

From: [Trials](#)
To: [Cavanaugh, David](#); [Trials](#)
Cc: [Lantier, Gregory](#); [Stern, Joshua](#); [Cohen, Alexis](#); [Smolenski, Gilbert T.](#); [Nemtzow, Alex](#); [Sahlsten, Sonja](#); [mike.jakes@finnegan.com](#); [Daley, Kathleen](#); [WH Neurent IPR Service](#)
Subject: RE: IPR2024-00281 - Request to Withdraw Petition and Refile after Nine Months from Patent Issue Date
Date: Friday, February 23, 2024 9:46:51 AM

Counsel,

From the Board –

Petitioner is authorized to file a motion to withdraw the petition without prejudice. The motion should reflect the intent of the Petitioner as set forth in the e-mail below as well as any agreements with Patent Owner concerning the timing of the preliminary responses in related proceedings. Also, Petitioner should expressly indicate whether the motion is unopposed by Patent Owner.

Regards,

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

From: Cavanaugh, David <David.Cavanaugh@wilmerhale.com>
Sent: Tuesday, February 13, 2024 6:06 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2024-00281 - Request to Withdraw Petition and Refile after Nine Months from Patent Issue Date

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Case IPR2024-00281
U.S. Patent No. 11,679,077

Dear Honorable Board:

Neurent Medical Inc. and Neurent Medical Ltd. (collectively “Neurent”) filed a Petition for Inter Partes Review for U.S. Patent No. 11,679,077 (the “’077 patent”) on January 18, 2024. The ’077 patent issued June 20, 2023. Neurent’s Petition asserts multiple grounds of unpatentability, some

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Ex. 3001

using the claimed priority date which is pre-AIA and others asserting a post-AIA priority date.

The filing date of the IPR is within nine months from the issue date of the '077 patent. This circumstance (multiple grounds, some based on earliest claimed priority pre-AIA and some based on a post-AIA date) has not to Petitioners' knowledge occurred previously, and Petitioners do not yet know whether Patent Owner will argue the claims of the '077 patent should get the benefit of the claimed priority date or argue that the '077 patent is not yet eligible for Inter Partes Review under 35 U.S.C. § 311(c). Any potential dispute about the timing of the filing date can be removed by terminating IPR2024-00281 and allowing Petitioner to refile after the nine month period expires, March 21, 2024.

Petitioners respectfully request the Board's authorization to file a motion to withdraw the petition in IPR2024-00281 through dismissal without prejudice with the express intent to refile the IPR after the nine months from the issue date concludes. The PTAB has granted such requests in similar circumstances in, for example, IPR2023-01323.

To minimize any prejudice to Patent Owner, Petitioner will refile the same grounds and arguments. Petitioner submits Patent Owner does not have cause to alter the schedules of separate IPR proceedings based on Petitioner's request, but in response to Patent Owner's position notes that Petitioner intends to refile the grounds and arguments which are already known to Patent Owner and the petition will be refiled over a month before the April 24, 2024 deadline for Patent Owner's preliminary response in co-pending proceedings IPR2024-00279 and IPR2024-00280.

Petitioner has conferred with Patent Owner, whose counsel is copied on this correspondence. Patent Owner's position on Petitioners' request is the following (in italics): *Patent Owner does not oppose Petitioners' motion to withdraw the petition in IPR2024-00281 without prejudice and with leave to refile the same grounds after the nine-month period concludes so long as Petitioners obtain extensions to the deadlines for Patent Owner's preliminary responses in IPR2024-00279 and IPR2024-00280 so that they are due on the same date as Patent Owner's preliminary response in the refiled IPR2024-00281. Patent Owner believes that the three IPRs on the related patents of The Foundry (IPR2024-00279, IPR2024-00280, IPR2024-00281) should proceed on the same schedule for efficiency for the parties and the Board, and to ensure fairness to Patent Owner.*

If the Board requires any additional information or would like to discuss with the parties on a conference call, the parties are currently available on Wednesday, February 14 between 3:30-5:00pm ET and Thursday, February 15 after 12:00pm ET. The parties can provide additional availability if/as needed.

Respectfully submitted,

David Cavanaugh
Counsel for Petitioner

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