From: Trials <Trials@USPTO.GOV>
Sent: Thursday, March 14, 2024 12:07 PM
To: Zucker, David (DC); Trials
Cc: LLawson@burr.com; rcorbett@burr.com; aspence@burr.com; misha.hill@witricity.com; Strang, Jonathan (DC); #C-M INDUCTEV IPRS - LW TEAM
Subject: RE: IPR2024-00105, IPR2024-00140 – Unopposed Request for Reply

Counsel,

From the Board –

Petitioner is authorized to file, within 10 business days, a 5-page Preliminary Reply to Patent Owner's Preliminary Response in each of IPR2024-00105 and IPR2024-00140, limited to the issues raised in Petitioner's email (Ex. 3001). Each Preliminary Reply should reference this authorizing email. Patent Owner is also authorized to file a 5-page Preliminary Sur-reply in each case within 10 business days of the corresponding Preliminary Reply, limited to issues raised in the Preliminary Reply.

Regards,

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

From: David.Zucker@lw.com <David.Zucker@lw.com>
Sent: Tuesday, March 12, 2024 5:05 PM
To: Trials <Trials@USPTO.GOV>
Cc: LLawson@burr.com; rcorbett@burr.com; aspence@burr.com; misha.hill@witricity.com; Jonathan.Strang@lw.com; inductevprs.lwteam@lw.com
Subject: IPR2024-00105, IPR2024-00140 – Unopposed Request for Reply

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Dear Board,

Petitioner InductEV, Inc. respectfully seeks leave to file a 5-page reply to Patent Owner WiTricity's Preliminary Response in each of IPR2024-00105 and IPR2024-00140. In the interest of fairness and ensuring that the Board is fully briefed, Petitioner will not oppose a sur-reply by Patent Owner in each proceeding, also limited to 5 pages and limited to the issues raised in each reply.

Patent Owner does not oppose this request.

InductEV states that good cause for the replies exists as follows:

With respect to the -00105 IPR:

> Good cause exists because Petitioner could not have reasonably addressed, predicted, or rebutted Patent Owner's argument that § 325(d) discretionary denial is appropriate here, given i) the absence of any evidence

InductEV, Inc.
Exhibit 1034
InductEV v. WiTricity
IPR2024-00105
Ex. 1034-001

that the Examiner considered or discussed Fells or Cook, let alone their teachings in combination with Ono and Wang, which were undisputedly not before the Office; and ii) the Examiner's material error in overlooking those references and issuing the '184 patent, as demonstrated by the Petition.

With respect to the -00140 IPR:

Good cause exists for two reasons.

First, for Ground 1 based on Odachi, Petitioner could not have reasonable addressed, predicted, or rebutted Patent Owner's argument that an "antenna" must be expressly and narrowly construed as a "coil that produces a near-field component of flux into free space that is intercepted by a secondary coil to effect resonant inductive coupling," given that this definition does not appear anywhere in the '654 patent or its prosecution history. Petitioner could not have previously explained, for example, that Patent Owner's emphasis on antennas emitting flux "into free space" is contrary to the '654 patent's statement that the invention uses near-field coupling "rather than propagating the energy from the transmitting antenna into free space." (Ex. 1001 3:19-23). Nor could Petitioner have previously pointed out that Patent Owner's own submitted dictionaries offer different, broader, definitions of "antenna" that do not support its proposed construction. (Ex. 2003, Ex. 2004).

Second, for Ground 2 based on Ross, Petitioner also could not have addressed, predicted, or rebutted Patent Owner's mischaracterizations of Ross, including (i) Patent Owner's argument that the Petition "combine[s] embodiments of Ross" (POPR 20), which Petitioner can show is facially inaccurate given that the two quoted passages of Ross, just lines apart, are part of the continued description of the same embodiment (Ex. 1007 12:33-62; 13:5-32); and ii) Patent Owner's argument that Ross uses "vehicle sensors 60, and not a signal based on any detected degree of coupling" (POPR 20), when in fact Ross states that "instead of using the sensors 60, or in combination with using the sensors 60 … the approximate lateral position may be determined by monitoring the change in amplitude of the inductively received power signal." (Ex. 1007 13:5-32).

Respectfully,
David Zucker
Counsel for Petitioner

David Zucker*

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