

Subject: RE: IPR2023-00490
Date: Thursday, February 29, 2024 at 2:15:21 PM Eastern Standard Time
From: Trials
To: Edwards, Jeremy, Daniel L. Shores, Trials
CC: Hongene, Joseph A. Hynds, Aydin Harston, Adam M. Nicolais, Nasri Hage, Erik van Leeuwen
Attachments: image001.jpg, image002.png

Counsel,

From the Board –

The proposed briefing schedule for Petitioner’s proposed Motion to Seal is acceptable to the Board. The parties may proceed with the scheduled briefing.

Regards,

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

From: Edwards, Jeremy <Jeremy.Edwards@procopio.com>
Sent: Thursday, February 29, 2024 11:49 AM
To: 'Daniel L. Shores' <DShores@rfem.com>; Trials <Trials@USPTO.GOV>
Cc: Hongene <Hongene@procopio.com>; Joseph A. Hynds <jhynds@rothwellfigg.com>; Aydin Harston <aharston@rothwellfigg.com>; Adam M. Nicolais <anicolais@rothwellfigg.com>; Nasri Hage <Nhage@rothwellfigg.com>; Erik van Leeuwen <evanlee@rothwellfigg.com>
Subject: RE: IPR2023-00490

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Dear Panel,

I write on behalf of Petitioner in the above IPR regarding Petitioner’s intent to file a motion to seal portions of the February 27, 2024 filings by Patent Owner. Petitioner would like to file its motion to seal by March 15, 2024, with any opposition due two weeks after the motion, and any reply due within one week after the opposition. The parties have conferred over email and Patent Owner does not object to this proposed schedule.

Naturally, Petitioner respectfully requests that the February 27, 2024 filings remain under seal at least until the motion to seal is decided (and thereafter to the extent the Panel determines that sealing is warranted).

We respectfully request that the Panel indicate whether this briefing schedule is acceptable, or

schedule a call to discuss, if needed.

The parties are available for such a call during the following times (all ET):

Petitioner:

March 4, 8am-6pm

March 6, 8am-4pm

March 7, 8am-3pm

Patent Owner:

March 4, 8am-5 pm

March 7, 8am-3pm

March 11, 8am-5pm

Respectfully,

JEREMY J. EDWARDS

PARTNER

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1901 L. Street, N.W., Suite 620, Washington, DC 20036

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From: Daniel L. Shores <DShores@rfem.com>

Sent: Monday, February 26, 2024 8:44 AM

To: Edwards, Jeremy <Jeremy.Edwards@procopio.com>; Trials@USPTO.GOV

Cc: Hongene <Hongene@procopio.com>; Joseph A. Hynds <jhynds@rothwellfigg.com>; Aydin Harston <aharston@rothwellfigg.com>; Adam M. Nicolais <anicolais@rothwellfigg.com>; Nasri Hage <Nhage@rothwellfigg.com>; Erik van Leeuwen <evanlee@rothwellfigg.com>

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*** EXTERNAL EMAIL - Please use Caution. ***

Dear Panel,

Petitioner did not contact Patent Owner before submitting the below. We are available during the referenced times. We object to Petitioner's submission of what amounts to an opposition brief to our request in an email to the Board.

Best regards,
Dan

From: Edwards, Jeremy <Jeremy.Edwards@procopio.com>

Date: Monday, February 26, 2024 at 11:19 AM

To: Daniel L. Shores <DShores@rfem.com>, Trials@USPTO.GOV <Trials@USPTO.GOV>

Cc: Hongene <Hongene@procopio.com>, Joseph A. Hynds <jhynds@rothwellfigg.com>, Aydin Harston <aharston@rothwellfigg.com>, Adam M. Nicolais <anicolais@rothwellfigg.com>, Nasri Hage <Nhage@rothwellfigg.com>, Erik van Leeuwen <evanlee@rothwellfigg.com>

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Dear Panel,

Petitioner opposes Patent Owner's February 23, 2024 email request to withdraw its Motion to Amend Claims (see below). Relatedly, Petitioner also renews its motion to stay the related reissue examination.

The Panel should rule on the patentability of all claims presented to it, including all claims challenged in the Petition and both substitute claims. A fulsome decision by the Panel in this IPR will provide fulsome guidance to the Examiner in any subsequent proceedings relating to the '855 patent. This is especially important here, where Patent Owner previously attempted to enforce this patent against Petitioner and is currently seeking reissue.

