

From: [Trials](#)
To: [Curtis, Nathan R.](#); [Hershkowitz, Matt](#); [Trials](#)
Cc: *** [GDC-SharkNinjaIPRD](#); [Buroker, Brian M.](#); [#DysonIPR](#)
Subject: RE: IPR2024-01233 - Petitioners' Request for Leave to File Reply to Patent Owner Preliminary Response
Date: Thursday, December 12, 2024 9:56:48 AM

Counsel,

From the Board –

Although we understand Patent Owner's points in opposition below, in order to provide a full record at this stage of the proceeding, we *grant* Petitioner's request to file a one-page reply to the Patent Owner Preliminary Response in IPR2024-01233. The requested reply must be filed **on or before December 17, 2024**.

Further, for any future issues requesting additional briefing or a conference call with the panel, please send **one jointly drafted email** with both sides' positions on the issue(s). This promotes efficiency in resolution of issues and helps ensure a robust meet-and-confer process.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Curtis, Nathan R. <NCurtis@gibsondunn.com>
Sent: Wednesday, December 11, 2024 4:32 PM
To: Hershkowitz, Matt <matt.hershkowitz@kirkland.com>; Trials <Trials@USPTO.GOV>
Cc: *** GDC-SharkNinjaIPRD <GDC-SharkNinjaIPRD@gibsondunn.com>; Buroker, Brian M. <BBuroker@gibsondunn.com>; #DysonIPR <DysonIPR@kirkland.com>
Subject: RE: IPR2024-01233 - Petitioners' Request for Leave to File Reply to Patent Owner Preliminary Response

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Your Honors,

Patent Owner opposes Petitioners' request for a short reply. In seeking a reply from the Board, Petitioners misrepresent and selectively quote the Invalidity Contentions in the Eastern District of Texas matter. In Patent Owner's Invalidity Contentions, Patent Owner states that, "[a]s expressed in IPR filings, the patent owner disagrees with Plaintiffs' [Dyson's] proposed combinations" in IPR2024-01233, but that "to the extent Plaintiff continue to pursue those combinations in IPR, Defendants reserve the right to rely on any such combination of reference put forward by Plaintiffs in such IPRs to demonstrate the invalidity of the Asserted Claims in this litigation." Patent Owner further

emphasizes, “Defendants’ [i.e., Patent Owner’s] reliance in this litigation on any prior art combination presented by Plaintiffs in IPR of Omachron patents [e.g., IPR2024-01233] does not waive any objections to such combinations.” Therefore, the Invalidity Contentions have no bearing on propriety of the Schmidt + Liddell combination in this IPR.

Patent Owner therefore oppose Petitioner’s request for leave to file a reply.

Respectfully,
Nathan Curtis

Nathan R. Curtis
Of Counsel

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From: Hershkowitz, Matt <matt.hershkowitz@kirkland.com>
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Cc: *** GDC-SharkNinjaIPRD <GDC-SharkNinjaIPRD@gibsondunn.com>; Buroker, Brian M. <BBuroker@gibsondunn.com>; #DysonIPR <DysonIPR@kirkland.com>
Subject: IPR2024-01233 - Petitioners' Request for Leave to File Reply to Patent Owner Preliminary Response

Your honors,

Petitioners request leave to file a 1-page reply to Patent Owner’s preliminary response in IPR2024-01233 to address intervening developments arising from Patent Owner’s statements in its November 22 invalidity contentions in litigation between the parties in the United States District Court for the Eastern District of Texas.

Petitioners in their Petition seek cancellation of all challenged claims based on grounds that rely on combining two prior art references, German Patent 357279C to Schmidt (“Schmidt”) and U.K. Patent Pub. GB2399780A to Liddell (“Liddell”). Patent Owner in its POPR argues that “Petitioners failed to show that a POSITA would have been motivated to combine Schmidt with Liddell,” that these references “are incompatible” and that combining them is “nothing more than impermissible hindsight.” Paper No. 7 at 12.

The parties are engaged in litigation in *Dyson, Inc. v. SharkNinja, Inc.*, Case No. 2:24-cv-386 (E.D. Tex.), in which Petitioners in this IPR (i.e., Dyson) are asserting certain patents against Patent Owner (i.e., Omachron). In response and on November 22, Patent Owner served invalidity contentions in which it contended for the first time “[t]he Schmidt + Liddell combination renders obvious all

Asserted Claims of” Dyson’s U.S. Patent No. 8,444,731, the same combination of two references that Patent Owner argued in its POPR that a POSA would not have combined because they “are incompatible” and combining them is “nothing more than impermissible hindsight.”

Because Patent Owner made these statements and advanced the combination of Schmidt and Liddell against Petitioner for the first time after Petitioners filed their Petition, Petitioners could not have included Patent Owner’s inconsistent statements in their Petition and believe that good cause exists to allow a 1-page reply to present Patent Owner’s statements from its invalidity contentions to the Board.

The parties have conferred via email and Patent Owner opposes.

Should the Board believe a call is necessary to discuss Petitioner’s request, the parties are generally available December 16 and 17. If the Board would like the parties to provide additional availability, please let us know. Petitioners will arrange for a court reporter to be present on the call.

Respectfully submitted,

Matt Hershkowitz

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