
From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, January 9, 2024 1:13 PM
To: Specht, Kara; Trials
Cc: CM-200371-00440 EPCC-Inno-IPRS; Davis Jr., Walter D.; Thronson, Mark; Edwards, Cory R.; England, Jonathan; Doshi, Dipu; Soffen, Stephen; Paradkar, Arun V.; Innoscience-EPC-IPRs
Subject: RE: IPR2023-01381



Dear Counsel,

From the Board –

Petitioner’s request for authorization to file a reply brief to address Patent Owner’s construction of the claim term “above the barrier layer and below the gate electrode” recited in US Patent No. 8,350,294 is granted. Additional briefing on this issue will be helpful to the panel in rendering its decision either granting or denying institution.

Petitioner’s request for authorization to file a reply brief to address Patent Owner’s statement that prior art reference *Bowers* is cumulative of *Kigami* is denied. The panel is able to review the references and the parties assertions without the need for additional briefing.

Petitioner’s brief is limited to 7 pages and is due by Tuesday, January 16th. Patent Owner is authorized to file a sur-reply, also limited to 7 pages, which is due Tuesday, January 23rd.

No conference call is required at this time.

Regards,

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

From: Specht, Kara <Kara.Specht@finnegan.com>
Sent: Monday, January 8, 2024 3:22 PM
To: Trials <Trials@USPTO.GOV>
Cc: CM-200371-00440 EPCC-Inno-IPRS <EPCC-Inno-IPRS@BlankRome.com>; Davis Jr., Walter D. <Walter.Davis@BlankRome.com>; Thronson, Mark <mark.thronson@blankrome.com>; Edwards, Cory R. <Cory.Edwards@BlankRome.com>; England, Jonathan <jonathan.england@blankrome.com>; Doshi, Dipu <dipu.doshi@blankrome.com>; Soffen, Stephen <stephen.soffen@blankrome.com>; Paradkar, Arun V. <arun.paradkar@blankrome.com>; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>
Subject: IPR2023-01381

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

Dear Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioners request authorization from the Board to file 15-page pre-institution reply in IPR2023-01381 to respond to the following two unforeseeable arguments raised by EPC that could not have been addressed in the Petition:

- (1) Patent Owner's unforeseeable and incorrect statement that prior art reference *Bowers* is cumulative of *Kigami* (e.g, Paper No. 7, at 25); and
- (2) Patent Owner's unforeseeable and incorrect construction of the phrase, "above the barrier layer and below the gate electrode" (e.g, Paper No. 7, at 31).

Good cause exists for pre-institution briefing on the first issue because Patent Owner misinterprets the prosecution history of the '294 patent and the disclosures of *Bowers* raising a meritless 325(d) argument. Good cause exists for pre-institution briefing on the second issue because Patent Owner incorrectly interprets the term "above" as limited to only cover the contact between elements 15b and 20 in the *Uemoto* reference, inappropriately limiting the claim term from its plain meaning. Both issues were therefore unforeseeable and could not have been addressed in the Petition.

Patent Owner opposes Petitioners' requested reply and is available for a call with the Board as follows:

1/9 – 10:30 am to 4:00 pm
1/11 – 10:30 am to 4:00 pm
1/12 – 10:30 am to 4:00 pm

Petitioners will not oppose a sur-reply by Patent Owner of equal length and are available for a call at the Board's convenience.

Best regards,

Kara Specht
Counsel for Petitioner

Kara Specht
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
271 17th Street, NW, Suite 1400, Atlanta, GA 30363-6209
404.653.6481 | fax 404.653.6444 | kara.specht@finnegan.com | [bio](#) | www.finnegan.com

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.