

From: [Director Discretionary Decision](#)
To: "Brandon R. Theiss"
Cc: [Director DI](#); "AA Intellectual Ventures"; "SWA-IV"; "Daniel H. Golub"; "Heather L. King"; "kharden@munckwilson.com"; "cshomaker@mckoolsmith.com"; "jcampbell@mckoolsmith.com"; [Director DI](#)
Subject: RE: IPR2025-01509- Patent Owner's Request for Authorization to Respond to Petitioners' Brief in Opposition to Patent Owner's Request for Discretionary Denial
Date: Wednesday, January 14, 2026 12:18:00 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)

Patent Owner is authorized to file a 5-page reply in IPR2025-01509, due no later than Friday, January 17, 2026, limited to addressing the arguments raised below. Petitioner is authorized a 5-page sur-reply, due no later than Tuesday, January 21, 2026.

From: Brandon R. Theiss <BTheiss@vklaw.com>
Sent: Tuesday, January 13, 2026 9:06 AM
To: Trials <Trials@USPTO.GOV>
Cc: AA_Intellectual_Ventures <AA_Intellectual_Ventures@mckoolsmith.com>; SWA-IV <swa-iv@munckwilson.com>; Daniel H. Golub <DGolub@vklaw.com>; Heather L. King <HKing@vklaw.com>; kharden@munckwilson.com; cshomaker@mckoolsmith.com; jcampbell@mckoolsmith.com
Subject: IPR2025-01509- Patent Owner's Request for Authorization to Respond to Petitioners' Brief in Opposition to Patent Owner's Request for Discretionary Denial

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Dear Honorable Board:

Patent Owner respectfully requests authorization to file a 5-page Reply to "Petitioners' Brief in Opposition to Patent Owner's Request for Discretionary Denial" ("Opposition Brief") (Paper # 9), limited to addressing the arguments advanced by Petitioners on pages 8-9 of the Opposition Brief in support of their position that "[t]here is no risk of inconsistent arguments before the district court proceedings and this proceeding that would disfavor institution."

Good cause exists because the arguments in Petitioners' Opposition Brief that "[t]here is no risk of inconsistent arguments before the district court proceedings and this proceeding that would disfavor institution" are based on developments and assertions that were not reasonably foreseeable when Patent Owner filed its Brief In Support Of Patent Owner's Request For Discretionary Denial ("Brief In Support")(Paper #7) on November 24, 2025. For example, the arguments that "[t]here is no risk of inconsistent arguments" in the Opposition Brief rely on the recent decision in *Caption Health, Inc. v. Univ. of British Columbia*, IPR2025-01422, Paper 15 (Director Dec. 18, 2025), which issued several weeks *after* Patent Owner filed its Brief In Support. Patent Owner could not reasonably have been expected to address in its Brief In Support a decision that had not yet issued at the time that brief was filed. Nor could Patent Owner have reasonably anticipated Petitioners' argument (on page 9 of the Opposition Brief) that the continued assertion by Petitioner American in the district court of an indefiniteness position based on *IPXL Holdings* is *not* inconsistent with Petitioners' claim construction positions in this case. Patent Owner disagrees with that assertion and requests an opportunity to respond to it before a decision on discretionary denial is reached in this case.

Patent Owner requests authorization to file a Reply not exceeding five (5) pages and limited to addressing the arguments advanced by Petitioners on pages 8-9 of the Opposition Brief in support of their position that "[t]here is no risk of inconsistent arguments before the district court proceedings and this proceeding that would disfavor institution." Patent Owner further requests that the response be due within five (5) business days of the Board's authorization, or on such schedule as the Board deems appropriate. Patent Owner does not object to Petitioners' being authorized to file a Sur-Reply of equal length.

Patent Owner attempted to confer with Petitioner. However, Petitioner did not respond to Patent Owner's email.

Regards,



**VOLPE
KOENIG**

Intellectual Property Law

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