

From: [Director Discretionary Decision](#)
To: [Jeremy Plenzler](#); [Director Discretionary Decision](#)
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Subject: RE: Request for Conference Call – PGR2026-00017, PGR2026-00020, PGR2026-00022, PGR2026-00031, and IPR2026-000194
Date: Thursday, April 23, 2026 1:10:51 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
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[image005.png](#)
[image006.png](#)
[image007.png](#)
[image008.png](#)
[image009.png](#)

Patent Owner may file a 1-page supplemental brief in PGR2026-00017 and PGR2026-00020, due no later than Tuesday, April 28, 2026. The brief is limited to address arguments related to the Director’s March 11, 2026 Memo: “Additional Discretionary Institution Considerations U.S. Manufacturing and Small Business Use of AIA Proceedings” raised in Petitioner’s Response filed after the due date for Patent Owner’s discretionary brief had elapsed.

From: Jeremy Plenzler <jeremy@vhiplaw.com>
Sent: Thursday, April 23, 2026 9:22 AM
To: Trials <Trials@USPTO.GOV>; [Director_Discretionary_Decision](#) <Director_Discretionary_Decision@uspto.gov>
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Subject: Request for Conference Call – PGR2026-00017, PGR2026-00020, PGR2026-00022, PGR2026-00031, and IPR2026-000194

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Hello,

Patent Owner requests a brief conference call with the Board, consistent with the Trial Practice Guide (“The Board encourages the use of conference calls to raise and resolve

issues in an expedited manner”). Patent Owner additionally copies the “Director Discretionary Decision” inbox with this request as it relates to additional briefing, among other things.

As seen in the correspondence below, Patent Owner complied with the Board’s meet and confer requirement, but the attempt failed to produce agreement. Patent Owner requests the call even without Petitioner’s agreement, as the Trial Practice Guide indicates: “The Board has the discretion to permit a hearing or conference call to take place even if a party refuses to participate.” Patent Owner will arrange for a court reporter.

Patent Owner can be available at the Board’s convenience next week (April 27–May 1) but requests the Board schedule a call after 11 AM ET to accommodate counsel on the west coast.

Patent Owner provides the following summary to give the Board context (rather than argument) on the issues to be presented, consistent with the Trial Practice Guide’s note to explain “why the call is needed and what materials may be needed during the call.” Patent Owner requests the call to discuss the following issues:

1. **Supplemental briefing on the Director's March 11, 2026 Memorandum.** An additional 1 page of briefing in each of PGR2026-00017 and PGR2026-00020. The briefing would address the Director’s March 11, 2026 Memo: “Additional Discretionary Institution Considerations U.S. Manufacturing and Small Business Use of AIA Proceedings” for both proceedings and allow Patent Owner to identify the statutory disclaimer filed in connection with the Patent Owner Preliminary Response in PGR2026-00020.

As seen below, the briefing request is opposed by Petitioner. Consistent with the current Director Guidance, good cause exists for this request. Patent Owner notes that this request is the result of Petitioner’s actions, rather than any gamesmanship by Patent Owner. Patent Owner’s Discretionary Denial Briefing in each of PGR2026-00017 and PGR2026-00020 was due before the Director’s March 11, 2026 memorandum, as Petitioner notes. Petitioner, however, reads the memorandum differently than Patent Owner. Petitioner notes that the memorandum states that it “applies to all IPRs and PGRs in which the due date for a patent owner discretionary brief has not yet elapsed,” yet Petitioner still addressed the memorandum in its Oppositions to PGR2026-00017 and PGR2026-00020. Patent Owner simply seeks to respond, or in the alternative,

requests that the Board disregard Petitioner's briefing on the issue.

With respect to identifying the statutory disclaimer in PGR2026-00020 in the requested briefing, Patent Owner notes that this is already made clear in its Preliminary Response, along with other issues Patent Owner references as incorporated from its Preliminary Responses. Patent Owner raises the issue in view of Petitioner's repeated arguments in its briefing that incorporation of arguments from the Patent Owner Preliminary Response is not allowed. As the Board is aware, this is contrary to current Director Guidance, which expressly allows such incorporation.

2. Notification regarding PGR2026-00031 and the related family of proceedings.

Patent Owner would like to bring PGR2026-00031 to the Board's attention in the event it benefits the Board's holistic assessment regarding efficiencies of denying the entire family of related proceedings (PGR2026-00017, -00020, -00022, -00031, and IPR2026-00194).

Patent Owner would also like to briefly note, for the Board's consideration in connection with the family of proceedings, that certain references presented in Petitioner's challenges share disclosures with references already considered by the Office (e.g., divisional or PCT publications of previously considered references). Patent Owner would like to bring this to the Board's attention before any decisions issue in the related proceedings so that the Board can have an accurate picture for holistic assessment of the family of proceedings.

Thank you for your consideration of this request.

