

From: [Director_PTABDecision_Review](#)
To: [Jim Glass](#); [Michael Specht](#); [Director_PTABDecision_Review](#)
Cc: [Trials](#); [Jonathan Tuminaro](#); [Richard M. Bemben](#); [Quincy Lu](#); [Ron Hagiz](#); [Yury Kapgan](#); [PTAB Account](#); [PTAB Account](#)
Subject: RE: IPR no. IPR2023-00437
Date: Thursday, May 30, 2024 3:17:00 PM

Counsel,

As explained on the Director Review webpage, to request Director Review, a party must: (1) file a Request for Rehearing by the Director in P-TACTS, and (2) email the Director at Director_PTABDecision_Review@uspto.gov, copying counsel for all parties to the proceeding. “A Director Review request is not perfected until both submissions are made.” Available at <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process> at Section 3.A. In this case, Petitioner submitted its Request for Rehearing by the Director in P-TACTS but failed to send the required email within the required time frame.

In this instance, the Office will accept Petitioner’s request for Director Review although the requisite email was not submitted on time. Counsel is cautioned, however, that Office procedures, including those for Director Review, must be followed.

From: Jim Glass <jimglass@quinnemanuel.com>
Sent: Wednesday, May 22, 2024 9:55 AM
To: Michael Specht <MSPECHT@sternekessler.com>; [Director_PTABDecision_Review](#) <Director_PTABDecision_Review@uspto.gov>
Cc: Trials <Trials@USPTO.GOV>; Jonathan Tuminaro <JTUMINAR@sternekessler.com>; Richard M. Bemben <RBEMBEN@sternekessler.com>; Quincy Lu <quincylu@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>; Yury Kapgan <yurykapgan@quinnemanuel.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR no. IPR2023-00437

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Honorable Director,

We regret burdening the Director with yet another email on this issue. Patent Owner opposes Petitioner’s request for a waiver of the rules, but in so doing Patent Owner itself ignores the rules of this Office. As Patent Owner is well-aware, unauthorized briefs are prohibited. Yet Patent Owner’s over five-hundred word, two-page email is tantamount to such an unauthorized brief and is thus contrary to the practices of this Office and prejudicial to Petitioner. To the extent the Director considers Patent Owner’s unauthorized brief, Petitioner respectfully requests that it be given the opportunity to be heard, through a two-page Reply brief or email of equal length. The Reply would specifically rebut Patent Owner’s alleged claims of prejudice, especially in light of its concession that Petitioner’s Request for Director Review was timely filed on PTACTS and served properly. And while Petitioner disagrees

with Patent Owner's positions, Petitioner will not respond substantively unless and until authorized to do so, as required by the rules.

Respectfully submitted,
Jim Glass

James M. Glass |Chair, Post-Grant Patent Practice| **Quinn Emanuel Urquhart & Sullivan, LLP** | 51 Madison Avenue, 22nd Floor, New York, NY 10010 | Office: +1.212.849.7142| [Web Bio](#)

From: Michael Specht <MSPECHT@sternekessler.com>
Sent: Tuesday, May 21, 2024 3:29 PM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Trials <Trials@USPTO.GOV>; Jonathan Tuminaro <JTUMINAR@sternekessler.com>; Richard M. Bemben <RBEMBEN@sternekessler.com>; Quincy Lu <quincylu@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>; Yury Kapgan <yurykapgan@quinnemanuel.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Jim Glass <jimglass@quinnemanuel.com>
Subject: RE: IPR no. IPR2023-00437

[EXTERNAL EMAIL from mspecht@sternekessler.com]

Honorable Director,

Patent Owner opposes Petitioner's requests because (1) consideration of Petitioner's defective Request for Director Review is prejudicial to Patent Owner, (2) Petitioner failed to properly follow PTAB requirements, and (3) Petitioner failed to act diligently and waited an unreasonable amount of time to follow-up on its original defective Request.

IPR2023-00437 is one of three IPRs that Petitioner filed to challenge three of Patent Owner's patents that are related to roof estimation technology. The other two IPRs are IPR2023-00435 and IPR2023-00436. In late July / early August 2023, the Board denied institution of the '437 IPR, but instituted review in the '435 and '436 IPRs. Discovery, briefing, and argument are now complete in the '435 and '436 IPRs – the Board conducted a joint oral hearing on April 23, 2024, and the parties await the Board's final decisions. The patents at issue are involved in a parallel district court litigation, which is currently stayed pending the IPRs. Considering Petitioner's defective Request at this late stage would significantly prejudice Patent Owner because, if the '437 IPR was instituted, Patent Owner would not be able to leverage the efficiencies gained when related IPR trials are conducted in parallel. Additionally, given the similar focus of the patents, the outcome of a potential Director Review may have influenced the positions taken by patent owner and the Board in the '435 and '436 IPRs.

Moreover, Petitioner filed its Request for Director Review in the '437 IPR on August 31, 2023, about 8.5 months ago. Petitioner has not provided any explanation why it waited so long to inquire about the status of its Request. Petitioner knew or should have known of the Board's requirement to email

the Director to perfect its request, as such requirement was clearly explained on the USPTO's Director Review website. Further, the Board maintains a spreadsheet showing the status of pending Director Review requests, and Petitioner's Request is not listed. Petitioner should have diligently reviewed the spreadsheet and timely inquired into the status of its Request. It failed to timely correct its error and should not be given the opportunity to do so after so much time has passed. Additionally, Patent Owner properly requested Director Review in the '435 IPR which was denied in September 2023, demonstrating again that Petitioner should have been aware of the process for making such a request, and highlighting that Petitioner was not diligent in monitoring the status thereof.

