

From: [Director Discretionary Decision](#)
To: [Richard M. Bemben](#); [Director Discretionary Decision](#); [René Vazquez](#)
Cc: [David Haars](#); [Rob Sokohl](#); [Justin Wang](#); [PTAB Account](#)
Subject: RE: IPR2026-00316 (Patent No. 11,664,123) — Patent Owner's Request for Authorization to File a Reply to Petitioner's Opposition to Discretionary Denial Brief
Date: Monday, August 31, 2026 12:18:34 PM

Petitioner's request is granted.

From: Richard M. Bemben <RBEMBEN@sternekessler.com>
Sent: Monday, August 31, 2026 11:46 AM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>; René Vazquez <rvazquez@dnlzito.com>
Cc: David Haars <DHaars@sternekessler.com>; Rob Sokohl <RSOKOHL@sternekessler.com>; Justin Wang <JWang@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2026-00316 (Patent No. 11,664,123) — Patent Owner's Request for Authorization to File a Reply to Petitioner's Opposition to Discretionary Denial Brief

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Honorable Director,

Because Monday, September 7, 2026, is Labor Day, Petitioner respectfully requests that its brief be due on Wednesday, September 9, 2026, so that each party has at least three business days to prepare its brief.

Respectfully,
Richard Bemben
Counsel for Petitioner

From: Director_Discretionary_Decision <[Director_Discretionary_Decision@uspto.gov](#)>
Sent: Monday, August 31, 2026 11:03 AM
To: Richard M. Bemben <[RBEMBEN@sternekessler.com](#)>; René Vazquez <[rvazquez@dnlzito.com](#)>; Director_Discretionary_Decision <[Director_Discretionary_Decision@uspto.gov](#)>
Cc: David Haars <[DHaars@sternekessler.com](#)>; Rob Sokohl <[RSOKOHL@sternekessler.com](#)>; Justin Wang <[JWang@sternekessler.com](#)>; PTAB Account <[PTAB@sternekessler.com](#)>
Subject: RE: IPR2026-00316 (Patent No. 11,664,123) — Patent Owner's Request for Authorization to File a Reply to Petitioner's Opposition to Discretionary Denial Brief

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Patent Owner is authorized to file a 5-page reply in IPR2026-00316, due no later than Thursday, September 3, 2026, limited to addressing the matters raised below. Petitioner is authorized to file a 5-page sur-reply, due no later than Tuesday, September 8, 2026.

From: Richard M. Bemben <RBEMBEN@sternekessler.com>
Sent: Monday, August 31, 2026 10:06 AM
To: René Vazquez <rvazquez@dnlzito.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: David Haars <DHaars@sternekessler.com>; Rob Sokohl <RSOKOHL@sternekessler.com>; Justin Wang <JWang@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2026-00316 (Patent No. 11,664,123) — Patent Owner's Request for Authorization to File a Reply to Petitioner's Opposition to Discretionary Denial Brief

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Honorable Director,

The parties did not confer regarding Patent Owner's request, and Petitioner disagrees that good cause exists for additional briefing. Patent Owner argues that good cause exists because it allegedly did not have an opportunity to address material error in the prosecution history. But whether the Office erred during prosecution, including with respect to the examiner's search, was a well-established discretionary denial consideration long before Patent Owner filed their request for discretionary denial on July 21, 2026. Patent Owner could have addressed the adequacy of the examiner's search in their request. Petitioner also disagrees with the substantive arguments that Patent Owner raised in their email.

To the extent briefing is granted, Petitioner requests it be limited to two pages of additional briefing for each party (i.e., a Reply by Patent Owner and a Sur-reply by Petitioner), which is commensurate with the issue Patent Owner raised.

Respectfully,
Richard Bemben
Counsel for Petitioner

From: René Vazquez <rvazquez@dnlzito.com>
Sent: Friday, August 28, 2026 4:37 PM
To: Director_Discretionary_Decision@uspto.gov
Cc: Richard M. Bemben <RBEMBEN@sternekessler.com>; David Haars <DHaars@sternekessler.com>; Rob Sokohl <RSOKOHL@sternekessler.com>; Justin Wang <JWang@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: IPR2026-00316 (Patent No. 11,664,123) — Patent Owner's Request for Authorization to File a Reply to Petitioner's Opposition to Discretionary Denial Brief

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Dear Director:

Pursuant to Section IV of the Interim Director Discretionary Process, Patent Owner iScan2D Technologies, LLC respectfully requests authorization to file a reply of no more than five pages to Petitioner's Opposition to Patent Owner's Discretionary Denial Brief (Paper [8]), filed August 26, 2026. Counsel for Petitioner is copied on this request.

Patent Owner seeks leave on a single, narrow issue: to correct Petitioner's factual account of the '123 prosecution history at pages 4–5 of the Opposition. Patent Owner does not seek to re-argue the Advanced Bionics framework, the cumulative nature of the asserted art, or any other matter, all of which are fully briefed on the existing briefing.

Good cause exists for three reasons.

First, the Opposition advances an affirmative factual theory that appears nowhere in the Petition or any prior paper. Petitioner asserts that the Examiner's claimed error "was caused by the applicant's post-notice of allowance amendment changing the preamble from 'exercise device' to 'wearable activity device,'" and that "[t]hese abbreviated searches caused the Examiner to miss relevant teachings in the prior art." Opp. 4–5. Patent Owner could not have addressed this theory in its Discretionary Denial Brief because it did not then exist, and under the Office's guidance a petition "should not address discretionary issues."

Second, the theory rests on record materials that neither party had previously placed at issue. Specifically, the Examiner's search histories cited at EX1002, 134–135, 170–171, 203–205, and 232–235, together with Petitioner's calculation of search durations from their timestamps. Patent Owner has had no opportunity to address that evidence.

Third, the theory is materially incomplete on the face of Petitioner's own exhibit. By way of example only:

- Wearable subject matter was expressly claimed before the amendment Petitioner identifies as the cause. In the amendment filed March 10, 2022 — preceding the first Notice of Allowance — claim 2 recited that the device "is at least one of a cardio exercise machine, a wearable activity device, a wearable health monitoring device, and a strength exercise machine." EX1002, 148.
- The September 12, 2022 search expressly combined the very limitations Petitioner contends were never investigated: "(wearable WITH (fitness activity)) WITH display AND accelerometer AND

biometric AND ((pair pairing paired connect\$3) WITH wireless) AND (mobile ADJ (phone device)).” EX1002, 204.

- The Opposition omits the Examiner’s May 19, 2022 search, which was not limited to stationary exercise equipment and included smartphone, barcode, image/scan, camera, accelerometer, and biometric terms. EX1002, 171.

Given the compressed schedule, Patent Owner is prepared to file its reply within three business days of authorization and does not believe this request will delay the Director’s decision. Patent Owner has no objection to Petitioner being afforded a sur-reply of equal length.

Respectfully submitted,

René A. Vazquez

Reg. No. 38,647

Lead Counsel for Patent Owner iScan2D Technologies, LLC