

From: [Trials](#)
To: [Trials](#); [Kennedy, Nicki](#)
Cc: [Bussey, Megan](#); [hawkins@fr.com](#); [Phillip Morton](#); [egardner@cooley.com](#); [Jared Newton](#); [jimglass@quinnemanuel.com](#); [nimahefazi@quinnemanuel.com](#)
Subject: RE: IPR2023-01458 Request for Leave to File Supplemental Brief
Date: Tuesday, August 13, 2024 11:14:33 AM
Attachments: [image001.png](#)

Counsel,

Correction –

From the Board -

Under the circumstance here, further briefing would be helpful to the Board. *See* Rule 42.5 (allowing for the Board to determine the proper course of conduct for any situation not specifically covered by part 42 and allowing the Board to waive or suspend a requirement of part 42); *See also* Section 5.A.ii.e. of the Board’s webpage on the Revised Interim Director Review Process, available at [Revised Interim Director Review Process | USPTO](#) (discussing additional briefing).

Patent Owner is authorized to file a 3-page brief as requested, no later than August 20, 2024.
Petitioner is authorize for file a responsive 3-page brief, no later than August 27, 2024.

Regards,

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

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, August 13, 2024 10:47 AM
To: Kennedy, Nicki <NKennedy@ktslaw.com>; Trials <Trials@USPTO.GOV>
Cc: Bussey, Megan <MBussey@ktslaw.com>; hawkins@fr.com; Phillip Morton <pmorton@cooley.com>; egardner@cooley.com; Jared Newton <jarednewton@quinnemanuel.com>; jimglass@quinnemanuel.com; nimahefazi@quinnemanuel.com
Subject: RE: IPR2023-01458 Request for Leave to File Supplemental Brief

Counsel,

Under the circumstance here, further briefing would be helpful to the Board. *See* Rule 42.5 (allowing for the Board to determine the proper course of conduct for any situation not specifically covered by part 42 and allowing the Board to waive or suspend a requirement of part 42); *See also* Section 5.A.ii.e. of the Board’s webpage on the Revised Interim Director Review Process, available at [Revised Interim Director Review Process | USPTO](#) (discussing additional briefing).

Patent Owner is authorized to file a 3-page brief as requested, no later than August 3, 2024.
Petitioner is authorize for file a responsive 3-page brief, no later than August 20, 2024.

Regards,

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

From: Kennedy, Nicki <NKennedy@ktslaw.com>
Sent: Wednesday, July 31, 2024 3:10 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bussey, Megan <MBussey@ktslaw.com>; hawkins@fr.com; Phillip Morton <pmorton@cooley.com>; egardner@cooley.com; Jared Newton <jarednewton@quinnemanuel.com>; jimglass@quinnemanuel.com; nimahefazi@quinnemanuel.com
Subject: IPR2023-01458 Request for Leave to File Supplemental Brief

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Dear Honorable Board,

I am lead counsel for Patent Owner, Ouster Inc. Patent Owner requests leave to file a supplemental brief not exceeding 3 pages in IPR2023-01458 following the Decision Granting Director Review (Paper 14). Good cause exists for Patent Owner's supplemental brief because the Decision directs the Board to address "all remaining issues" relating to its decision on institution (Paper 14 at 9), and the Decision did not address all remaining issues that support denial of institution.

Petitioner opposes Patent Owner's request because the proposed supplemental briefing: (1) is contrary to the express mandate from the Director regarding the next step ("I vacate ... and remand to the Board to issue a decision on institution"); (2) ignores that the Board is amply capable of identifying any remaining issues from the already-filed preliminary response in the Board's normal course; and (3) violates the plain text of 37 CFR 42.108(c) in which only the "petitioner" may seek leave to file additional briefing after patent owner's preliminary response.

If needed, Patent Owner and Petitioner can be available for a PTAB conference call on August 1 (9AM-5PM Eastern Time) and August 2 (8AM-4PM Eastern Time).

Best,



Nicki Kennedy
NKennedy@ktslaw.com
Kilpatrick Townsend & Stockton LLP

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