Finally, Patent Owner seeks to clarify the scope of the parties' meet and confer on this issue. On the afternoon of Thursday, May 16th, counsel for the parties had a short telephone call in which Petitioner's counsel asked, if Patent Owner would not oppose Petitioner's request that the Director consider its Request for Director Review. Patent Owner counsel indicated they would need to confer with their client and get back to Petitioner. Petitioner then proceeded to send its email the next day. Petitioner did not indicate that it would request authorization to file a petition to waive the email requirement or mention the *Verizon* case cited in its email. In any event, Patent Owner opposes all of Petitioner's requests for the reasons stated.

Respectfully,
Michael Specht

Michael Specht

Director

Sterne, Kessler, Goldstein & Fox P.L.L.C.

Email: mspecht@skgf.com

Direct: 202.772.8756 **Main:** 202.371.2600

Administrative Assistant: Maya Bennett

Direct Dial: 202.772.8843

From: Jim Glass <jimglass@quinnemanuel.com>

Sent: Friday, May 17, 2024 2:00 PM

To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Cc: Trials <Trials@USPTO.GOV>; Michael Specht <MSPECHT@sternekessler.com>; Jonathan Tuminaro <JTUMINAR@sternekessler.com>; Richard M. Bemben <RBEMBEN@sternekessler.com>; Quincy Lu <quincylu@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>; Yury Kapgan <yurykapgan@quinnemanuel.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>

Subject: RE: IPR no. IPR2023-00437

EXTERNAL EMAIL: Use caution before clicking links or attachments.
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Honorable Director,

We have confirmed that the Request for Director Review was timely filed on PTACTS and that it was also timely served on opposing counsel shortly after filing. We cannot, however, confirm whether an

email was sent to the Director. The attorney that handled this filing is no longer with our Firm and, given the passage of time, cannot recall one way or another whether an email was sent. We are unable otherwise to confirm based on our records.

We respectfully request that the Request for Director Review be considered on its merits. However, should the Director be inclined to deny the Request for Review based on the failure to send the email, we request permission to file a petition under 37 CFR § 42.5(b) to either waive the requirement for an email or for permission to send the email to the Director for our properly filed and served papers. *See, e.g., Verizon v. Omega*, IPR2023-01162, Paper 8 (extending the deadline for a POPR pursuant to section 42.5). Assuming there was a failure here, it was an unfortunate oversight and, as service and filing were proper and timely, no further filings would be required. Given that the brief was timely filed, that it was timely served, and that there is no appeal that is being tolled by our request, we respectfully submit that no prejudice would be suffered by either party or the public should the Director consider our Request for Review on the merits. We have met and conferred with counsel for Patent Owner. Patent Owner has not had sufficient time to consider its position on this request.

If the Director would like to schedule a conference, we will reach out to Patent Owner and revert with mutually acceptable times.

Respectfully,
Jim Glass

James M. Glass |Chair, Post-Grant Patent Practice| **Quinn Emanuel Urquhart & Sullivan, LLP** | 51 Madison Avenue, 22nd Floor, New York, NY 10010 | Office: +1.212.849.7142| [Web Bio](#)

From: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Sent: Wednesday, May 15, 2024 2:28 PM
To: Jim Glass <jjimglass@quinnemanuel.com>; mspecht-PTAB@sternekessler.com; jtuminar-PTAB@sternekessler.com; rbemben-PTAB@sternekessler.com; Quincy Lu <quincylu@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>
Cc: Trials <Trials@USPTO.GOV>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Subject: RE: IPR no. IPR2023-00437

[EXTERNAL EMAIL from director_ptabdecision_review@uspto.gov]

Hello Mr. Glass,

As explained on the Revised Interim Director Review Process webpage, a party may request Director Review by “(1) filing a Request for Rehearing by the Director in the Patent Trial and Appeal Case Tracking System (P-TACTS); and (2) emailing the Director at Director_PTABDecision_Review@uspto.gov, copying counsel for all parties to the proceeding. A Director Review request is not perfected until both submissions are made.” *See*

<https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process> at Section 3.A.

The P-TACTS system shows that a Paper titled “Petition for Director Review” was filed on August 31, 2023. Please respond to this email to indicate whether an email was sent to Director_PTABDecision_Review@uspto.gov when the Paper was entered. If so, please forward a copy of that email to this address.

Thank you.

From: Trials <Trials@USPTO.GOV>
Sent: Monday, May 13, 2024 4:11 PM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Trials <Trials@USPTO.GOV>
Subject: FW: IPR no. IPR2023-00437

From: Jim Glass <jimglass@quinnemanuel.com>
Sent: Monday, May 13, 2024 3:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: mspecht-PTAB@sternekessler.com; jtuminar-PTAB@sternekessler.com; rbemben-PTAB@sternekessler.com; Quincy Lu <quincylu@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>
Subject: IPR no. IPR2023-00437

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Your Honors,

I am lead counsel for the Petitioner in IPR2023-00437. I write to inquire as to the status of Petitioner’s Request for Director Review of the Board’s institution decision (Paper 15), which was filed on August 31, 2023 and has not yet been ruled on. Please let us know whether any additional action is required from us.

Respectfully,
Jim Glass

James M. Glass |Chair, Post-Grant Patent Practice| **Quinn Emanuel Urquhart & Sullivan, LLP** | 51 Madison Avenue, 22nd Floor, New York, NY 10010 | Office: +1.212.849.7142| [Web Bio](#)