

From: [Director Discretionary Decision](#)
To: [Mike Locklar](#); [Brian Buss](#); [Director Discretionary Decision](#)
Cc: [Michael Benefield](#); [Chance Hardie](#); [Trials](#)
Subject: RE: External - RE: PGR2025-00061; Discretionary Denial Briefing
Date: Wednesday, September 17, 2025 4:46:22 PM
Attachments: [image002.png](#)

Patent Owner is authorized an additional 10 pages. Patent Owner's due date is hereby extended to Monday, September 22, 2025.

From: Mike Locklar <mlocklar@ewingjones.com>
Sent: Tuesday, September 16, 2025 12:25 PM
To: Brian Buss <brian@bussbenefield.com>; [Director_Discretionary_Decision](#) <[Director_Discretionary_Decision@uspto.gov](#)>
Cc: Michael Benefield <michael@bussbenefield.com>; Chance Hardie <chardie@ewingjones.com>; Trials <[Trials@USPTO.GOV](#)>
Subject: RE: External - RE: PGR2025-00061; Discretionary Denial Briefing

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Director Discretionary Decisions:

Petitioner continues to respectfully oppose any additional pages for a brief that Patent Owner readily admits will not address the *Finitiv* factors or the merits.

Best regards,

Mike Locklar



Michael Locklar
Principal
6363 Woodway, Suite 1000
Houston, Texas 77057
☎ Office 713.590.9600 | Direct 832.830.8945
📠 Fax: 713.590.9602 | ✉ mlocklar@ewingjones.com

From: Brian Buss <brian@bussbenefield.com>
Sent: Tuesday, September 16, 2025 11:20 AM
To: Mike Locklar <mlocklar@ewingjones.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Michael Benefield <michael@bussbenefield.com>; Chance Hardie <chardie@ewingjones.com>; Trials <Trials@USPTO.GOV>
Subject: RE: External - RE: PGR2025-00061; Discretionary Denial Briefing

Director Discretionary Decisions:

Patent Owner respectfully requests that the Director issue a decision on its request for additional pages (below) as soon as reasonably practicable. Patent Owner's Discretionary Denial briefing is due in just 2 days (9/18/2025).

Respectfully submitted,

Brian Buss

From: Brian Buss
Sent: Wednesday, September 10, 2025 5:57 PM
To: 'Mike Locklar' <mlocklar@ewingjones.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Michael Benefield <michael@bussbenefield.com>; Chance Hardie <chardie@ewingjones.com>; Trials <Trials@USPTO.GOV>
Subject: RE: External - RE: PGR2025-00061; Discretionary Denial Briefing

Director Discretionary Decisions:

Petitioner's email below is off base. Patent Owner has no intention of treating the Discretionary Denial Brief as an "opportunity for merits briefing" as Petitioner alleges. As outlined in Patent Owner's request, Patent Owner's Discretionary Denial Brief will focus on 35 U.S.C. 325(d) and 314(a) addressing the *Advanced Bionics* factors related to cumulative prior art already before the Examiner. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020). Additionally, Patent Owner will not focus on the *Fintiv* factors as argued by Petitioner as there is no parallel Court proceeding to analyze.

Respectfully submitted,

Brian Buss

From: Mike Locklar <mlocklar@ewingjones.com>

Sent: Wednesday, September 10, 2025 4:02 PM

To: Brian Buss <brian@bussbenefield.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Cc: Michael Benefield <michael@bussbenefield.com>; Chance Hardie <chardie@ewingjones.com>; Trials <Trials@USPTO.GOV>

Subject: RE: External - RE: PGR2025-00061; Discretionary Denial Briefing

Director Discretionary Decisions,

Patent Owner's request for 200% of the normal page count for a discretionary denial briefing is without merit and is designed only to obtain two bites at the arguments on the merits apple. Patent Owner wants to spend 40 pages addressing obviousness, indefiniteness, and lack of written description, all merits issues. This argument by the Patent Owner thus cannot suffice for "good cause."

Petitioner and Patent Owner agree there is no related matter involving the patent US12,110,780 for which this PGR is requested, nor does Patent Owner suggest it needs additional briefing space to address any parallel proceedings. Typical briefing for discretionary denial would require a substantial portion of the Patent Owner's pages allotted for addressing relevant considerations with respect to multiple proceedings. In this case, five of six *Fintiv* factors that all relate to parallel proceedings do not exist and hence leaves only one of six *Fintiv* factors for the Patent Owner to address in its allotted pages.