The salient procedural history here is as follows. In early 2022, Patent Owner sued Petitioner alleging infringement of the '855 patent, thus triggering the one year period for Petitioner to submit a petition for IPR on the '855 patent. Patent Owner then unilaterally dismissed that lawsuit. With no settlement agreement in place, Petitioner filed this IPR petition to pursue patent peace and to avoid estoppel.

In its petition, Petitioner demonstrated (among other things) that certain species of claims 1 and 5 of the '855 patent were anticipated. (See Paper 1 at 22-29, 52-56.) Patent Owner did not submit an POPR, and instead sought reissue, in which Patent Owner tried to carve out the anticipated species from the Petition. (Ex. 1032.) Petitioner moved to stay those reissue proceedings. (Paper 10.) Before the Panel ruled on that motion to stay, the reissue examiner *sua sponte* stayed reissue proceedings until March 2024. In view of the reissue Examiner's decision, this Panel dismissed Petitioner's motion to stay as moot, without prejudice. (Paper 15.)

In its response to the Petition, Patent Owner offered no substantive rebuttal regarding patentability of claims 1 and 5. (Paper 16 at 20-21, 76-77.) Instead, Patent Owner moved to amend claims 1 and 5 to try to carve out the anticipated species via substitute claims 6 and 7, and requested preliminary guidance from the Panel. (Paper 17.) Petitioner opposed the motion to amend, demonstrating that the substitute claims were unpatentable as anticipated and obvious, including by Patent Owner's own prior art patent (which Patent Owner apparently did not disclose to the PTO during examination of the '855 patent).

The Preliminary Guidance indicated that the substitute claims were likely unpatentable as anticipated and obvious. (Paper 23.)

Now, having put Petitioner to the time and expense of opposing the Motion to Amend Claims, and having put the panel through the process of reviewing the motion and opposition and issuing

Preliminary Guidance, Patent Owner is seeking to withdraw its Motion to Amend Claims.

Petitioner's Position: The Panel should deny Patent Owner's request to withdraw its Motion to Amend Claims, stay reissue proceedings for the same reasons expressed in Petitioner's motion to stay the reissue application (Paper 10), and address all challenged claims of the '855 patent, including proposed substitute claims 6 and 7. This will promote efficiency and consistency by affording the reissue Examiner the benefit of a complete record and this Panel's fulsome analysis of patentability of claims, including those that Patent Owner apparently intends to pursue during reissue. This will also promote fairness and the integrity of the IPR proceedings. IPRs should not be vehicle for Patent Owner to play cat and mouse with the claims. Nor should Patent Owners be permitted to put Petitioners and the Panel to the expense and time of dealing with motions to amend, only for Patent Owners to then retreat from negative preliminary guidance by unilaterally withdrawing their motions to amend.

Petitioner is available to discuss this further at the following times:

Tuesday, February 27 (9am–3:30pm ET)
Thursday, February 29 (10am-2:30pm ET)

Respectfully,

JEREMY J. EDWARDS
PARTNER

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From: Daniel L. Shores <DShores@rfem.com>

Sent: Friday, February 23, 2024 2:41 PM

To: Trials@USPTO.GOV

Cc: Hongene <Hongene@procopio.com>; Joseph A. Hynds <jhynds@rothwellfigg.com>; Aydin Harston <aharston@rothwellfigg.com>; Adam M. Nicolais <anicolais@rothwellfigg.com>; Nasri Hage <Nhage@rothwellfigg.com>; Erik van Leeuwen <evanlee@rothwellfigg.com>

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Dear Panel,

Patent Owner requests authorization to withdraw its October 17, 2023 Motion to Amend Claims (Paper 17), including Substitute Claims 6 and 7, from consideration in this IPR. *See* 84 Fed. Reg. 9497, 9502 (Mar. 15, 2019). Patent Owner notes that withdrawing the MTA and claims will simplify the issues for the Board. This request is being submitted without prejudice, disclaimer, or admission.

The parties communicated over email regarding this request and, as of today, Petitioner has not taken a position on this request.

If the Board wishes to discuss, Patent Owner is available on:

Monday, February 26 (9a-12p and 1p-5p) and

Tuesday, February 27 (9a-12p and 1p-5p).

When asked about its schedule, Petitioner indicated it is not sure when it will be available next week due to travel. Therefore, if the Board wishes to discuss, please advise and the parties will endeavor to find a convenient time to do so.

Best regards,

Dan Shores



Daniel L. Shores, Esq.

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Mon Feb 26 2024 08:18:49

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Thu Feb 29 2024 08:49:23

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