

From: Trials
Sent: Wednesday, March 20, 2024 9:28 AM
To: Pepe, Christopher; Trials
Cc: Jim Glass; John McKee; Jason Williams; Quincy Lu; Desai, Anish; Percer, Adrian; Yu, Tom; Ansley, Sutton; Sieger, Matthew
Subject: RE: IPR2024-00223: Request for Authorization to File Reply to Patent Owner's Preliminary Response

Counsel,

From the Board –

Petitioner is authorized to file a five-page Preliminary Reply to respond to Patent Owner's arguments and evidence of objective indicia of nonobviousness. Patent Owner is also authorized to file a five-page Sur-reply to respond to the arguments Petitioner raises in its Preliminary Reply. Petitioner's Preliminary Reply must be filed no later than 3/27/24 and Patent Owner's Sur-reply must be filed no later than 4/3/24.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Pepe, Christopher <Christopher.Pepe@weil.com>
Sent: Tuesday, March 19, 2024 3:38 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jim Glass <jimglass@quinnemanuel.com>; John McKee <johnmckee@quinnemanuel.com>; Jason Williams <jasonwilliams@quinnemanuel.com>; Quincy Lu <quincylu@quinnemanuel.com>; Desai, Anish <anish.desai@weil.com>; Percer, Adrian <adrian.percer@weil.com>; Yu, Tom <Tom.Yu@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Sieger, Matthew <Matthew.Sieger@weil.com>
Subject: IPR2024-00223: Request for Authorization to File Reply to Patent Owner's Preliminary Response

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Dear Board,

Petitioners NJOY LLC and NJOY Holdings Inc. respectfully request leave in IPR2024-00223 to file a five-page reply to Patent Owner's Preliminary Response that was filed on February 29, 2024. Specifically, Petitioners seek leave to file a reply to address Patent Owner's secondary considerations arguments. Good cause exists to do so because Patent Owner's arguments reference confidential information subject to an ITC protective order that Petitioner could not have addressed in the Petition. Petitioners also seek leave to file two full deposition transcripts that correspond to excerpts of deposition transcripts submitted with the Preliminary Response (See Ex. 2025 and Ex. 2026), as well as three exhibits to those deposition transcripts. The deposition transcripts and three exhibits will be designated "PROTECTIVE ORDER MATERIAL – ATTORNEYS' EYES ONLY" pursuant to the proposed stipulated Protective Order (Ex. 2101), will be filed "Parties and Board Only" on P-TACTS, and Petitioner will file a concurrent motion to seal under the pending proposed stipulated Protective Order.

The parties have conferred. Patent Owner does not agree with Petitioner's position that it could not have addressed secondary considerations in the Petition, but to avoid needless dispute, Patent Owner does not oppose Petitioner's request provided that Patent Owner is permitted to submit a five-page sur-reply within one week of Petitioner submitting its Reply. Petitioner does not oppose Patent Owner's request for a sur-reply.

To the extent the Board would like to hold a teleconference concerning Petitioners' request, the parties will confer and provide their availability.

Thank you,

Chris Pepe
Counsel for Petitioners

The logo for the law firm Weil, consisting of the word "Weil" in white text on a green rectangular background.

Christopher Pepe

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