

Chuning, Matthew

From: Trials <Trials@USPTO.GOV>
Sent: Monday, December 18, 2023 3:31 PM
To: Flannery, Liz; Trials
Cc: mkoziarz@cgolaw.com; aszypa@cgolaw.com; Chuning, Matthew; Henkelman, Brad; Ton, Thao; Fulghum, Roger
Subject: RE: IPR Nos. IPR2023-01236 and -01238; Petitioner request to file replies to POPRs

[EXTERNAL EMAIL]

Counsel,

From the Board –

No conference call is necessary. Petitioner is authorized to file a 7-page reply in each proceeding on the claim construction issue and section 325(d) issue identified below. Patent Owner is authorized to file a 7-page sur-reply. The reply is due January 5, 2024, and the sur-reply is due January 12, 2024.

Regards,

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

From: Flannery, Liz <liz.flannery@bakerbotts.com>
Sent: Thursday, December 14, 2023 6:44 PM
To: Trials <Trials@USPTO.GOV>
Cc: mkoziarz@cgolaw.com; aszypa@cgolaw.com; Chuning, Matthew <matthew.chuning@bakerbotts.com>; Henkelman, Brad <bradley.henkelman@bakerbotts.com>; Ton, Thao <thao.ton@bakerbotts.com>; Fulghum, Roger <Roger.Fulghum@BakerBotts.com>
Subject: Re: IPR Nos. IPR2023-01236 and -01238; Petitioner request to file replies to POPRs

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Dear Honorable Board:

Petitioners request authorization to file 8-page preliminary replies to Patent Owner's Preliminary Responses (POPRs) in the above-identified matters. Due to the holidays, Petitioners request that the replies would be due on the later of January 8, 2024 or 9 business days after the Board's authorization for the replies. Petitioners' preliminary replies would be limited to addressing the following issues raised in the POPRs.

- IPR No. IPR2023-01236:
 - arguments regarding construction of the claim term "a tube and a sleeve that circumscribes the tube", and

- arguments that institution should be denied under s325(d) and *Advanced Bionics* because the Coxreels and Shoap references are cumulative of the Amann, Harman, and Griffiths references presented to the Office during prosecution.
- IPR Nos. IPR2023-01238:
 - arguments regarding construction of the claim term “connected”, and
 - arguments that institution should be denied under s325(d) and *Advanced Bionics* because the Cable reference is cumulative of the Amann and Harman references presented to the Office during prosecution.

We would also use the reply to inform the Board that the underlying litigation between the parties has been stayed pending completion of these IPR proceedings.

Petitioners submit that there is good cause for Petitioners to submit replies as to the above issues. Regarding the s325(d) / *Advanced Bionics* issues, Petitioners could not have anticipated that Patent Owner would select the Amann, Harman, and Griffiths references from amongst the 100+ references of record to argue that prior art in the Petitions is cumulative of such references. Regarding the claim construction issues, Petitioners could not have foreseen the specific bases for Patent Owner’s arguments narrowing the constructions of those claim terms, including but not limited to dictionary definitions (see IPR2023-01236 POPR at 8-9) and alleged “inference[s] from the context” of the claims (see IPR2023-01238 POPR at 9-10) presented for the first time in the POPRs.

Petitioners and Patent Owner met and conferred regarding this request, and Patent Owner indicated its belief that good cause does not exist for granting replies. In particular, issues tied to i) the explicit factors of *Advanced Bionics* that are based on art of record and ii) claim construction on terms that Petitioner could have addressed in its petition, but chose not to, were all entirely foreseeable. Allowing the Petitioner to revisit these issues would not be proper and seems likely to be prejudicial to Patent Owner.

The parties can be available for a telephone conference with the Board at the following times:

- Mon Dec 18 9am - noon ET
- Wed Dec 20 9am – 5pm ET
- Thurs Dec 21 9am-10am ET or 11am-5pm ET

Liz Durham Flannery

Partner

Baker Botts L.L.P.

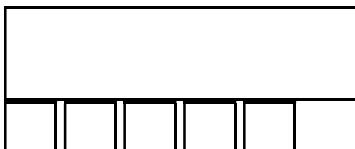
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