

From: [Director Discretionary Decision](#)
To: [Levine, Howard](#); [Director Discretionary Decision](#)
Cc: [Wong, Ky-Yen](#); [Feigenbaum, David](#); [Swan, Jennifer](#); [LNH IPRs](#); [Davis, George B.](#)
Subject: RE: IPR2025-00248 & IPR2025-00249 -- Request by Patent Owner to file Replies to Petitioner's Oppositions
Date: Friday, June 6, 2025 1:54:09 PM

Petitioner is authorized to file a 5-page sur-reply in IPR2025-00248 and IPR2025-00249, due no later than Friday, June 13, 2025, limited to addressing arguments made in Patent Owner's reply briefs.

From: Levine, Howard <howard.levine@hoganlovells.com>
Sent: Thursday, June 5, 2025 5:57 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Wong, Ky-Yen <ky-yen.wong@hoganlovells.com>; Feigenbaum, David <david.feigenbaum@hoganlovells.com>; Swan, Jennifer <Jennifer.Swan@hoganlovells.com>; LNH IPRs <LNH_IPRs@mcguirewoods.com>; Davis, George B. <GDavis@mcguirewoods.com>
Subject: RE: IPR2025-00248 & IPR2025-00249 -- Request by Patent Owner to file Replies to Petitioner's Oppositions

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Dear Honorable Director,

As indicated by Patent Owner's email below, Petitioners had opposed Patent Owner's request for a 5-page reply brief. In granting this request, the Director did not have the benefit of Petitioners' position on this issue. The Director's March 26, 2025, memorandum was issued *before* Patent Owner filed its briefs, and Patent Owner chose not to address any of the factors set forth in the memorandum, such as strength on the merits or expert testimony. Petitioners would be very prejudiced if Patent Owner were permitted to raise new factors and legal authority for the first time in reply without affording Petitioners an opportunity to respond. Further, Petitioners' arguments concerning the non-cumulativeness of the art in the Petition were not "unforeseeable," as asserted by Patent Owner, as they closely followed the arguments set forth in the Petition. Accordingly, Petitioners respectfully request a 5-page sur-reply brief to respond to the new positions in Patent Owner's reply briefs by Friday, June 13. There is good cause for this request as set forth above.

Best,

Howard W. Levine

Counsel for Petitioners Embody, Inc. and Zimmer Biomet Holdings, Inc.

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From: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>**Sent:** Thursday, June 5, 2025 3:11 PM**To:** Davis, George B. <GDavis@mcguirewoods.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>**Cc:** Levine, Howard <howard.levine@hoganlovells.com>; Wong, Ky-Yen <ky-yen.wong@hoganlovells.com>; Feigenbaum, David <david.feigenbaum@hoganlovells.com>; Swan, Jennifer <Jennifer.Swan@hoganlovells.com>; LNH IPRs <LNH_IPRs@mcguirewoods.com>**Subject:** RE: IPR2025-00248 & IPR2025-00249 -- Request by Patent Owner to file Replies to Petitioner's Oppositions**[EXTERNAL]**

Patent Owner is authorized to file a 5-page Reply in IPR2025-00248 and IPR2025-00249, due no later than Monday, June 9, 2025, limited to addressing : (1) Petitioner's arguments that the prior art applied in the Petitions is not cumulative to that presented to the Office during prosecution; (2) use of expert testimony and the Director's consideration of merits arguments; and (3) new PTAB precedent in *Ecto World, LLC v. RAI Strategic Holdings, Inc.*

From: Davis, George B. <GDavis@mcguirewoods.com>**Sent:** Thursday, June 5, 2025 12:10 PM**To:** Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>**Cc:** Levine, Howard <howard.levine@hoganlovells.com>; Wong, Ky-Yen <ky-yen.wong@hoganlovells.com>; Feigenbaum, David <david.feigenbaum@hoganlovells.com>; Swan, Jennifer <Jennifer.Swan@hoganlovells.com>; LNH IPRs <LNH_IPRs@mcguirewoods.com>**Subject:** IPR2025-00248 & IPR2025-00249 -- Request by Patent Owner to file Replies to Petitioner's Oppositions

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Dear Honorable Director,

Patent Owner LifeNet Health ("LNH") requests authorization to file 5-page Replies to

Petitioner's Oppositions to LNH's Requests for Discretionary Denial in IPR2025-00248 and IPR2025-00249.

LNH seeks to address: (1) Petitioner's arguments that the prior art applied in the Petitions is not cumulative to that presented to the Office during prosecution; (2) factors identified in the Office's April 25, 2025, [FAQs](#) regarding the bifurcated discretionary denial process, including the appropriate use of expert testimony and the Director's consideration of merits arguments; and (3) new PTAB precedent, *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (May 19, 2025).

Good cause exists because, e.g., Petitioner presents unforeseeable arguments regarding cumulativeness. Moreover, because the Office issued the FAQs and *Ecto World* after Patent Owner's Requests were filed (on April 4, 2025), LNH did not have an opportunity to address that new guidance. Moreover, although LNH did not raise arguments regarding the merits in its Requests for Discretionary Denial, Petitioner devotes three pages of its Opposition to the merits, attempting to cure defects identified in Patent Owner's Preliminary Response. LNH requests an opportunity to respond by no later than June 9.

The undersigned sought agreement from Petitioner's counsel, and Petitioner's counsel has indicated that they oppose Patent Owner's request.

Regards,
George B. Davis
Counsel for Patent Owner LifeNet Health

George B. Davis

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