From:	Director_Discretionary_Decision
To:	Alan Whitehurst; Arvind Jairam; Christopher P. McNett; Chris Leone; Vervain-Phison-MS; Hsuanyeh Chang; Douglas Chin; Peter Yi; Stephen Chow
Cc:	Trials
Subject:	RE: IPR2025-00212
Date:	Friday, May 2, 2025 12:37:05 PM
Attachments:	image001.png image002.png

Counsel –

The "Notice of Referral to the Board Panel" will be expunged. Thank you.

From: Christian Dorman <cdorman@McKoolSmith.com>
Sent: Friday, May 2, 2025 9:53 AM
To: Trials <Trials@USPTO.GOV>
Cc: Alan Whitehurst <awhitehurst@McKoolSmith.com>; Arvind Jairam <ajairam@McKoolSmith.com>; Christopher P. McNett <cmcnett@McKoolSmith.com>; Chris Leone <cleone@McKoolSmith.com>; Vervain-Phison-MS <Vervain-Phison-MS@mckoolsmith.com>; Hsuanyeh Chang <hsuanyeh@hsuanyeh.com>; Douglas Chin <doug.chin@hsuanyeh.com>; Peter Yi <peter.yi@hsuanyeh.com>; Stephen Chow <stephen.y.chow@hsuanyeh.com>
Subject: IPR2025-00212

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IPR2025-00212

Dear Board,

Patent Owner has received the Board's "Notice of Referral to Board Panel," in which the Board "referred [IPR2025-00212] to a Board panel to consider the merits and non-discretionary considerations" because "Patent Owner did not file … a brief [requesting discretionary denial]" in accordance with "the March 26, 2026, memorandum entitled 'Interim Processes for PTAB Workload Management[.]'" IPR2025-00212, Paper 9 (P.T.A.B. Apr. 30, 2025).

Patent Owner respectfully disagrees that it had the opportunity to file a separate brief requesting discretionary denial of institution. The Board's "FAQs for Interim Processes for PTAB Workload Management" explain, in bullet "1" of the "Availability and timing" section, that the "bifurcated process is available in IPRs … in which patent owner files a preliminary response, or the deadline to file a preliminary response occurs, *after* March 26, 2025." *See* https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (emphasis added).

In IPR2025-00212, Patent Owner filed its preliminary response *on* March 26, 2026. *See* IPR2025-00212, Paper 8 (P.T.A.B. Mar. 26, 2025). Based on the guidance provided in the Board's FAQs, Patent Owner respectfully submits that it was not eligible to file a separate brief requesting discretionary denial.

Patent Owner therefore respectfully requests that the Board vacate the "Notice of Referral to Board Panel" and consider the discretionary denial arguments set forth in Patent Owner's preliminary response. *See* IPR2025-00212, Paper 8 at 31-37 (P.T.A.B. Mar. 26, 2025) (arguing that institution should be denied under *Fintiv*).

Patent Owner has conferred with Petitioner, and Petitioner provided the following statement:

> "Petitioner takes no position on Patent Owner's request."

The Parties can be available on May 2nd, or the week of May 5th, if the Board desires a conference call.

Respectfully,
Christian Dorman
Counsel for Patent Owner Vervain, LLC

MCKOOL SMITH

Christian Dorman
Associate
Washington, D.C.
Tel: (202) 370-8328
www.mckoolsmith.com

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