From:	Trials
To:	Jared Newton; Trials
Cc:	Jim Glass; Ron Hagiz; Morton, Phillip; nkennedy@kilpatricktownsend.com; mbussey@kilpatricktownsend.com; Gardner, Eamonn; Lauppe, Patrick W.; Smith, Stephen; Boroumand Smith, Mehrnaz
Subject:	RE: IPR2023-01421 and -01458 - Request for Leave
Date:	Tuesday, January 16, 2024 2:45:20 PM

Counsel,

A conference call is scheduled for **10-11 am Eastern time (tomorrow - January 17th**).

The dial-in number is: 866-617-3597 and the passcode is: 9501631#.

Regards,

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

From: Jared Newton <jarednewton@quinnemanuel.com>
Sent: Monday, January 15, 2024 1:07 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jim Glass <jimglass@quinnemanuel.com>; Ron Hagiz <ronhagiz@quinnemanuel.com>; Morton, Phillip <pmorton@cooley.com>; nkennedy@kilpatricktownsend.com; mbussey@kilpatricktownsend.com; Gardner, Eamonn <egardner@cooley.com>; Lauppe, Patrick W. <plauppe@cooley.com>; Smith, Stephen <stephen.smith@cooley.com>; Boroumand Smith, Mehrnaz <mboroumand@ktslaw.com>
Subject: IPR2023-01421 and -01458 - Request for Leave

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Dear Honorable Board:

I am lead counsel for Petitioner in the above proceedings. Petitioner seeks leave to submit a short (no more than 5 pages) preliminary reply brief in each proceeding to address arguments raised in Patent Owner's Preliminary Responses as specified below. Petitioner is mindful of both the Board's prohibition against argumentative emails to *Trials* and of 37 CFR § 42.108(c), which requires a request for a reply to "make a showing of good cause." Good cause exists for this request because Petitioner could not have foreseen the following arguments:

- With respect to the -01421 proceeding, it was not foreseeable that Patent Owner would argue the term "aperture" requires an "air gap." Patent Owner premises its argument on Petitioner's proposed construction in the related ITC Investigation, which included the term "hole"; but Petitioner did not argue or otherwise propose that a "hole" must be an "air gap."

Petitioner seeks leave to address this narrow claim construction issue.

- In the -01458 proceeding, it was not foreseeable that Patent Owner would rely on *LG Elecs. Inc. v. ImmerVision, Inc.*, 39 F.4th 1364, 1372-73 (Fed. Cir. 2022) and *In re Yale*, 434 F.2d 666 (C.C.P.A. 1970), both of which involved "an obvious error of a typographical or similar nature." Petitioner seeks leave to address these cases and their applicability to the prior art at issue.

The parties have met and conferred, and Patent Owner opposes Petitioner's request. To the extent the Board wishes to hold a hearing on this request, the parties are available Wednesday, January 17th between 10-12ET. The parties will revert with availability should the Board require additional time slots. To the extent the Board authorizes a preliminary reply, Petitioner does not oppose Patent Owner receiving a sur-reply of the same length.

Counsel for Patent Owner is copied on this email.

Best Regards,
Jared Newton
Reg. No. 65,818

Jared Newton
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