

From: [Director_PTABDecision_Review](#)
To: [Kennedy, Nicki](#); [Director_PTABDecision_Review](#)
Cc: [hawkins@fr.com](#); [Bussey, Megan](#); [Phillip Morton](#); [egardner@cooley.com](#); [Jared Newton](#); [jimglass@quinnemanuel.com](#); [nimahefazi@quinnemanuel.com](#); [IPR56432-0094IP1](#)
Subject: RE: IPR2023-01458 Request for Director Review
Date: Friday, May 31, 2024 10:51:05 AM

Counsel,

Thank you for your email. Your request to file a response to the pending Director Review Request is denied at this time. See Revised Interim Director Review Process, available at <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process>, Section 5.A.ii.b (“Director Review decisions are generally made based on the existing record, without the need for responsive or amici curiae briefing. Responsive or amici curiae briefing may only be submitted if requested by the Director.”). If the Director determines that briefing is necessary, counsel will be informed.

Your email and this response will be entered into the public record. See *id.* at Section 3.G (“All communications will be entered into the record of the proceeding.”).

Thank you.

From: Kennedy, Nicki <NKennedy@ktslaw.com>
Sent: Monday, May 13, 2024 9:35 AM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: [hawkins@fr.com](#); [Bussey, Megan](#) <MBussey@ktslaw.com>; [Phillip Morton](#) <[pmorton@cooley.com](#)>; [egardner@cooley.com](#); [Jared Newton](#) <[jarednewton@quinnemanuel.com](#)>; [jimglass@quinnemanuel.com](#); [nimahefazi@quinnemanuel.com](#); [IPR56432-0094IP1](#) <[IPR56432-0094IP1@fr.com](#)>
Subject: IPR2023-01458 Request for Director Review

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Dear Honorable Director,

I am lead counsel for Patent Owner, Ouster Inc. Patent Owner requests leave to file a response to Petitioner’s Request for Director Review in IPR2023-01458. Good cause exists for Patent Owner’s response because Petitioner’s Request improperly includes new arguments and evidence that it neither included in the Petition nor sought leave to include in a reply, such as the arguments relating to the Hall patent and a past IPR, IPR2018-00255. In addition, good cause exists because Petitioner’s email to the Director below includes improper argument beyond the brief explanation of the issues allowed by Part 3.A of the Director Review process.

Petitioner opposes because Patent Owner’s request is alleged to be: (1) tardy, (2) contrary to the *Revised Interim Director Review Process* Section 5.A.ii.b (“without the need for responsive ...

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Ex. 3101

briefing”), and (3) directed to the ‘issue of policy’ that necessarily arose only after the Petition was filed.”

Best regards,

Nicki Kennedy

NKennedy@ktslaw.com

Kilpatrick Townsend & Stockton LLP

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From: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Sent: Friday, April 26, 2024 2:36 PM

To: Michael Hawkins <hawkins@fr.com>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Cc: Kennedy, Nicki <NKennedy@ktslaw.com>; Bussey, Megan <MBussey@ktslaw.com>; Phillip Morton <pmorton@cooley.com>; egardner@cooley.com; jarednewton@quinnemanuel.com; jimglass@quinnemanuel.com; nimahefazi@quinnemanuel.com; IPR56432-0094IP1 <IPR56432-0094IP1@fr.com>

Subject: RE: IPR2023-01458 Request for Director Review

****CAUTION: External Email****

Counsel,

Your request for Director Review has been received for the above-referenced case. The Director will determine whether review will be granted or denied and you will be notified of the result of your request.

Thank you.

From: Michael Hawkins <hawkins@fr.com>

Sent: Friday, April 26, 2024 1:15 PM

To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Cc: nkennedy@kilpatricktownsend.com; mbussey@kilpatricktownsend.com; pmorton@cooley.com; egardner@cooley.com; jarednewton@quinnemanuel.com; jimglass@quinnemanuel.com; nimahefazi@quinnemanuel.com; IPR56432-0094IP1 <IPR56432-0094IP1@fr.com>

Subject: IPR2023-01458 Request for Director Review

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Honorable Director,

Hesai Technology Co., Ltd., the Petitioner in IPR2023-01458, respectfully recommends and requests Director Review of the Final Written Decision issued by the Board in that proceeding. Concurrently herewith, Petitioner has filed the attached Petitioner’s Request for Director Review.

The Board denied institution after erroneously concluding that a drawing in a prior patent failed to depict a claimed arrangement—contrary to both the drawing itself and the only testimony evidence in the record. The Decision here mirrors the same errors noted in the recent *Mahle* case, which resulted the institution decision being vacated and remanded.

The Decision additionally raises an important issue of policy—one that is refined for review here due to the unique relationship between the prior patent, the Patent Owner, and the Board’s previous findings for that same prior patent. Consistent with *Cuozzo Speed*’s identification of the “basic” Congressional purpose of IPR and “the public’s paramount interest” therein, Director Review is needed here to address what should be the minimum level of inquisitiveness required from the Board at the institution stage where a patent owner presents mere attorney argument questioning the teaching of its own prior patent contrary to unrebutted testimony on that same issue.

Respectfully,

Michael Hawkins

Principal ■ Fish & Richardson P.C.

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