

From: [Trials](#)
To: [Arjomand, Mehran](#); [Trials](#)
Cc: [Yap, Alex S.](#); [Kramer, Brian M.](#); [Hillier, Drew Alan](#); [DNAGSpectrum](#); [BoxSpectrum8](#); [Joe Jennings](#); [Ali Razai](#); [Ben Everton](#); [Paul Conover](#); [Ben Anger](#)
Subject: RE: IPR2023-01424 - Request for Reply Briefing
Date: Wednesday, January 17, 2024 1:35:35 PM

Counsel:

From the Board –

A conference call is not necessary. Short briefing focused solely on the proper claim construction of “cap” would be helpful, particularly because an explicit claim construction for the term was not presented earlier by either party in the related proceeding prior to the Board’s request following the oral hearing in that case.

Accordingly, we authorize additional briefing on the sole issue of the proper claim construction of the term “cap” as recited in U.S. Patent 11,536,632. Petitioner is authorized to file a Preliminary Reply Brief not to exceed 5 pages in length on or before January 25, 2024 and, if it chooses to do so, Patent Owner is authorized to file a Preliminary Sur-Reply Brief not to exceed 5 pages in length on or before February 1, 2024.

Petitioner shall file as an exhibit to its Preliminary Reply Brief a copy of this email authorization.

Regards,

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

From: Arjomand, Mehran <MArjomand@mofo.com>
Sent: Thursday, January 11, 2024 8:19 PM
To: Trials <Trials@USPTO.GOV>
Cc: Yap, Alex S. <AYap@mofo.com>; Kramer, Brian M. <BMKramer@mofo.com>; Hillier, Drew Alan <DHillier@mofo.com>; DNAGSpectrum <DNAGSpectrum@mofo.com>; BoxSpectrum8 <BoxSpectrum8@knobbe.com>; Joe Jennings <Joe.Jennings@knobbe.com>; Ali Razai <Ali.Razai@knobbe.com>; Ben Everton <Ben.Everton@knobbe.com>; Paul Conover <Paul.Conover@knobbe.com>; Ben Anger <Ben.Anger@knobbe.com>
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Trials,

Petitioner is correct that Patent Owner opposes Petitioner's request for a reply brief to the POPR. But Petitioner is incorrect in asserting the post-hearing briefing provides good cause for its request. Petitioner was well aware of the "cap" issue before the filing of its Petition on September 15, 2023, because it was raised by Patent Owner in its POR (Paper 18 at pp. 83-88) on May 9, 2023 and in its Sur-reply (Paper 26 at pp. 21-22) on September 12, 2023 in IPR2022-01347. Petitioner did not have to file its Petition on September 15, 2023. And, in any event, Petitioner had an opportunity to provide a construction for "cap" when it did file.

Petitioner's counsel is copied on this e-mail.

Respectfully,

Mehran Arjomand

MEHRAN ARJOMAND

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From: Ben Anger <Ben.Anger@knobbe.com>

Sent: Wednesday, January 10, 2024 12:37 PM

To: 'Trials' <trials@uspto.gov>

Cc: Arjomand, Mehran <MArjomand@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Kramer, Brian M. <BMKramer@mofo.com>; Hillier, Drew Alan <DHillier@mofo.com>; DNAGSpectrum <DNAGSpectrum@mofo.com>; BoxSpectrum8 <BoxSpectrum8@knobbe.com>; Joe Jennings <Joe.Jennings@knobbe.com>; Ali Razai <Ali.Razai@knobbe.com>; Ben Everton <Ben.Everton@knobbe.com>; Paul Conover <Paul.Conover@knobbe.com>

Subject: IPR2023-01424 - Request for Reply Briefing

External Email

RE: *Spectrum Solutions v. DNA Genotek*
Case No. IPR2023-01424

Dear PTAB,

Pursuant to 37 CFR § 42.108(c), Petitioner requests leave to file a 5-page reply brief to Patent Owner's Preliminary Response (POPR) filed on December 28, 2023 in this case. The proposed reply will address Patent Owner's proposed construction of the claim term "cap." See POPR at 11-14, 34-36. Petitioner believes good cause exists for the requested reply because it will concisely inform the Board of Petitioner's claim construction position for purposes of the Board's Institution Decision. Petitioner could not have anticipated Patent Owner's proposed claim construction when filing the

petition in September 2023. Patent Owner first raised its proposed claim construction for “cap” in post-hearing briefing in IPR2022-01347 (addressing related U.S. Patent No. 11,002,646), which briefing occurred in November and December 2023. *See* IPR2022-01347, Paper Nos. 37, 39, 40, 41, 42.

Petitioner contacted Patent Owner regarding this request on January 3, 2024, and the parties conducted a meet and confer on January 8, 2024. Patent Owner later indicated that it opposes Petitioner’s request for a reply brief. If the Board elects to hold a conference call, the parties can be available on Tuesday, January 16 from 12 pm – 2 pm ET or Thursday, January 18 from 12 pm – 5 pm ET.

Patent Owner’s counsel are cc’d on this email.

Best,
Ben Anger
Counsel for Petitioner, Spectrum Solutions

Ben Anger
Partner
858-707-4116 Direct
Knobbe Martens

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