
From: Jerold Schneider <jerold.schneider@schneideriplaw.legal>
Sent: Monday, August 5, 2024 4:12 PM
To: Trials <Trials@USPTO.GOV>
Cc: Scott Smiley <scott@conceptlaw.com>; raltherr@bannerwitcoff.com; jiwanicki@bannerwitcoff.com; croth@bannerwitcoff.com; cgalfano@bannerwitcoff.com
Subject: Re: IPR2024-00801 - Petitioner's Motion for leave to file reply

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Ms. Goldschlager:

Counsel for Petitioner provides the following requested information:

Petitioner wishes to address the following issues in a Reply to Patent Owner's Preliminary Response:

1. Factual comparison of Petitioner's unapplied prior art to the Examiner's applied prior art, including precise location of the Examiner's analysis in the 501 page prosecution history.
2. Location in the record where Petitioner does not rely on "the same or substantially the same art or arguments previously presented to the Office" and/or where the Office erred in a manner material to patentability" -- the six *Becton, Dickinson* factors.
3. The factual differences between Petitioner's evidence and arguments when compared to the prosecution history in response to Patent Owner's use of the terms "similar" and "same or similar" and "substantially the same" in Patent Owner's Preliminary Response.

Patent Owner

A summary of Patent Owner's position on the matter is as follows:

Patent Owner has indicated that it opposes this request. Patent Owner's position is that the Petitioner cannot show the requisite "good cause" for a preliminary reply because the subject matter of the proposed reply was foreseeable by Petitioner.

Mutual Availability for teleconference:

August 7th – Any time between 1:00 p.m. and 5:00 p.m. (Eastern Daylight Time)
August 9th – Any time between 12:00 noon and 5:00 p.m. (Eastern Daylight Time)
August 12th – Any time between 3:00 p.m. and 5:00 p.m. (Eastern Daylight Time)

A copy of this email is sent to counsel and back-up counsel for Patent Owner.

Thank you,

Jerold I. Schneider

Schneider IP Law

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U.S. News - Best Law Firms® 2020-2023

U.S. News - Best Lawyers® 2021-2024

Florida Board Certified – Intellectual Property Law

561.309.5374

Jerold.schneider@schneideriplaw.legal

From: Trials <Trials@USPTO.GOV>

Date: Monday, August 5, 2024 at 8:17 AM

To: Jerold Schneider <jerold.schneider@schneideriplaw.legal>, Trials <Trials@USPTO.GOV>

Cc: Scott Smiley <scott@conceptlaw.com>, raltherr@bannerwitcoff.com <RAltherr@bannerwitcoff.com>, jiwanicki@bannerwitcoff.com <jiwanicki@bannerwitcoff.com>, croth@bannerwitcoff.com <croth@bannerwitcoff.com>, cgalvano@bannerwitcoff.com <cgalvano@bannerwitcoff.com>

Subject: RE: IPR2024-00801 - Petitioner's Motion for leave to file reply

Counsel,

Please provide the panel with a nonargumentative and brief description of the issue (no more than two or three sentences), a summary of Patent Owner's position on the matter, and 3 or 4 dates and times the parties are available for a conference call.

Regards,

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

From: Jerold Schneider <jerold.schneider@schneideriplaw.legal>

Sent: Thursday, August 1, 2024 3:26 PM

To: Trials <Trials@USPTO.GOV>

Cc: Scott Smiley <scott@conceptlaw.com>; raltherr@bannerwitcoff.com; jiwanicki@bannerwitcoff.com; croth@bannerwitcoff.com; cgalvano@bannerwitcoff.com

Subject: IPR2014-00801 - Petitioner's Motion for leave to file reply

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On behalf of Petitioner, we seek leave to file a Reply to Patent Owner's Preliminary Response and request a telephone conference.

Opposing counsel is copied on this e-mail.

We have exchanged e-mails with opposing counsel on the scope/topics for the Reply.

Thank you,

Jerold I. Schneider

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