

Nicholas Stephens

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, January 18, 2024 1:04 PM
To: Dou, Yimeng; Trials
Cc: Nicholas Stephens; Grace Kim; Casey Kraning; #ATL_IPR; IPR12732-2330IP1; Baker, W. Todd
Subject: RE: IPR2023-01349: Amperex Technology Limited v. Semiconductor Energy Laboratory Co., Ltd.

[This email originated outside of F&R.]

Counsel,

Petitioner is authorized to file a preliminary reply addressing the issues Petitioner raised in its January 15 email to the Board. The preliminary reply shall not exceed 10 pages, and it shall be filed not later than January 29, 2024. If Petitioner files a preliminary reply, Patent Owner is authorized to file a preliminary sur-reply addressing the issues addressed in the preliminary reply. The preliminary sur-reply shall not exceed 10 pages, and it shall be filed not later than February 8, 2024. Neither the preliminary reply nor the preliminary sur-reply shall be accompanied by new evidence, other than on the issue of public accessibility.

Regards,

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

From: Dou, Yimeng <yimeng.dou@kirkland.com>
Sent: Monday, January 15, 2024 1:08 PM
To: Trials <Trials@USPTO.GOV>
Cc: Nicholas Stephens <nstephens@fr.com>; Grace Kim <gkim@fr.com>; Casey Kraning <Kraning@fr.com>; #ATL_IPR <ATL_IPR@kirkland.com>; IPR12732-2330IP1 <IPR12732-2330IP1@fr.com>; Baker, W. Todd <todd.baker@kirkland.com>
Subject: IPR2023-01349: Amperex Technology Limited v. Semiconductor Energy Laboratory Co., Ltd.

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

To the Honorable Board,

Petitioner ATL respectfully seeks leave to file a reply to the POPR in the subject IPR against the '660 Patent. The reply would be limited to ten pages addressing the following four issues raised by Patent Owner SEL in its POPR:

First, Petitioner seeks to address Patent Owner's implicit claim construction arguments, including that the second region can only be a rock-salt structure and that Mg, Ti, O, and F in the claimed second region can only exist in rock salt form. In so arguing, Patent Owner presents an unforeseeable and overly narrow interpretation of the claim language, and Petitioner should be given the opportunity to respond on this issue. Further, Petitioner should be given the opportunity to respond to Dr. Lucht's testimonial evidence relied upon by Patent Owner.

Second, Petitioner seeks to address Patent Owner's argument that the Petition should be denied under 35 U.S.C. § 325(d) for relying on previously considered prior art and arguments. While this issue was proactively addressed in the Petition, Petitioner should have the opportunity to respond because the § 325(d) issue is potentially dispositive of the proceeding.

Third, Petitioner seeks to address Patent Owner's argument that Petitioner has not provided sufficient evidence to establish that Yamamoto and Kim are prior art printed publications. Because there are sufficient indicia of public availability on the faces of both references, Patent Owner's argument was unforeseeable. Thus, Petitioner should have the opportunity to respond on this issue and provide additional evidence to support the public availability of the references.

Fourth, Petitioner seeks to address Patent Owner's arguments that mischaracterize the Petition as relying on inherency and arguments in the POPR that mischaracterize embodiments in the cited prior art in conjunction with Dr. Lucht's testimonial evidence. Such mischaracterization of the Petition and the references was unforeseeable, and Petitioner should have the opportunity to respond on these unforeseeable issues.

The parties have conferred by email and Patent Owner provided the following position:

Patent Owner opposes the request in its entirety because Petitioner has not identified good cause for briefing on any of the four proposed topics as required by 37 CFR § 42.108(c). To the extent the Board does authorize briefing, it should be limited to six (6) pages addressing only the second (i.e., 35 U.S.C. § 325(d)) and third (i.e., public accessibility of Yamamoto and Kim) topics identified in Petitioner's request. Petitioner's request for briefing on the first and fourth topics in particular are unnecessary and unwarranted. Regarding topic one, Patent Owner did not advance a construction of any claim term in the POPR and Petitioner will have the opportunity to depose Dr. Lucht should the Board grant institution. Regarding topic four and Petitioner's request to address inherency and PO's view of prior art embodiments, Petitioner already had the opportunity (and indeed did) provide its own view of the prior art and its reliance thereon in its Petition. These issues were foreseeable when the Petition was filed, and further debate is unnecessary. Should the Board authorize any aspect of Petitioner's request, Patent Owner respectfully requests authorization to file a Sur-Reply of corresponding length and scope to Petitioner's authorized Reply.

In the interest of fairness and ensuring the Board is fully briefed, should it decide to allow briefing, Petitioner will not oppose a Sur-Reply by Patent Owner of the same length. The parties are available at the following times for a call with the Board:

1. Tuesday 1/16, 1-5pm ET
2. Wednesday 1/17, 10am-4pm ET
3. Thursday 1/18, 10am-4pm ET

Best regards,

Yimeng Dou
(Reg. No. 69,770)
Counsel for Petitioner ATL

Yimeng Dou, Ph.D.

KIRKLAND & ELLIS LLP
555 South Flower Street, 37th Floor
Los Angeles, CA 90071
T +1 213 680 8283
F +1 213 680 8500

yimeng.dou@kirkland.com

The information contained in this communication is confidential, may be attorney-client privileged, may constitute inside information, and is intended only for the use of the addressee. It is the property of Kirkland & Ellis LLP or Kirkland & Ellis International LLP. Unauthorized use, disclosure or copying of this communication or any part thereof is strictly prohibited and may be unlawful. If you have received this communication in error, please notify us immediately by return email or by email to postmaster@kirkland.com, and destroy this communication and all copies thereof, including all attachments.