From:	Jason Fitzsimmons
To:	Director_PTABDecision_Review
Cc:	John M. Halan; Michael Specht; Daniel E. Yonan; Brian Burke; Ian Soule; PTAB Account; Sangeeta G. Shah; Andrew B. Turner; Bernard P. Tomsa; Thomas A. Lewry; Reza Esfahani; Fiona Archer; TRCH0114IPR@brookskushman.com; TRCH0117IPR@brookskushman.com; PTAB Account
Subject:	RE: Patent Owner"s Requests For Director Review (IPR2023-00328 and IPR2023-00355)
Date:	Friday, August 4, 2023 1:58:56 PM
Attachments:	image002.png image003.png

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IPR2023-00328, -00335 // US Pat. No. 10,894,503

Dear Director Vidal,

Patent Owner's Requests for Director Review in IPR2023-00328 and -00335 should be denied.

First, Patent Owner's notification email presents arguments far-exceeding the "brief explanation" stated in the guidelines. *See* Revised Interim Director Review Process, Section 3.A ("The brief explanation should not exceed a few sentences and is not a substitute for formal arguments on the record."), https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process. The email also includes new arguments not presented in Patent Owner's Preliminary Response or Sur-Reply on issues already addressed in the Board's Institution Decision.

Second, no important issue of law or policy is raised. The Board fully addressed and rejected Patent Owner's "lack of particularity" arguments in its Institution Decisions. *See* –00328 DI, 14-15; –00335 DI, 13-14 ("We do not agree that Petitioner's challenges lack particularity, because we understand the asserted combinations.").

Third, the Board did not abuse its discretion by instituting three petitions. The parties further briefed this issue in the Petitioner's Reply and Patent Owner's Sur-reply, and the Board again fully addressed and rejected Patent Owner's arguments, finding that "the filing of three petitions [is] justified in view of the large number of claims and the differences in claim scope," and that "it would not be appropriate to deny institution on procedural grounds." *See* –00328 DI, 14-15; –00335 DI, 13-14.

Respectfully submitted,
Jason Fitzsimmons
Counsel for Petitioner

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From: John M. Halan <jhalan@brookskushman.com>
Sent: Monday, July 31, 2023 9:57 PM
To: Director PTABDecision <Review@uspto.gov>
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Subject: Patent Owner's Requests For Director Review (IPR2023-00328 and IPR2023-00355)

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Director Vidal,

Patent Owner, Yechezkal Evan Spero, notifies the parties and the USPTO of the filing of the attached (1) Patent Owner's Request For Director Review/Rehearing in IPR2023-00328, and (2) Patent Owner's Request For Director Review/Rehearing in IPR2023-00335. These are being filed pursuant to at least the Revised Interim Director Review Process (https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process).

Both Requests address the same two issues. While the underlying support for each is substantially the same, Patent Owner respectfully suggests that the Request regarding IPR2023-00335 be reviewed first.

The first issue is whether a Petition lacks particularity, and should not result in institution, where it suffers all of the following (1) it cites to an appendix of claim limitations and, as a result, the analysis fails to identify with specificity where each claim limitation is found in the prior art, (2) it makes disclaimer-type arguments – *e.g.*, if one reference does not disclose a limitation then maybe another does, and (3) Petitioner asserts multiple prior art teachings and/or combinations within a single ground – and then compounds the lack of particularity by not identifying which art or combination it is relying on.

The lack of particularity is further compounded by the number of challenges asserted by Petitioner. More specifically, Petitioner has filed 3 petitions challenging the same '503 patent with a total of 25 grounds, and in all asserts the same two prior art combinations against all of the challenged claims, while adding additional secondary references in other grounds.

This tactical lack of particularity results in a shell game, in which the Patent Owner and Board are challenged to decipher the arguments and try to pin down Petitioner's positions –

resulting in a denial of due process and making it impossible for Patent Owner to respond fully to all possible arguments. This creates procedural unfairness at both the Institution and Trial stages – especially in the present case where Petitioner filed 3 petitions asserting 25 grounds challenging all claims of the '503 Patent with the same two combination sets, Beam/Thominet and Karlsson/Harbers – while asserting that the primary reference in each teaches all claim limitations. Petitioner could have easily dropped one of the redundant combination sets, and/or the other grounds adding other prior art, to consolidate the petitions into 1, and at the most 2. See, e.g., *InVue Sec. Prods., Inc. v. Mobile Tech., Inc.*, No. IPR2019-00078, Paper 7, at 15, 18 (PTAB May 1, 2019) (emphasis added) in which a Board held the following, applicable to this case:

> This [lack of particularity] would require the panel or the Patent Owner to scour the Petition to discern Petitioner's evidence as to each of forty-five claims in each of three obviousness grounds. Moreover, a Petition that requires the panel or the Patent Owner to do so lacks particularity and is tantamount to impermissibly shifting Petitioner's burden under 35 U.S.C. § 312(a)(3)
>
> Patent Owner would be required to defend against four asserted grounds (i.e., three obviousness and one anticipation) against each of forty-five of challenged claims and do so despite the lack of particularity by which the nineteen references are asserted against each claim. This would place a significant and unfair burden on the Patent Owner.

Patent owner submits that an important issue of law and policy to both the Office and patent community is whether a petitioner can do the above – *i.e.*, (1) hide limitations in an Appendix and not address all of the limitation words in the analysis, (2) make either/or prior art arguments, and (3) assert multiple prior art teachings within a single ground or single limitation without identify which it is relying on – and still expect institution. Patent Owner submits that to institute on such a Petition creates a slippery slope and sends a message to the patent community that such tactics will be allowed. Patent Owner also submits that it was an abuse of discretion for the Board to overlook, and institute despite, these multiple Petition deficiencies.

The second issue is whether one or more of three parallel petitions should not result in institution where they fail to "identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)" as required by the Patent Trial and Appeal Board Consolidated Trial Practice Guide (CTPG) at 60.

Patent owner submits that this second issue is an issue of first impression and an important issue of law and policy to both the Office and patent community; more specifically whether

the CTPG ranking and explanation requirements are meaningful and should be enforced – or whether a petitioner can simply ignore them and still expect institution. Patent Owner also submits it was an abuse of discretion for the Board to overlook, and institute in light of, Petitioner's willful disregard of the CTG requirements, especially where (1) Petitioner's counsel was well aware of the requirements by way of an earlier IPR decision regarding such requirements in which they participated, and (2) Petitioner was allowed to file a Reply on the issue and still did not provide the required rankings and explanations.

As to a providing a priority ranking of the two issues presented in these Requests , Patent Owner submits that given the egregiousness of the particularity issues, the resulting procedural unfairness and denial of due process, and the need for the Office and the patent community to know that such tactics will not be countenanced, the first issue (lack of particularity) should be ranked first in priority.

Very Respectfully,

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