From: Jim Glass
To: Trials
Cc: Michael Specht; Jonathan Tuminaro; Jonathan Tuminaro; Sean Gloth; Yury Kapgan; Ron Hagiz
Subject: IPR nos. IPR2023-00435; IPR2023-00436 and IPR2023-00437
Date: Tuesday, May 23, 2023 1:08:31 PM

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Honorable Board,

I am lead counsel for Petitioner in the above IPRs. Petitioner seeks leave to submit a short supplemental brief (no more than five pages), to be due within two weeks of an Order granting this request, that responds to arguments raised in the Preliminary Responses. Specifically, the requested briefs would respond to Patent Owner's arguments regarding discretionary denial under Section 325(d) (in all petitions) and Patent Owner's priority/reduction to practice arguments asserted in PR2023-00437.

Petitioner is mindful of both the Board's prohibition against argumentative emails to *Trials* and of 37 CFR § 42.108(c), which requires a request for a reply to "make a showing of good cause." Good cause exists for this request because Petitioner could not have foreseen Patent Owner's arguments. With respect to Patent Owner's priority arguments in the '437 proceeding, it was not foreseeable that Patent Owner would argue that the challenged patent is entitled to an earlier priority date based on an alleged reduction to practice and, as the patents are entitled to a presumption that the priority date listed on the face of the patent is correct. It was not Petitioner's burden to address this issue in the first instance in the Petition. Petitioner cites to portions of deposition transcripts and an order denying a request for a new trial in support of its priority position from a case not involving Petitioner – Petitioner respectfully submits that evidence is not relevant, but will not address that argument unless requested by the Panel.

With respect to the 325(d) arguments, it was not foreseeable that Patent Owner would argue in the '435 proceeding that the art cited in the grounds was cumulative over art cited in the parent applications to the challenged patents -- which have different claims than the challenged claims. Likewise, it was not foreseeable that Patent Owner would argue in the '437 and '436 proceedings that cited art that was not used as a basis for a rejection during prosecution should be the basis for discretionary denial.

The parties have met and conferred, and Patent Owner opposes this request.

To the extent the Board wishes to hold a hearing on this request, the parties are available Wednesday, May 24th between 10-12ET, and Thursday, May 25th between 11-12ET.
The parties will revert with availability should the Board require additional time slots.

Respectfully submitted,
James Glass

Eagle View EX2029
Roofr v. Eagle View
IPR2023-00437

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