From:	Trials
To:	Zachary Coots; Trials
Cc:	Dara Kurlancheek; Susie Newman; josephpalys@paulhastings.com; Modi, Naveen
Subject:	RE: Petitioner"s Request to file a reply to the POPR in IPR2024-00391
Date:	Wednesday, May 1, 2024 4:24:51 PM
Attachments:	image001.png

Counsel,

Petitioner is authorized a five page reply to Patent Owner's Preliminary Response due Wednesday, May 9, only to address the issues of (1) whether the Petition included sufficient evidence of Katz as a printed publication to satisfy the particularity and evidentiary requirements of 35 U.S.C. § 312(a), and (2) provide additional information and evidence as to whether Katz is a printed publication. Patent Owner is similarly authorized a five page sur reply to respond to Petitioner's Reply, due Wednesday, May 16. Petitioner and Patent Owner are authorized to file their respective reply and sur reply in each of IPR2024-00391 and IPR2024-00443.

Regards,

Andrew Kellogg,
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From: Zachary Coots <ZCoots@KSLAW.com>
Sent: Tuesday, April 30, 2024 11:46 AM
To: Trials <Trials@USPTO.GOV>
Cc: Dara Kurlancheek <dkurlancheek@kslaw.com>; Susie Newman <SNewman@KSLAW.com>; josephpalys@paulhastings.com; Modi, Naveen <naveenmodi@paulhastings.com>
Subject: Petitioner's Request to file a reply to the POPR in IPR2024-00391

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Honorable Board,

Petitioner would like to seek leave from the Panel in IPR2024-00391 to file a reply to Patent Owner's POPR argument challenging the public availability of Katz. Patent Owner opposes.

Petitioner's Position:

> The Board's precedent in *Hulu LLC v. Sound View Innovations* authorizes Petitioner to submit additional information including a declaration with a reply to support its argument that a reference qualifies as a printed publication, if challenged by the Patent Owner. IPR2018-01029, Paper 29 at 14 (PTAB Dec. 20, 2019) (citing 37 C.F.R. 42.23); *See also Google LLC v. Vocalife LLC*, IPR2022-00004 Paper 7 at 3-4 (Feb. 22, 2022) (authorizing Petitioner to submit

a Reply limited to the issue of whether the challenged art qualifies as a printed publication). Specifically, Petitioner's reply will provide information, including a supporting declaration, that confirms Katz was published in Volume 40 of the journal Analogue Dialogue, the longest-running in-house publication in the electronics industry, and publicly available at that time.

Patent Owner's position:

Petitioner's failure to mention, much less address, the alleged public accessibility of Katz in the Petition warrants denial of Petitioner's request to seek leave to file a reply. While *Hulu* indicates that there is a limited opportunity for a petitioner to submit evidence after filing a petition to address printed publication arguments raised in a POPR, and the Board permitted such a reply in the *Google* case cited by Petitioner, the circumstances surrounding Transcore's Petition are distinguishable. Namely, unlike Transcore's Petition, the Petition in *Google* at least included assertions and evidence (in the form of a declaration) in the first instance to support its arguments concerning the publication of the NPL reference at issue (Briere). *Google*, IPR2022-00004, Paper 1 at 12; *id.*, Ex. 1020 (declaration). Here, as explained in the POPR (Paper 9 at 5-8), Transcore's Petition did not address, include any evidence, or otherwise allege that Katz was publicly accessible at any time, much less before the critical date of the '784 patent. Further, the "Board would [not] benefit from additional briefing on this issue to determine whether to institute trial" (*Google*, IPR2022-00004, Paper 7 at 3-4) since the Petition suffers from numerous deficiencies (e.g., improper incorporation by reference, failures to address limitations/claims, etc.), which additional briefing on the alleged public accessibility of Katz will not rectify. As such, there is no good cause to support Transcore's request for leave to file a reply and it thus should be denied.

To the extent the Board grants Transcore's request, Patent Owner seeks leave to file a sur-reply of similar page length with possible supporting evidence.

Should the Board wish for a conference call, the parties are generally available this week Tuesday through Thursday.

Thank you in advance,

Zachary Coots
Associate

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