

From: [Director_Discretionary_Decision](#)
To: [Yang, Christina Ji-Hye](#); [Saraswat, Anant K.](#); [Director_Discretionary_Decision](#)
Cc: [Nutanix-PTAB](#); [PTAB Anant Saraswat](#); [PTAB Elisabeth Hunt](#)
Subject: RE: IPR2025-00322: Petitioner's Response to Request for Discretionary Denial
Date: Tuesday, June 3, 2025 10:15:16 AM
Attachments: [image001.png](#)

Counsel,

Patent Owner's request to strike pages 13-22 of Petitioner's opposition to Patent Owner's request for discretionary denial is denied and Patent Owner is not authorized to file a reply brief to address the allegedly new arguments. The Director will consider whether Petitioner's opposition includes new arguments on the merits of Petitioner's unpatentability grounds, and to the extent that it does, the Director will not give weight to the new arguments. See FAQs for Interim Process for PTAB Workload Management ("FAQ") No. 25 ("The parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing."). Please note that if the Director determines that discretionary denial is not appropriate, the Board panel will not consider merits arguments made in the opposition brief for purposes of determining whether or not to institute trial. See FAQ No. 12.

From: Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>
Sent: Friday, May 30, 2025 4:45 PM
To: Saraswat, Anant K. <Anant.Saraswat@WolfGreenfield.com>; [Director_Discretionary_Decision](#) <[Director_Discretionary_Decision@uspto.gov](#)>
Cc: [Nutanix-PTAB](#) <[Nutanix-PTAB@finnegan.com](#)>; [PTAB Anant Saraswat](#) <[ASaraswat-PTAB@WolfGreenfield.com](#)>; [PTAB Elisabeth Hunt](#) <[EHunt-PTAB@WolfGreenfield.com](#)>
Subject: RE: IPR2025-00322: Petitioner's Response to Request for Discretionary Denial

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Dear Director,

For the record, procedurally Patent Owner followed FAQ #16 in the FAQs for Interim Processes for PTAB Workload Management:

What is the process for requesting a reply brief to a petitioner's discretionary denial opposition brief?

A patent owner who wants to request a reply should send an email request, with a copy to counsel for all parties, to Director_Discretionary_Decision@USPTO.gov.

Sincerely,
Christina Ji-Hye Yang
Counsel for Patent Owner
Reg. No. 79,103

Christina Jihye Yang
Associate

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413

From: Saraswat, Anant K. <Anant.Saraswat@WolfGreenfield.com>

Sent: Friday, May 30, 2025 3:18 PM

To: Director_Discretionary_Decision@USPTO.gov

Cc: Nutanix-PTAB <Nutanix-PTAB@finnegan.com>; PTAB Anant Saraswat <ASaraswat-PTAB@WolfGreenfield.com>; PTAB Elisabeth Hunt <EHunt-PTAB@WolfGreenfield.com>; Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>

Subject: RE: IPR2025-00322: Petitioner's Response to Request for Discretionary Denial

Dear Director,

Petitioner objects to Patent Owner's request as procedurally improper. Patent Owner made no attempt to meet and confer with Petitioner's counsel prior to sending the email below. Petitioner also opposes Patent Owner's request as baseless. The Interim Processes for PTAB Workload Management expressly permit a petitioner to address any considerations relevant to discretionary denial, including the strength of the unpatentability grounds, regardless of the patent owner's choice to forego addressing that issue in patent owner's brief. See March 26, 2025 Memorandum at 2 ("the parties are permitted to address all relevant considerations, which may include: ... The strength of the unpatentability challenge"). See also 37 C.F.R. § 42.23(b) (limiting only the scope of a "reply," and not the arguments that may be raised in an "opposition").

Regards,



Anant Saraswat

He/Him/His

Shareholder

Admitted to Practice: MA; U.S. Patent Office

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From: Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>

Sent: Friday, May 30, 2025 1:36 PM

To: Director_Discretionary_Decision@USPTO.gov

Cc: Nutanix-PTAB <Nutanix-PTAB@finnegan.com>; PTAB Anant Saraswat <ASaraswat-PTAB@WolfGreenfield.com>; PTAB Elisabeth Hunt <EHunt-PTAB@WolfGreenfield.com>

Subject: IPR2025-00322: Petitioner's Response to Request for Discretionary Denial

Dear Director,

Patent Owner respectfully requests that the Director strike pages 13 to 22 of Petitioner's response to Patent Owner's request for discretionary denial (Paper 13), which include new arguments on the merits of Petitioner's

unpatentability grounds raised for the first time in its response to the discretionary denial brief, which are not responsive to any issues addressed in Patent Owner's request for discretionary denial (Paper 12). In the alternative, Patent Owner requests authorization to submit a reply brief to address the new arguments. Good cause exists given the unique posture of this case.

For context, the POPR in this IPR was due a few days after the Director issued Interim Processes for PTAB Workload Management on March 26, 2025. As a result, Patent Owner's discretionary denial brief in this IPR was due *after* the Patent Owner submitted its POPR. Before the Patent Owner's discretionary denial was due, Petitioner had already requested and was authorized to submit a pre-institution reply on a limited issue, and Petitioner never sought a pre-institution reply to defend the alleged "background knowledge" of a POSA, as it did on pages 13-22 of Paper 13. In the discretionary denial brief, Patent Owner did not address the strength of Petitioner's unpatentability challenge. *See generally* Paper 12. In its response, however, Petitioner spent nearly 10 pages addressing the merits of its grounds, addressing arguments raised in the POPR and explaining why it believes that the disputed claim element is disclosed in the asserted references and distinguishing the cases cited in the POPR.

Given the unique posture of this IPR coupled with Petitioner's new arguments that Patent Owner never had a chance to address, Patent Owner respectfully requests that the Director either strike the new arguments on pages 13-22 of Paper 13 or authorize Patent Owner to address them in a reply brief.

Sincerely,
Christina Ji-Hye Yang
Counsel for Patent Owner
Reg. No. 79,103

Christina JiHye Yang
Associate

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