
From: Arvind Jairam <ajairam@McKoolSmith.com>

Sent: Tuesday, October 8, 2024 12:40 PM

To: Trials <Trials@USPTO.GOV>

Cc: IPR49649-0030IP1 <IPR49649-0030IP1@fr.com>; Nicholas Stephens <nstephens@fr.com>; Usman Khan <khan@fr.com>; Scott W. Hejny <shejny@McKoolSmith.com>

Subject: RE: IPR2023-01055

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IPR2023-01055

Your Honors,

Patent Owner does not oppose Petitioner's request for a responsive paper.

Respectfully,

Arvind Jairam

Counsel for Patent Owner

McKool Smith | Arvind Jairam

Principal | Washington, D.C. | Tel: (202) 370-8324

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From: Trials <Trials@USPTO.GOV>

Sent: Monday, October 7, 2024 12:23 PM

To: Arvind Jairam <ajairam@McKoolSmith.com>; Trials <Trials@USPTO.GOV>

Cc: IPR49649-0030IP1 <IPR49649-0030IP1@fr.com>; Nicholas Stephens <nstephens@fr.com>; Usman Khan <khan@fr.com>; Scott W. Hejny <shejny@McKoolSmith.com>

Subject: RE: IPR2023-01055

Counsel:

Patent Owner has not indicated whether Patent Owner opposes Petitioner's request to submit a responsive paper of equal length, with an equal amount of time, if the Board were to grant Patent Owner's request. If Patent Owner does not oppose Petitioner's request, Patent Owner may send a responsive email indicating that it does not oppose Petitioner's request for a responsive paper. If Patent Owner opposes Petitioner's request, the parties should provide three days and times both parties are available for a call the week of October 7, 2024.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Arvind Jairam <ajairam@McKoolSmith.com>
Sent: Friday, October 4, 2024 1:02 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR49649-0030IP1 <IPR49649-0030IP1@fr.com>; Nicholas Stephens <nstephens@fr.com>; Usman Khan <khan@fr.com>; Scott W. Hejny <shejny@McKoolSmith.com>
Subject: IPR2023-01055

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IPR2023-01055

Your Honors,

On September 27, 2024, the Board issued an Order permitting Patent Owner to file a ten page brief addressing new arguments raised by Petitioner for the first time in its MTA Sur-reply, and identified by Patent Owner in the oral argument in IPR2023-01054. The Board in its Order indicated that "[b]ased on the arguments raised at the hearing, we believe the record would benefit from allowing Patent Owner to submit a Sur-sur-reply on the Motion to Amend in order to have an opportunity to respond to the arguments made in Petitioner's MTA Sur-reply." IPR2023-01054, Paper 43, at 2-3.

On the same day as the IPR2023-01054 oral hearing, the Board heard oral argument in a related case, IPR2023-01055. During the -1055 oral argument, Patent Owner identified new arguments raised for the first time in Petitioner's MTA Sur-reply in that proceeding to which Patent Owner likewise did not have the opportunity to respond via a brief.

To ensure fairness and consistency across both cases, Patent Owner respectfully requests a similar ten-page brief to address new arguments raised for the first time by Petitioner in its MTA Sur-reply in IPR2023-01055.

The parties conferred by email and Petitioner indicated that it opposes Patent Owner's request. Petitioner provided the following statement:

Patent Owner's late request is unjustified and rewards Patent Owner for failing to observe the procedures in timely raising concerns over alleged new arguments/evidence issues. Patent Owner's present request is either redundant to arguments made at the hearing, which would not promote judicial efficiency, or amount to further briefing on an issue that was waived. The parties also addressed differences between the issues implicated by the MTAs in the -1054 and -1055 proceedings during the hearings conducted on the same day, and the Board only authorized briefing in the -1054 proceeding. The Trial Practice Guide explicitly notes that "the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial." 2019 CTPG, p. 80. For these reasons, Petitioner respectfully opposes Patent Owner's request.

To the extent Patent Owner's request is granted, Petitioner respectfully requests authorization to submit a responsive paper of equal length, with an equal amount of time to prepare the same.

The parties can make themselves available for a conference call with the Board during the week of October 7, 2024 if the Board so desires.

Respectfully,
Arvind Jairam
Counsel for Patent Owner

McKool SMITH

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