

McGee, Sheldon

From: Trials
Sent: Thursday, August 1, 2024 7:16 AM
To: Jim Glass; Trials
Cc: Patrick J. Smith; Matthew Robson; Quincy Lu; Athena Dalton; Dave Nelson; Kevin Guynn; Justin Joseph; Andrew Burnham
Subject: RE: IPR2024-00603

Counsel,

The Board grants Petitioner's conditionally unopposed request to submit a Preliminary Reply not exceeding five pages limited to the three issues listed in Petitioner's July 30, 2024, email; and Patent Owner's unopposed request to submit a Preliminary Sur-reply not exceeding five pages limited to responding to Petitioner's reply arguments. In view of the timing of Petitioner's request over one month after Patent Owner's Preliminary Response was filed, Petitioner's Preliminary Reply may be filed no later than August 6, 2024, and Patent Owner's Preliminary Sur-Reply may be filed no later than five business days after Petitioner's Reply. Neither party may file any additional evidence at this time.

Regards,

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

From: Jim Glass <jimglass@quinnemanuel.com>
Sent: Tuesday, July 30, 2024 2:40 PM
To: Trials <Trials@USPTO.GOV>
Cc: Patrick J. Smith <psmith@gbc.law>; Matthew Robson <matthewrobson@quinnemanuel.com>; Quincy Lu <quincylu@quinnemanuel.com>; Athena Dalton <athenadalton@quinnemanuel.com>; Dave Nelson <davenelson@quinnemanuel.com>; Kevin Guynn <kguynn@gbc.law>; Justin Joseph <jjoseph@gbc.law>; Andrew Burnham <aburnham@gbc.law>
Subject: IPR2024-00603

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Your Honors,

I am lead counsel for Petitioner in the above-captioned proceeding. I write on behalf of Petitioner to seek leave to submit a short (no more than 5 pages) Reply to be due within 10 days of a decision granting leave. The Reply will address Patent Owner's arguments that: (1) the Board should deny institution under *Fintiv*, (2) the Board should deny institution under Section 325(d), and (3) the Board should deny institution for "inconsistent claim construction positions."

Petitioners are mindful of both the Board's prohibition against argumentative emails to *Trials* and of 37 CFR § 42.108(c), which requires a request for a pre-institution Reply to "make a showing of good cause." Good cause exists because Petitioner could not have foreseen Patent Owner's arguments, in particular, its *Fintiv* arguments that, despite no trial date being set, denial is appropriate, its 325(d) arguments incorrectly arguing that the Petition's art is substantially the same as that presented to the examiner, and the incorrect assertion that Petitioner has asserted "inconsistent claim construction positions."

The parties have met and conferred. Patent Owner conditionally does not oppose Petitioner's request. If the Board grants Petitioner's request, Patent Owner requests a sur-reply of equal length and with the same time for briefing. Patent Owner does not oppose Petitioner's request if its request for a sur-reply is granted. Petitioner does not oppose Patent Owner's request for a sur-reply.

To the extent the Board wishes to hold a hearing on this request, the parties will revert with their availability.

Respectfully,
James Glass

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