

From: [Trials](#)
To: [Brandon R. Theiss](#); "[Krieger, Justin](#)"; [Trials](#)
Cc: [Gibby, Darin](#); [Spink, Torrey](#); [Ryan O'Donnell](#); [Robert D. Leonard](#); rrigby@intven.com; [Kennedy, Nicki](#); [Daniel H. Golub](#)
Subject: RE: IPR2024-01221 Petitioner's Request to File Reply to Patent Owner's Preliminary Response
Date: Wednesday, December 4, 2024 11:33:39 AM
Attachments: [image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)
[image007.png](#)

Counsel,

Both parties are authorized to submit additional evidence in support of the supplemental briefing as to the claim construction of the term "embedded."

The parties are cautioned to refrain from submitting email correspondence to the Board that includes legal or factual arguments. Emails to the Board need only mention generally the relief requested and times when all parties are available for a conference call with the Board. The parties are also reminded of the Board's meet and confer requirement and are directed to confer in good faith to resolve disputes prior to contacting the Board.

Best regards,

Eric W. Hawthorne

Supervisory Paralegal Specialist

Patent Trial and Appeal Board

From: Brandon R. Theiss

Sent: Wednesday, December 4, 2024 9:41 AM

To: 'Krieger, Justin'; Trials

Cc: Gibby, Darin; Spink, Torrey; Ryan O'Donnell; Robert D. Leonard; rrigby@intven.com; Kennedy, Nicki; Daniel H. Golub

Subject: RE: IPR2024-01221 Petitioner's Request to File Reply to Patent Owner's Preliminary Response

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Honorable Board,

There was nothing unforeseeable about Patent Owner's proposed construction of embedding. As used in the patent, "embedding" is a term of art (which was plainly knowable by Petitioner), and Patent Owner has construed the term as such. Moreover, Petitioner cites no rule or decision authorizing Petitioner to submit additional evidence with a Pre-institution Reply. According to 35 U.S.C. 314(a), the Board is required to base its institution decision on "the information presented in the petition filed under section 311 and any response filed under section 313." Neither the statute nor the rules provide for the submission of additional information (evidence) at this point in the proceedings.

Regards,



Brandon R. Theiss

Shareholder

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From: Krieger, Justin <JKrieger@ktslaw.com>

Sent: Tuesday, December 3, 2024 5:06 PM

To: Trials USPTO <trials@uspto.gov>

Cc: Gibby, Darin <dgibby@ktslaw.com>; Spink, Torrey <TSpink@ktslaw.com>; Brandon R. Theiss <BTheiss@vklaw.com>; Ryan O'Donnell <RODonnell@vklaw.com>; Robert D. Leonard <RLeonard@vklaw.com>; rrigby@intven.com; Kennedy, Nicki <NKennedy@ktslaw.com>

Subject: RE: IPR2024-01221 Petitioner's Request to File Reply to Patent Owner's Preliminary Response

Petitioner's Request for Clarification of Prior Board Authorization

IPR2024-01221

Honorable Board,

Petitioner respectfully seeks clarification of the Board's below email authorization to file a reply brief in the above-reference proceeding.

Specifically, Petitioner would like to confirm or alternatively request that it is authorized to submit exhibits with its reply brief responsive to the exhibits Patent Owner submitted with its POPR, limited to the construction of the term "embedded" as previously authorized. Good cause exists in that it was unforeseeable that Patent Owner would submit exhibits 2003-2007 and 2001 (citing same) with its POPR on the claim construction issue, and it is fair for Petitioner to be afforded a similar opportunity to present exhibits on this issue. Since Patent Owner is free to respond to such exhibits in its sur-reply, no prejudice would result in granting this request.

Patent Owner opposes this request. The parties are available for a telephone call with the Board, if necessary, any time tomorrow (Dec. 4).

Sincerely,

Justin Krieger

Counsel for Petitioner Early Warning Services, LLC

Justin Krieger
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Kilpatrick Townsend & Stockton LLP
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From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 27, 2024 9:00 AM
To: Kennedy, Nicki <NKennedy@ktslaw.com>; Trials <Trials@USPTO.GOV>
Cc: Krieger, Justin <JKrieger@ktslaw.com>; Gibby, Darin <dgibby@ktslaw.com>; Spink, Torrey <TSpink@ktslaw.com>; btheiss@vklaw.com; rodonnell@vklaw.com; Robert D. Leonard <RLeonard@vklaw.com>; rrigby@intven.com
Subject: RE: IPR2024-01221 Petitioner's Request to File Reply to Patent Owner's Preliminary Response

CAUTION: External Email

Counsel,
From the Board –
Petitioner is authorized to file a five-page Reply to Patent Owner's Preliminary Response, no later than December 5th, limited to responding to Patent Owner's arguments relating to (1) claim construction of the term "embedded," and (2) the Petition's citations to Ex. 1006. Patent Owner is authorized to file a five-page Sur-reply, limited to responding to arguments made by Petitioner in its Reply, no later than December 12th.
Regards,
Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Kennedy, Nicki <NKennedy@ktslaw.com>
Sent: Tuesday, November 26, 2024 2:29 PM
To: Trials <Trials@USPTO.GOV>
Cc: Krieger, Justin <JKrieger@ktslaw.com>; Gibby, Darin <dgibby@ktslaw.com>; Spink, Torrey <TSpink@ktslaw.com>; btheiss@vklaw.com; rodonnell@vklaw.com; Robert D. Leonard <RLeonard@vklaw.com>; rrigby@intven.com
Subject: IPR2024-01221 Petitioner's Request to File Reply to Patent Owner's Preliminary Response

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Petitioner's Request to File Reply to Patent Owner's Preliminary Response
IPR2024-01221

Honorable Board,
Petitioner respectfully requests permission to file a Reply to Patent Owner's Preliminary Response in the above-referenced IPR. Good cause exists in accordance with 37 C.F.R. § 42.108(c) at least based on Patent Owner's unforeseeable claim construction of "embedded" and arguments concerning citations to Ex. 1006.
Petitioner requests a 7-page reply due 7 days from the order granting our request. Petitioner does not oppose a sur-reply of equal length for Patent Owner due 7 days after Petitioner's reply.
Petitioner has conferred with Patent Owner and Patent Owner opposes Petitioner's request.
Should the panel wish to convene a telephone conference, the parties are available on December 2 and 3 from 9 am to 5 pm (eastern).

Best,



Nicki Kennedy
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