From:	Trials
To:	Williams, Eliot D.; Trials
Cc:	Taylor, Jeremy; Pankratz, Kurt; Lee, Sean; Cappaert, Kate; Nuttall, Jay; Yebernetsky, Thomas; Suarez, Christopher
Subject:	RE: IPR2023-00805: Petitioner's Reply
Date:	Thursday, September 14, 2023 8:58:06 AM

Counsel,

From the Board –

Petitioner's reasons for requesting authorization to file a reply to Patent Owner's Preliminary Response do not constitute good cause, and Petitioner's request for authorization is denied. First, Petitioner's concern that it did not have the Board's Decision in IPR2023-00370 when it filed its Petition does not amount to good cause in that generally, it is not in the public interest that a petitioner should be given an opportunity to use an earlier decision as a roadmap for a new petition. *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha,* Case IPR2016-01357, slip op. at 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential). Second, Petitioner's concern that Patent Owner's Preliminary Response mischaracterizes relevant facts and issues does not amount to good cause, as such concerns exist in every proceeding, and the Board routinely evaluates the parties' briefs accordingly.

Regards,

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

From: Williams, Eliot D. <Eliot.Williams@BakerBotts.com>
Sent: Friday, September 1, 2023 4:27 PM
To: Trials <Trials@USPTO.GOV>
Cc: Taylor, Jeremy <jeremy.taylor@bakerbotts.com>; Pankratz, Kurt <kurt.pankratz@bakerbotts.com>; Lee, Sean <sean.lee@bakerbotts.com>; Cappaert, Kate <kcappaert@Steptoe.com>; Nuttall, Jay <jnuttall@Steptoe.com>; Yebernetsky, Thomas <tyebernetsky@Steptoe.com>; Suarez, Christopher <csuarez@Steptoe.com>
Subject: IPR2023-00805: Petitioner's Reply

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Dear Honorable Board:

Petitioner writes to seek authorization for a 5-page reply to Patent Owner's Preliminary Response pursuant to 37 C.F.R. § 42.108(c), due 5 business days after authorization. Petitioner has good cause for this request as detailed below.

Petitioner seeks an opportunity to address Patent Owner's unanticipated incorrect characterizations of the Petition, as well as the new evidence submitted by Patent Owner with its POPR. In particular:

1. Patent Owner cites to and relies on the Institution Decision in IPR2023-00370 (370 IPR) that previously was not available at the time the Petition for the '400 Patent was filed; and

2. Patent Owner incorrectly alleges that "the arguments and evidence that Petitioner relies on here are identical to those presented in the 370 IPR." (POPR, 5).

Petitioner believes that the Board would benefit from additional briefing that clarifies how the Petition's arguments and evidence are not identical to those presented in the 370 IPR and how this impacts the applicability of the Institution Decision of the 370 IPR in this IPR proceeding. Patent Owner has indicated that it opposes Petitioner's request for a reply and disagrees with Petitioner's assertion that Patent Owner's statements regarding the similarities between the 370 IPR and the instant Petition are incorrect. If, however, the Board is inclined to provide Petitioner with an opportunity to submit a reply, Patent Owner respectfully requests a 5-page sur-reply to respond to the arguments made in that reply. Petitioner does not oppose that request.

If necessary, counsel for Patent Owner and Petitioner are available for a call with the Board on Tuesday, September 5 during PTAB operating hours (Eastern Time) and Wednesday, September 6, between 9 and 11am and 3 and 5pm Eastern time.

Respectfully submitted,

Eliot D. Williams

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