

Timothy Cremen

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, June 28, 2023 12:11 PM
To: Timothy Cremen
Cc: LegalTM-GCE-IPR; Atallah, David L.; Murphy, Timothy J.; Fleetham, Jessica E.; Trials
Subject: RE: IPR2023-00527 - GCE/Vbox - GCE Request for Reply Brief

Counsel:

The panel determines that additional briefing, narrowly limited to issues (1) and (3) identified in Mr. Cremen's e-mail below, may be helpful to the Board in reaching a fair and expeditious decision on institution. The Petitioner may file a five-page reply limited to those two issues within five business days of this authorization. The Patent Owner may file a five-page sur-reply within five business days of the filing of any reply.

The Petitioner may file the Parties' June 23, 2023 request to the Maryland District Court for a scheduling conference as a new exhibit with any reply filed pursuant to this authorization.

The Petitioner shall also file a copy of this e-mail transmission as an exhibit to the reply.

No other new evidence may accompany either brief.

No conference call is necessary at this time.

Regards,

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

From: Timothy Cremen <TCremen@sheppardmullin.com>
Sent: Tuesday, June 27, 2023 7:47 PM
To: Trials <Trials@USPTO.GOV>
Cc: LegalTM-GCE-IPR <LegalTM-GCE-IPR@sheppardmullin.com>; Atallah, David L. <DAtallah@cgolaw.com>; Murphy, Timothy J. <TMurphy@cgolaw.com>; Fleetham, Jessica E. <JFleetham@cgolaw.com>
Subject: IPR2023-00527 - GCE/Vbox - GCE Request for Reply Brief

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Dear Honorable Board,

Pursuant to 37 C.F.R. § 42.108(c), Petitioner GCE seeks leave to file a short reply of no more than nine pages (about three pages for each issue below) to the Patent Owner Preliminary Response ("POPR") filed by Patent Owner Vbox on June 15, 2023 in the above-referenced IPR. GCE also requests leave to file one new exhibit reflecting the Parties' June 23, 2023 request to the Maryland District Court for a scheduling conference that is relevant to a Fintiv analysis. Vbox opposes GCE's requests. To the extent the Board grants GCE's requests, and pursuant to 37 C.F.R. § 42.20(d), GCE does not oppose Vbox filing a sur-reply brief of equal length to GCE's reply brief.

GCE's Reply would be limited to the following three issues:

- (1) GCE would address Vbox's mischaracterization of the teachings of Deane (see POPR at 33-43) as to the element "a separation cartridge selectively removable from the receptacle by movement relative to the receptacle in a first direction" and Vbox's apparent construction of this term as requiring "downward movement." For example, GCE would point out that Vbox's attorney argument has: (i) misrepresented the teachings of Deane as to how its components are connected and is inconsistent with the actual teachings of Deane and the expert testimony offered by GCE (the only expert testimony of record); and (ii) appears to rely on a narrow construction for "movement relative to the receptacle" that is not supported by the intrinsic record. GCE could not have anticipated either argument.
- (2) GCE would address Vbox's assertion(s) the Petition should be denied under 35 U.S.C. § 325(d) (see POPR at 45-57). In particular, GCE would point out that Vbox's arguments: (i) misapply the law; and (ii) misrepresent the substantial factual basis in the Petition demonstrating Examiner error (see, e.g., Petition at 12-21).
- (3) GCE would address Vbox's assertion(s) the Petition should be denied under 35 U.S.C. § 314(a) (see POPR at 57-65). In particular, GCE would provide a more fulsome Fintiv analysis in view of Director Vidal's February 27, 2023 guidance that issued after the filing date of this Petition, and address Vbox's misapplication of Fintiv and misrepresentations of the record. GCE could not have been aware of Director Vidal's further guidance when it filed the Petition, and could not have anticipated Vbox's arguments.

Because the reply would address potentially dispositive issues, good cause exists for the filing of a short reply. See, e.g., *Lab. Corp. of Am. Holdings v. Quest Diagnostics Invs. LLC*, IPR2019-00738, Paper 8, at 2 (PTAB May 7, 2021) (authorizing petitioner to file a reply because "petitioner has good cause to respond to alleged mischaracterization of certain evidence"), *SweeGen, Inc. v. PureCircle Sdn Bhd*, IPR2020-00070, Paper 11 (PTAB Nov. 12, 2020) (authorizing petitioner to file a reply because, in part, "having a meaningful response from Petitioner on those arguments will help the Board determine whether denial of the Petition under § 325(d) is (or is not) appropriate"), and *Nespresso USA, Inc. v. K-Fee System GMHB*, IPR2022-01574, Paper 9 (PTAB February 9, 2023) (authorizing reply to address 325(d) issues).

Patent Owner's Statement in Opposition: Across two related IPR proceedings involving these parties (the present IPR and IPR2023-00326), Petitioner has now requested a reply on virtually every issue raised in Patent Owner's two POPRs. At some point, Petitioner's attempts to supplement their Petitions does not meet the "good cause" standard for a reply. In response to Petitioner's item (1) for example, Patent Owner does not agree that Patent Owner is asking for a claim construction at all. Rather, Patent Owner merely explained that the prior art does not meet the claim language. More generally, Patent Owner does not agree that it has mischaracterized any evidence or that this case requires further briefing. Patent Owner otherwise believes each of Petitioner's points could have been addressed in the Petition.

If necessary, the parties are generally available for a Board conference call on June 29, 2023 between 10 and 4 ET.

Respectfully submitted,
Timothy Cremen (50,855)
Counsel for Petitioner GCE

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