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**Subject:** IPR2024-01163: Tommy John, Inc. v. Pakage Apparel, Inc. || Petitioner's Request for Leave to File a Preliminary Reply  
**Date:** Tuesday, November 5, 2024 4:44:48 PM

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IPR2024-01163  
U.S. Patent No. 10,834,974  
Tommy John, Inc. v. Pakage Apparel, Inc.

Dear Honorable Board,

Pursuant to 37 C.F.R. §§ 42.108(c) and 42.23, Petitioner in the above-referenced proceeding respectfully requests leave to file a preliminary reply of no more than five pages to address Patent Owner's arguments in its Preliminary Response regarding:

1. Whether discretionary denial is appropriate under 35 U.S.C. §325(d) and *Advanced Bionics*; and
2. Whether discretionary denial is appropriate under *Fintiv* and §314(A).

Petitioner submits that good cause exists for such a preliminary reply in order to, for example, address Patent Owner's statements regarding the prosecution history and comparisons of prior art used in rejections during prosecution to the references used in the Petition, and Patent Owner's arguments regarding the state of the parallel district court case and any potential overlap in grounds presented in this Petition and grounds that may be litigated in the district court case.

Petitioner and Patent Owner have conferred regarding Petitioner's request, and Patent Owner indicated it does not oppose a five page preliminary reply by Petitioner on the issues of §325(d) and *Fintiv*, provided Petitioner agrees to a subsequent five page sur-reply by Patent Owner due within ten business days of Petitioner's preliminary reply. Petitioner does not oppose Patent Owner's requested five page sur-reply. If helpful to the Board, the parties are available to discuss this request.

Best regards,

Scott Hughes  
Counsel for Petitioner

**Scott A. Hughes**  
Partner

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