

From: [Trials](#)
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: IPR2023-01383
Date: Tuesday, January 9, 2024 1:07:50 PM
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Dear Counsel,

From the Board -

Petitioner's request for authorization to file a reply brief to address Patent Owner's construction of the claims of US Patent No. 8,404,508 as requiring a "gate first" process is granted. Additional briefing on this claim construction issue will be helpful to the panel in rendering its decision either granting or denying institution. Petitioner's brief is limited to 10 pages and is due by Tuesday, January 16th. Patent Owner is authorized to file a sur-reply, also limited to 10 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 3:23 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2023-01383

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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 a 10-page pre-institution reply in IPR2023-01383 to respond to Patent Owner's unforeseeable and incorrect construction of the '508 patent claims as requiring a "gate first" process (e.g., Paper No. 7 at 2, 6, 22, 25, 27).

Good cause exists for pre-institution briefing on this issue because Patent Owner's construction of the '508 patent claims requiring a "gate first" process is contrary to the claims and the specification, and is inconsistent with Patent Owner's claim construction position at the parallel ITC litigation that steps of the claims require no order. Patent Owner's claim construction argument was thus unforeseeable.

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

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