

Bajaj, Raghav (ATX)

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, November 13, 2025 10:06 AM
To: Bajaj, Raghav (ATX); Director_DI; Trials
Cc: Moore, Matthew (DC); Weston, Tiffany (DC); Svendsen, John (NY); Kim, Brian (Bay Area); Rosen, Lauren (LA); kfriesen@hpcllp.com; lglick@hpcllp.com; WAPPTT@hpcllp.com
Subject: RE: IPR2025-01325 - Petitioner's Request for Authorization to File a Reply to Patent Owner's Preliminary Response

Counsel,

Petitioner is authorized to file a 3-page preliminary reply in IPR2025-01325, due no later than November 18, 2025, limited to addressing the issues identified below. Patent Owner is authorized to file a 3-page preliminary sur-reply due no later than November 21, 2025, limited to addressing the same issues.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366



From: Raghav.Bajaj@lw.com <Raghav.Bajaj@lw.com>
Sent: Thursday, November 13, 2025 10:48 AM
To: Director_DI <Director_DI@uspto.gov>; Trials <Trials@USPTO.GOV>
Cc: Matthew.Moore@lw.com; Tiffany.Weston@lw.com; John.Svendsen@lw.com; Brian.Kim@lw.com; Lauren.Rosen@lw.com; kfriesen@hpcllp.com; lglick@hpcllp.com; WAPPTT@hpcllp.com; Raghav.Bajaj@lw.com
Subject: RE: IPR2025-01325 - Petitioner's Request for Authorization to File a Reply to Patent Owner's Preliminary Response

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

Dear Honorable Director,

Petitioner respectfully follows up on the request outlined below to for authorization to file a reply to the Patent Owner Preliminary Response filed October 31, 2025 ("POPR", Paper 7).

Capital One
Exhibit 1057
Capital One v. Wapp Tech
IPR2025-01325
Ex. 1057-001

Best regards,

Raghav Bajaj
Counsel for Petitioner

Raghav Bajaj

LATHAM & WATKINS LLP

300 Colorado St. | Suite 2400 | Austin, TX 78701
D: +1.737.910.7370

From: Bajaj, Raghav (ATX)

Sent: Thursday, November 6, 2025 5:27 PM

To: 'director_di@uspto.gov' <director_di@uspto.gov>

Cc: Bajaj, Raghav (ATX) <Raghav.Bajaj@lw.com>; Moore, Matthew (DC) <Matthew.Moore@lw.com>; Weston, Tiffany (DC) <Tiffany.Weston@lw.com>; Svendsen, John (NY) <John.Svendsen@lw.com>; Kim, Brian (Bay Area) <Brian.Kim@lw.com>; Rosen, Lauren (LA) <Lauren.Rosen@lw.com>; 'Kyle Friesen' <kfriesen@hpcllp.com>; Lily Glick <lglick@hpcllp.com>; WAPP TT <WAPPTT@hpcllp.com>

Subject: IPR2025-01325 - Petitioner's Request for Authorization to File a Reply to Patent Owner's Preliminary Response

Dear Honorable Director,

Pursuant to 37 CFR § 42.108(c), Petitioner respectfully requests authorization to file a reply to the Patent Owner Preliminary Response filed October 31, 2025 ("POPR", Paper 7).

Petitioner seeks to address four aspects of the POPR, as detailed below. For each item, good cause supports authorization of the requested reply, because Petitioner could not have reasonably anticipated the POPR's arguments when filing the Petition, or because evidence refuting certain arguments was not available to Petitioner when filing the Petition.

1. Petitioner seeks to address the POPR's argument that "no prior '192 Patent challenger has asked for a product-by-process construction" and "Petitioner's assertion ... based on its product-by-process interpretation conflicts with past claim constructions adopted by the District Court." POPR, p. 26.
 - a. Petitioner could not have anticipated that Patent Owner would make an argument that is unsupported by evidence or facts.
 - i. First, no court has previously adopted any previous claim construction that claim 60 is or is not product-by-process or evaluated any such argument (and Patent Owner cites no evidence to the contrary); accordingly, Petitioner's assertions are not in conflict with any past construction.
 - ii. Second, Patent Owner failed to acknowledge or serve evidence in its possession that is inconsistent with the advanced positions (see 37 CFR § 42.51(b)(1)(iii)). Contrary to Patent Owner's assertion that previous challengers have not "asked for a product-by-process construction," previous defendants did in fact recognize that claim 60 was subject to a product-by-process interpretation, as Petitioner's Opposition to Patent Owner's Discretionary Denial Brief establishes (see Paper 8, p. 8, *citing* Ex.1055, p. 13). This evidence was not available to Petitioner when the Petition was filed; it was only produced by Patent Owner in October 2025 in the parties' parallel litigation.