**JEREMY
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From: Peterson, Jacob <jacob.peterson@morganlewis.com>

Sent: Wednesday, April 22, 2026 9:33 PM

To: Jeremy Plenzler <jeremy@vhiplaw.com>

Cc: Richard McCaulley <richard@mccaulleylawgroup.com>; Andres Arrubla <aarrubla@treace.net>; LaVanway, Paul <plavanway@fredlaw.com>; Joshua Van Hoven <josh@vhiplaw.com>; MLB-P28-PGR-397 <MLB-P28-PGR-397@morganlewis.com>; MLB-P28-PGR-428 <MLB-P28-PGR-428@morganlewis.com>

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Subject: RE: PGR2026-00017, 20, and 31 -- Request for Call with the Board

Hi Jeremy,

We have considered Patent Owner's request. Petitioner does not agree that a conference call or additional briefing is warranted.

Patent Owner already had the opportunity to file discretionary-denial briefs in PGR2026-00017 and PGR2026-00020. Under the PTAB's Interim Processes for PTAB Workload Management memorandum, "the parties [were] permitted to address all relevant considerations." Patent Owner's decision not to address U.S. manufacturing or small-business considerations in those briefs does not establish good cause for additional briefing. In any event, the Director's March 11, 2026 memorandum states that it "applies to all IPRs and PGRs in which the due date for a patent owner discretionary brief has not yet elapsed." Because the due dates for Patent Owner's discretionary-denial briefs in PGR2026-00017 and PGR2026-00020 had already elapsed before the memorandum issued, the memorandum does not provide a basis for additional briefing in those proceedings. Allowing the requested additional briefing would instead give Patent Owner an unauthorized reply and, in PGR2026-00017, would effectively circumvent the applicable page limit.

The statutory disclaimer concerning the patent challenged in PGR2026-00020 likewise does not establish good cause. Patent Owner controlled the timing of any disclaimer and the content of its discretionary-denial brief. To the extent Patent Owner seeks only to identify a statutory disclaimer that the Office has already received, no additional discretionary-denial brief is necessary.

Patent Owner's request concerning PGR2026-00031 is also not a proper basis for a Board call or additional briefing in the earlier proceedings. As best as Petitioner understands the request, Patent Owner appears to seek to have prospective briefing or issues in PGR2026-00031 coordinated with, considered in, or used to affect the timing or discretionary-denial analysis in earlier proceedings. Petitioner does not agree. The challenged '941 patent does not share a priority claim with the patents challenged in the earlier proceedings, and the grounds in PGR2026-00031 do not rely on the same references as the grounds in those proceedings. In any event, even if the proceedings were related in some respect, that would not justify importing future PGR2026-00031

briefing into the closed discretionary-denial briefing in the earlier proceedings.

To the extent Patent Owner is seeking an order requiring Petitioner to address particular issues in a future opposition in PGR2026-00031, that request is premature and improper. No discretionary-denial brief has been filed in PGR2026-00031. If Patent Owner files such a brief, Petitioner is entitled to respond to the arguments Patent Owner actually makes, within the governing rules. There is no basis to preemptively dictate the content of Petitioner's future opposition.

Accordingly, Petitioner does not believe good cause exists for additional briefing. Petitioner also does not believe that a conference call with the Board or Director is necessary or appropriate.

Best,
Jacob

Jacob Peterson

Morgan, Lewis & Bockius LLP

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From: Jeremy Plenzler <jeremy@vhiplaw.com>

Sent: Wednesday, April 22, 2026 11:33 AM

To: MLB-P28-PGR-397 <MLB-P28-PGR-397@morganlewis.com>; MLB-P28-PGR-428 <MLB-P28-PGR-428@morganlewis.com>; MLB-P28-PGR-941 <MLB-P28-PGR-941@morganlewis.com>; Razai, Ali <ali.razai@morganlewis.com>; Peterson, Jacob <jacob.peterson@morganlewis.com>; Smith, Brandon G. <brandon.g.smith@morganlewis.com>; Messick, Zachary <zachary.messick@morganlewis.com>; Everton, Benjamin <ben.everton@morganlewis.com>

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Subject: PGR2026-00017, 20, and 31 -- Request for Call with the Board

[EXTERNAL EMAIL]

Hello,

Patent Owner would like to file a 1-page Reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in PGR2026-00017 and PGR2026-00020. The

Reply would be limited to the Director's March 11, 2026 Memo: "Additional Discretionary Institution Considerations U.S. Manufacturing and Small Business Use of AIA Proceedings" for both proceedings and provide for Patent Owner to identify the statutory disclaimer filed in connection with the Patent Owner Preliminary Response in PGR2026-00020.

Patent Owner would also like to discuss timing with the Board regarding considering the PGR2026-00031 briefing when deciding discretion on the family of cases, as well as to bring to the Board's attention the manner in which references are being applied by Petitioner so the Board may consider potentially ordering Petitioner in its discretionary denial opposition to address certain aspects of the prior use of family members of those references in prosecution.

Pursuant to the Board's meet and confer requirement, please let us know: (1) whether you are amenable to a Patent Owner Reply as outlined above, and (2) your availability for a conference call with the Board during the week of April 27.

Thank you.

JEREMY PLENZLER

PARTNER

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