

From: [Trials](#)
To: [Jo Dale Carothers](#); [Trials](#); [Pisano, Nicola](#)
Cc: [Eric A. Caligiuri](#); [Worley, Regis](#)
Subject: RE: Request For Authorization to File Reply to POPR - IPR2025-00436 - '024 Patent
Date: Tuesday, July 1, 2025 8:50:24 AM

Counsel,

Petitioner's request for authorization to file a reply brief in response to Patent Owner's preliminary response is denied.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Jo Dale Carothers <JCarothers@weintraub.com>
Sent: Wednesday, June 4, 2025 5:18 PM
To: Trials <Trials@USPTO.GOV>; Pisano, Nicola <nicolapisano@eversheds-sutherland.com>
Cc: Eric A. Caligiuri <ECaligiuri@weintraub.com>; Worley, Regis <regisworley@eversheds-sutherland.com>
Subject: RE: Request For Authorization to File Reply to POPR - IPR2025-00436 - '024 Patent

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Dear Mr. Kellogg,

By way of this email, Patent Owner responds with its position as to Petitioner's request. A reply brief is unnecessary to address the arguments set forth in Patent Owner's Preliminary Response ("POPR"). Specifically, Patent Owner responds to each of Petitioner's asserted reasons for good cause as follows:

1. Patent Owner merely responded and countered Petitioner's argument that Mizobuchi anticipates claims of the '024 patent. Specifically, Patent Owner responded by pointing out that a claim limitation is missing under what Patent Owner currently understands to be the plain and ordinary meaning of the claim limitation.
2. Patent Owner applied what it believes to be the plain and ordinary meaning of terms at the time of the filing of the POTR. In the District Court, no expert opined on the claim terms and no claim terms have been construed by the District Court yet. Therefore, there are no claim constructions or expert opinions from that case for the PTAB to consider at this time.

3. Patent Owner included in its POPR the arguments it deemed proper and appropriate in order to provide a complete brief to the Board. Petitioner does not need a reply brief to make this point.
4. Patent Owner's comment as to "100% odds" of a stay is purely argumentative, not factual, and clearly not correct. There is no pending motion to stay in the Additional Litigation, which involves an unrelated and different defendant. To the contrary, the parties in the Additional Litigation informed the Court of the pending IPRs (see attached). In response, the Court has taken no action to stay the case and has not indicated any intent to do so. Instead, the Court thereafter set a series of dates in the Additional Litigation at the Case Management Conference (See Paper 10 at pp. 7-8)

Petitioner's reasons do not demonstrate the required good cause for Petitioner to be granted a reply. There is no prejudice to Petitioner and allowing Petitioner to submit new arguments in a reply brief is both inappropriate and potentially prejudicial to Patent Owner. Therefore, a reply is unwarranted and unnecessary.

Regards,
Jo Dale Carothers

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, June 3, 2025 12:17 PM
To: Pisano, Nicola <nicolapisano@eversheds-sutherland.com>; Trials <Trials@USPTO.GOV>
Cc: Jo Dale Carothers <JCarothers@weintraub.com>; Eric A. Caligiuri <ECaligiuri@weintraub.com>; Worley, Regis <regisworley@eversheds-sutherland.com>
Subject: [EXTERNAL] RE: Request For Authorization to File Reply to POPR - IPR2025-00436 - '024 Patent

Counsel,

Patent Owner may respond with its position as to Petitioner's request via email by Wednesday, June 4th.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Pisano, Nicola <nicolapisano@eversheds-sutherland.com>
Sent: Monday, June 2, 2025 3:44 PM
To: Trials <Trials@USPTO.GOV>

Cc: jcarothers@weintraub.com; ecaligiuri@weintraub.com; Worley, Regis <regisworley@eversheds-sutherland.com>

Subject: Request For Authorization to File Reply to POPR - IPR2025-00436 - '024 Patent

Importance: High

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Dear Patent Trial Board:

Petitioner requests authorization to file a short reply brief to address the arguments set forth in Patent Owner's Preliminary Response ("POPR").

Good reason for filing the proposed response exists because :

1. Patent Owner presents new arguments that the prior art does not meet the claim terms using its new and undefined claim terms (Paper No. 10 at 19-20)
 - a. Whether the prior art discloses "a light engine driving circuit" depends upon construction of that term. In the district court litigation, Patent Owner identified that "circuit" variously as circuit board traces (Ex. 1013 at 10-11 - identifying circuit traces) and an EML driver (Ex. 1010 at 11); in the POPR, Patent Owner argues that circuit disclosed in Mizobuchi as located on the substrate for controlling the light engine is **not** the claimed term, but instead corresponds to a different IC located in the hermetically sealed housing. See Paper No. 10 at 22 and compare, Paper No. 9 at 13-17 and Ex. 1014..
2. Patent Owner argues for a "plain and ordinary" meaning **different** than it applied in its infringement contentions before the District Court (See Paper No. 9 at 13-14);
3. the POPR disregards PTAB guidance (see Exhibit 1012 at 4) not to replicate in the POPR arguments from Patent Owner's discretionary denial request brief;
4. Patent Owner's arguments ignore the 100% odds that the Additional Litigation (not involving Petitioner) will be stayed (See Ex. 1011, ¶¶ 4-8 and Ex. H).

Respectfully, it would be prejudicial not to permit Petitioner to respond to the Patent Owner's continually shifting sands approach to claim construction, or alternatively, for the Board to consider the merits-related arguments set forth in Petitioner's Opposition (Paper No. 9 at 12-20 and Exs. 1011-1014) submitted in response to PO's discretionary denial briefing.

Petitioner's counsel is available for a conference call to discuss this request at the Board's convenience. (Both Petitioner's and Patent Owner's counsel are located in California and request that a conference call, if scheduled, be set for 11:00 am Eastern, 8:00 am Pacific or later).

Respectfully submitted,

Nicola Pisano | San Diego Office Partner In Charge

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[Biography](#)

Eversheds Sutherland

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