From: Richard M. Bemben
To: trials@uspto.gov
Cc: jimglass@quinnemanuel.com; seangloth@quinnemanuel.com; yurykapgan@quinnemanuel.com; ronhagiz@quinnemanuel.com; Michael Specht; Jonathan Tuminaro; PTAB Account
Subject: RE: IPR nos. IPR2023-00435; IPR2023-00436 and IPR2023-00437
Date: Tuesday, May 23, 2023 8:27:05 PM

Your Honors,

Patent Owner opposes Petitioner's request for supplemental briefing because Petitioner does not establish good cause. Petitioner alleges that good cause exists because it could not have foreseen Patent Owner's arguments regarding (1) discretionary denial under Section 325(d) in all proceedings and (2) priority/reduction to practice in IPR2023-00437.

Patent Owner disagrees. Patent Owner's arguments on these issues were readily foreseeable upon routine pre-filing investigation into the prosecution and litigation histories of the patents-at-issue. Patent Owner's discretionary denial arguments are based on public prosecution histories and apply the now-familiar *Advanced Bionics* framework. Petitioner's claim that it could not have foreseen Patent Owner's argument that the references that were cited but not applied during prosecution invoke Section 325(d) is contrary to *Advanced Bionics's* express instruction that such references should be analyzed under its framework. *Advanced Bionics* at 7-8 ("Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant ….").

Regarding the prior-art issues that Patent Owner raised in IPR2023-00437, Petitioner had notice of these issues before it filed the Petition. In its Petition, Petitioner asserts as a primary reference the pre-grant publication of the Kennedy patent (U.S. 8,417,061), which the Xactware court previously determined is not prior art to the '840 patent. Petitioner had notice of this prior determination because Patent Owner cited it in the original complaint that Patent Owner filed against Petitioner in the co-pending litigation. '437 POPR at 39-40; EX2008, 4-5.

In sum, Patent Owner's arguments are based on the publicly available records of the patents-at-issue and were readily foreseeable had Petitioner exercised routine diligence before filing its Petitions. It did not and should not be given an opportunity to cure its fatally flawed Petitions ***after the one-year statutory bar date***.

Patent Owner is available for a Board call at the times indicated by the Petitioner.

Best regards,

Richard Bemben
Counsel for Patent Owner

From: Jim Glass <jimglass@quinnemanuel.com>
Date: May 23, 2023 at 10:08:30 AM PDT
To: Trials <trials@uspto.gov>
Cc: Michael Specht <MSPECHT@sternekessler.com>, Jonathan Tuminaro

Eagle View EX2030
Roofr v. Eagle View
IPR2023-00437

<JTUMINAR@sternekessler.com>, Jonathan Tuminaro <JTUMINAR@sternekessler.com>, Sean Gloth <seangloth@quinnemanuel.com>, Yury Kapgan <yurykapgan@quinnemanuel.com>, Ron Hagiz <ronhagiz@quinnemanuel.com>

Subject: IPR nos. IPR2023-00435; IPR2023-00436 and IPR2023-00437

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

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