

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONESOURCE SOLUTIONS INTERNATIONAL, INC.,
Petitioner

v.

HIPPOCRATIC AI, INC.,
Patent Owner

Case PGR2025-00075
U.S. Patent No. 12,142,371

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY¹

¹ This sur-reply was authorized by the Board on January 14, 2026. Ex. 3001.

I. The Petition is Time-Barred

Petitioner substantively altered its proposed grounds of invalidity in the “corrected” Petition filed August 27, 2025, which is after the 9-month statutory bar. Patent Owner’s Preliminary Response (“POPR”), 6-8. Given that the grounds that would have been instituted based on the original petition (filed August 11, 2025) are different from the grounds that would be instituted based on the “corrected” Petition, the Petition is only entitled to an August 27, 2025 filing date. *Id.*

Petitioner’s assertion that it “made no substantive changes” to the original petition is plainly false. Petitioner itself admits that the “corrected” Petition changed the original petition by eliminating all citations and discussions about certain prior art previously discussed under the asserted grounds. Petitioner’s Preliminary Reply, 2. (“Reply,” Paper 24) (alleging that the corrected Petition “made only regulatory/ministerial corrections ... including ***removing a cumulative non-patent literature citation***”). Petitioner suggests that this change was not “substantive” because the removed art is allegedly “cumulative.” But whether that art is cumulative is irrelevant to whether removing it constitutes ***a substantive change to*** the original petition. It clearly does, and Petitioner fails to provide any rational explanation to the contrary.

Petitioner’s reliance on the Board’s Notice of Accorded Filing Date (“Notice,”

Paper 3) to avoid this inescapable conclusion is also misplaced. As Petitioner acknowledges, the Notice expressly prohibits substantive changes to the petition: “**No substantive changes** (e.g., new grounds) may be made to the petition.” Notice, 2. Because the “corrected” Petition violates this prohibition, Petitioner loses any entitlement that it may have had to the August 11 filing date. Indeed, the corrections contemplated by the Notice were to address procedural defects (e.g., no certificate of service), not make substantive changes. This is why a motion is required to correct clerical or typographical mistakes in a petition and why the grant of a motion to make such corrections “does not change the filing date of the petition.” 37 C.F.R. § 42.204(c). Under Petitioner’s flawed logic, a notice of accorded filing date gives petitioners *carte blanche* to make **any** changes they desire to a petition without losing the filing date, even substantive changes to the grounds of invalidity.

Equally futile are Petitioner’s legal citations. Petitioner cites 37 C.F.R. § 42.204(c) for the notion that the “corrected” Petition “does not change the filing date of the [original] petition.” However, § 42.204(c) only applies to correcting a “**clerical or typographical mistake** in the petition,” something that none of the changes at issue here do. Indeed, many of the changes are substantive and none of them were made to address a clerical or typographical “mistake”—Petitioner admits they were made to reduce the word count and comply with 37 C.F.R. § 42.24(ii).

Adello Biologics LLC v. Amgen Inc. is irrelevant, as the issue there related to a petitioner's belated attempt to identify additional real-parties-in-interest. PGR2019-0001, Paper 11 at 4-5 (PTAB Feb. 14, 2019). *DynaEnergetics Europe GmbH v. QinetiQ Ltd.* is likewise irrelevant, as the issue was whether the filing date of a petition is only accorded upon service of the petition on the patent owner. PGR2023-0003, Paper 8 at 4-5 (PTAB Apr. 13, 2023). Neither PGR involved nor related to whether substantive changes to a petition alter its effective filing date for purposes of the statutory time-bar. Those PGRs are inapplicable and irrelevant here.

II. Because the '371 Patent is Not in Evidence, Denial is Warranted.

Petitioner failed to file the '371 Patent as an exhibit, and thus it is not in evidence and cannot be considered. POPR, 23-24. Petitioner argues this “elevates form over substance,” but tellingly does not cite any Board decision or proceeding where the Board instituted trial without the challenged patent in evidence.

Petitioner also nonsensically asserts that “Patent Owner itself ‘presently has no exhibits.” Of course, additional exhibits were unnecessary to identify the many fatal defects in the Petition, including impermissibly ambiguous grounds and a complete lack of prior art mapping to the claims. Moreover, it is Petitioner—not Patent Owner—that has the obligation to place in the record all evidence needed to carry its burden of proof, including the '371 Patent.

PO Preliminary Sur-Reply

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Dated: January 23, 2026

Respectfully submitted,

/Stephen D. Zinda/
Stephen D. Zinda (Reg. No. 67,272)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on January 23, 2026, a copy of the foregoing document (*Patent Owner's Preliminary Sur-Reply*), was served via electronic mail on all attorneys of record at the email addresses provided for electronic service listed in Petitioner's mandatory notices, as set forth below:

Alfredhoyte.ipconsulting@gmail.com

shannonocan.ipconsulting@gmail.com

michaelrazavi.ipconsulting@gmail.com

/Stephen D. Zinda/
Stephen D. Zinda