

From: [Director Discretionary Decision](#)
To: [Christopher Gallo](#); [Director Discretionary Decision](#)
Cc: [Eldora Ellison](#); [Olga Partington](#); [PTAB Account](#); [Christopher Roth](#); [Robert F. Altherr](#); [John Iwanicki](#); [ValnevaIPRService](#)
Subject: RE: IPR2025-00776
Date: Wednesday, July 30, 2025 8:51:19 AM
Attachments: [image001.png](#)
[image002.png](#)

Patent Owner's request to file a reply to Petitioner's opposition brief on discretionary issues is denied. The request for a supplemental Patent Owner Preliminary Response is referred to the Board panel to decide.

From: Christopher Gallo <CGALLO@sternekessler.com>
Sent: Tuesday, July 29, 2025 2:48 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
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Subject: IPR2025-00776

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Honorable Director,

Patent Owner filed its brief requesting discretionary denial in the above-captioned proceeding on June 18, 2025 (Paper 6) and its Preliminary Patent Owner Response on July 18, 2025 (Paper 7). Shortly after Patent Owner filed its preliminary response, Petitioner filed its brief in opposition to Patent Owner's request for discretionary denial (Paper 8). In its opposition brief, Petitioner accuses Patent Owner and its expert, Dr. Dan Barouch, of violating their duty of candor to the Office in view of the Schuller reference (EX1036) submitted by Petitioner with its opposition brief and Dr. Barouch's previously submitted declaration in IPR2023-00354 and his declaration in support of Patent Owner's discretionary denial brief submitted in this proceeding (EX2001). Patent Owner and Petitioner have conferred and provide the following positions.

Patent Owner's Position:

Given Petitioner's accusations, Patent Owner believes there is good cause to request authorization to file a 5,600-word reply to Petitioner's opposition brief to address Petitioner's unfounded accusations in view of the Schuller reference Petitioner has newly raised in this proceeding and Dr. Barouch's declaration from IPR2023-00354 and his declaration in support of Patent Owner's discretionary denial brief in this proceeding. See Interim Processes for PTAB Workload Management, dated March 26, 2025, at 2; FAQs for Interim Processes for PTAB Workload Management at FAQ 16, available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

Patent Owner does not oppose Petitioner getting a sur-reply of equal length. Given that the Petition may be referred to the Board, Patent Owner notes that it will also be simultaneously requesting authorization from the Board to file a 7-page Supplemental Preliminary Patent Owner Response.

Petitioner's Position:

Petitioner opposes both this and Patent Owner's request to the Board for a supplemental preliminary patent owner response pursuant to Rule 42.5. This request appears substantively duplicative of the basis for requesting a supplemental preliminary patent owner response and is not only an inefficient use of the Director's and/or Board's resources, but also facially improper as Patent Owner is blatantly requesting multiple bites at the same apple and will simply incur further duplicative, costly and inefficient preliminary proceedings in an otherwise straight-forward process where Patent Owner can provide the substance of its requested additional briefing in its upcoming response upon institution. Accordingly, both this and Patent Owner's substantively duplicative request to the Board should be singularly considered and decided by either the Director or the Board but not both. Should it be determined that this and Patent Owner's duplicative request to the Board be granted, Petitioner submits that not more than a single paper responsive to both requests is necessary or appropriate. The sole issue is whether patent owner, its counsel and its expert made contradictory statements in this IPR as to the true state of the prior art and withheld the Schuller reference of which they were well aware based on their statements and citation of Schuller in the earlier IPR, in violation of their duty of candor. It is beyond dispute that patent owner, its counsel and its expert were aware of Schuller's teachings. This issue should take no more than 5 pages for patent owner, its counsel and its expert to explain why each did not violate its duty of candor. Should Patent Owner's request be granted, Petitioner would further request a response of equal length to any granted request.

Parties' Availability:

If the Director wishes to discuss any issues regarding this request with the parties, the parties can make themselves available for a conference call from 2-5 pm on Thursday, July 31, 2025 and 9 am-12 pm on Friday, August 1, 2025.

Respectfully,
Christopher Gallo
Back-Up Counsel for Patent Owner



Christopher Gallo, Ph.D. (he/him)
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