From: Trials
To: John R. Hutchins
Cc: tmurphy@cgolaw.com; jfleetham@cgolaw.com; Paul T. Qualey; ZFIPRService; Trials
Subject: RE: IPR2023-00273 – Petitioner's Request for Authorization to File Pre-Institution Reply
Date: Wednesday, April 12, 2023 4:45:45 PM

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Counsel,

Petitioner is authorized to file a three-page pre-institution reply brief limited to the subject of the Board's jurisdiction over an expired patent. This reply shall be filed within three business days of the date of this email authorization. Petitioner shall also file this email authorization as an exhibit and cite it in the reply.

If Patent Owner desires to do so, it is authorized to file a three-page pre-institution sur-reply brief for the sole purpose of responding to the arguments in the reply. Any such sur-reply brief shall be filed within three business days of the filing of the reply.

No further filings are authorized.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: John R. Hutchins <JHutchins@bannerwitcoff.com>
Sent: Wednesday, April 5, 2023 3:46 PM
To: Trials <Trials@USPTO.GOV>
Cc: tmurphy@cgolaw.com; jfleetham@cgolaw.com; Paul T. Qualey <PQualey@bannerwitcoff.com>; ZFIPRService <ZFIPRService@bannerwitcoff.com>
Subject: IPR2023-00273 – Petitioner's Request for Authorization to File Pre-Institution Reply

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To the Board –

Pursuant to 37 C.F.R. § 42.108(c), Petitioner ZF respectfully requests permission to file a 3 page, pre-institution Reply to Patent Owner Stoneridge's Preliminary Response filed in the above referenced IPR against United States Patent No. 7,021,415. Good cause exists for this relief because Patent Owner argues that the Board lacks jurisdiction to consider an IPR on an expired patent, but failed to include in their briefing pertinent contrary authority (e.g., *Apple, Inc. v. Gesture Tech. Partners, LLC*,

IPR2021-00922, Paper 26 at 25-27 (PTAB Nov. 28, 2022)). Petitioner seeks to address Patent Owner's arguments regarding the Board's jurisdiction over expired patents in its Reply.

Petitioner has conferred with Patent Owner who opposes Petitioner's request. The parties are available April 12-14 between 10 am and 2 pm EDT for a conference call if the Board wishes to discuss the issue.

Best regards,
John Hutchins

JOHN R. HUTCHINS | ATTORNEY

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