

From: [Trials](#)
To: [Michael D. Saunders; Trials](#)
Cc: [Bryan D. Atkinson; *DAL - Force MOS IPRs; Lines, Aaron; Martin \(DeWerff\), Mackenzie](#)
Subject: RE: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS – Petitioner's Request for Pre-Institution Briefing
Date: Thursday, April 11, 2024 1:22:26 PM
Attachments: [image002.png](#)
[image003.png](#)
[image004.png](#)

Good afternoon Counsel,

From the Board –

Petitioner's request for authorization to reply to the § 314(a) arguments in Patent Owner's Preliminary Responses is denied. We deny this request because Petitioner has not provided a reason for its delay in making the request, and because granting additional briefing in this instance would negatively impact our ability to meet our statutory deadline for a decision on institution.

Petitioner's request for authorization to address Patent Owner's claim construction of the term "lateral contact layer" is also denied. We have taken Petitioner's request under advisement, however we do not require additional briefing at this time.

The parties are reminded of their obligation to make a reasonable and good faith attempt to meet and confer prior to contacting the Board. In future correspondence, the parties are instructed to meaningfully meet and confer and to include their respective positions in a single joint email to the Board.

Regards,

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

From: Michael D. Saunders <MSaunders@dickinson-wright.com>
Sent: Sunday, March 31, 2024 10:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bryan D. Atkinson <BATkinson@dickinson-wright.com>; *DAL - Force MOS IPRs <DAL-ForceMOSIPRs@bakermckenzie.com>; Lines, Aaron <Aaron.Lines@bakermckenzie.com>; Martin (DeWerff), Mackenzie <Mackenzie.Martin@BakerMckenzie.com>
Subject: RE: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS – Petitioner's Request for Pre-Institution Briefing

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To the Honorable Board:

Patent Owner opposes Petitioner's requests, and Patent Owner requests a teleconference with the Board if the Board is inclined to entertain Petitioner's requests.

Petitioner's counsel did not raise the issue of additional briefing with Patent Owner until March 27, 2024—a full month after Patent Owner's preliminary responses were filed in these IPRs. Moreover, Petitioner did not promptly provide details regarding why it believed further section 314(a) briefing was needed, and only did so in the afternoon of Friday March 29—after multiple requests from Patent Owner for such details. Petitioner refused Patent Owner's counsel's request for time to confer with its client after Petitioner provided those details, and instead Petitioner's counsel emailed the Board below only hours after first providing details to Patent Owner regarding Petitioner's purported need for additional section 314(a) briefing.

Petitioner's unexplained, month-long delay in seeking additional briefing prejudices Patent Owner and its counsel. In particular, a claim construction hearing is set for April 11, 2024 in the *EDTX Force MOS v. ASUSTek Computer, Inc.* ("ASUS") matter. Force MOS's counsel in this IPR also represents Force MOS in the *ASUS* case, and is expected to prepare for and participate at the *Force MOS v. ASUS* claim construction hearing. Petitioner's delay in seeking additional briefing will likely cause the proposed supplemental briefing schedule to conflict with Force MOS's counsel's preparation for the *ASUS* claim construction hearing. We also note that Petitioner's delay is prejudicial to the Board's schedule for preparation of an institution decision within the time provided under section 314(b).

Additionally, the reasons that Petitioner has identified for additional briefing were foreseeable at the time the petitions were filed. As to the section 314(a) issue, Petitioner admitted in its Petitions that ASUS was a real-party-in-interest, and—in its *Fintiv* Factor 2 analysis—that Force MOS's EDTX action against ASUS was scheduled to be tried six months prior to expected final written decisions if these IPRs were instituted. Petitioner's decision to not address the EDTX *Force MOS v. ASUS* matter in a number of the other *Fintiv* factors, and to instead discuss those factors in a perfunctory manner, reflected a tactical decision by Petitioner. The Board should not acquiesce to gamesmanship in allowing Petitioner to change its tactics over a month after the preliminary responses were filed.

As to the "lateral contact layer" issue, as set forth in the preliminary response in IPR2024-00093, the Petitioner's identification of terms for express claim construction reflected tactical decision-making rather than a good faith effort to comply with 37 CFR 42.104(b)(3). In particular, Petitioner elected to seek the construction of "the sidewalls of said trenches in said base layer" but intentionally omitted the rest of the claim phrase ("are covered by the lateral contact layer"). As discussed in the preliminary response, Petitioner's identification of a claim construction issue regarding "the sidewalls of said trenches in said base layer" has no apparent connection to any of the issues identified in the Petition, but rather appears to have been included solely to obtain this Board's ruling as persuasive authority to use in related District Court litigation in furtherance of ASUS's non-infringement theories (Petitioner and ASUS are represented by the same counsel). Thus, the decision to not construe "lateral contact layer" in the Petition was a tactical decision by Petitioner, rather than something that was unforeseeable. Moreover, Petitioner's reliance on *Axonics* is misplaced—that is a decision relating to post-institution claim constructions, and thus has no bearing over the Board's decision on whether to institute.

