

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTAS PHARMACEUTICALS LTD.,  
Petitioner,

v.

ATOSSA THERAPEUTICS, INC.,  
Patent Owner

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Case PGR2025-00043  
Patent 12,071,391

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**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION  
TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY  
UNDER 37 C.F.R. §42.51(b)(2)**

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Pursuant to the Board’s Order (Pap.28), Patent Owner Atossa Therapeutics, Inc. (“Atossa”) respectfully submits this Reply to Intas’s Opposition to Patent Owner’s Motion for Additional Discovery,<sup>1</sup> limited to addressing Petitioner Intas’s (“Intas”) affirmative counter-request to amend its faulty RPI disclosure to add Jina Pharmaceuticals (“Jina”) and retain its original petition filing date, a request on which Intas bears the burden.<sup>2</sup> Under current law, Intas’s deliberate decision to omit an RPI in the Petition (and thus avoid binding that RPI to estoppel), cannot be excused. Further, this PGR would be time-barred, and there is no basis to allow Intas to maintain its filing date given its deliberate decision not to name Jina at the outset.

## **I. Background**

There has been a recent, marked change in how the Board handles failures to timely identify RPIs. In September, Director Squires de-designated *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Pap.11 (Oct. 6, 2020), which had

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<sup>1</sup> Sections are from 35 U.S.C./37 C.F.R. as context indicates, and emphases are added and internal quotations/citations omitted unless noted.

<sup>2</sup> This Reply assumes that Jina is an RPI for purposes of this proceeding. Given that Intas apparently still contests whether Jina was an RPI *at the time the petitions were filed*, Atossa maintains additional discovery would be useful to show that Jina was an RPI at that time, and that the Petition should therefore be terminated.

formerly relaxed RPI enforcement and dropped the requirement that RPI issues be addressed absent a time bar issue. The next month, Director Squires designated *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Pap.68 (Aug. 18, 2015) as precedential, formally restoring the USPTO’s prior practice of requiring petitioners to identify *all* RPIs *before institution*. *Precedential Designation of Corning Optical* (Oct. 28, 2025) (“*Corning Optical Memo*”). The Director’s new mandate is unambiguous: “Under *Corning Optical*, the Office will now enforce § 312(a)(2)’s requirement that a *petition* must ‘identif[y] all real parties in interest.’” *Id.* at 4. This rule serves the important purpose of requiring RPI identification and commitment to estoppel without the need to chase a petitioner for it in motion practice and discovery. *See* 35 U.S.C. § 325(e).

## **II. Intas Cannot Amend its Petition Now to Include Jina**

Intas’s proposed RPI amendment comes too late. Because Intas failed to name Jina in its Petition (and prior to institution), the Petition failed the § 322(a)(2) requirement, and cannot be considered. *Cf. Corning Optical*, Pap.68, 24. Intas’s deliberate decision not to name Jina as an RPI in the Petition means it cannot show “good cause or otherwise [explain] that it would be in the interests of justice to allow correction . . . without loss of the original filing date.” *Reflectix, Inc. v. Promethean Insulation Tech. LLC*, IPR2015-00039, Pap.18, 18 (April 24, 2015). Indeed, Intas chose not to name and bind Jina as an RPI until it was called out in front of the

Board. And it is not in the interests of justice to permit Intas to amend where its decision was “not objectively reasonable” and there would have been “no way to know whether a 35 U.S.C. § 315(e) bar on subsequent petitions would have been conceded if [Intas] had never raised the issue.” *Id.* at 15–16. “The AIA contains a direct sanction against petitions that do not identify all RPIs”: they may not be considered. *Id.* at 17 (citing § 312(a)(2)). Any argument about lack of prejudice not only ignores the costs of having to bring this motion but is also irrelevant: it is *Intas’s* burden to show good cause or that it would be in the interests of justice to maintain the original filing date. *Id.* at 13–18; *Corning Optical*, Pap.68, 23–24.

