

## Kiblawi, Fadi N.

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Wednesday, September 4, 2024 3:45 AM  
**To:** mburke@ideaintellectual.com; Kiblawi, Fadi N.; Mandir, William H.; Rabena, John F.; Hur, Soo Jin; Trials@uspto.gov  
**Cc:** Sam Yip (IIL); General (IIL)  
**Subject:** RE: IPR2024-00744 Request to Board to file a Reply Patent Owner's Preliminary Response

Counsel,

From the Board –

Petitioner may file a reply of up to 7 pages discussing only the issues specified in Petitioner's email. Petitioner may not file additional evidence with its reply. Petitioner's reply is due by September 10, 2024. Patent Owner may file a sur-reply of up to 7 pages responding to Petitioner's reply. Patent Owner's sur-reply is due five business days after Petitioner files its reply.

Regards,

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

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**From:** Margaret Burke (IIL) <mburke@ideaintellectual.com>  
**Sent:** Monday, September 2, 2024 5:54 AM  
**To:** Kiblawi, Fadi N. <fkiblawi@sughrue.com>; Mandir, William H. <wmandir@sughrue.com>; Rabena, John F. <jrabena@sughrue.com>; Hur, Soo Jin <shur@sughrue.com>; Trials <Trials@USPTO.GOV>  
**Cc:** Sam Yip (IIL) <syip@ideaintellectual.com>; General (IIL) <general@ideaintellectual.com>  
**Subject:** IPR2024-00744 Request to Board to file a Reply Patent Owner's Preliminary Response  
**Importance:** High

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Honorable Board:

Petitioner respectfully requests authorization to file a reply in IPR2024-00744 to the Patent Owner's Preliminary Response of August 13, 2024. The proposed reply would be 7 pages or fewer and be limited solely to the issue of whether the institution of the IPR should be denied under 35 U.S.C. § 325(d) based on the references being cumulative to cited references in previous EPRs and the previous IPR. The discussion would be limited entirely to a technical discussion of features of the references relied upon vs. those that the Patent Owner alleges are cumulative to the cited references.

The reply can be filed within three business days of authorization by the Board in order to minimize any disruption to the schedule.

Good cause exists due to the numerous references in previous EPRs, IPR, and district court proceedings; it is respectfully submitted that any particular technical argument from the Patent Owner was not foreseeable by the Petitioner. For example, with respect to the newly-cited Tang-Lemense system, Petitioner states that it is “cumulative” to the combined teachings of Taguchi, Nantz, and Toyofuku in that it fails to teach the “judging consistency” limitation. Patent Owner then goes on to completely mischaracterize the teachings of Tang-Lemense regarding this “judging consistency” limitation at pages 21-22.

As Petitioner cannot foresee reference mischaracterization (and, in particular, regarding a limitation that was cited for denial of a previous institution), good cause exists for a limited reply by Petitioners.

Similarly, the Patent Owner has raised the issue of Matsui’s registration verification (again, directed to the “judging consistency” limitation cited in the previous denial) being “no different than that of the Nihei reference cited in the Autel IPR” or being cumulative to Toyofuku. The particular characterization of this newly-cited reference to one of many references was not foreseeable by Petitioners.

Petitioner would agree to the Patent Owner being able to respond (sur-reply) to Petitioner’s reply of equal length.

Patent owner objects to this request for the following reasons:

Patent Owner opposes the request, and submits that a disagreement over the characterization of the teachings of the prior art is not unforeseeable and not cause for additional briefing. To the extent that additional briefing is ordered with respect to the cumulative nature of the cited art under 35 U.S.C. § 325(d), Patent Owner submits that the briefing be limited to no more than one page per party, as this is more than the half-page of § 325(d) analysis provided by Petitioner in its Petition (Pet. at 75).

Counsel for Patent Owner has indicated an availability for teleconference from 8 AM to 10AM for the week of September 2<sup>nd</sup> ; Counsel for Petitioner is also available at this time period. Counsel for Petitioner are physically located in Taiwan and Hong Kong which have a time zone 12 hours ahead of Eastern (Daylight) time. As such, late afternoon US time is not possible although early evening US time is possible.

Sincerely,

Margaret Burke

U.S. Patent Attorney | U.S. Attorney-at-law



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