

From: [Trials](#)
To: [Timothy Cremen](#)
Cc: [LegalTM-GCE-IPR](#); [Atallah, David L.](#); [Tobin, Brian S.](#); [Murphy, Timothy J.](#); [jfleetham@cgolaw.com](#); [Trials](#)
Subject: RE: IPR2023-00326 - GCE/Vbox - GCE Request for Reply Brief
Date: Friday, April 21, 2023 2:32:03 PM

Counsel:

The panel determines that additional briefing, narrowly limited to the two issues identified in Mr. Cremen's email below, may be helpful to the Board in reaching a fair and expeditious decision on institution. Petitioner may file a five-page reply limited to those two issues within five business days of this authorization. Patent Owner may file a five-page sur-reply within five business days of the filing of any reply. No new evidence may be filed with either brief, except that Petitioner shall file a copy of this email transmission as an exhibit to any reply filed pursuant to this authorization. No conference call is necessary at this time.

Regards,

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

From: Timothy Cremen <TCremen@sheppardmullin.com>
Sent: Friday, April 21, 2023 10:40 AM
To: Trials <Trials@USPTO.GOV>
Cc: LegalTM-GCE-IPR <LegalTM-GCE-IPR@sheppardmullin.com>; Atallah, David L. <DATallah@cgolaw.com>; Tobin, Brian S. <BTobin@cgolaw.com>; Murphy, Timothy J. <TMurphy@cgolaw.com>
Subject: IPR2023-00326 - GCE/Vbox - GCE Request for Reply Brief

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Dear Honorable Board,

Pursuant to 37 C.F.R. § 42.108(c), Petitioner GCE seeks leave to file a short reply of no more than five pages to the Patent Owner Preliminary Response ("POPR") filed by Patent Owner Vbox on April 11, 2023 in the above-referenced IPR. Vbox opposes GCE's request. To the extent the Board grants GCE's request, and pursuant to 37 C.F.R. § 42.20(d), GCE does not oppose Vbox filing a sur-reply brief of equal length to GCE's reply brief. No new exhibits will be filed by GCE.

GCE's Reply would be limited to the following two issues:

1. GCE would address Vbox's mischaracterization of FIG. 6 of Deane (see POPR at 2-3 and 31-35) and related arguments as to GCE's annotations/analysis thereof. For example, GCE would point out that Vbox's attorney argument has misrepresented the teachings of FIG. 6 of Deane

and is inconsistent with: (i) the actual teachings of Deane; and (ii) the expert testimony offered by GCE (the only expert testimony of record). GCE could not have anticipated such mischaracterizations of Deane when it filed its Petition.

2. GCE would address Vbox's assertion(s) the Petition should be denied under 35 U.S.C. § 325(d) (see POPR at 36-45). In particular, GCE would point out that Vbox's arguments: (i) misapply the law; and (ii) misrepresent the substantial factual basis in the Petition demonstrating Examiner error (see, e.g., Petition at 10-13, 20).

Because the reply would address potentially dispositive issues, good cause exists for the filing of a short reply. *See, e.g., Lab. Corp. of Am. Holdings v. Quest Diagnostics Invs. LLC*, IPR2019-00738, Paper 8, at 2 (PTAB May 7, 2021) (authorizing petitioner to file a reply because "petitioner has good cause to respond to alleged mischaracterization of certain evidence"), *SweeGen, Inc. v. PureCircle Sdn Bhd*, IPR2020-00070, Paper 11 (PTAB Nov. 12, 2020) (authorizing petitioner to file a reply because, in part, "having a meaningful response from Petitioner on those arguments will help the Board determine whether denial of the Petition under § 325(d) is (or is not) appropriate"), and *Nespresso USA, Inc. v. K-Fee System GMHB*, IPR2022-01574, Paper 9 (PTAB February 9, 2023) (authorizing reply to address 325(d) issues).

Patent Owner opposes the request because, in its view, both issues could have been addressed in the Petition, and therefore the request lacks a showing of good cause.

If necessary, the parties are available for a Board conference call on April 24, 27, or 28 between 10AM and 2PM ET.

Respectfully submitted,
Timothy Cremen (50,855)
Counsel for Petitioner GCE

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