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Subject: RE: IPR2025-00274, -278, -280, and -281: Authorization Requested for Additional Briefing
Date: Friday, June 20, 2025 3:15:22 PM

Patent Owner is authorized to file a 5-page reply in IPR2025-00274, -278, -280, and -281, due no later than, Tuesday, June 24, 2025, limited to addressing the discretionary denial arguments raised below.

Petitioner is authorized to file a 5-page sur-reply in IPR2025-00274, -278, -280, and -281, due no later than Thursday, June 26, 2025, limited to addressing arguments made in Patent Owner's reply brief.

Petitioners' request for authorization to file a reply to the POPRs in IPRs2025-00274, -278, -280, and -281 is referred to the Board for a Board panel to decide.

From: Hamad Hamad <hhamad@caldwellcc.com>
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Dear Acting Director and Board,

We write in connection with IPR Nos. 2025-00274, -278, -280, and -281 to request authorization for Patent Owner to file five-page Reply Briefs in support of its Requests for Discretionary Denial. We also request that Petitioners be afforded the opportunity to file five-page Sur-replies one week later.

In parallel, we have conferred with Petitioners about reply briefs to Patent Owner's Preliminary Response (POPR), and Petitioners request that the parties be afforded Preliminary Replies and

Sur-replies in connection with the briefing submitted to the Board Panel, as outlined below.

The petitions for IPR2025-00274, -278, -280, and -281 were all filed before the Director instituted the Interim Processes for PTAB Workload Management on March 26, 2025, and the proposal below helps ensure that the discretionary denial arguments are fully presented to the Director, and the merits arguments are fully presented to the Board panel.

Briefing to the Director on Discretionary Denial

First, with respect to IPR Nos. 2025-00274 ('114 Patent) and 2025-00280 ('517 Patent), Patent Owner requests additional briefing to address discretionary denial under 35 U.S.C. § 325(d). Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on arguments previously presented to the office. In making this decision, the Director or the Board considers the two-part framework in *Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (precedential). That framework was recently clarified in *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (May 19, 2025), which was entered and designated precedential by the Board after Patent Owner filed its Briefs Regarding Discretionary Denial. In light of the above, while Patent Owner did not include any arguments for 325(d) in its discretionary denial briefs, Patent Owner submits that it should be permitted to supplement its briefing regarding this change in the law regarding § 325(d).

Second, with respect to IPR Nos. 2025-00274, -278, -280, and -281, Patent Owner requests additional briefing regarding real parties in interest. In particular, after Patent Owner filed its Briefs Regarding Discretionary Denial, Petitioners produced a number of agreements with refined coal providers involved in Patent Owner's prior litigation and IPRs. These agreements contain indemnity and other contractual provisions that Patent Owner contends are relevant to the real-party-in-interest analysis. Accordingly, Patent Owner submits that it should be permitted to supplement its briefing regarding these newly-produced agreements relevant to the real-party-in-interest analysis.

In sum, for each of IPR Nos. 2025-00274, -278, -280, and -281, Patent Owner requests a total of five pages of reply in support of discretionary denial for each proceeding, with Petitioners being allowed five pages for sur-reply.

Counsel for Patent Owner has conferred with counsel for Petitioners, who have provided the following position with respect to Patent Owner's request: Petitioners do not oppose Patent Owner's request for a five-page reply (Patent Owner) and five-page sur-reply (Petitioners), provided that Petitioners may also have a reply to POPR. As it stands, the proceedings are in an unusual procedural posture, because of how Patent Owner prepared its discretionary denial and POPR briefs: with RPI issues (merits) in the discretionary denial briefs, and 325(d) issues (discretionary) in the POPRs. Pursuant to FAQ No. 12, Petitioners understand that "the Board panel will not consider papers filed by parties relating to discretionary considerations."

Accordingly, Petitioners request a reply to the POPRs (discussed below) to ensure that the Board panel can consider Petitioners' response to Patent Owner's RPI/privity arguments among other merits-based arguments.

Briefing for Board Panel

Petitioners request that Petitioners be afforded the opportunity to file replies to the POPRs in IPR2025-00274, -278, -280, and -281 as follows.

IPR2025-00274 ('114 Patent) and IPR2025-00280 ('517 Patent): Petitioners request a reply to the POPR of 15 pages that would address: (a) RPI/privity; (b) conception and reduction to practice; and (c) Patent Owner's arguments concerning Vosteen and the procedural history of the prior litigations. The majority of each brief would be directed to replying to Patent Owner's RPI/privity arguments from the POPRs. Petitioners previously submitted RPI/privity arguments in opposition to Patent Owner's discretionary denial briefs that addressed RPI issues.

Because the Board panel does not review the discretionary denial briefs (FAQ No. 12), Petitioners request the ability to also address the RPI/privity arguments in reply to POPR so that they may be considered by the Board panel.

Patent Owner also addressed 325(d) in its POPR. Pursuant to FAQ No. 25, Petitioners understand that 325(d) is considered by the Director but no longer considered by the Board panel. To the extent the Board panel does consider the 325(d) issues, Petitioners request an additional three pages in its reply to POPR to address 325(d).

IPR2025-00278 ('114 Patent) and IPR2025-00281 ('517 Patent): Petitioners request a reply to the POPR of 15 pages that would address: (a) RPI/privity; and (b) priority date analysis.

Petitioners note that across the -274, -278, -280, and -281 proceedings, the RPI/Privity issues are identical. Petitioners would essentially be copying and pasting the RPI/privity arguments across four petitions, so that the briefing in each IPR proceeding will be fully self-contained for consideration by the Board panel. To reduce the burden on the Board panel, Petitioners would add a footnote in each brief to indicate which sections of the brief are identical between proceedings.

To the extent Petitioners are granted leave to submit a reply to the POPR in the above proceedings, they would not oppose a sur-reply from Patent Owner of equal length.

Patent Owner has provided the following position with respect to Petitioners' request: Patent Owner does not oppose Petitioners' request to file replies to the POPRs in these matters, provided that Patent Owner is authorized to file a sur-reply of equal length in each matter.

* * *

If either the Board or the Director wishes to schedule a conference call to discuss the above, the parties will provide their collective availability for a call upon request. Thank you in advance for your attention to these matters.

Sincerely,
Hamad Hamad
Counsel for Patent Owner Birchtech Corp.

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