

From: [Trials](#)
To: [Qureshi, Wasif](#); [Wood, Megan](#); [LLagostera, Domingo M.](#); [Trials](#)
Cc: [Wong, Russell T.](#); [Davis Jr., Walter D.](#); [Collins, Pam](#); [Jones, Carmella](#); [Schoenhuber, Manny](#); [Dietrich, Blake](#); [Emery, Tori](#)
Subject: RE: IPR2024-00851 - Request to file Reply to Patent Owner's Prelim Response
Date: Tuesday, September 17, 2024 10:50:16 AM

Counsel:

From the Board –

Petitioner's request for a preliminary reply is *denied*. On the particular facts of this proceedings, and for the reasons identified in Patent Owner's email from September 16 (3:29 p.m.), additional briefing on these issues will not assist the panel in determining whether to institute here.

Further, for any future issues requesting additional briefing or a conference call with the panel, please send *one jointly drafted email* with both sides' positions on the issue(s). This promotes efficiency in resolution of issues and helps ensure a robust meet-and-confer process.

Regards,

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

From: Qureshi, Wasif <wqureshi@jw.com>
Sent: Monday, September 16, 2024 3:29 PM
To: Wood, Megan <megan.wood@blankrome.com>; LLagostera, Domingo M. <domingo.llagostera@blankrome.com>; Trials <Trials@USPTO.GOV>; Qureshi, Wasif <wqureshi@jw.com>
Cc: Wong, Russell T. <russell.wong@blankrome.com>; Davis Jr., Walter D. <Walter.Davis@BlankRome.com>; Collins, Pam <pcollins@jw.com>; Jones, Carmella <cjones@jw.com>; Schoenhuber, Manny <mschoenhuber@jw.com>; Dietrich, Blake <bdietrich@jw.com>; Emery, Tori <temery@jw.com>
Subject: RE: IPR2024-00851 - Request to file Reply to Patent Owner's Prelim Response

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Dear Board –

Patent Owner opposes Petitioner's requested leave to file a Preliminary Reply. Petitioner's attempt to address "certain mischaracterizations and misstatements" in Patent Owner's Preliminary Response does not amount to good cause for the sought leave. *See, e.g., Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00593, Paper 11 at p. 3 (July 1, 2016). Patent Owner will explain on the conference call if held.

Respectfully,

Wasif Qureshi
Counsel for Patent Owner

Wasif Qureshi | Partner



From: Wood, Megan <megan.wood@blankrome.com>
Sent: Monday, September 16, 2024 2:19 PM
To: Llagostera, Domingo M. <domingo.llagostera@blankrome.com>; Trials <Trials@USPTO.GOV>
Cc: Wong, Russell T. <russell.wong@blankrome.com>; Davis Jr., Walter D. <Walter.Davis@BlankRome.com>; Collins, Pam <pcollins@jw.com>; Jones, Carmella <cjones@jw.com>; Schoenhuber, Manny <mschoenhuber@jw.com>; Dietrich, Blake <bdietrich@jw.com>; Emery, Tori <temery@jw.com>; Qureshi, Wasif <wqureshi@jw.com>
Subject: RE: IPR2024-00851 - Request to file Reply to Patent Owner's Prelim Response

Caution: **External Email.

Dear Honorable Board,

Our apologies, we inadvertently left off of the below email one of Patent Owner's attorneys of record, Mr. Wasif Qureshi. He is copied here now.

Thank you,
Megan

Megan R. Wood | BLANKROME
1825 Eye Street NW | Washington, D.C. 20006
O: 202.420.2753 | F: 202.420.2201 | megan.wood@blankrome.com

From: Llagostera, Domingo M. <domingo.llagostera@blankrome.com>
Sent: Monday, September 16, 2024 2:58 PM
To: Trials <Trials@USPTO.GOV>
Cc: Wood, Megan <megan.wood@blankrome.com>; Wong, Russell T. <russell.wong@blankrome.com>; Davis Jr., Walter D. <Walter.Davis@BlankRome.com>; Collins, Pam <pcollins@jw.com>; Jones, Carmella <cjones@jw.com>; Schoenhuber, Manny <mschoenhuber@jw.com>; Dietrich, Blake <bdietrich@jw.com>; Emery, Tori <temery@jw.com>
Subject: IPR2024-00851 - Request to file Reply to Patent Owner's Prelim Response

Dear Honorable Board,

Pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioner requests authorization from the Board to file a 5-page pre-institution reply in IPR2024-00851 to respond to certain of Patent Owner’s positions in the Patent Owner’s Preliminary Response to Petition (Paper No. 7).

Petitioner does not oppose a sur-reply by Patent Owner of equal length.

Petitioner and Patent Owner have met and conferred via email and telephone, and Patent Owner opposes Petitioner’s request. To the extent the Board deems a conference call with the parties necessary, the parties are available for a call as follows:

9/23, 10 am ET – 1 pm ET

9/24, 10 am ET – 1 pm ET

Good cause exists for pre-institution reply briefing, primarily in that Petitioner could not have foreseen what it believes are certain mischaracterizations and misstatements in Patent Owner’s arguments. Petitioner will explain in detail on a call if necessary, and notes the issues here:

Patent Owner provides an incomplete account of the claim construction proceedings in the parallel district court case. *See* Prelim Response, pp. 10-21.

Patent Owner mischaracterizes and misapplies the Board’s case law and Trial Practice Guide as it relates to a Petitioner’s obligation to raise in its Petition a claim construction position, given the stage of the parallel district court claim construction proceedings. *Id.*

Counsel for Patent Owner is copied on this email.

Best regards,

Domingo M. Llagostera

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