If the Board does grant Petitioner's request(s), Patent Owner would request sur-replies of equal length to be due the later of: (a) one week from the replies, or (b) April 18, 2024 (which is one week after the Court's claim construction hearing in the *Force MOS v. ASUS* case). Please let us know if the Board has any questions or would like any further information in regards to Patent Owner's position or Patent Owner's availability for a teleconference.

Regards,
Michael Saunders

For docketing purposes of patent & trademark matters only, please add the appropriate email of dwpatents@dickinson-wright.com or dwtrademarks@dickinson-wright.com to any emails being sent to our office. Thank you.



Michael D. Saunders

Member

O: 512-770-4208

MSaunders@dickinson-wright.com

From: Martin (DeWerff), Mackenzie <Mackenzie.Martin@BakerMckenzie.com>

Sent: Friday, March 29, 2024 4:15 PM

To: Trials@USPTO.Gov

Cc: Michael D. Saunders <MSaunders@dickinson-wright.com>; Bryan D. Atkinson <BAtkinson@dickinson-wright.com>;

*DAL - Force MOS IPRs <DAL-ForceMOSIPRs@bakermckenzie.com>; Lines, Aaron <Aaron.Lines@bakermckenzie.com>

Subject: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS – Petitioner's Request for Pre-Institution Briefing

Your Honors,

Petitioner requests authorization to submit a Petitioner pre-institution reply in each of IPR proceeding Nos. IPR2024-00093 and IPR2024-00094 (the “’634 IPR” and “’409 IPR”), which relate to U.S. Pat. Nos. 7,629,634 and 7,812,409, respectively.

In both IPRs, Petitioner requests authorization to reply to the § 314(a) arguments in Patent Owner’s Preliminary Responses. In particular, Patent Owner argued that the Board should exercise its discretion to deny institution under § 314(a) in view of co-pending Eastern District of Texas litigation involving a different entity, ASUSTek Computer Inc. Good cause exists for briefing Petitioner’s response to Patent Owner’s arguments at least because Petitioner could not have predicted the specific arguments Patent Owner would raise in support of Patent Owner’s request for discretionary denial under § 314(a). In particular, Petitioner anticipates responding to Patent Owner’s argument that the *Fintiv* factors weigh in favor of denial in view of ASUSTek Computer Inc.’s (not Petitioner’s) involvement in the Eastern District of Texas action based on the real-party-in-interest argument. Petitioner further anticipates responding to Patent Owner’s argument that the facts and legal analysis relevant to ASUSTek--and not Petitioner--are relevant to the *Fintiv* analysis (for example, *Fintiv* factors 1-5).

Further, in Petitioner’s reply for the ’634 IPR, Petitioner requests authorization to address Patent Owner’s claim construction of the term “lateral contact layer,” which was disclosed for the first time in Patent Owner’s Preliminary Response. Petitioner believes good cause exists for a reply because Petitioner could not have predicted Patent Owner’s claim construction or the specific arguments Patent Owner would raise in support of its claim construction and in arguing that Petitioner has allegedly failed to demonstrate a reasonable likelihood that the challenged claims are unpatentable. (Notably, this also implicates the Board’s § 314(a) analysis of the merits of the petition.) Petitioner believes that the Board would likely benefit from Petitioner’s opportunity to address the construction prior to the Board’s consideration of such construction, and the § 314(a) analysis, in coming to the Board’s institution decision. See, e.g., *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 at 1382 (Fed. Cir. 2023) (“[A] petitioner is entitled to respond to a new claim construction.”) (citation omitted).

Petitioner requests a five-page limit for its reply in the ’409 IPR and a seven-page limit in the ’634 IPR (in view of the claim construction issue). Petitioner does not oppose Patent Owner’s submission of sur-replies of equal lengths.

Petitioner conferred with Patent Owner over email and was unable to obtain Patent Owner’s position on whether it opposes Petitioner’s requested reply.

Counsel for Petitioner is available for a call to discuss this request if helpful to the Board. Please let us know if the Board has any questions or would like any further information in consideration of Petitioner’s request.

Kind regards,
Mackenzie Martin

Mackenzie Martin
Partner, Intellectual Property & Technology
1900 N. Pearl Street, Suite 1500
Dallas, TX 75238
Tel: +1 214 978 3048
Cell: +1 214 534 0345
Mackenzie.Martin@bakermckenzie.com

**Baker
McKenzie.**

This message may contain confidential and privileged information. If it has been sent to you in error, please reply to advise the sender of the error and then immediately delete this message. Please visit www.bakermckenzie.com/disclaimers for other important information concerning this message.

The information contained in this e-mail, including any attachments, is confidential, intended only for the named

recipient(s), and may be legally privileged. If you are not the intended recipient, please delete the e-mail and any attachments, destroy any printouts that you may have made and notify us immediately by return e-mail. Neither this transmission nor any attachment shall be deemed for any purpose to be a "signature" or "signed" under any electronic transmission acts, unless otherwise specifically stated herein. Thank you.