

**From:** [Michael Hawkins](#)  
**To:** [Trials](#)  
**Cc:** [IPR58498-0003IP2](#); [Trenton.Ward@gtlaw.com](mailto:Trenton.Ward@gtlaw.com); [Elana.Araj@gtlaw.com](mailto:Elana.Araj@gtlaw.com); [gilfordb@gtlaw.com](mailto:gilfordb@gtlaw.com); [girinathp@gtlaw.com](mailto:girinathp@gtlaw.com); [BriggsH@gtlaw.com](mailto:BriggsH@gtlaw.com)  
**Subject:** IPR2024-01296  
**Date:** Saturday, June 7, 2025 9:53:20 AM  
**Attachments:** [image001.png](#)

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Dear Board,

In light of the Board's institution decision followed by Patent Owner's election to forego any Response (see below and Exhibit 3001), Petitioner is notifying the Board that it will not file any Petitioner's Reply in this proceeding.

Additionally, both Petitioner and Patent Owner conferred and jointly agreed to not request any oral argument in this proceeding.

As such, there are no further papers or due dates remaining in this case. The parties will await the Board's final written decision.

**Michael Hawkins**

Principal ■ Fish & Richardson P.C.

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Tuesday, May 27, 2025 11:59 AM  
**To:** [BriggsH@gtlaw.com](mailto:BriggsH@gtlaw.com); Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Michael Hawkins <[hawkins@fr.com](mailto:hawkins@fr.com)>; IPR58498-0003IP2 <[IPR58498-0003IP2@fr.com](mailto:IPR58498-0003IP2@fr.com)>; IPR58498-0005IP1 <[IPR58498-0005IP1@fr.com](mailto:IPR58498-0005IP1@fr.com)>; IPR58498-0004IP1 <[IPR58498-0004IP1@fr.com](mailto:IPR58498-0004IP1@fr.com)>; [Willow-IPRs@gtlaw.com](mailto:Willow-IPRs@gtlaw.com); Craig A. Deutsch <[deutsch@fr.com](mailto:deutsch@fr.com)>; Terry J. Stalford <[Stalford@fr.com](mailto:Stalford@fr.com)>; Eric Peng <[epeng@fr.com](mailto:epeng@fr.com)>; Ryan Chowdhury <[rchowdhury@fr.com](mailto:rchowdhury@fr.com)>  
**Subject:** RE: Patent Owner's Notice of Election Not to File a POR (IPR2024-01296)

[This email originated outside of F&R.]

Counsel,

This is in response to the email sent May 21, 2025, from counsel for Patent Owner informing the Board that Patent Owner “has elected not to file a Patent Owner Response” in IPR2024-01296. As correctly noted by Patent Owner’s counsel, the Scheduling Order in this proceeding *requires* Patent Owner to arrange a conference call to discuss Patent Owner’s election not to file a Response. See Paper 10 at 9 (“If Patent Owner elects not to file a response, Patent Owner *must* arrange a conference call with the parties and the Board.” (emphasis added)). Our Consolidated Trial Practice Guide (2019) also refers to the necessity of a conference call if Patent Owner elects not to file a Response. See Consol. TPG Consol. 66 (citing 37 CFR 42.73(b)).

The Board appreciates counsel’s notice that a Patent Owner Response will not be filed. We determine that a conference call is *not* necessary to further discuss this matter. Patent Owner’s election not to file a Response does not change or diminish Petitioner’s burden of proof. See, e.g., *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”). Also, we do not draw any adverse inference from Patent Owner’s election. Specifically, we do not consider this to be a request for adverse judgment. We remind Patent Owner, however, as stated in the Scheduling Order, “Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.” Paper 10 at 9.

If Patent Owner has other issues it would like to discuss with the Board regarding the election not to file a Patent Owner Response, it should renew its request for a conference call.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
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**From:** [BriggsH@gtlaw.com](mailto:BriggsH@gtlaw.com) <[BriggsH@gtlaw.com](mailto:BriggsH@gtlaw.com)>  
**Sent:** Wednesday, May 21, 2025 2:44 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [hawkins@fr.com](mailto:hawkins@fr.com); [IPR58498-0003IP2@fr.com](mailto:IPR58498-0003IP2@fr.com); [IPR58498-0004IP1@fr.com](mailto:IPR58498-0004IP1@fr.com); [Willow-IPRs@gtlaw.com](mailto:Willow-IPRs@gtlaw.com); [deutsch@fr.com](mailto:deutsch@fr.com); [stalford@fr.com](mailto:stalford@fr.com); [epeng@fr.com](mailto:epeng@fr.com); [rchowdhury@fr.com](mailto:rchowdhury@fr.com); [BriggsH@gtlaw.com](mailto:BriggsH@gtlaw.com)  
**Subject:** Patent Owner's Notice of Election Not to File a POR (IPR2024-01296)

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Dear Honorable Board:

Pursuant to the Scheduling Order in this matter, Patent Owner is notifying the Board that Patent Owner has elected not to file a Patent Owner Response (POR) in this proceeding. (Paper 10 at 9 (“If Patent Owner elects not to file a response, Patent Owner must arrange a conference call with the parties and the Board.”).)

Should a conference call be required to discuss Patent Owner’s election, the parties are available at the below dates and times:

- May 27: 10-11 AM and 1-5 PM
- May 28: 11-1 and 2-5 PM
- May 29: 1-5 PM

As additional background, a Motion for Withdrawal and Substitution of Counsel is currently pending, which requests the replacement of prior counsel with attorneys from Greenberg Traurig, including the undersigned. Counsel for Patent Owner would be grateful if a decision on that Motion was entered prior to any call with the Board.

Sincerely,

**Heath Briggs**

Global Co-Chair Patents and Innovation Group

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