

Esrām, Trishan

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, September 6, 2023 8:06 AM
To: Lin, Haixia; Trials
Cc: Esrām, Trishan; Lambson, Brian J; Richard Kamprath; Bragi_IPR; Kaylee Hoffner
Subject: RE: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

EXTERNAL SENDER

Counsel,

From the Board –

This is to clarify that Petitioner has leave to file a Reply to respond to the newly submitted evidence directed to:

1. showing that Hensen-Patent is entitled to an earlier effective filing date of March 25, 2010 or October 8, 2014, both of which pre-date the alleged earlier inventor disclosures submitted in the Preliminary Response, and
2. challenging the sufficiency of the newly submitted evidence to establish an earlier inventor disclosure.

The briefing details remain as set forth in the Board's September 5, 2023 email.

Petitioner shall file a copy of this email string as an exhibit.

Regards,

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

From: Lin, Haixia <Haixia.Lin@wilmerhale.com>
Sent: Tuesday, September 5, 2023 10:05 AM
To: Trials <Trials@USPTO.GOV>
Cc: Lin, Haixia <Haixia.Lin@wilmerhale.com>; Esrām, Trishan <Trishan.Esrām@wilmerhale.com>; Lambson, Brian J <Brian.Lambson@wilmerhale.com>; Richard Kamprath <rkamprath@McKoolSmith.com>; Bragi_IPR <Bragi_IPR@mckoolsmith.com>; Kaylee Hoffner <khoffner@McKoolSmith.com>
Subject: RE: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

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Dear Honorable Board,

Thank you for granting Petitioner's request. We are seeking clarification on the second issue of the 5-page Reply brief, described in the Board's email as: "(2) the date of invention of U.S. Patent No. 10,635,385 (the "385 patent")."

IPR2023-00901
HIMPP v. BRAGI
HIMPP 1026

Petitioner had requested that the second issue for the Reply brief “challeng[e] the sufficiency of the newly submitted evidence to establish an earlier inventor disclosure,” rather than address any date of invention of the ’385 patent. We do not understand Patent Owner to have raised any argument in its Preliminary Response regarding the date of invention of the ’385 patent. Instead, Patent Owner submitted evidence (e.g., Ex. 2005-2010) to allege that the inventor of the ’385 patent disclosed the same subject matter as U.S. Patent No. 9,781,514 (Ex-1003) (“Hensen-Patent”), before the filing date of Hensen-Patent, to support an argument that Hensen-Patent is not prior art under AIA 35 U.S.C. § 102(b)(2)(B). Petitioner disagrees, and would like to address why the evidence (e.g., Ex. 2005-2010) is insufficient to show earlier inventor disclosure of the subject matter relied upon in Hensen-Patent.

Petitioner would be grateful for the Board’s clarification to ensure that Petitioner’s Reply brief remains within the scope that the Board intended.

If it would be helpful to the Board, Petitioner is generally available for a conference call if requested.

Respectfully submitted,

Haixia Lin
Lead Counsel for Petitioner

From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, September 5, 2023 8:13 AM

To: Kaylee Hoffner <khoffner@McKoolSmith.com>; Trials <Trials@USPTO.GOV>; Lin, Haixia <Haixia.Lin@wilmerhale.com>

Cc: Efram, Trishan <Trishan.Efram@wilmerhale.com>; Lambson, Brian J <Brian.Lambson@wilmerhale.com>; Richard Kamprath <rkamprath@McKoolSmith.com>; Bragi_IPR <Bragi_IPR@mckoolsmith.com>

Subject: RE: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

EXTERNAL SENDER

Counsel,

From the Board –

Petitioner has leave to file, within ten days, a 5-page reply brief directed to the issues of (1) the effective filing date of U.S. Patent No. 9,781,514 (Ex-1003) (“Hensen-Patent”), and (2) the date of invention of U.S. Patent No. 10,635,385 (the “’385 patent”).

Within ten days of service of the reply brief, Patent Owner may file a 5-page sur-reply brief limited to the issues raised by the reply brief.

