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Subject: RE: IPR2024-00101 (Luminex v. Signify, "336 Patent) - Request for Authorization
Date: Wednesday, June 25, 2025 3:02:57 PM

Counsel,

In response to the June 24, 2025, email from Patent Owner's counsel concerning IPR2024-00101, the Board authorizes (1) Patent Owner to file within three business days of this email a supplemental brief no longer than two pages that addresses the continuity of disclosure in the ancestor applications for the '336 patent and (2) Petitioner to file within six business days of this email a supplemental response brief no longer than two pages that responds to the supplemental brief.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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From: Dorsky, Jason M. <JMDorsky@Venable.com>
Sent: Tuesday, June 24, 2025 4:55 PM
To: Trials <Trials@USPTO.GOV>
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IPR No. IPR2024-00101

To the Board,

Patent Owner requests leave to submit a 2-page paper to address Petitioner's argument—raised for the first time during the hearing—regarding the continuity of disclosure for priority. *See* Paper 40 at 4 (a party may not present at oral argument any new argument); *G&H Diversified Manuf., LP v.*

DynaEnergetics Europe GmbH, No. PGR2021-00078, Paper 44 at 11-12 (PTAB Oct. 28, 2022). The paper would address (i) Petitioner’s prior statements acknowledging that continuity exists for embodiments disclosed in the earliest provisional through the latest filed application, but not vice versa (Petition, 18-23), (ii) Petitioner’s contrary statement during the hearing that it had not taken a position on continuity, and (iii) Federal Circuit case law establishing that, in any event, incorporation by reference of prior applications can serve to demonstrate continuity of disclosure, as in the intervening applications here (*see, e.g.*, Exs. 1007, 1021, and 1022).

Patent Owner does not oppose a responsive paper by Petitioner of equal length. Patent Owner conferred with Petitioner concerning this request, and Petitioner stated the following:

“Petitioner opposes additional briefing on the issue. Petitioner identified that the ’141 and ’062 applications both failed to provide written description support for the claims of the ’336 patent in the Petition (at 18-23), and such arguments were not newly raised at the Hearing. There is no dispute that it is Patent Owner’s burden to establish written description support in ‘each application in the chain leading back to the [’424 provisional].’ *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). Despite having every opportunity to do so, the Patent Owner Response did not address the ’141 and ’062 applications (POR at 10-31), thus waiving any argument regarding alleged continuity of disclosure for priority. Paper 15 (Scheduling Order) at 10. Patent Owner’s Sur-Reply likewise did not address the ’141 and ’062 applications. Paper 41 (PO Sur-Reply). Any additional briefing would be an improper attempt to do what Patent Owner failed to do previously – i.e., to provide arguments and evidence supporting its new continuity-of-disclosure position.”

The parties will provide availability for a conference call on this request, should the Board deem the same necessary.

Respectfully,

Jason M. Dorsky
Counsel for Patent Owner Signify Holdings B.V.

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