

From: [Brandon R. Theiss](#)
To: [Trials](#)
Cc: [Daniel H. Golub](#); [Dinesh Melwani](#); [Jameson Ma](#); "[Jordan Maucotel](#)"
Subject: RE: Request to file Reply to Patent Owner's Preliminary Response | IPR2024-01224
Date: Wednesday, November 27, 2024 8:35:49 PM
Attachments: [image001.png](#)
[image002.png](#)
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[LinkedIn_Icon_27x27_3170b404-fd2f-4d10-9641-d8fd8066fdca.png](#)
[Facebook_Icon_27x27_9936184e-d3cf-41c3-bed9-037bf23e89dd.png](#)
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Dear Honorable Board,

The Petitioner has not demonstrated good cause for its request, which should be denied. The PTAB's case law explains that "[g]ood cause may exist in certain situations such as where new evidence comes to light after the filing of a petition or a legal argument of first impression is made by the Patent Owner." *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00593 (non-precedential). Here, there is no new evidence nor any legal arguments of first impression made by the Patent Owner.

The Petition said it was a "me too" petition that raised "identical issues to those in the Zebra IPR" (IPR2024-00883), and since it would be an "understudy," there is "no basis to deny institution" under §325(d). Pet., 6-7. On November 20, 2024, the Board denied the institution of IPR2024-00883 based on a failure to "sufficiently establish that Dammann qualifies as a prior-art printed publication." IPR2024-00883, Paper #10, at 26. Now that the Board has ruled, the Petitioner seeks to depart from its "me too" status and use the Board's decision as a roadmap to correct the deficiencies relating to the prior art status of Dammann. This tactic is blatantly unfair to Patent Owner. *General Plastic Industrial Co., Ltd. v Canon*, IPR2016-01357, Paper #19 (P.T.A.B. 2017) (Precedential) ("The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments ... using our decisions as a roadmap, until a ground is found that results in the grant of review. All other factors aside, this is unfair to patent owners.")

Out of all of the issues raised in the POPR, the only issue that the Petitioner now seeks to address is the prior art status of Dammann, which just happens to have been the basis of the Board's denial of institution in the Zebra IPR. This is not a coincidence. While a normal "me too" petition may not raise issues under §325(d), the Petitioner's request for additional briefing and evidence now in order to correct the deficiencies identified by the Board in the decision denying the institution of the Zebra IPR raises significant issues under §325(d). For this reason, and because Petition has not demonstrated good cause, Petitioner's request should be denied.

Respectfully,



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From: Jordan Maucotel <JMaucotel@bomcip.com>

Sent: Wednesday, November 27, 2024 5:01 PM

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Subject: Request to file Reply to Patent Owner's Preliminary Response | IPR2024-01224

IPR2024-01224
Ex. 3003

Dear Honorable Board,

Petitioner requests authorization to file a preliminary reply to the Patent Owner's preliminary response in the above-referenced proceeding. Petitioner believes that good cause exists and that it is in the interest of justice to address the Patent Owner's argument challenging the public availability of Dammann (Ex.1004) before an institution decision is reached. Patent Owner has indicated that it opposes this request.

Petitioner's Position:

The Board's precedent in *Hulu LLC v. Sound View Innovations* authorizes the Petitioner to submit additional information including a reply to support its argument that a reference qualifies as a printed publication, if challenged by the Patent Owner. IPR2018-01039, Paper 29 at 14 (PTAB Dec. 20, 2019) (citing 37 C.F.R. §42.23); *See also Google LLC v. Vocalife LLC*, IPR2022-00004 Paper 7 at 3-4 (Feb. 22, 2022) (authorizing Petitioner to submit a Reply to address the issue of whether the challenged art qualifies as a printed publication before an institution decision). Petitioner seeks similar authorization in this proceeding to address Patent Owner's allegations that Dammann is not a printed publication.

Specifically, Petitioner seeks to file a reply no longer than five (5) pages and is limited to the issue of Dammann's status as a prior art reference based on its public availability. Petitioner's reply will provide information, including a supporting declaration from a research librarian and no more than 2-3 exhibits in total, that confirms that Dammann was publicly available before the critical date of the '439 patent.

Best regards,
Jordan Maucotel



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