After the Board granted Atossa discovery into RPI, Intas asserted “[it] is willing to modify its mandatory notices to explicitly identify Jina as a[n] [RPI]” so as “to avoid any further dispute.” Pap.21, 2. However, *Corning Optical* forecloses this option. There, as here, petitioner contended “Petitioner should be permitted to amend its Petition and retain its filing date.” *Corning Optical*, Pap.68, 23. The Board disagreed, explaining “prior panels have terminated proceedings where a petitioner has failed to name all RPIs, and consistently found that any Petition corrected to disclose additional RPIs must be given a new filing date.” *Id.* (collecting cases).

Where, as here, petitioner fails to identify all RPIs at the time the Petition was filed, the Board “cannot consider the Petitions, and should not have considered them at the time of institution.” *Id.* at 25. Because Jina is an RPI (either based on currently

available facts or the requested RPI discovery), Atossa respectfully requests the Board terminate this proceeding, consistent with the Director’s mandate to enforce § 312(a)(2) (here, § 322(a)(2)) and the estoppel-carrying identification requirement of § 325(e).

**III. There is No Good Cause for Intas to Amend its Petition, and Even If Amended, the Petition Would Receive a New Filing Date and Would Be Time-barred.**

“[A]ny Petition corrected to disclose additional RPIs must be given a new filing date.” *Id.* at 23 (collecting cases). *Corning Optical* indicates a PGR petition “will not be accorded a filing date until the petition . . . [c]omplies with § 42.[2]04.” *Id.* at 24 (quoting § 42.[2]06). § 42.204 requires compliance with § 42.8, which requires each RPI be named in the petition. §§ 42.204, 42.8. As such, if Intas updates its mandatory notices to name Jina as an RPI, the Petition should receive a new filing date. Here, a new filing date would be more than 9 months after the ’391 Patent issued (August 27, 2024), making the Petition time-barred under § 321(c). Thus, amendment would be futile. The appropriate remedy is to terminate this proceeding and vacate the Institution Decision. *See Corning Optical*, Pap.68, 24–25.

Despite *Corning Optical*’s straightforward application here, Intas contends “the Board has good cause to maintain the filing date.” Pap.21, 5. But, there is not a sufficient reason to do so in this case, “especially in view of 35 U.S.C. § 312(a)(2),” *Corning Optical*, Pap.68, 25, and the Director’s mandate that “the Office will now

enforce § 312(a)(2)'s requirement that a petition must 'identif[y] all real parties in interest'" before institution. *Corning Optical Memo*, 4.

To begin with, Intas provides no explanation as to why good cause exists to amend and why Jina was not named an RPI from the outset. Pap.21, 5. And Intas's incorrect RPI determination is not some mistake of fact; rather, counsel for Intas (who also represents Jina, *see* EX2024, EX2026) carefully crafted Intas's disclosure to indicate Jina "may" have an interest without binding Jina to RPI estoppel, and continues to assert Jina was not an RPI at the time of the Petition. Pap.21, 2. Instead, Intas states "Jina has agreed to be added as an RPI to resolve any dispute or need for further discovery and Intas has agreed to add Jina." *Id.* at 1. But Jina's consent does not change the RPI analysis. Stating a party "may have an interest" without making an RPI designation defeats the purpose of assuring proper application of statutory estoppel. If a petitioner knows of an RPI, that petitioner can either identify the party as an RPI and accept the estoppel consequences (as Intas recognizes, Pap.21, 2), or (as Intas chose here) not identify the party and gamble with the consequence of failing to comply—the sanction of termination for petitions that fail to identify all RPIs. While Atossa approached Intas about the RPI issue prior to institution, Intas never asked to correct its RPI identification until after institution when the Board granted briefing on RPI discovery. This behavior does not demonstrate good cause. *See Reflectix*, Pap.18, 14–15. Instead, Intas asserts Jina was not and is not time-barred.

