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To: Trials <Trials@USPTO.GOV>

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Subject: IPR2019-01064; -01065 // Request for Preliminary Reply

To the Honorable Board,

Pursuant to 37 C.F.R. § 42.108(c), Petitioner Apple Inc. respectfully requests authorization to file a five-page Reply to Patent Owner's Preliminary Response in both IPR2019-01064 and IPR2019-01065. Petitioner seeks to address Patent Owner's arguments and evidence that allegedly establish actual reduction to practice of a video camera that antedates the Presler reference (Ex. 1005). This is not an issue that Petitioner was aware of or could have addressed in the Petitions. The parties have conferred and Patent Owner does not oppose if given a Sur-Reply of equal length.

Petitioner also respectfully requests authorization to file a Motion for Pre-Institution Discovery. Petitioner seeks the following:

- 1) Depositions of Mr. Jannard, Mr. Nattress, and Mr. Land who have submitted declarations in each proceeding to support Patent Owner's claim of actual reduction to practice of the "Boris" and "Natasha" cameras (see Exs. 2001, 2011, and 2017);
- 2) Documentation in Patent Owner's possession dated prior to April 13, 2007 regarding the "Mysterium CMOS image sensor" used in either the "Boris" or the "Natasha" cameras (see POPR at 36);
- 3) Any data files in Patent Owner's possession generated by either the "Boris" or "Natasha" cameras prior to April 13, 2007; and
- 4) Access to the "Boris" and "Natasha" cameras for inspection by Petitioner's expert.

The parties have conferred and Patent Owner opposes Petitioner's request for pre-institution discovery. To the extent that the Board would like to conduct a call on these issues, the parties are available after 2pm ET on both Monday, August 26th and Tuesday, August 27th.

Best regards,

Michael S. Parsons

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