

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAGNOLIA MEDICAL TECHNOLOGIES, INC.,

Petitioner

v.

KURIN, INC.,

Patent Owner

IPR2026-00097

Patent No. 12,138,052

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO ITS
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF EXHIBITS

Exhibit No.	Description
2001	Kurin's Motion to Amend Answer and Counterclaims, <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. November 13, 2024).
2002	Kurin's Amended Answer and Counterclaims, <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. November 21, 2024).
2003	Magnolia Medical Tech., Inc.'s Opening Brief in Support of its Motion for Summary Judgment of Invalidity of U.S. Patent No. 12,138,052 under 35 U.S.C. §§102 and 103 (Redacted), <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. August 1, 2025).
2004	Memorandum Order (denying Magnolia's Motion for Summary Judgment), <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. September 2, 2025).
2005	Defendant Kurin, Inc.'s Opening Brief in Support of Daubert Motion to Exclude Testimony of Plaintiff's Expert Carl D. Meinhart, <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. August 1, 2025).
2006	Memorandum Order (excluding certain testimony of Dr. Carl Meinhart), <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. November 3, 2025).
2007	Verdict Form (Redacted), <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. December 16, 2025).
2008	Excerpts from Trial Transcript, <i>Magnolia Medical Technologies, Inc. v. Kurin, Inc.</i> , C.A. No. 24-1124-CFC (D. Del. December 8-16, 2025).
2009	U.S. Pat. No. 9,155,495.

2010	Highlighted copy of U.S. Pat. No. 12,138,052 (EX1001).
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Patent Owner Kurin respectfully submits this reply to Petitioner's Opposition ("Pet. Opp.") to Patent Owner's request for discretionary denial. This reply is authorized per the Board's correspondence of March 5, 2026. EX3102.

Petitioner Magnolia alleges in its Opposition that Kurin failed to submit the Bullington800 reference during prosecution, and that the "omission of this art is all the more glaring given the history of the parties." Pet. Opp., p. 3. Magnolia alleges that there was significant contact between Magnolia and Kurin's CEO (Bob Rogers) during the 2013-2015 timeframe, and that in February of 2023, Magnolia even sent Bob Rogers a letter purporting to list patents and applications "relevant to the work being done by Patent Owner." *Id.* at pp. 3-4. Magnolia concludes: "[t]he inclusion of the application that published as Bullington800 in the February 23 letter and Mr. Rogers's long-standing general knowledge of Petitioner's intellectual property demonstrate that Patent Owner reasonably should have known about Bullington800." Pet. Opp., p. 4.

Magnolia's assertions, however, are not as faithful to reality as might be hoped. First, the fact that Bullington800 was not specifically cited during prosecution is hardly "glaring", because the earliest U.S. members of the *same family* were cited. Specifically, Bullington800 claims priority to U.S. Prov. App. 61/731,620 (EX1012, cover), as does U.S. App. Ser. No. 14/094,073 filed on the same day as the PCT application leading to Bullington800 (Dec. 2, 2013). The '073

application was published as U.S. Pat. App. Pub. 2014/0163419 A1 and issued as U.S. Pat. No. 9,155,495 (EX2009). Both of these documents were cited during the prosecution of the '052 patent. *See* EX2010 (a copy of the '052 patent with the citations in the bibliography highlighted).

Bullington800 does contain some additional disclosure (on which Magnolia relies in its Petition) over the cited U.S. 9,155,495, but it is difficult for those not privy to Magnolia's patent drafting strategy to know of the additional disclosure without doing a paragraph-by-paragraph comparison of each new Magnolia application. The added material in Bullington800 is a relatively small insertion in the middle of the application (§§1107-1127 and Figs. 16 and 17). The addition is not visible from the application metadata—Bullington800 was filed as a PCT application, not a continuation-in-part. From the outside, there is simply no reason to suspect that there would be any difference between the disclosures of a PCT application and a corresponding U.S. utility application filed on the same day, claiming priority to the same provisional application.

Magnolia may argue that the surreptitious nature of the differences between Bullington800 and other family members is immaterial, because Magnolia warned Kurin's CEO in a letter that Bullington800, among other applications, was "relevant to the work being done by Patent Owner." Pet. Opp., p. 4. But this too is a stretch. The letter in question (EX1041) has a 13-page table listing 279 unique patent

applications (and 70 duplicates) without specifically calling out Bullington800, much less its uniquely-modified disclosure within its family. Moreover, the letter is clearly not meant to point out prior art, but rather by its very terms, relates to potential future patent enforcement. EX1041, p. 1.

Magnolia's allegations that Bob Rogers (Kurin's CEO) was involved with Magnolia in the 2013-2015 timeframe are not only of questionable relevance beyond atmospherics, but are also significantly overstated. Mr. Rogers was not an advisor to Magnolia, and had extremely limited interactions with Mr. Bullington during the 2013-2015 period of time (or otherwise). *See* EX1043, 753:2-762:24 (Rogers testimony).

Nor is this a case where Magnolia's innuendo might prove better-founded upon further investigation. The full investigation has been done. Magnolia had the powers of district-court discovery at its disposal for more than a year in the recently-completed district court litigation involving the '052 patent. But after access to thousands of pages of Kurin's internal documentation and days of testimony from Kurin's witnesses, Magnolia elected not to pursue an inequitable conduct theory. What the Board sees in Magnolia's briefing—vague insinuations based on mischaracterized events occurring years apart—is the most Magnolia can make of its claim. But it is not enough to obscure the deficiencies in the Petition, nor the circumstances surrounding Magnolia's challenge that merit a denial of institution.

Date: <u>March 9, 2026</u>	<u>/Matthew A. Smith/ (RN 49,003)</u> Matthew A. Smith SMITH BALUCH LLP 700 Pennsylvania Ave SE Ste. 2060 Washington, DC 20003 (202) 669-6207 smith@smithbaluch.com <i>Counsel for Patent Owner Kurin, Inc.</i>
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Reply to Petitioner's Opposition to Discretionary Denial, was served by email on the Patent Owner's counsel of record at the United States Patent & Trademark Office having the following addresses:

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Date: March 9, 2026

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