

From: [Director_PTABDecision_Review](#)
To: [Peters, Steven](#); [Paul Hart](#)
Cc: [ptab@eriseip.com](#); [Adam Seitz](#); [Pathmanaban, Giri](#); [Naples, Clement](#); [Todd, Daniel S.](#); [Hlavka, David J.](#)
Subject: RE: IPR2025-00068 and -00070: Request for Reply to Address New Precedent
Date: Friday, June 6, 2025 4:25:00 PM

Counsel,

Patent Owner's request for authorization to file a reply to Petitioner's response to Patent Owner's Request for Director Review in the above-captioned proceedings is denied.

Thank you.

From: Peters, Steven <speters@cgsh.com>
Sent: Monday, June 2, 2025 7:32 PM
To: Paul Hart <paul.hart@eriseip.com>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: ptab@eriseip.com; Adam Seitz <adam.seitz@eriseip.com>; Pathmanaban, Giri <gpathmanaban@cgsh.com>; Naples, Clement <cnaples@cgsh.com>; Todd, Daniel S. <dtodd@cgsh.com>; Hlavka, David J. <dhlavka@cgsh.com>
Subject: RE: IPR2025-00068 and -00070: Request for Reply to Address New Precedent

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Honorable Director,

Patent Owner disputes several aspects of Petitioner's argumentative email (which would span over four pages in a brief formatted under PTAB rules), including the characterization of an article by Patent Owner's counsel. Patent Owner will properly address these disputes should the Director authorize a brief.

Respectfully submitted,
Steven Peters
Counsel for Patent Owner

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From: Paul Hart <paul.hart@eriseip.com>
Sent: Monday, June 2, 2025 4:55 PM

IPR2025-00068
Ex. 3101

To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Cc: Peters, Steven <speters@cgsh.com>; ptab@eriseip.com; Adam Seitz <adam.seitz@eriseip.com>; Pathmanaban, Giri <gpathmanaban@cgsh.com>; Naples, Clement <cnaples@cgsh.com>; Todd, Daniel S. <dtodd@cgsh.com>; Hlavka, David J. <dhlavka@cgsh.com>

Subject: Re: IPR2025-00068 and -00070: Request for Reply to Address New Precedent

Dear Honorable Director,

Patent Owner's ("PO") Request for Director Review raised only two issues. First, it argued that the Board improperly instituted two petitions challenging the same patent. Second, it argued that the Board erred in too broadly construing "computer system" to include more than an individual endpoint device. These two issues track the arguments PO advanced in its Preliminary Response ("POPR"). The POPR did not ask the Board to deny institution on any other basis.

PO now asks for additional briefing to address—for the first time—the *Advanced Bionics* framework under 35 U.S.C. § 325(d), following the Director's precedential decision in *Ecto World*, which clarified the framework. PO's request should be denied for at least the following reasons:

(1) PO Waived the § 325(d) Argument by Failing to Raise It in Its POPR or Its Request for Director Review

Under the USPTO's Director Review Process guidelines, "[a]ny argument not made within the request [for Director Review] may be deemed waived." *See Director Review Process*, § 3.E (last updated May 23, 2025) (<https://www.uspto.gov/patents/ptab/decisions/director-review-process>) ("Director Review Process"). And the guidelines make clear that new arguments may be authorized only in limited circumstances, e.g., changes in law or USPTO procedures, guidance or decisions.

Ecto World did not announce a new § 325(d) standard. Rather, it resolved a known PTAB Board split concerning whether a petitioner must affirmatively explain how the Examiner erred. *See Ecto World*, IPR2024-01280, Paper 13 at 5 (explaining that "Board panels have disagreed as to whether a petitioner must provide an analysis under part two of *Advanced Bionics* and, if so, whether a petitioner must explain how the Examiner erred or whether a petitioner can simply rely on its unpatentability contentions to imply that an error occurred. . . . This decision resolves that dispute . . ."). Indeed, PO's counsel published an article observing that *Ecto World* "resolves a split among previous PTAB panels." <https://www.clearygottlieb.com/news-and-insights/publication-listing/ptab-requires-ipr-petitioners-to-identify-examiner-error>.

Because *Ecto World* resolved a known split among PTAB panels, PO could have advanced a § 325(d) standard in its POPR, which may have formed a foundation to have raised it in the Request for Director Review. But PO did not address the issue prior until its May 30th email to the Director. Accordingly, it has waived the argument.

