

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEURENT MEDICAL INC. & NEURENT MEDICAL LTD.

Petitioners,

v.

THE FOUNDRY, LLC,
Patent Owner.

Case No. IPR2024-00281

U.S. Patent No. 11,679,077

**PETITIONERS' REPLY IN SUPPORT OF ITS
OPPOSED MOTION TO WITHDRAW PETITION
THROUGH DISMISSAL WITHOUT PREJUDICE**

Petitioners respectfully submit this Reply in support of their motion to withdraw this IPR without prejudice, as authorized by the Board's February 23, 2024 email.

Petitioners' Motion proposes a straightforward solution to avoid an unnecessary dispute. The present IPR petition was filed within nine months of issuance of the challenged '077 patent and presents grounds based on both pre-AIA and post-AIA priority. Patent Owner ("PO") refuses to confirm it will not raise an issue of first impression regarding the proper timing of such a petition under 35 U.S.C. §311(c), so Petitioners move to withdraw this IPR and refile it after nine months. Despite filing an "opposition," PO does not actually oppose Petitioners' withdrawal request, or offer authority why such request should not be granted. Instead, PO seeks to use this motion to delay separate proceedings. That request is meritless. PO would not have been entitled to such delay had this Petition been filed after March 20, 2024, and this Motion does not justify such prejudice to Petitioners. Petitioners' motion should be granted, and PO's extension request should be denied.

I. Petitioners Have Established That Withdrawal Is Warranted

As Petitioners' Motion explains, withdrawal of the petition without prejudice is appropriate to avoid any dispute regarding eligibility of the challenged claims of the '077 patent for IPR. Mot., 2-4.

PO's opposition identifies no reason why Petitioners' request for withdrawal without prejudice should be denied. *See* Opp., 4-6. It is undisputed that the Board has not previously addressed whether a Petition that presents grounds based on pre-AIA and post-AIA priority may be filed within nine months of patent issuance or that granting the motion will avoid an unnecessary dispute. Indeed, PO does not take a position on this timing issue, or argue that the '077 patent is entitled to a pre-AIA filing date in an attempt to moot it. Because withdrawal would avoid a dispute regarding the formalities of the timing of filing, the withdrawal and refiling Petitioners propose is appropriate and will be more efficient for the parties and the Board.

In purported "opposition," PO notes that a refiled Petition will proceed on a different schedule than separate IPR proceedings involving related patents (IPR2024-00279 and IPR2024-00280). Opp., 5. This is not a basis to deny the motion to withdraw. PO identifies no case in which a motion to withdraw was denied based on the timing of separate IPR proceedings. To the contrary, PO's cited cases support that dismissal without prejudice is appropriate here because doing so would promote efficiency and unnecessary costs by avoiding a dispute about formalities. *See, e.g., General Elec. Co. v. Siemens Gamesa Renewable Energy A/S*, IPR2021-00722, Paper 11, 2-3 (P.T.A.B. Oct. 7, 2021) ("terminat[ing] the

proceedings to promote efficiency and minimize unnecessary costs.”). This is exactly what the Board did in *SharkNinja, Inc. v. Dyson Technology Ltd.*, IPR2023-01323, Paper 7, 2-3 (P.T.A.B. Nov. 28, 2023), where it terminated an IPR filed within nine months of patent issuance without prejudice to refiling after that period.¹

II. Patent Owner's Request For An Extension In Separate Proceedings Should Be Denied

PO's request that the Board modify schedules in *separate inter partes* review proceedings as a condition of granting Petitioners' motion in this proceeding, Opp., 6-8, should be denied.

Contrary to PO's argument, Opp. 7, delaying separate IPR proceedings by two months would prejudice Petitioners, not PO. After PO sued Petitioners, Petitioners expeditiously filed IPRs challenging each asserted patent within approximately six months. As contemplated by the AIA, PO did so to streamline and avoid unnecessary district court proceedings. PO should not be permitted to delay those proceedings, and Petitioners' ability to avoid additional months of litigation on invalid patents, simply because PO's strategy of improperly claiming a pre-AIA

¹ PO cannot meaningfully distinguish *SharkNinja* on the basis that the motion there was unopposed. *See* Opp., 5. The mere fact of PO's "opposition" does not require a different result because PO offers no legitimate *basis* for its opposition.

priority date raised an issue of first impression regarding the timing of a separate IPR. IPRs 2024-00279 and -00280 were appropriately filed and should not be delayed.

Also contrary to PO's argument, Opp. 7, PO will not be prejudiced by maintaining the current schedules in the -279 and -280 IPRs. Because Petitioners could have filed the three IPRs at issue at *any time* within a year of the complaint in litigation, including separated by even more than two months, there is no unfairness in this IPR proceeding two months after the other two. Indeed, it is utterly typical for petitions challenging patents in the same family to proceed on different timelines. For example, the law firm representing PO filed IPRs on behalf of the same petitioner *four* months apart challenging two separate patents in the same family, using declarations from the same expert, and relying on the same prior art references. *See Truist Bank v. United Services Automobile Association*, IPR2023-00829, Paper 1, 2-3 (Apr. 13, 2023) (grounds relying on Garcia, King, and Watanabe and supported by the declaration of Dr. David Doermann); *Truist Bank v. United Services Automobile Association*, IPR2023-01326, Paper 1, 2 (Aug. 16, 2023) (grounds relying on Garcia, King, and Watanabe and supported by the declaration of Dr. David Doermann). The Board routinely addresses such challenges on different timelines, including with different POPR deadlines for different IPRs. *See*

also IPR2021-00193 and IPR2020-01737 (IPRs for patents in the same family with different schedules dispute having overlapping prior art and experts).

If anything, PO benefits from the fact that Petitioners have already filed the present IPR and would refile it two months later, with identical grounds and arguments. The resulting change would give PO up to *five months* between first receiving the Petition and the expected deadline for its POPR instead of the standard three months. And to the extent PO believes it would be prejudiced by such difference in timeline, for example because its expert may be subject to multiple depositions, PO can mitigate any such issue by simply by filing its POPR in the refiled proceeding on the same day as the separate proceedings. PO is certainly not required to engage in such self-help, but when that reasonable option is available to it, it should not be heard to demand that Petitioners suffer the prejudice of delay.

III. Conclusion

Petitioners respectfully request termination of the Petition through dismissal of the Petition without prejudice to refile the petition after the nine month period from issuance has passed and denial of Patent Owner's request for an extension of time in IPRs 2024-00279 and 2024-00280.

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Petitioners' Reply Supporting its Motion to Withdraw
Case No. IPR2024-00281

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, on March 15, 2024, I caused a true and correct copy of the following materials:

- Petitioners' Reply In Support Of Its Motion To Withdraw Petition Through Dismissal Without Prejudice

to be served on Patent Owner via electronic mail to:

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