| | |
|---|---|
| **From:** | Elizabeth O"Brien |
| **To:** | Trials |
| **Cc:** | Tom Dunham; Robert Molitors; PTAB Scott McKeown; PTAB Adam Wichman; PTAB Randy Pritzker |
| **Subject:** | IPR2024-00923 |
| **Date:** | Saturday, March 1, 2025 8:50:24 PM |

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

May it please the Board,

Yesterday, the USPTO rescinded the June 21, 2022, memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Memorandum).

In the Institution Decision, the Board stated: "we deny Patent Owner's request for discretionary denial under § 314(a) in view of Petitioner's *Sotera* stipulation." Paper 11 at 8. This proceeding is, however, still in its early stages.

Because the Board emphasizes system efficiency and fairness, Patent Owner respectfully requests authorization to file a motion to terminate this proceeding, without the Board rendering a final written decision, in view of parallel district court litigation. *See* 37 C.F.R. § 42.72. In the alternative, Patent Owner respectfully requests the Board authorize Patent Owner to file a request for rehearing of the institution decision outside the 14-day window, or authorize Patent Owner to partake in any other procedure the Board may prescribe to address the change in policy. *See* 37 C.F.R. §§ 42.5, 42.71.

Patent Owner is available at the Board's convenience for a conference call if desired.

Counsel for Petitioner is copied on this email.

Thank you,
Elizabeth O'Brien
(Back-up Counsel for Patent Owner)

Elizabeth O'Brien
Counsel
Cherian LLP
https://cherianllp.com/
1901 L Street NW, Ste 700
Washington, DC 20036
O: (202) 873-1726
M: (703) 930-0505