

Exhibit 1011

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, March 6, 2024 2:10 PM
To: shenwang@archlakelaw.com; Trials
Cc: 'Kaiser, Jessica (Perkins Coie)'; 'Rose, Kate (Perkins Coie)'; SES-imagotag-IPRs@perkinscoie.com; pete_curtin@archlakelaw.com; haotan@archlakelaw.com; marioavaldi@archlakelaw.com
Subject: RE: Hanshow v. SES-Imagotag // IPR2024-00208

Counsel:

Petitioners' request for authorization to file a preliminary reply is granted. Within 10 days, Petitioners may file a preliminary reply limited to 10 pages and the subject matter discussed in the email. Within 10 days of the preliminary reply being filed, Patent Owner may file a preliminary sur-reply limited to 10 pages and the subject matter of the reply.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: shenwang@archlakelaw.com <shenwang@archlakelaw.com>
Sent: Wednesday, March 6, 2024 1:54 PM
To: Trials <Trials@USPTO.GOV>
Cc: 'Kaiser, Jessica (Perkins Coie)' <JKaiser@perkinscoie.com>; 'Rose, Kate (Perkins Coie)' <KateRose@perkinscoie.com>; SES-imagotag-IPRs@perkinscoie.com; pete_curtin@archlakelaw.com; haotan@archlakelaw.com; marioavaldi@archlakelaw.com
Subject: Hanshow v. SES-Imagotag // IPR2024-00208

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Dear Board:

Petitioners, Hanshow America Inc. and Hanshow Technology Co., Ltd. write requesting leave under 37 C.F.R. §42.108(c) to file a preliminary reply to Patent Owner's Preliminary Response (Paper 11) in IPR2024-00208. Petitioner specifically seeks leave to reply to:

1. Patent Owner's arguments under §325(d) that include new argument not in the record at the time of filing the Petition;
2. Patent Owner's argument that the same §325(d) analysis applies to grounds 1 and grounds 2-4 of the Petition;
3. Patent Owner's arguments under §314(a) that include new argument not in the record at the time of filing the Petition; and
4. Patent Owner's reliance on foreign-language documents that do not comply with 37 CFR 42.63.

Good cause exists. Specifically, in its 325(d) analysis, Patent Owner contends that arguments made in a written opinion of the International Searching Authority (ISA) and an office action by the Institut National De La Propriété Industrielle

(INPI) can be considered arguments made during examination of U.S. Patent No. 11,010,709 ('709 Patent). [See, e.g., Preliminary Response at 25-28.] Petitioner requests the opportunity to explain that, to the extent the Board may deem this relevant, its arguments for invalidity differ from those considered in the written opinion of the ISA or INPI office action. Petitioner would also like the opportunity to respond to the analysis of the *Advanced Bionics* factors in Patent Owner's 325(d) analysis, which Petitioner contends was not foreseeable at the time of filing of the Petition. Petitioner further contends that Patent Owner's 314(a) arguments construe "planogram" in a manner that differs from the plain and ordinary meaning in the '709 Patent. Petitioner further contends that Patent Owner's arguments and reliance on evidence not in the record at the time of filing the Petition were not foreseeable.

Petitioners conferred with Patent Owner on the above request and Patent Owner indicates it opposes. As to issues 1 and 2, Petitioners do not have good cause for a reply as to Section 325(d). This issue was clearly foreseeable because Petitioner in fact addressed it in the Petition (Paper 2, 91), as Patent Owner explained in its Preliminary Response (Paper 11, 44). Additional briefing would excuse Petitioner's intentional choice to give Section 325(d) short shrift when that issue was clearly implicated both on the face of the patent and by the prosecution history (see Paper 11, 17-33). The Wu Pub—which Petitioner mistakenly refers to as the Wu Patent—is cited on the face of the patent, as is the International Search Report for the PCT counterpart patent, and the French Preliminary Search Report for the French counterpart. Both the International Search Report and the French Preliminary Search Report show the prior consideration of the Wu Pub., and had Petitioner considered this material *before* filing its petition, Petitioner would have seen the obvious and significant section 325(d) concerns and attempted to address them. But Petitioner either ignored these materials and now asks the Board to forgive that oversight, or intentionally did not raise these issues in hopes that Patent Owner would not. The Board deny Petitioner's request as to issues 1 and 2.

As to issue 3, Patent Owner did not raise an issue of claim construction, but rather argued that Petitioner failed to explain why a label content table in Wu teaches the recited "planogram." That Petitioner failed to include such explanation in the Petition does not justify a preliminary reply; otherwise, the Board would have to authorize a preliminary reply in every case.

As to issue 4, Patent Owner's exhibits were filed to show materials the Examiner considered during prosecution (and should have been provided by Petitioner in the first instance). Nevertheless, if the Board determines a certified translation of any of Patent Owner's exhibits is necessary to comply with 37 C.F.R. 42.63, Patent Owner requests authorization to file such translations as additional exhibits.

To the extent that the Board allows Petitioner a preliminary reply (which it should not), Patent Owner requests a preliminary sur-reply of equal length.

If needed, counsel for both parties can meet and confer and provide times of mutual availability for a conference call.

Best regards,
Shen

Arch & Lake LLP

Shen Wang / Partner
shenwang@archlakelaw.com

Arch & Lake LLP
203 N LaSalle Street, Suite 2100
Chicago, IL 60601
Phone: 636-236-5390

Fax: 312-614-1873

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