

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, May 1, 2024 12:57 PM
To: Ian Soule; Trials
Cc: Schroeder, John R.; Foley, Amanda N.; James, Kurt F.; Levitt, Steven; Pollmann, Jonathan; Kim, David S.; Jason Eisenberg; Yangbeini Wang; PTAB Account; PTAB Account; PTAB Account
Subject: RE: Petitioner Request for Leave to file a Reply to Patent Owner's Preliminary Response - US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119 ('760 patent)

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Counsel,

The panel has determined that briefing would help the panel understand the issue regarding whether Wong qualifies as prior art. Petitioner may file a preliminary reply of seven pages or less by no later than May 10, 2024. Patent Owner may file a preliminary sur-reply of seven pages or less by no later than May 17, 2024. The preliminary reply and preliminary sur-reply shall only address issues related to whether or not Wong qualifies as prior art.

Petitioner should include this authorization e-mail as an exhibit to the preliminary reply for the record.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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From: Ian Soule <ISOULE@sternekessler.com>
Sent: Tuesday, April 30, 2024 10:45 PM
To: Trials <Trials@USPTO.GOV>
Cc: Schroeder, John R. <john.schroeder@stinson.com>; Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>; Jason Eisenberg <jasone@sternekessler.com>; Yangbeini Wang <BWANG@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: Petitioner Request for Leave to file a Reply to Patent Owner's Preliminary Response - US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119 ('760 patent)

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IPR2024-00119 - US Conec Ltd. v. Senko Advanced Components Inc. – Petitioner Request for Leave to file a Reply to Patent Owner's Preliminary Response ('760 patent)

Dear Honorable Board,

Petitioner requests leave to file a reply to Patent Owner's Preliminary Response (POPR) in accordance with 37 C.F.R. §§ 42.23, 42.24(c), in order to address the POPR's unforeseeable rebuttal arguments and evidence alleging Wong does not qualify as prior art. CTPG, 51-52, citing 37 C.F.R. §§ 42.108(c).

Patent Owner's Position

The Patent Owner opposes this request for the reasons in the attached email chain.

In addition to the emails, the parties have met and conferred via phone.

Petitioner's Position

Good cause exists at least because the POPR relies on incomplete assignment records that fail to include several irregularities with the recorded assignments for the '760 patent, as well as Wong. The POPR's rebuttal arguments to the Petition's use of Wong as prior art does not meet PO's burden of showing Wong is excepted under 35 U.S.C. § 102(b)(2)(C) because:

- The only assignment recorded against the '760 patent appears to be the initial assignment of a great-grandparent. But this ignores an intervening CIP in the chain leading to the '760 patent that would require a new assignment. EX2007.
 - Patent Owner's substantive arguments related to the claim phrase "slidably received" are not supported by the great-grandparent, to which EX2007 purportedly relates. *See* POPR, pp., 5-6, 8, 10, 16, citing the claims of the '760 patent for the claim construction argument. *See also id.*, p. 9, acknowledging that "'slidably' is not used within [the '760 patent's] specification," and instead citing unrelated portions.
 - Assignments recorded against the original application only gives the assignee rights to only the subject matter common to both applications.
- The initial assignment of the great-grandparent does not include the application number of the great-grandparent. EX2007.
- The initial assignment of the great-grandparent does not have the same title as the '760 patent. EX2007.
- The POPR omits a second assignment styled as a "New Assignment" recorded against two of the parent cases of the '760 patent (but *not* against the '760 patent itself). This assignment:
 - is signed by *only one* of the inventors;
 - is executed *after* the filing date of the '760 patent, and includes an appendix that lists the application number for the '760 patent;
 - does not on its face purport to be confirmatory, but rather shows as a "New Assignment"; and
 - is the *only* recorded document that lists the *actual* application number for the '760 patent.
- The POPR assignment documents related to Wong (EX2006) also contain irregularities not addressed by the POPR.

During the meet and confer and email exchanges, Patent Owner tries to excuse these omissions in its POPR while acknowledging that it "do[es] not have a full explanation" for this omission in its POPR and the USPTO records.

Petitioner does not believe a call to be necessary. The parties can provide times available for a call if the panel would find one helpful.

Respectfully submitted,

Ian Soule
Counsel for Petitioner US Conec Ltd.



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