From:	Trials
To:	Best, Timothy P.; Trials
Cc:	Brian Eutermoser; Mikaela Stone; Russell Blythe
Subject:	RE: IPR Nos. IPR2023-00731, -00732
Date:	Monday, October 16, 2023 12:13:38 PM

Counsel,

From the Board –

Petitioner's request to file Replies to the Preliminary Responses, as an alternative relief to its motions to dismiss, does not show good cause and is denied. *See* 37 C.F.R. § 42.108(c).

With the institution deadline being a little more than three weeks away, permitting additional briefing would place an undue burden on Patent Owner and on the Board. This burden would be particularly acute because Petitioner proposes filing three new witness declarations. In particular, Petitioner's proposal of providing Patent Owner five pages and seven business days to respond to three new declarations is highly prejudicial to Patent Owner. Had Petitioner submitted these declarations with its Petition, Patent Owner would have had three months to respond and far more than five pages. Not only that, but under Petitioner's proposed schedule, the Board would have less than two weeks to review the parties' arguments about this new evidence.

Petitioner's proposed new declarations also plainly exceed the proper scope of a reply. Any argument in the Replies pertaining to the new declarations would likely be improper new argument, not a response to Patent Owner's arguments against Petitioner's existing public accessibility declaration. *See* 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments raised in the . . . preliminary response[.]"). "The reason for limiting the scope of a [reply] is simple—to promote procedural fairness and prevent sandbagging." *See Trane U.S., Inc. v. SEMCO, LLC*, IPR2018-00514, Paper 36 at 7 (PTAB Apr. 17, 2019).

Petitioner's assertion that it did not seek permission to file Replies until it had gathered all available evidence does not excuse its delay. IPR proceedings have a compressed schedule, which incentivizes petitioners to put forth their best evidence in their petitions. Permitting Petitioner to file Replies with extensive new evidence at this late stage would not "secure the just, speedy, and inexpensive resolution of [these] proceeding[s]." 37 C.F.R. § 42.1(b).

The Board's decisions on Petitioner's motions to dismiss will follow in due course.

Regards,

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

From: Best, Timothy P. <TBest@gibsondunn.com>

Sent: Friday, October 13, 2023 6:48 PM
To: Trials <Trials@USPTO.GOV>
Cc: Brian Eutermoser <BEutermoser@KSLAW.com>; Mikaela Stone <Mikaela.Stone@KSLAW.com>; Russell Blythe <RBlythe@KSLAW.com>
Subject: IPR Nos. IPR2023-00731, -00732

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To the Honorable Board:

Pursuant to 37 C.F.R. §§ 42.23 and 42.108(c), Petitioners Sophos Inc. and Sophos Ltd. request permission to file Replies to Patent Owner's Preliminary Responses in IPR Nos. IPR2023-00731 and -00732 as alternative relief to the motions to dismiss the foregoing petitions filed on October 10th, should such motions be denied. The purpose of each Reply is to address Patent Owner's arguments concerning the availability of Li (EX-1005) as a prior art reference, and to supplement the record with additional evidence establishing Li as prior art to the challenged patents.

Specifically, Petitioners intend to supplement the record with the following additional evidence:

- The declaration of librarian expert Dr. Mary K. Bolin establishing the date of public availability of Li;
- The declaration of Cristina Abad, a co-author of Li, testifying as to her knowledge of the publication and public availability of Li, and addressing additional evidence establishing Li as a prior art reference; and
- The declaration of Dr. Morley Mao, a co-author of a publication that cites to Li prior to the critical date, testifying as to her knowledge of the public availability of Li, and testifying that Li was locatable before the critical date.

Pursuant to 37 C.F.R. § 42.108(c), Petitioners have good cause for requesting these Replies. Specifically, Petitioners did not earlier request permission to file Replies because Petitioners have been working diligently to gather additional evidence establishing Li as prior art to submit to the Board. This work has entailed locating and reaching out to the co-authors of Li and other references citing Li, drafting declarations from librarian experts and co-authors, and working with librarian research experts and various libraries (both nationally and internationally) to obtain additional evidence of public availability. This evidence gathering has taken time, and Petitioners did not seek to request permission from the Board to file Replies until Petitioners had substantively gathered all evidence available to present to the Board.

Assuming the Board authorizes the foregoing request, Petitioners propose five pages for a Reply and the same for any Sur-Reply from Patent Owner. Petitioners further propose a Reply deadline within three business days of the Board's authorization and any Sur-Reply be due seven business days thereafter.

Petitioners have met and conferred with Patent Owner, and Patent Owner opposes Petitioners

instant request as well as the proposed deadlines.

The parties are available at the following times should the Board request a conference to discuss Petitioners' request:

- 10/18 at 12:30-2 and 4-5 ET
- 10/19 at 12-1 ET

Regards,

Timothy P. Best
Partner

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