

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JIANGSU FAVORED NANOTECHNOLOGY CO., LTD.,
Petitioner,

v.

P2I LTD.,
Patent Owner.

IPR2024-00380
Patent 11,041,087 B2

Before GRACE KARAFFA OBERMANN and SHELDON M. McGEE,
Administrative Patent Judges.

McGEE, *Administrative Patent Judge.*

ORDER

Granting Petitioner's Request for Authorization to File Reply to
Patent Owner's Preliminary Response

37 C.F.R. § 42.5

Jiangsu Favored Nanotechnology Co., Ltd. (“Petitioner”) filed a petition on January 3, 2024 (Paper 1, “Petition”) challenging claims 1–5, 7, and 9–14 of US Patent 11,041,087 B2. In response to the Petition, P2I Ltd., (“Patent Owner”) filed its Patent Owner Preliminary Response on April 22, 2024 (Paper 5, “POPR”).

On April 24, 2024, Petitioner emailed the Board requesting authorization to file a preliminary reply to address Patent Owner’s arguments pertaining to 35 U.S.C. § 325(d) set forth in the Patent Owner Preliminary Response. Ex. 3001. After the Board requested input from Patent Owner regarding Petitioner’s request, Patent Owner objected. *Id.*

After considering Petitioner’s request and Patent Owner’s objection, the panel has determined that additional—and limited—briefing from both parties may be helpful to the Board in reaching an equitable decision regarding whether to discretionarily deny institution under 35 U.S.C. § 325(d). We are mindful, however, that Petitioner has already availed itself of its first opportunity to address discretionary denial under § 325(d). Pet. 60–62. Thus, in the interest of fairness to both parties, we emphasize that Petitioner may only make statements in its reply that are directly responsive to statements presented in the Patent Owner Preliminary Response. Petitioner may not introduce any new arguments pertaining to § 325(d) that it could have made in its Petition. Similarly, Patent Owner, in its sur-reply, may only respond to statements made by Petitioner in its reply. Any new argument by either party will not be considered. No new evidence may be filed in support of either brief authorized by this Order.

Accordingly, it is:

ORDERED that Petitioner is authorized to file a reply to Patent Owner's Preliminary Response consistent with this Order no later than May 9, 2024 and not exceeding five pages; and

ORDERED that Patent Owner is authorized to file a sur-reply consistent with this Order within five business days of Petitioner's reply and not exceeding five pages.

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PETITIONER:

Patrick McKeever
Han-Wei Chen
Andrew Dufresne
Allison Glasunow
PERKINS COIE LLP
mckeever-ptab@perkinscoie.com
chen-ptab@perkinscoie.com
dufresne-ptab@perkinscoie.com
glasunow-ptab@perkinscoie.com

PATENT OWNER:

Andrew D. Bochner
Ariel Reinitz
BOCHNER PLLC
andrew@bochner.law
ariel@bochner.law