

McGee, Sheldon

Subject: IPR2024-00380 - Req. for Auth. for Prelim. Reply

From: Ariel Reinitz <ariel@bochner.law>

Sent: Tuesday, April 30, 2024 5:00 PM

To: Trials <Trials@USPTO.GOV>; McKeever, Patrick J. (Perkins Coie) <PMcKeever@perkinscoie.com>

Cc: mckeever-ptab@perkinscoie.com; chen-ptab@perkinscoie.com; dufresne-ptab@perkinscoie.com; Glasunow-ptab@perkinscoie.com; Andrew Bochner <andrew@bochner.law>

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Dear Honorable Board:

Patent Owner objects to Petitioner's request to file a preliminary reply because Petitioner fails to demonstrate "good cause" for such a submission as required under 37 C.F.R. § 42.108.

Petitioner claims (below) that "it would not have been practical for Petitioner to anticipate and pre-but Patent Owner's 13 pages of argument regarding Section 325(d)[.]" But Petitioner did *exactly* that, by anticipating (and addressing) Section 325(d) in its Petition. *See* Paper 1 (Petition) at 60-62 ("Statement regarding § 325(d)"). Because Petitioner could have – and did – foresee Patent Owner's Section 325(d) argument, good cause does exist for a reply.

In comparable circumstances the Board has found no good cause and denied petitioner's request for a reply. *See Vizio, Inc. v. Polaris Powered Techs., LLC*, IPR2020-00043, Paper 12, 4 (P.T.A.B. Feb. 24, 2020) ("We are not persuaded there is good cause for Petitioner to file a reply addressing Patent Owner's arguments... that the Board should deny institution under 35 U.S.C. § 325(d)... [W]e agree with Patent Owner that Petitioner already addressed arguments under § 325(d) in the Petition.... Furthermore, Petitioner does not present any persuasive arguments that the Preliminary Response raises any new arguments that Petitioner could not reasonably foresee and address in the Petition itself. As such, we are not persuaded that there is good cause for authorizing a reply to this issue raised by Patent Owner in the Preliminary Response.").

Because Petitioner has not shown that good cause exists to file a reply, the Board should deny the request. In the alternative, Patent Owner requests a call with the Board to discuss this issue.

Respectfully,
Ariel Reinitz
Reg. No. 65,220
Attorney for Patent Owner

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From: Trials <Trials@USPTO.GOV>

Sent: Monday, April 29, 2024 2:10 PM

To: McKeever, Patrick J. (Perkins Coie) <PMcKeever@perkinscoie.com>; Trials <Trials@USPTO.GOV>
Cc: mckeever-ptab@perkinscoie.com; chen-ptab@perkinscoie.com; dufresne-ptab@perkinscoie.com; Glasunow-ptab@perkinscoie.com; Andrew Bochner <andrew@bochner.law>; Ariel Reinitz <ariel@bochner.law>
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Good afternoon, counsel –

The Board requests, by 5pm ET on April 30, 2024, input regarding whether Patent Owner objects to Petitioner's request for authorization to file a preliminary reply to Patent Owner's Preliminary Response. Thank you.

Regards,

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

From: McKeever, Patrick J. (Perkins Coie) <PMcKeever@perkinscoie.com>
Sent: Wednesday, April 24, 2024 7:20 PM
To: Trials <Trials@USPTO.GOV>
Cc: mckeever-ptab@perkinscoie.com; chen-ptab@perkinscoie.com; dufresne-ptab@perkinscoie.com; Glasunow-ptab@perkinscoie.com; andrew@bochner.law; Ariel Reinitz <ariel@bochner.law>
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Dear Honorable Board,

Petitioner requests authorization to file a preliminary reply in the above-referenced case, limited to the *Advanced Bionics* issues raised in the preliminary response (Paper 5) filed April 22, 2024. Good cause exists for a preliminary reply at least (a) because it would not have been practical for Petitioner to anticipate and pre-but Patent Owner's 13 pages of argument regarding Section 325(d) / *Advanced Bionics* and (b) to allow Petitioner to address Patent Owner's characterizations of the prosecution history in connection with these issues. Petitioner seeks 5 pages for its preliminary reply and to file it within 10 days of receiving authorization. Petitioner does not oppose Patent Owner being authorized to file a preliminary sur-reply of equal length to be filed within 10 days of the preliminary reply being filed and limited to the issues raised in the preliminary reply.

Petitioner reached out to Patent Owner seeking its position regarding this request and waited more than 24 hours before contacting the Board, but Patent Owner has yet to respond. Counsel for Patent Owner is copied on this email.

If the Board wishes to have a conference call, the parties can confer and propose times of mutual availability.

Best regards,

Patrick J. McKeever
Reg. No. 66,019
Attorney for Petitioner

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