Furthermore, the *Interim Processes for PTAB Workload Management Memorandum* issued on March 26, 2025, states "decisions on whether to institute an IPR or PGR will be bifurcated (emphasis added) between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations" with "the parties to file separate briefing (emphasis added) on requests for discretionary denial of institution." The *Interim Director Discretionary Process* at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> further provides definitive guidance on this issue and the Patent Owner's solely merit based reasonings for requesting additional pages to brief discretionary denial as follows:

I.C Interim director discretionary process, Briefing: "Parties must make all their arguments (citing evidence, as needed) on the merits and other non-discretionary considerations in the petition, POPR, and any authorized reply or sur-reply."

II.C.i. Patent owner's discretionary denial brief, Content: "A patent owner should not repeat its merits arguments verbatim but should briefly explain why the merits are relevant. A patent owner should not treat a discretionary denial brief as an additional opportunity for merits briefing (emphasis added)."

Finally, Petitioner denies any cumulativeness of references considered by the Examiner during prosecution of the '780 patent or any cumulative nature of Petitioner's written description and indefiniteness arguments. This assertion of the Patent Owner lacks "good cause" for the Patent

Owner's additional page request. Patent Owner is able to address merits issues in the merits briefing.

Accordingly, Petitioner respectfully requests denial of the Patent Owner's request to modify page limits for Patent Owner's Discretionary Denial Brief.

Respectfully Submitted,

Mike Locklar



Michael Locklar

Principal

6363 Woodway, Suite 1000

Houston, Texas 77057

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From: Brian Buss <brian@bussbenefield.com>

Sent: Wednesday, September 10, 2025 9:43 AM

To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Cc: Michael Benefield <michael@bussbenefield.com>; Mike Locklar <mlocklar@ewingjones.com>;
Chance Hardie <chardie@ewingjones.com>; Trials <Trials@USPTO.GOV>

Subject: External - RE: PGR2025-00061; Discretionary Denial Briefing

Dear Director Discretionary Decisions:

I write to request an additional 20 pages (for a total of 40) for Patent Owner's Discretionary Denial brief that is due on September 18, 2025. Good cause exists for this page limit extension because the number of challenged claims and the number of references cited in the PGR petition require additional pages to adequately respond. In the PGR, Petitioner has challenged all 22 claims of U.S. Patent No. 12,110,780 using various combinations of four references (four grounds) and has also challenged the majority of claims based on lack of written description and indefiniteness (2 additional grounds). Petitioner's ground 3 challenge (claims 1-6, 8-15 and 17-22) uses two reference and spans 20 pages of briefing. In addition, Petitioner's ground 5 challenge (claims 1-6, 8-15 and 17-22) also uses two references and spans an additional 24 pages of briefing. Petitioner's ground 4 and

6 challenges (claims 7 and 16) uses an additional 5 pages of briefing. In total, Petitioner's brief is 62 pages long.

Patent Owner's response requesting discretionary denial based on 35 U.S.C. 325(d) and 314(a) focuses on showing that the references cited by Petitioner in its PGR are cumulative of at least 3 references considered by the Examiner during prosecution of the '780 patent and also addresses the cumulative nature of Petitioner's written description and indefiniteness arguments. In order to effectively present the cumulative nature of Petitioner's references in comparison to the references before the Examiner, a detailed chart comparing citations to the references will be presented in Patent Owner's brief. In order to effectively make the comparison of references and address Petitioner's additional grounds, Petitioner needs a total of 40 pages of briefing.

Therefore, in the interests of justice, and to ensure a fair and comprehensive proceeding, Patent Owner respectfully request that the page limit for its Discretionary Denial Brief be extended to 40 pages total.

Respectfully submitted,

Brian Buss
Lead Counsel for Patent Owner

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, September 10, 2025 8:45 AM
To: Brian Buss <brian@bussbenefield.com>; Trials <Trials@USPTO.GOV>
Cc: Michael Benefield <michael@bussbenefield.com>; mlocklar@ewingjones.com; chardie@ewingjones.com; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Subject: RE: PGR2025-00061; Discretionary Denial Briefing

Good morning,

I am adding the correct e-mail address to the cc line of this e-mail.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366



From: Brian Buss <brian@bussbenefield.com>

Sent: Tuesday, September 9, 2025 4:16 PM

To: Trials <Trials@USPTO.GOV>

Cc: Michael Benefield <michael@bussbenefield.com>; mlocklar@ewingjones.com;
chardie@ewingjones.com

Subject: PGR2025-00061; Discretionary Denial Briefing

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board:

I am writing to inquire how to request additional pages for a Patent Owner Discretionary Denial brief. On the USPTO website, it seems that the email address [Director Discretionary Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov) is the correct email, but when I put that email into my outlook, it says the email address is no longer valid.

Please advise as to the correct email address to send my request to.

Respectfully,

Brian Buss