

From: [Trials](#)
To: [Tammy J. Terry](#); [Jarratt, Scott](#); [Lisa Margonis](#); [Califf T. Cooper](#); [Laura Witbeck](#); [Peter C. Schechter](#); [OBWB-IWS-DOWNING](#); [Scott Jarratt IPR](#); [Tiffany Cooke IPR](#); [Drott, Andrew](#); [Laura Vu IPR](#); [Caroline Fox IPR](#)
Cc: [Trials](#)
Subject: RE: PGR2025-00002
Date: Friday, January 10, 2025 8:29:55 AM
Attachments: [image001.jpg](#)

EXTERNAL: Sent from outside Haynes and Boone, LLP

Counsel,

Patent Owner seeks authorization to file an opposition to Petitioner's Motion to Waive Word Count (Paper 4), as well as a sur-reply to any reply that Petitioner may file. Petitioner states that it does not believe additional briefing is necessary. Having considered the issues raised, we determine the proper course to follow is as follows. Patent Owner is authorized to file a response of no more than 10 pages to Petitioner's Motion to Waive Word Count, which must be filed no later than January 17, 2025. Petitioner is likewise authorized to file a reply of no more than 5 pages, limited to addressing arguments raised in Patent Owner's response, which must be filed by January 24, 2025. Patent Owner should enter this email as an exhibit to its response indicating authorization for the above papers.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Tammy J. Terry <Terry@obwb.com>
Sent: Monday, January 6, 2025 10:47 AM
To: Jarratt, Scott <Scott.Jarratt@haynesboone.com>; Trials <Trials@USPTO.GOV>
Cc: Lisa Margonis <Margonis@obwb.com>; Califf T. Cooper <Cooper@obwb.com>; Laura Witbeck <Witbeck@obwb.com>; Peter C. Schechter <Schechter@obwb.com>; OBWB-IWS-DOWNING <OBWB-IWS-Downing@obwb.com>; Scott Jarratt IPR <Scott.Jarratt.IPR@haynesboone.com>; Tiffany Cooke IPR <tiffany.cooke.ipr@haynesboone.com>; Drott, Andrew <Andrew.Drott@haynesboone.com>; Laura Vu IPR <laura.vu.ipr@haynesboone.com>; Caroline Fox IPR <Caroline.Fox.ipr@haynesboone.com>
Subject: RE: PGR2025-00002

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Dear Honorable Board:

Petitioner's counsel respectfully responds to Patent Owner's email dated January 2, 2025. Unfortunately, due to having become extremely ill, lead counsel for Petitioner was out of the office last week and, therefore, unable to respond to any inquiries by Patent Owner's counsel. Now being back in the office, Petitioner's counsel responds with the following position regarding Patent Owner's request for briefing on Petitioner's Motion to Exceed Word Count in the above-referenced proceeding:

Petitioner does not believe additional briefing is necessary; however, should the Board desire briefing, Petitioner submits that 37 CFR § 42.24's standard motion briefing rules should apply, allowing Patent Owner to file an opposition of up to 15 pages and Petitioner to file a reply to the opposition of up to 5 pages. A sur-reply is unnecessary for the resolution of parties' dispute, is neither customary nor provided for under the rules governing these types of motions, and would unnecessarily tax the Board's finite resources.

Respectfully submitted,

Tammy Terry
Lead Counsel for Petitioner

Tammy J. Terry | Partner | Head of Litigation
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This communication may contain confidential or privileged information.

From: Jarratt, Scott <Scott.Jarratt@haynesboone.com>

Sent: Thursday, January 2, 2025 12:59 PM

To: Trials <Trials@USPTO.GOV>

Cc: Tammy J. Terry <Terry@obwb.com>; Lisa Margonis <Margonis@obwb.com>; Califf T. Cooper <Cooper@obwb.com>; Laura Witbeck <Witbeck@obwb.com>; Peter C. Schechter <Schechter@obwb.com>; OBWB-IWS-DOWNING <OBWB-IWS-Downing@obwb.com>; Scott Jarratt IPR <Scott.Jarratt.IPR@haynesboone.com>; Tiffany Cooke IPR <tiffany.cooke.ipr@haynesboone.com>; Drott, Andrew <Andrew.Drott@haynesboone.com>; Laura Vu IPR <laura.vu.ipr@haynesboone.com>; Caroline Fox IPR <Caroline.Fox.ipr@haynesboone.com>

Subject: PGR2025-00002

Dear Honorable Board,

Along with its PGR petition, Petitioner submitted a Motion to Waive Word Count (Paper 4) seeking to have the Board consider an alternative version of the petition that includes over 23,000 words -- 4,320 words over the allowed word count. Patent Owner seeks authorization to file an opposition to the motion, as well as a sur-reply to any reply that Petitioner may file.

Patent Owner attempted to confer with Petitioner's counsel several times regarding this request (Dec. 19 and Dec. 30) but did not receive a response.

In terms of timing, Patent Owner respectfully requests the Board set a briefing schedule that would permit a ruling on the Motion prior to the due date of the Preliminary Response (February 27). The improper 23,000-word petition includes grounds not found in the petition complying with the word count.

Thank you,
Scott Jarratt
Counsel for Patent Owner

Scott Jarratt

Partner

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