

From: [Trials](#)
To: [Bell, Cory](#); msaunders@dickinson-wright.com; [Panitch, Gerson](#); [High, Robert](#); [Schlesinger, Benjamin](#); [Bazrod, Wyatt](#); [Bryan D. Atkinson](#); [Linda L. Emerson](#)
Cc: [Trials](#)
Subject: RE: Pre-Institution Reply Request for IPR2024-01110
Date: Monday, January 6, 2025 3:47:54 PM

Counsel:

Petitioner's request for additional briefing is granted with the conditions as set forth below.

Petitioner is authorized to file a Preliminary Reply, limited to five pages and due within five business days. Petitioner may present arguments regarding 1) Patent Owner's proposed definition of "characterization profile," including how it may be inconsistent with positions taken in the parallel district court litigation, and 2) discretionary denial under *Fintiv*. Petitioner is authorized to file Patent Owner's infringement contentions filed in the parallel district court litigation. No other additional evidence is authorized.

Patent Owner is authorized to file a Preliminary Sur-reply, limited to five pages and due five business days after Petitioner files its Preliminary Reply. Patent Owner may present arguments only in response to arguments made in the Preliminary Reply.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Bell, Cory <Cory.Bell@finnegan.com>
Sent: Friday, January 3, 2025 12:48 PM
To: Trials <Trials@USPTO.GOV>
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Ex. 3001
IPR2024-01110

Subject: Pre-Institution Reply Request for IPR2024-01110

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Honorable Board,

Petitioner requests authorization to file a ten-page pre-institution reply in IPR2024-01110 to address Patent Owner's construction for "characterization profile," point out inconsistencies with Patent Owner's infringement contentions, and respond to Patent Owner's *Fintiv* arguments as set forth in Patent Owner's Preliminary Response (Paper 7). Good cause exists for filing this pre-institution reply because Petitioner could not have reasonably foreseen (1) Patent Owner's construction we believe is inconsistent with Facet's infringement contentions submitted in district court proceedings after the IPR petition was filed; and (2) Patent Owner's *Fintiv* arguments.

If granted, Petitioner does not oppose permitting Patent Owner a sur-reply of equal length to address any issue authorized for further briefing by the Board.

Petitioner and Patent Owner have conferred, and Patent Owner responds to this request as follows:

"In IPR2024-01110, Patent Owner is agreeable to Petitioner being allowed a reply brief to address Patent Owner's *Fintiv* arguments, as well as to address the construction of 'characterization profile.' Patent Owner believes those issues can be addressed in a 5-page brief. Patent Owner does not believe there is any inconsistency with the infringement contentions—the infringement claim chart for claim 15 of the '255 Patent is self-evidently distinguishable from the arguments in the preliminary response. Patent Owner would not oppose Petitioner being granted leave to simply file the '255 Patent infringement contention claim chart as an exhibit, but extensive further briefing (directed to the single challenged, non-disclaimed claim that remains) would invite attempts to improperly fix deficiencies in the Petition. Thus, Patent Owner opposes any further pre-institution briefing by Petitioner in IPR2024-01110 other than to address Patent Owner's *Fintiv* arguments and the construction of 'characterization profile.' Patent Owner requests a sur-reply of equal length as granted for Petitioner's reply."

If a call is necessary, the parties are available on Wednesday January 8, 2025 or Friday, January 10, 2025 between 11am ET and 4pm ET.

Regards,
Cory C. Bell
Lead Counsel for Petitioner

Cory C. Bell
Partner

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