

From: [Trials](#)
To: [Ostrowski, Carter S.](#); [Trials](#)
Cc: [Lauridsen, Steven E.](#); [Mason, Derek](#); SFeldman@hahnlaw.com; [Walter Kawula](#); [Joel S. Sonnenberg](#); [Sherry Rollo](#)
Subject: RE: IPR 2023-01015 - UV Engineering Solutions LLC v. Trojan Technologies Group, ULC
Date: Monday, October 16, 2023 1:06:51 PM

Counsel,

The Panel denies Petitioner's request to file a reply to the Patent Owner's Response. A mere factual dispute with arguments made in the Preliminary Response does not satisfy the good cause standard of 37 C.F.R. § 42.108(c). A conference is not necessary.

Petitioner has filed a substantive email in violation of Board practice. The Board does not consider arguments in emails unless requested. The parties are reminded not to engage in such practices in the future.

Regards,

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

From: Ostrowski, Carter S. <Carter.Ostrowski@tuckerellis.com>
Sent: Friday, October 13, 2023 2:40 PM
To: Trials <Trials@USPTO.GOV>
Cc: Lauridsen, Steven E. <Steven.Lauridsen@tuckerellis.com>; Mason, Derek <Derek.Mason@tuckerellis.com>; SFeldman@hahnlaw.com; Walter Kawula <WKawula@hahnlaw.com>; Joel S. Sonnenberg <JSonnenberg@hahnlaw.com>; Sherry Rollo <SRollo@hahnlaw.com>
Subject: IPR 2023-01015 - UV Engineering Solutions LLC v. Trojan Technologies Group, ULC

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Your Honors,

Petitioner respectfully requests leave to file a five-page reply to Patent Owner's Preliminary Response ("POPR") in IPR2023-01015. Petitioner conferred with the Patent Owner and the Patent Owner opposes Petitioner's request.

The reply would address the POPR's interpretation of the scope of the claims of the subject patent (U.S. Patent No. 8,167,654), as well as the POPR's characterization of the prior art, namely, U.S. Patent No. 4,700,101 to Ellner.

Petitioner respectfully submits that good cause exists to request leave to file a reply to provide clarity regarding Patent Owner's interpretation of the '654 patent's claims as it relates to their

scope, and how that interpreted claim scope unduly raises the knowledge level of the person having ordinary skill in the art (POSITA). The ‘654 patent claims “a lamp device” generally, yet Patent Owner reads narrowing language into the claims throughout the POPR.

For example, the POPR attempts to differentiate from U.S. Patent No. 7,033,203 to Titchener by arguing that Titchener fails to teach a configuration that “could be applied to ultraviolet lamps immersed in water for water treatment purposes or any other water immersed electrical application.” (POPR at 11) (emphasis added). But the claims of the ‘654 patent make no reference to any such application nor any restriction related to water, water treatment, or water immersion.

Patent Owner carries its narrowed scope into its definition of the POSITA, stating that “some knowledge of fluid treatment systems and electro-mechanical interactions is necessary given the challenging, immersed-in-water environment in which these UV wastewater treatment systems and lamps operate.” (POPR at 6.) Given the discrepancy between the written claims and the claim scope as interpreted in the POPR, Petitioner respectfully submits that a briefing on the matter would prevent (i) the undue narrowing of the interpretation of the claims, (ii) the exclusion of relevant prior art, and (iii) the undue raising of the knowledge level of the POSITA.

Additionally, the POPR mischaracterizes the teachings of Ellner. The POPR asserts that the embodiments of Ellner relied upon by Petitioner require an electrical connection via wires because the embodiments are “generally similar to the ultraviolet lamp of Fig. 2.” (POPR at 9.) But the very lines that Patent Owner uses to make this assertion fully provides that the embodiment having terminal pins “is generally similar to the ultraviolet lamp 40 of FIG. 2 with the exception that the ultraviolet lamp 100 is connected to a source of electrical power by means of three terminal [sic] pins.” (Ellner at 4:20-25). Petitioner respectfully submits that good cause exists to provide context and clarification to the language from Ellner used in the POPR.

Petitioner submits that no new evidence would accompany a reply.

Petitioner proposes the briefing schedule outlined below, and further submits that any such filing would not delay the Board’s institution decision:

IPR Proceeding	Preliminary Response Filed	Institution Deadline	Petitioner’s Reply Deadline
IPR2023-01015	September 14, 2023	December 14, 2023	Within 5 business days of the Board’s authorization.

Petitioner’s counsel is additionally available to schedule a telephone conference with the Board and Patent Owner’s counsel should the Board desire to discuss this request.

Respectfully,

J. Derek Mason, Steven Lauridsen, Carter Ostrowski
Counsel for Petitioner

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