Pap.21, 5. But Jina is time-barred now. *See* § 321(c). And, in any event, whether a petition may be maintained has no bearing on whether good cause exists to amend. *Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2017-01917, Pap.86, 9–16 (Feb. 13, 2019).

**IV. This case is more like *Corning Optical*, *Reflectix*, and *GEA Process* than *Lumentum*, *Proppant*, or *Adello*.**

The Director’s designation of *Corning Optical* following the de-designation of *SharkNinja* is a swift return of strict adherence to § 312(a)’s RPI identification requirement. The Director has abandoned the softened *SharkNinja* approach to RPI identification. *Corning Optical* is controlling, and any reliance on other conflicting RPI precedential cases—such as *Lumentum*, *Proppant*, and *Adello* (now old law)—is inconsistent with the Director’s directive set forth in the *Corning Optical Memo*. It follows that the cases Intas relies on—*One World*, *Banilla*, *LifeCORE*, *BlueCat-Bio*, and *Dispersive Networks*, which follow *Lumentum*, *Proppant*, and *Adello*—are also no longer good law. In any event, this case is more like *Corning Optical*—and *Reflectix* and *GEA Process*, two cases *Corning Optical* favorably relies on—than *Lumentum*, *Proppant*, and *Adello*.

Following institution, the *Corning Optical* panel terminated the proceedings and vacated institution because (as here) petitioner had failed to timely name all RPIs in its petition. *Corning Optical*, Pap.68, 16, 23–26. After institution, patent owner sought RPI discovery. *Id.* at 2. And when it became clear that the petition hadn’t

named certain RPIs, the petitioner there, like Intas here, sought to amend the petition and keep its original filing date. *Id.* at 23. The Board refused, concluding that the petition failed to name all RPIs and, thus, was incomplete and could not be considered. *Id.* at 24–25.

Intas contends that *Corning Optical* “terminated a proceeding because the missing RPI was time-barred and the party had refused to add it as an RPI.” Pap.21, 3. This is wrong for two reasons. First, the Board terminated the proceeding “[b]ecause Petitioner [had] failed to name all [RPIs],” not because the missing RPI was time-barred. *Corning Optical*, Pap.68, 24. The Board found that “the Petitions ha[d] not met the requirements of 35 U.S.C. § 312(a)(2), and, therefore, [we]re incomplete and [could not] be considered.” *Id.* After reaching this conclusion, the Board *additionally* determined that “*even if* Petitioner amended its Petitions, those Petitions would receive a new filing date” and thus would also have been “time-barred under 35 U.S.C. § 315(b).” *Id.* at 24, 25. The time bar did not control the outcome of *Corning Optical*. Indeed, the USPTO’s own characterization of *Corning Optical*’s holding states the Petition was dismissed “for failing to name all RPIs[]”. See <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>.

Second, the *Corning Optical* petitioner did not refuse to add the missing party as an RPI. Petitioner argued that the missing party was not an RPI, but, if the Board found the missing party to be an RPI, petitioner asked to amend the petition to add

the missing RPI. *Corning Optical*, Pap.54, 25 (“Here, like in the above cited cases, the Board should allow Petitioner to amend its Petition and retain its filing date should the Board find an unnamed party to be an RPI.”). This is consistent with the Board’s discussion in Section F of *Corning Optical*, where the Board analyzes whether petitioner would be permitted to amend its petition.

This case is also like *Reflectix* and *GEA Process*. In *Reflectix*, the Board found the petitions failed to identify all RPIs and, thus, could not be considered under § 312(a). *Reflectix*, Pap.18, 18. The *Reflectix* petitioner argued it should be permitted to amend the petitions to correct its identification of RPIs without affecting the petitions’ filing date. *Id.* at 17. The Board disagreed, noting that petitioner “ha[d] not provided a sufficient showing of good cause or otherwise convinced [the Board] that it would be in the interests of justice to allow correction of the RPIs identified in its Petition without loss of the original filing date.” *Id.* at 18. In reaching this conclusion, the Board emphasized two points: (1) “[petitioner]’s incorrect determination of RPI did not arise out of some mistake of fact,” and (2) “[petitioner] never asked to correct its RPI identification . . . until [patent owner] raised the issue.” *Id.* at 14–15. Both points are true here, as well. Intas’s RPI disclosure did not arise out of some mistake of fact: Intas’s decision to not name Jina as an RPI was deliberate, not inadvertent. And Intas never asked to correct its RPI identification until Atossa raised the issue and the Board granted briefing on RPI discovery.

