

From: [Director Discretionary Decision](#)
To: [Evans, Robert M.](#); [O'Brien, David](#); [Director Discretionary Decision](#)
Cc: [Hartley, Michael J.](#); [Lyle, Kelly Gehrke](#)
Subject: RE: PGR2025-00066 - Request for Authorization for Reply
Date: Thursday, November 6, 2025 3:14:22 PM
Attachments: [image001.png](#)

Please see revised response.

Patent Owner is authorized to file a 5-page reply in PGR2025-00066, due no later than Monday, November 10, 2025, limited to addressing the arguments raised below. Patent Owner may also file the exhibit. Petitioner is authorized to file a 5-page sur-reply, due no later than November 13, 2025.

From: Evans, Robert M. <revans@lewisrice.com>
Sent: Thursday, November 6, 2025 2:16 PM
To: O'Brien, David <David.O'Brien@haynesboone.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Hartley, Michael J. <MHartley@lewisrice.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>
Subject: RE: PGR2025-00066 - Request for Authorization for Reply

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Dear Honorable Director,

At 9:28 a.m. Central Time this morning, Counsel for Petitioner informed Counsel for Patent Owner that Petitioner would provide a Position Statement for inclusion in Patent Owner's email to the Director requesting authorization to file a reply.

At 11:35 a.m. Central Time, as Petitioner was preparing its position statement, Patent Owner submitted the below email without waiting for the Position Statement.

Petitioner now provides the following Position Statement:

The Board found in the '966 FWD in the prior PGR that Patent Owner "mischaracterize[d]" the 2019 Letter. EX1015 at 24-27, 33-34.

The Petition explains how Patent Owner thereafter made the same "mischaracterization" of the 2019 Letter to the Examiner during subsequent prosecution of the '627 Application. Paper 2 at 13-14, citing EX1015 and EX1016 (which provides excerpts from the '627 Application File History). The Petition asserted the "mischaracterization" as one reason for why the Challenged Claims should not

have issued. *Id.*

In the Patent Owner Response, Patent Owner addressed the “mischaracterization.” See Paper 8 at page 10, fn. 6. Patent Owner notably used only 7,452 of the available 14,000 words for this Response.

In its Brief in Support of Discretionary Denial, Patent Owner did not address the “mischaracterization.” Patent Owner did, however, submit the file histories for five applications in the ‘319 Patent family (including the ‘627 Application) with its Brief in Support of Discretionary Denial. Paper 6, Exhibits 2003-2007.

As Petitioner pointed out in its Response thereto, Patent Owner made the same mischaracterization of the 2019 Letter to the Examiner in each of four of those five file histories. Paper 7 at 10-12, citing EX2003 at 62-63, 323-325; EX2004 at 45-46, 306-307; EX2006 at 592-94; EX2007 at 339-40. As the mischaracterization issue was raised in the Petition, Patent Owner should not have been surprised that the issue was also addressed in Petitioner’s Response.

A copy of the 2019 Letter appears in four of those file histories previously submitted as exhibits by Patent Owner and is thus already part of the record. EX2003 at 302-10; EX2004 at 285-293; EX2006 at 346-354; EX2007 at 59-67. As such, Patent Owner’s request to file a fifth copy should be denied.

As Patent Owner already had two opportunities to address the “mischaracterization” issue, and did address it in Patent Owner’s Response, Patent Owner has not shown good cause for additional briefing. This request should also be denied.

If the Director grants Patent Owner authorization to file a Reply, Petitioner requests that it be granted authorization to file a Sur-Reply of equal length.

Petitioner further confirms that it is available for a conference if requested.

Respectfully submitted,
Robert M. Evans, Jr., Reg. No. 36,794
Lead Counsel for Petitioner



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From: O'Brien, David <David.OBrien@haynesboone.com>

Sent: Thursday, November 6, 2025 11:35 AM

To: Director_Discretionary_Decision@USPTO.gov

Cc: Hartley, Michael J. <MHartley@lewisrice.com>; Evans, Robert M. <revans@lewisrice.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>

Subject: [EXTERNAL] PGR2025-00066 - Request for Authorization for Reply

Dear Honorable Director,

In accordance with your discretionary considerations process, Patent Owner, Hart InterCivic, Inc., respectfully requests authorization to file a Reply to Petitioner's Opposition to discretionary denial. Patent Owner requested discretionary denial in a brief (DDR) filed September 30, 2025 and, on October 31, 2025, Petitioner opposed.

In its Opposition, Petitioner (Election Systems & Software, LLC, "ES&S") accused Patent Owner of "repeatedly mischaracterizing" a Letter during prosecution(s) before the Office. There is good cause for the Director to authorize Patent Owner's Reply as Patent Owner could not have anticipated that accusation.

Patent Owner's Reply will address the accusation by briefing the following points:

1. Patent Owner's quotes from ES&S' 2019 Letter to Senators Klobuchar, Peters, Reed and Warner are entirely factual. The Letter was invited testimony and responded to questions from the Senators regarding whether voting practices employing ES&S' machines would be "secure enough to be used in the 2020 election cycle."
2. Context matters—the Letter was raised in a prior PGR relative to objective indicia of non-obviousness. But the Examiner did not discuss objective indicia or withdraw any rejection based thereon in the targeted patent or any of its prior applications.
3. Finally, Patent Owner submitted the full Letter, together with ES&S' arguments and the Board's FWD, to the Office for transparency, in furtherance of its disclosure obligations, and with the goal that patents issuing from its post-PGR prosecution are born strong.

Patent Owner requests authorization for a 5-page reply to the Opposition that includes as an Exhibit a **copy of the Letter**. Although Petitioner accused Patent Owner of "repeatedly mischaracterizing" the Letter, it neglected to enter a copy of the Letter.

Patent Owner and Petitioner have met and conferred. Petitioner opposes Patent Owner's request. Although, Petitioner offered a "position statement," no statement has as yet been received. In lieu, Petitioner's response from M&C is duplicated below

According to Petitioner:

[T]he Petition clearly identified and discussed the Board’s “mischaracterization” findings in the ‘966 FWD. Petition at 13-14. Those same pages of the Petition further quoted Patent Owner’s statement in its response to an office action during prosecution of the ‘627 Application regarding ES&S’s 2019 Letter and how such statements were inconsistent with the Board’s findings. *Id.* (“Indeed, the Board in the ‘966 FWD expressly stated that PO ‘mischaracterized ES&S’s letter’ in making essentially the same argument ...”). The identical quote and assertion by Patent Owner appear in each of four different file histories in the purported priority chain. EX2007 at 339; EX2006 at 593; EX2004 at 45, 307; EX2003 at 62-63, 325 (EX1016, 113-114). And Patent Owner addressed the issue in its POPR at page 10, note 6. Patent Owner’s feigned surprise that Petitioner addressed a specific issue in its Opposition to Patent Owner’s Request for Discretionary Denial that was also raised in the Petition is unconvincing.

In view of the time constraints on the discretionary considerations process, Patent Owner does not anticipate that a conference call will be desired; however, the Parties are generally available early next week should the Director or Board so require.

Respectfully submitted,
David OBrien, Reg. No. 40,107
Lead Counsel for Patent Owner
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