

From: [Director Discretionary Decision](#)
To: andrew.mason@klarquist.com; [Larochelle, Christie](#); [Director Discretionary Decision](#)
Cc: [DG-X1-IPR](#); [Todd M. Siegel](#); [Amy C. Haspel](#); [Samuel Thacker](#); [Stephanie R. Fulk](#); [Msft-X1-IPRs](#)
Subject: RE: IPR2025-00253, IPR2025-00254, IPR2025-00255
Date: Monday, June 16, 2025 11:30:16 AM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)
[image007.png](#)

Patent Owner is authorized to file a 1-page reply in IPR2025-00253, 00254 and 00255, due no later than, Tuesday, June 17, 2025, limited to addressing the arguments raised below.

Petitioner is authorized to file a 1-page sur-reply in IPR2025-00253, 00254 and 00255, due no later than Wednesday, June 18, 2025, limited to addressing arguments made in Patent Owner's reply brief.

From: Andrew M. Mason <andrew.mason@klarquist.com>
Sent: Friday, June 13, 2025 7:56 PM
To: [Larochelle, Christie <Larochelle.Christie@goodwinlaw.com>](mailto:Larochelle.Christie@goodwinlaw.com); [Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>](mailto:Director_Discretionary_Decision@uspto.gov)
Cc: [DG-X1-IPR <DG-X1-IPR@goodwinlaw.com>](#); [Todd M. Siegel <todd.siegel@klarquist.com>](mailto:todd.siegel@klarquist.com); [Amy C. Haspel <Amy.C.Haspel@klarquist.com>](mailto:Amy.C.Haspel@klarquist.com); [Samuel Thacker <Samuel.Thacker@klarquist.com>](mailto:Samuel.Thacker@klarquist.com); [Stephanie R. Fulk <Stephanie.Fulk@klarquist.com>](mailto:Stephanie.R.Fulk@klarquist.com); [Msft-X1-IPRs <Msft-X1-IPRs@klarquist.com>](#)
Subject: RE: IPR2025-00253, IPR2025-00254, IPR2025-00255

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Dear Director Stewart,

Patent Owner X1's belated request for a "reply" (below) should be rejected and expunged for at least four reasons.

First, the requested relief would violate Rule 42.23(b). Patent Owner seeks a reply to present only new arguments and identifies nothing in the opposition to which it seeks to respond. See 37 CFR § 42.23(b) ("A reply may only respond to arguments raised in the corresponding opposition.").

Second, counsel for Patent Owner did not attempt to meet and confer on this issue. Prior to unilaterally emailing the Board, counsel for Patent Owner never communicated any intent to seek a reply. This failure contradicts the Board's Notices in these IPRs and the Trial Practice Guide. See, e.g., IPR2025-00253, Paper 5 at 7 (emails to the Board "shall" certify that "parties have met and conferred telephonically or in person"); Consol. TPG at 9; TPG at 9 ("Prior to making a request for a conference call, the parties should meet and confer to resolve any disputes.").

Third, Patent Owner improperly presents substantive argument in its email to the Board. See, e.g.,

IPR2025-00253, Paper 5 at 7 (“The email may not contain substantive argument.”).

Fourth, Patent Owner’s request is untimely. Over a month before Patent Owner’s April 28 discretionary denial brief (Paper 7 in each IPR), the Director encouraged parties to address *inter alia* the “[s]ettled expectations of the parties.” Stewart Memo. Interim Processes (March 26, 2025). A belated reply brief is no place for new argument that Patent Owner could have presented in its opening brief.

Respectfully submitted,

Andy Mason
Counsel for Petitioner Microsoft

Andy Mason | Partner

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From: Larochelle, Christie <CLarochelle@goodwinlaw.com>

Sent: Friday, June 13, 2025 1:32 PM

To: Director_Discretionary_Decision@USPTO.gov

Cc: DG-X1-IPR <DG-X1-IPR@goodwinlaw.com>; Todd M. Siegel <todd.siegel@klarquist.com>; Amy C. Haspel <Amy.Haspel@klarquist.com>; Andrew M. Mason <andrew.mason@klarquist.com>; Samuel Thacker <Samuel.Thacker@klarquist.com>

Subject: IPR2025-00253, IPR2025-00254, IPR2025-00255

Dear Director Stewart,

Pursuant to FAQ 16 of the FAQs for Interim Processes for PTAB Workload Management, Patent Owner X1 Discovery, Inc. respectfully requests permission to submit a reply brief in each of the above-captioned IPRs, limited to one page, within one business day of the Director’s approval of this request.

Patent Owner filed Requests for Discretionary Denial in IPR2025-253, IPR2025-254, and IPR2025-255 on April 28, 2025. Petitioner filed Oppositions on May 28, 2025. Since that time, the Director issued several decisions related to the “settled expectations” of the parties that provide additional support for Patent Owner’s Requests for Discretionary Denial. See, e.g., *iRythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) (granting Patent Owner’s Request for Discretionary Denial).

Specifically, Petitioner Microsoft has been aware of U.S. Patent No. 7,370,035, which issued on May 6, 2008, and is challenged in IPR2025-00253, since at least 2008, when Petitioner cited it as one of four references on an Information Disclosure Statement during prosecution of one of its own patents. U.S. Patent Nos. 9,633,139 and 10,552,490, challenged in IPR2025-00254 and -00255, are continuations of

the '035 patent.

Consistent with FAQ 16, counsel for Petitioner is copied on this email.

Respectfully,

Christie Larochelle

Counsel for Patent Owner X1 Discovery, Inc.

Christie L. Larochelle, Ph.D.

she/her/hers



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