

From: [Trials](#)
To: [Garr, David](#); [Trials](#)
Cc: [PictivaIPR@irell.com](#); [hzhong@irell.com](#); [jgao@irell.com](#); [rcarson@irell.com](#); [pwarrick@irell.com](#); [jsheasby@irell.com](#); [Weidenfeller, Scott](#); [SDC-Pictiva-IPR](#)
Subject: RE: IPR2024-00855 -- request for preliminary reply
Date: Wednesday, September 4, 2024 10:13:10 AM

Counsel:

The panel has determined that it may be helpful to the Board, in reaching an equitable decision on whether to institute review, to allow additional briefing on the issues identified by Petitioner's counsel in the email below. Petitioner is authorized to file a 5-page reply to Patent Owner's preliminary response within 5 business days of this email. Any reply filed pursuant to this authorization shall be limited to addressing Patent Owner's arguments about discretionary denial under 35 U.S.C. §§ 314(a) and 325(d), and whether Igarashi qualifies as prior art under 35 U.S.C. § 102(b). Patent Owner is authorized to file a 5-page sur-reply within 5 business days of the filing of any reply.

Regards,

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

From: Garr, David <dgarr@cov.com>
Sent: Tuesday, September 3, 2024 3:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: [PictivaIPR@irell.com](#); [hzhong@irell.com](#); [jgao@irell.com](#); [rcarson@irell.com](#); [pwarrick@irell.com](#); [jsheasby@irell.com](#); [Weidenfeller, Scott](#) <[SWeidenfeller@cov.com](#)>; [SDC-Pictiva-IPR](#) <[SDC-Pictiva-IPR@cov.com](#)>
Subject: IPR2024-00855 -- request for preliminary reply

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Dear Honorable Board,

Petitioner in IPR2024-00855 writes to request the Board's authorization to file a 5-page reply to Patent Owner's preliminary response, in order to address Patent Owner's arguments on discretionary denial under 35 U.S.C. §§ 314(a) and 325(d), as well as Patent Owner's reliance on the '547 patent's foreign priority claim in challenging whether Igarashi qualifies as prior art under 35 U.S.C. § 102(b).

Patent Owner has advised that it does not oppose Petitioner's request for a reply on issues related to discretionary denial, but that it does not believe there is a need to brief issues related to 102(b).

Patent Owner also advised that it would request a sur-reply of the same length. Petitioner does not oppose this request.

If a conference call should be necessary, the parties are generally available this week between 10 a.m. and 5 p.m.

Respectfully submitted,
David Garr
Counsel for Petitioner

David A. Garr

Pronouns: He/Him/His

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