From: Homayoon Rafatijo <hrafatijo@bochner.law>
Sent: Wednesday, August 14, 2024 6:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: Erick Robinson <erobinson@bochner.law>; Patrick Dunn <pdunn@bochner.law>; Jayme Partridge <jpartridge@bochner.law>; marjomand@mofo.com; bblumen@mofo.com; ayap@mofo.com; Sony-Quantum-IPR@mofo.com; Quantum-Sony <quantum-sony@bochner.law>
Subject: FW: FYI - FW: IPR2023-00954: Patent Owner's Request for Permission to File Rebuttal Evidence with Sur-Reply

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Dear Honorable Board,

Patent Owner will file the corrected sur-reply it originally intended to submit, excluding the two footnotes that the Board required to be removed but were included in the initial version that Patent Owner intended to file, if not for the hurricane-related impediment.

In light of the Federal Circuit's recent decision in *ZyXEL Communications Corp. v. UNM Rainforest Innovations*, 107 F.4th 1368, 1382-83 (Fed.Cir.2024) (holding that a Patent Owner should "point to any relevant evidence that it would have presented if the opportunity had been available"), Patent Owner respectfully requests permission to list for appellate purposes the rebuttal evidence to Petitioner's new arguments that Patent Owner had intended to file but was precluded from doing so due to the Board's July 8 email. If permitted, Patent Owner will only provide a list of evidence via email.

Patent Owner appreciates the Board's understanding and attention to Patent Owner's request.

Petitioner's Statement
Petitioner opposes Patent Owner's request to submit a list of sur-reply rebuttal exhibits to the Board. In its July 8 email, the Board denied Patent Owner's request. That decision was proper, and there is no reason for the Board to undo it by agreeing to Patent Owner's request. Patent Owner's reliance on *ZyXEL* is also misplaced. The Court's reference to a listing of exhibits was in the context of whether there was prejudice to the party seeking to submit exhibits on sur-reply. Here, there has been no prejudice to Patent Owner. The Board in denying Patent Owner's initial request made clear that Patent Owner could identify the purported new evidence and arguments within its sur-reply. Moreover, allowing Patent Owner to provide such a listing would result in the Board being overwhelmed with such requests going forward.

Sincerely,

Homayoon Rafatijo, Ph.D., Esq.
Intellectual Property Attorney

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From: Trials <Trials@USPTO.GOV>
Sent: Monday, August 5, 2024 12:06 PM
To: Robinson, Erick <erobinson@spencerfane.com>; Trials <Trials@USPTO.GOV>
Cc: patdunn64@gmail.com; Dunn, Patrick <pdunn@spencerfane.com>; mbrockhaus@dunlapcodding.com; Allee, J. Lori <JAllee@spencerfane.com>; dsorocco@dunlapcodding.com; ayap@mofo.com; marjomand@mofo.com; bblumen@mofo.com; Sony-Quantum-IPR@mofo.com; Tuttle, Kevin <ktuttle@spencerfane.com>; Rafatijo, Homayoon <hrafatijo@spencerfane.com>; robinson.erick <robinson.erick@gmail.com>; Quantumimaging <quantumimaging@spencerfane.com>
Subject: [EXTERNAL] RE: IPR2023-00954: Patent Owner's Request for Permission to File Rebuttal Evidence with Sur-Reply

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Counsel,

From the Board –

Patent Owner is authorized to file a corrected Sur-reply and exhibit list that Patent Owner initially intended to file on July 8. The corrected Sur-reply shall not include footnotes explaining what was eliminated for appellate purposes. The originally filed Sur-reply will not be expunged, preserving a complete record for appeal.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board

From: Robinson, Erick <erobinson@spencerfane.com>
Sent: Monday, July 8, 2024 9:31 PM
To: Trials <Trials@USPTO.GOV>
Cc: patdunn64@gmail.com; Dunn, Patrick <pdunn@spencerfane.com>; mbrockhaus@dunlapcodding.com; Allee, J. Lori <JAllee@spencerfane.com>; dsorocco@dunlapcodding.com; ayap@mofo.com; marjomand@mofo.com; bblumen@mofo.com; Sony-Quantum-IPR@mofo.com; Tuttle, Kevin <ktuttle@spencerfane.com>; Rafatijo, Homayoon <hrafatijo@spencerfane.com>; robinson.erick <robinson.erick@gmail.com>; Quantumimaging <quantumimaging@spencerfane.com>
Subject: Re: IPR2023-00954: Patent Owner's Request for Permission to File Rebuttal Evidence with Sur-Reply

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Dear Honorable Board,

Upon further comment from my non-hurricane-ravaged colleagues, PO respectfully requests the entire sur-reply (Paper 35) to be expunged. If allowed, we will provide a corrected sur-reply and exhibit list immediately to eliminate any reference to Ex. 2015.

Apologies for the confusion and thank you for your consideration.

Best regards,
Erick Robinson

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From: Robinson, Erick <erobinson@spencerfane.com>
Sent: Monday, July 8, 2024 8:21:59 PM
To: Trials@uspto.gov <Trials@uspto.gov>
Cc: patdunn64@gmail.com <patdunn64@gmail.com>; Dunn, Patrick <pdunn@spencerfane.com>; mbrockhaus@dunlapcodding.com <mbrockhaus@dunlapcodding.com>; Allee, J. Lori <JAllee@spencerfane.com>; dsorocco@dunlapcodding.com <dsorocco@dunlapcodding.com>; ayap@mofo.com <ayap@mofo.com>; marjomand@mofo.com <marjomand@mofo.com>; bblumen@mofo.com <bblumen@mofo.com>; Sony-Quantum-IPR@mofo.com <Sony-Quantum-IPR@mofo.com>; Tuttle, Kevin <ktuttle@spencerfane.com>; Rafatijo, Homayoon <hrafatijo@spencerfane.com>; robinson.erick <robinson.erick@gmail.com>; Quantumimaging <quantumimaging@spencerfane.com>
Subject: Re: IPR2023-00954: Patent Owner's Request for Permission to File Rebuttal Evidence with Sur-Reply

Dear Honorable Board:

Patent Owner respectfully requests that Ex. 2015 from PO's sur-reply (Paper 35) re IPR2023-00954 be expunged. Petitioner's counsel are copied on this email.

Primary counsel for PO as well as supporting staff are based in Houston, which today took a direct hit from Hurricane Beryl. We have been without power or Internet all day in the office and at our homes. In the chaos, we mistakenly filed an old version of our Sur-Reply from before this morning's ruling from the Board. Out of an abundance of caution based on this morning's ruling, we request Ex. 2015 be expunged. If the Board approves, we will immediately file an updated exhibit list without Ex. 2015. Thank you for your patience and understanding. Please contact me if you have any questions. Thank you again.

Sincerely,
Erick Robinson
Counsel for Patent Owner
Quantum Imaging LLC
Partner and Co-Chair of IP
Spencer Fane LLP
713-498-6047