

From: [Director Discretionary Decision](#)
To: [Torczon, Richard \(External\)](#); Inge.Osman@lw.com; [Director Discretionary Decision](#)
Cc: Michael.Morin@lw.com; David.Frazier@lw.com; Michelle.Ernst@lw.com; Raghav.Bajaj@lw.com; Ashley.Fry@lw.com; hostettler_danica@lilly.com; barkoff_aaron@lilly.com; Lauren.Rosen@lw.com; [Mills, Jad](mailto:Mills_Jad); Rosato, Michael; Bresnahan, Matthew; 4918-6720-7954@mail.vault.netdocuments.com
Subject: RE: IPR2025-01024: Discretionary Denial Reply Request
Date: Tuesday, September 30, 2025 8:40:44 AM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)

Patent Owner is authorized to file a 5-page reply in IPR2025-01024 due no later than Thursday, October 2, 2025, limited to addressing the arguments raised below. Patent Owner may file the exhibits. Petitioner is authorized to file a 5-page sur-reply due no later than Monday, October 6, 2025.

From: Torczon, Richard <rtorczon@wsgr.com>
Sent: Monday, September 29, 2025 3:55 PM
To: Inge.Osman@lw.com; [Director_Discretionary_Decision](#) <Director_Discretionary_Decision@uspto.gov>
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Subject: RE: IPR2025-01024: Discretionary Denial Reply Request

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Dear Honorable Director,

Petitioner objects to Patent Owner's requests as improper and unjustified. Patent Owner first raised the issue of discretionary denial reply briefing on Friday, issuing only vague and unsupported allegations of "new" arguments in Petitioner's discretionary denial opposition but failing to identify **any** arguments allegedly at issue. Petitioner responded by offering to meet and confer and by asking Patent Owner to identify the allegedly "new" arguments. Patent Owner waited until Sunday evening to respond, insisted on meeting at 9am Pacific (where conferee Jad Mills is located, see attachment) and contacting the Director shortly afterward (leaving Petitioner's counsel no opportunity for counsel to confer with Petitioner), and raised an entirely new request to submit a new exhibit (but not sending the proposed exhibit). Petitioner asked Patent Owner to send

over the new exhibit before the meet and confer but Patent Owner waited until after the meet and confer. Petitioner thus has had very little time to evaluate the exhibit or even to identify its location on Patent Center (where Patent Owner represents obtaining it). Despite our repeated requests to have the time to evaluate Patent Owner's requests and consult with our client (see attached), Patent Owner insisted on submitted its requests today before Petitioner could respond.

Patent Owner's broad requests misidentify as "new" Petitioner arguments that were squarely raised in the petition materials (as shown by repeated citations throughout Petitioner's discretionary-denial briefing), and which were directly responsive to Patent Owner's discretionary-denial brief. Patent Owner also fails to justify the length of its requested reply based on two Board cases briefly referenced in Petitioner's Opposition, and fails to explain why its 11th-hour record supplementation was not included with its discretionary-denial request or its preliminary response. In short, Patent Owner's request appears to be a blatant attempt to sandbag Petitioner and to re-do the parties' already-completed briefing. Accordingly, Petitioner objects to Patent Owner's actions and is left without any basis to acquiesce to Patent Owner's requests.

If, however, the Director determines that Patent Owner demonstrates good cause for reply briefing, Petitioner requests authorization of sur-reply briefing of equal size, **and equal time to prepare such briefing** as Patent Owner had from service of Petitioner's discretionary-denial opposition brief (served September 22) until service of Patent Owner's reply brief.

Respectfully,

/Richard Torczon/

Richard Torczon, Reg. No. 34,448

Counsel for Petitioner

WILSON SONSINI

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From: Inge.Osman@lw.com <Inge.Osman@lw.com>

Sent: Monday, 29 September 2025 15.40

To: Director_Discretionary_Decision@uspto.gov

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Subject: IPR2025-01024: Discretionary Denial Reply Request

EXT - inge.osman@lw.com

Dear Honorable Director,

Patent Owner Eli Lilly & Co. respectfully requests leave to file a Reply to Petitioner's Opposition to Patent Owner's Discretionary Denial Request (Paper 11) along with an Exhibit providing relevant portions of the prosecution history for the '780 Patent not included within Exhibit 1004, the "Excerpts" of the prosecution history filed by Petitioner.

Good cause exists to file a Reply to provide the Director additional information relevant to the Director's decision to exercise discretion. Specifically, Patent Owner intends to address the following issues in Reply:

1. Petitioner's argument against Patent Owner's settled expectations (Paper 11, pp. 50-63).
2. Petitioner's § 325(d)/*Advanced Bionics* argument (Paper 11, pp. 9-50), including Petitioner's related merits arguments (e.g., Paper 11, 41-48).

Although the Petition briefly addressed alleged Office error (Petition, Paper 2, pp. 7-8), the discussion of the Office's alleged error in Petitioner's Opposition contains numerous new arguments, including multiple merits arguments that do not appear in the Petition or conflict with the Petition. Fairness dictates that Patent Owner be given an opportunity to respond to these new arguments raised by Petitioner for the first time in Petitioner's Opposition.

Further, Patent Owner respectfully requests leave to submit an exhibit with relevant portions of the '780 patent's prosecution history that were omitted from the "Excerpts" filed by Petitioner as Exhibit 1004 so that the Director may decide discretionary denial based on the full record. The omitted portions of the prosecution history directly refute Petitioner's assertion that there is "no indication" that asserted prior art reference Alsina-Fernandez was "ever involved" in prosecution. Opp. 19-20.

Additionally, with respect to Petitioner's settled expectations arguments, Petitioner raises new arguments, including arguments citing decisions issued after Patent Owner's brief was filed and policy arguments, that could not have been reasonably foreseen; Patent Owner requests leave to address these new arguments in its Reply.

Given the extensive length of Petitioner's argument on these topics, Patent Owner requests 10 pages for its Reply, and requests that its Reply be due 5 business days after authorization. Patent Owner would not object to Petitioner filing a sur-reply of equal length 5 business days after Patent Owner files its Reply.

Patent Owner requested Petitioner's position on its request on Friday, September 26, 2025, after which Petitioner requested that Patent Owner identify with particularity the arguments to be made in Patent Owner's reply. Patent Owner provided Petitioner that information on Sunday, September 28, 2025, and a meet and confer between counsel for the parties occurred by telephone today, September 29, 2025, so that Patent Owner could obtain Petitioner's position on this request. After the meet and confer, and after Patent Owner had provided the relevant omitted portion of the file history, Petitioner indicated that it anticipated being able to respond to Patent Owner's request and provide its position by tomorrow. However, we are making this request now in view of the expedited timeline under which the Director issues decisions on discretionary considerations (see Interim Director Discretionary Process, § V.A.).

Patent Owner is available for a conference call, if requested, at the Director's convenience.

Respectfully,

Inge Osman
Counsel for Patent Owner

Inge A. Osman

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