(2) The Requested "Reply" Brief is Procedurally Insufficient

PO asks for a "reply" to newly explain why Petitioner allegedly failed to satisfy the *Advanced Bionics* framework clarified in *Ecto World*. This provides Petitioner no opportunity to provide

its own explanation for why the newly clarified framework is satisfied. In the *Ecto World* proceeding, the Director remanded the case, providing both parties additional briefing before the original panel was tasked with applying the newly clarified framework. Here, PO asks the Director to deprive Petitioner of the same opportunity.

(3) PO's Citation to *Motorola* is Inapposite

PO's email argues its "request is justified by the issuance of a new precedential opinion and the fact that there has not been a 'final decision on institution,' i.e., there is a request for Director review that remains pending. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01284, Paper 17 at 4 (Stewart May 23, 2025)." This language from *Motorola* was analyzing express rescission language from a March 2025 memo, which rescinded an earlier *Fintiv* memo. The *Motorola* case did not more broadly set forth a standard for determining when new substantive arguments can be introduced during the pendency of a Request for Director Review.

(4) Additional §325(d) Briefing Will be Redundant

Capalik, the base reference underlying each ground in the instituted proceedings, is a 102(b) printed patent application that shares an inventor with the Challenged Patent. The Petitions established that, although Capalik was ostensibly brought to the Examiner's attention via its listing in the "Related Applications" section of the specification, its teachings render obvious the Challenged Claims (either alone or in combination with secondary references, depending on the ground). The POPR raised a single merit-based challenge that sought to distinguish the Challenged Claims from Capalik. Namely, it argued that the Board erred rejecting PO's claim construction argument that "computer system" should be limited to an individual endpoint device.

This claim construction argument is already briefed in the current Director Review record. Accordingly, if the Director finds the Board did not err in rejecting PO's claim construction argument, the record will show that there are no meaningful distinctions between Capalik and the Challenged Claims—a showing that strongly favors finding that the Examiner erred by failing to reject the claims over Capalik during original prosecution. Accordingly, PO's request to newly address §325(d) is redundant of the merits-based argument already pending before the Director.

Respectfully,

Paul Hart | Shareholder
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On May 30, 2025, at 1:08 PM, Director_PTABDecision_Review
<Director_PTABDecision_Review@uspto.gov> wrote:

Counsel,

Petitioner may respond with its position as to Patent Owner's request via email by Monday June 2nd.

Thanks.

From: Peters, Steven <speters@cgsh.com>

Sent: Friday, May 30, 2025 12:54 PM

To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>

Cc: ptab@eriseip.com; Adam Seitz <adam.seitz@eriseip.com>; Paul Hart <paul.hart@eriseip.com>; Pathmanaban, Giri <gpathmanaban@cgsh.com>; Naples, Clement <cnaples@cgsh.com>; Todd, Daniel S. <dtodd@cgsh.com>; Hlavka, David J. <dhlavka@cgsh.com>

Subject: IPR2025-00068 and -00070: Request for Reply to Address New Precedent

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IPR2025-00068 and -00070

Dear Honorable Director,

Patent Owner requests a reply to Petitioner's response to the Director Review Requests in the above-captioned proceedings.

The facts in this case are aligned with those in the Director's May 19 precedential opinion in *Ecto World*, which issued after Patent Owner's May 16 Requests. Although the Petitions nominally addressed §325(d), the Petitions failed to show that the Examiner erred in overlooking the Capalik reference (which is the primary reference asserted in both proceedings) despite acknowledging that this reference was previously presented to the Office at least by way of its incorporation-by-reference into the challenged patent, and because related office actions and responses thereto from Capalik's prosecution were cited in an IDS. *See* Ex. 1001 (872 patent) at 2-3 (listing Capalik Office Actions).

The Petition instead made "generalized statements as to the strength of the Petition" which the Director has now held "fail to identify sufficiently a material error." *Ecto World* at 6; *see* Petition (-00068) at 78 (referring generally to "strength of the Proposed Grounds" without identifying any error).

The request is justified by the issuance of a new precedential opinion and the fact that there has not been a “final decision on institution,” i.e., there is a request for Director review that remains pending. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01284, Paper 17 at 4 (Stewart May 23, 2025).

Respectfully submitted,
Steven Peters
Counsel for Patent Owner

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