Likewise, in *GEA Process*, the Board found that, “[b]ecause [petitioner] did not identify all the real parties-in-interest in its petitions, it ha[d] not met the statutory requirement of § 312(a)(2), and [the Board] cannot consider the petitions.” *GEA Process Eng’g. Inc. v. Steuben Foods, Inc.*, IPR2014-00041, Pap.140, 23 (Feb. 11, 2015). There, as here, petitioner argued “that equity and justice warrant allowing [petitioner] to correct its identification of the RPIs without changing the filing dates of the Petitions.” *Id.* at 25. Again, the Board disagreed. Petitioner, like Intas here, had not been forthcoming about the missing RPI until after institution when patent owner requested additional RPI discovery. *Id.* On similar facts here, the Board should not allow Intas to correct its identification of the RPIs now.

By contrast, *Lumentum*, *Proppant*, and *Adello* each involved proactive attempts by petitioners to correct mistakes of fact. For instance, *Lumentum*’s petitioner disclosed the new name of an RPI following a corporate reorganization and met no opposition from patent owner to correct the disclosure. *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Pap.38, 7 (Mar. 4, 2016). The Board noted “[t]here is no dispute that the Petition, when filed, identified all real parties in interest, and, therefore, the Petition was complete, was properly accorded a filing date, and was available to be ‘considered’ under § 312(a).” *Id.* at 6. Here, in contrast, Intas chose not to identify all RPIs in the as-filed Petition, thereby skirting the estoppel consequences. Only after Atossa identified the RPI issue and the Board authorized

RPI briefing was Intas willing to amend its Petition to avoid any sanction for its noncompliance. Intas's course of action is inconsistent with the Director's clear policy directive to enforce § 312(a)'s RPI requirement. In *Proppant*, despite various changes in law caused by the Federal Circuit and the panel's interpretation of those decisions, the Board found petitioner had been as forthcoming as it could on the RPI issue. *Proppant*, Pap.86, 12–14. And in *Adello*, petitioner expressly represented “that there was no intentional concealment or bad faith in the accidental omission of [the missing party] as an RPI.” *Adello Biologics LLC v. Amgen Inc.*, PGR2019-0001, Pap.11, 5 (Feb. 14, 2019) (precedential). As such, the Board found “the omission may have been human error, and Petitioners, instead of attempting to circumvent estoppel rules, [we]re attempting to be diligent in updating the mandatory notices.” *Id.* In sharp contrast here, Intas specifically chose *not* to name Jina as an RPI.

## V. Conclusion

For the foregoing reasons, Atossa respectfully requests that the Board either grant Atossa's Motion for Additional Discovery or, in the alternative, terminate the instant proceeding and vacate the Decision on Institution.

Respectfully Submitted by:  
/s/ Megan Raymond (Reg. No. 72,997)

Dated: January 5, 2026

**CERTIFICATE OF PAGE COUNT**

The undersigned certifies that the foregoing PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO PATENT MOTION FOR ADDITIONAL DISCOVERY UNDER 37 C.F.R. §42.51(b)(2) complies with the 10 page limit for this motion.

Dated: January 5, 2026

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of PATENT OWNER'S  
REPLY TO PETITIONER'S OPPOSITION TO PATENT MOTION FOR  
ADDITIONAL DISCOVERY UNDER 37 C.F.R. §42.51(b)(2) has been  
served in its entirety by causing the aforementioned document to be electron-  
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