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To: [Becker, Jeff](#); [Trials](#)
Cc: [Meredith Addy](#); [Greg Gulliver](#); [Sue Tucker](#); [Sirota, Neil](#); [Williams, Eliot D.](#); [McDonald, Jacob](#)
Subject: IPR2025-00101 - Request for Preliminary Reply
Date: Wednesday, March 5, 2025 6:00:08 PM

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Dear Patent Trial and Appeal Board,

Patent Owner opposes the Petitioners' request for a 3-page preliminary reply addressing claim construction regarding the claim term "device" as recited in elements 18[p] and 18[a]. In view of the Board's direction in Paper 3, Patent Owner's email response below is not providing "substantive argument ... [or] attachments," but provides factual rationale to the Board why Petitioner's reply request is an attempt to game the PTAB rules and why granting Petitioner's request prejudices the Patent Owner.

1. Petitioners' request is an attempt to improperly assert post-Petition claim construction prior to IPR institution. The Petition included a section titled "Claim Construction," yet Petitioner failed to provide any claim constructions. Please note, Patent Owner did not construe the term "device" in its POPR that the Petitioner now seeks to construe. (See POPR 15-17).
2. Petitioners' request to file a reply is merely a ploy to circumvent the Petition's 14,000 word count limitation, introduce new arguments and construe claim elements that were not construed by Patent Owner. The Petition used 13,969 words to address four grounds, with only three or four claims cited in each ground. Petitioner now seeks a three page reply to increase the word count to overcome the 14,000 word limitation.

Increasingly, Patent Owners are witnessing Boards grant Petitioner's request to file a reply in order to further address claim construction. However, Board grants of these claim construction replies actually prejudice Patent Owners because reply grants allow Petitioners to overcome the 14,000 word count limitation. Petitioners are not held to the same standard as Patent Owners since Petitioners get to decide what claim terms to construe after the POPR arguments are submitted. This gaming of the IPR rules must not be allowed or the rules lose their meaning. Moreover, Patent Owners are unduly prejudiced because they can only respond to Petitioner's new claim constructions without being allowed to adjust its arguments presented in the POPR based on the post-POPR claim constructions.

Petitioners' strategy allows it to superficially address claim construction in the Petition knowing the PTAB will liberally grant a reply after the POPR where it will get an opportunity to write an additional 3-6 pages on issues that should have been addressed in the Petition. Here, what is even more prejudicial to the Patent Owner is the Petitioner seeks to construe a claim term that was not addressed in the POPR.

The Board should hold both the Petitioner and the Patent Owner to the same standard, namely the 14,000 word count limitation. Thus, there is no reason to grant Petitioners' request, and if Petitioners' request is granted, to prevent prejudice to the Patent Owner, the Board should (1) limit the reply to thirty-one (31) words - - the difference between the 14,000 word limitation for the Petition and 13,969, the number words already used in the Petition; and (2) grant the Patent Owner thirty (30) days to evaluate the new claim construction and potentially file an Amended POPR and Expert Declaration in view of Petitioners' new claim construction which may contradict, undermine or make moot Patent Owner's original POPR arguments.

3. The Petition provides a discussion of the term "device" in the Claim Construction section of the Petition. (Pet. 12). The Petition instructed the Board; "Petitioners respectfully submit that the Board need not construe any term because the prior art invalidates the claims under any plausible construction, in accordance with 37 C.F.R. 42.100(b)." (Pet. 12, *emphasis added*). Petitioners' admission and instructions that the Board need not construe any term are now contradicted by Petitioners' request to file a reply.

4. The Petition also states: "Petitioners submit that regardless of how the claim is interpreted, this Petition presents grounds that invalidate the Challenged Claims." (*Id.*). Any argument provided at this point regarding an element that was not construed by the Patent Owner and in view of Partitioners' statements (*See* Pet. 12) would be improper new arguments forbidden under the IPR and Patent Rules.

5. Given that only four (4) out of twenty-one (21) claims of the patent under attack are at issue in the IPR, it was foreseeable that the Patent Owner would construe terms in their POPR. But, as stated above, Petitioners failed to include a claim construction for any term, including the term "device" in its Petition.

6. Allowing Petitioners' request now is a waste of judicial resources when the Petitioners will have an opportunity to make such arguments if the IPR is instituted. Thus, denial of the pre-institution reply will not unfairly prejudice the Petitioner but will prejudice the Patent Owner for the reasons set forth in Section 2 above.

For these reasons, the Petitioners' request to file a reply should be denied. If the Board requests Patent Owner's substantive arguments to support the denial of Petitioners' request, Patent Owner asks for a briefing schedule for a two-page per side brief regarding why/why not a reply by Petitioners is allowed and necessary.

Patent Owner is available for a call with the Board anytime on March 6 (any time before 2 pm EST), any time on March 7th, or any time on March 10th.

Best regards,

Robert Hart
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From: Becker, Jeff <Jeff.Becker@BakerBotts.com>

Sent: Wednesday, March 5, 2025 3:23 PM

To: Trials@USPTO.GOV

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Subject: IPR2025-00101 - Request for Preliminary Reply

Dear Patent Trial and Appeal Board,

Petitioners in the above-referenced IPR respectfully request authorization to file a 3-page preliminary reply addressing claim construction issues in Patent Owner's Preliminary Response in IPR2025-00101 related to the claim term "device," recited in elements 18[p] and 18[a], which Patent Owner contends requires an integrated and network-enabled device. POPR, p.26. Petitioners would not oppose providing Patent Owner a 3-page sur-reply.

Patent Owner opposes Petitioners' request and has informed Petitioners that Patent Owner will send its own statement. The parties can be available for a conference call with the Board to discuss these issues, if requested, anytime on March 6 (except 3-4 PM ET), anytime on March 7, or anytime on March 10.

Regards,
Jeff Becker
Counsel for Petitioners

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