2. Petitioner seeks to address the POPR's argument that "Petitioner has provided nothing which would contradict the default interpretation that the software authoring platform of Claim 60 should be interpreted in its structural sense." POPR, p. 27.
 - a. Petitioner could not have anticipated that Patent Owner would make an argument that is contrary to positions Patent Owner has taken in district court.
 - i. First, Patent Owner's Exhibit H claim chart, which accompanied Patent Owner's district court amended complaint filed August 15, 2025 (after the filing of the Petition), refutes Patent Owner's contention. In Exhibit H, Patent Owner alleges infringement because the defendants' "mobile applications that they develop ... are configured to enable a user to modify a photo on the mobile device" (a product) and "mobile applications are developed using a software authoring platform ..." (the alleged product is developed by a specific process). Ex.1056, pp. 63-64. Petitioner could not have presented this argument in the Petition, as the relevant claim chart was filed in the district court after the Petition was filed; however, the relevant claim chart was filed with Petitioner's Opposition (Paper 8) as Exhibit 1056 and is included in the record of this proceeding.
 - ii. Second, Patent Owner's allegation that "claim 60 recites" a system with "two structural components: (1) 'an application' and (2) 'a software authoring platform' that was used in developing 'the application'" is contrary to its original complaint. Patent Owner's complaint alleges the system comprises only one component, the recited application, as Patent Owner contends Petitioner's "application is a 'system comprising an application configured to enable a user to modify a photo on a mobile device[]' and it was developed using 'a software authoring platform configured to simultaneously visually emulate, via one or more profile display windows, a plurality of hardware characteristics indicative of performance of the mobile device when executing the application.'" Ex.2001, ¶ 28. Petitioner could not have anticipated Patent Owner would seek to interpret the claim one way to avoid institution and interpret the claim a different way against accused infringers, which is impermissible in IPR. See *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359-60 (Fed. Cir. 2017); see also Paper 8, p. 10.
3. Petitioner seeks to address the POPR's allegation that the Petition's Ground 2 is a "backdoor" written description challenge (see, e.g., POPR, pp. 2, 28, 32-33).
 - a. Petitioner could not have anticipated that Patent Owner would make an argument that is squarely foreclosed by Federal Circuit precedent, including at least *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023). In *Parus Holdings*, the Federal Circuit held that the Board acted within the statutory authority of 35 USC § 311(b) where the Board considered whether claims of the challenged patent were supported by the written description of the patent's priority documents. The holding in *Parus Holdings* is directly contrary to Patent Owner's argument that the Petition's Ground 2 is "improper in an *inter partes* review" (POPR, p. 33). See also *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1344-45 (Fed. Cir. 2022) (affirming that the Board may consider and determine priority in IPR proceedings).
4. Petitioner seeks to address the POPR's reliance on *Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00208, Paper 10 (P.T.A.B. June 24, 2020). See POPR, p. 22.
 - a. Petitioner could not have anticipated that Patent Owner would make an argument citing a decision that was later reversed after a request for rehearing was granted. See *Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00208, Paper 14 (P.T.A.B. June 1, 2021) (Decision Granting Petitioner's Request on Rehearing and Granting Institution of *Inter Partes* Review). In the

subsequent *Maxlite* decision, the Board noted that the passage Patent Owner cites in its POPR was not supported by any Federal Circuit case. See POPR, p. 22, *see also Maxlite*, IPR2020-00208, Paper 14 at 6. The Board then held that, as particularly relevant here, once a petitioner presents a specific feature that is lacking written description support in a priority application and presents a prior art reference having a date prior to the filing date of the challenged patent, the burden of production shifts to the patent owner to present argument and evidence to show that “each of the limitations of the challenged claims ... could rely on an earlier priority date than the” prior art reference. *Maxlite*, IPR2020-00208, Paper 14 at 3-8. Patent Owner has not made a sufficient showing here.

Given the number of issues to address, Petitioner respectfully seeks a 15-page reply. Petitioner does not seek authorization to file new evidence.

Counsel for Petitioner and Patent Owner have conferred. Patent Owner opposes Petitioner’s request as to issues 1–3 because Petitioner briefed the same issues already in its Opposition to Patent Owner’s Discretionary Denial Brief. See Paper 8 at 8 (addressing issue 1), 9 (addressing issue 2), 17 (addressing issue 3). Good cause does not exist for Petitioner to expand on these arguments. Moreover, 15 pages is an excessive length for a preliminary Reply brief on the question of institution. Patent Owner would not oppose a 4-page Reply brief on the limited question of the shifting burdens of production that apply when challenging priority of a continuation application in an IPR (which Petitioner addresses in issue 4), provided that (i) the Reply may not be used in an attempt by Petitioner to belatedly meet its burden and (ii) Patent Owner has the opportunity to file a sur-reply of similar length.

The parties are available for a conference call to discuss Petitioner’s request at the Director’s convenience.

Respectfully submitted,

Raghav Bajaj
Counsel for Petitioner

Raghav Bajaj

LATHAM & WATKINS LLP
300 Colorado St.
Suite 2400
Austin, TX 78701
Direct Dial: +1.737.910.7370
Email: raghav.bajaj@lw.com
<https://www.lw.com>

This email may contain material that is confidential, privileged and/or attorney work product for the sole use of the intended recipient. Any review, disclosure, reliance or distribution by others or forwarding without express permission is strictly prohibited. If you are not the intended recipient, please contact the sender and delete all copies including any attachments.

Latham & Watkins LLP or any of its affiliates may monitor electronic communications sent or received by our networks in order to protect our business and verify compliance with our policies and relevant legal requirements. Any personal information contained or referred to within this electronic communication will be processed in accordance with the firm's privacy notices and Global Privacy Standards available at www.lw.com.