumio's pre-institution replies) or is inconsistent with arguments Jumio advanced (e.g., any payments from iProov that cover Jumio's IPR legal expenses). If Jumio declines to produce any of the above information, please let us know times next week when you are available to speak with the Board about authorizing a motion for routine discovery and additional discovery (if the Board were to deem any of the above not to fall within routine discovery).

Best regards,

Jason

Jason Stach
Partner
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