Regards,

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

From: Kaylee Hoffner <khoffner@McKoolSmith.com>

Sent: Friday, September 1, 2023 2:51 PM

To: Trials <Trials@USPTO.GOV>; Lin, Haixia <Haixia.Lin@wilmerhale.com>

Cc: Efram, Trishan <Trishan.Efram@wilmerhale.com>; Lambson, Brian J <Brian.Lambson@wilmerhale.com>; Richard Kamprath <rkamprath@McKoolSmith.com>; Bragi_IPR <Bragi_IPR@mckoolsmith.com>

Subject: RE: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

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Dear Honorable Board,

Patent Owner will similarly seek leave to file a Sur-Reply, also limited to 5 pages in the event that the request for a reply is granted. Petitioner does not oppose our request.

Best,
Kaylee Hoffner

McKool Smith

Kaylee Hoffner
Associate
Houston TX
Tel: (713) 486-7320
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From: Trials <Trials@USPTO.GOV>

Sent: Friday, September 1, 2023 1:08 PM

To: Lin, Haixia <Haixia.Lin@wilmerhale.com>; Trials <Trials@USPTO.GOV>

Cc: Efram, Trishan <Trishan.Efram@wilmerhale.com>; Lambson, Brian J <Brian.Lambson@wilmerhale.com>; Richard Kamprath <rkamprath@McKoolSmith.com>; Kaylee Hoffner <khoffner@McKoolSmith.com>; Bragi_IPR <Bragi_IPR@mckoolsmith.com>

Subject: RE: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

All counsel,

From the Board –

Please confer and then advise the Board as to whether or not Patent Owner seeks leave to file a Sur-Reply brief in the event that the request for a reply is granted.

Regards,

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

From: Lin, Haixia <Haixia.Lin@wilmerhale.com>

Sent: Friday, September 1, 2023 12:43 PM

To: Trials <Trials@USPTO.GOV>

Cc: Lin, Haixia <Haixia.Lin@wilmerhale.com>; Efram, Trishan <Trishan.Efram@wilmerhale.com>; Lambson, Brian J <Brian.Lambson@wilmerhale.com>; rkamprath@mckoolsmith.com; khoffner@mckoolsmith.com; Bragi_IPR@mckoolsmith.com

Subject: IPR2023-00901 (US10635385) – Request for Leave for Petitioner Reply to Patent Owner Preliminary Response

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board:

Petitioner respectfully seeks leave to file a Reply, limited to 5 pages, to Patent Owner Preliminary Response filed in IPR2023-00901 challenging U.S. Patent No. 10,635,385 (the “’385 patent”). Patent Owner does not oppose our request.

Petitioner submits there is good cause to file a Reply in order to respond to arguments raised in the Preliminary Response that Petitioner could not have reasonably foreseen. Specifically, the grounds in the Petition are based in part on U.S. Patent No. 9,781,514 (Ex-1003) (“Hensen-Patent”), that qualifies as prior art under 35 U.S.C. § 102(a)(2) because its filing date of October 8, 2015 is before the ’385 patent’s earliest priority date of November 13, 2015. Patent Owner submits new evidence (e.g., Ex. 2005-2010) that allegedly shows that the inventor disclosed the same subject matter as Hensen-Patent before the filing date of Hensen-Patent, to support an argument that Hensen-Patent is not prior art under 35 U.S.C. § 102(b)(2)(B).

Petitioner seeks leave to file a Reply to respond to the newly submitted evidence by:

1. showing that Hensen-Patent is entitled to an earlier effective filing date of March 25, 2010 or October 8, 2014, both of which pre-date the alleged earlier inventor disclosures submitted in the Preliminary Response, and
2. challenging the sufficiency of the newly submitted evidence to establish an earlier inventor disclosure.

If it would be helpful to the Board, Petitioner is generally available for a conference call if requested.

Respectfully submitted,

Haixia Lin

Lead Counsel for Petitioner

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