

From: [Director Discretionary Decision](#)
To: [Hamad Hamad](#); [Director Discretionary Decision](#); [Trials](#)
Cc: [Hartley, Michael J.](#); [Petrillo, Kathleen](#); revans@lewisrice.com; midwest@caldwellcc.com
Subject: RE: IPR2025-01117, -01118 - Notification of Development and Request for Authorization to File Supplemental Briefing
Date: Thursday, October 9, 2025 9:05:29 AM

Patent Owner is authorized to file a 5-page Reply on discretionary issues in IPR2025-01117 and IPR2025-01118 due no later than Monday, October 13, 2025, limited to addressing the arguments raised below. Petitioner is authorized to file a 5-page Sur-reply due no later than Wednesday, October 15, 2025.

Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response in IPR2025-01117 and 01118 is granted. Petitioner may file a 15-page Reply, limited to issues identified in its email to the Board on October 8, no later than October 22, 2025. Patent Owner is also authorized to file a 15-page Sur-reply, responding to the issues raised in the Reply, no later than November 5, 2025.

From: Hamad Hamad <hhamad@caldwellcc.com>
Sent: Wednesday, October 8, 2025 9:58 AM
To: Director_Discretionary_Decision@uspto.gov; Trials@USPTO.GOV
Cc: [Hartley, Michael J.](mailto:mhartley@lewisrice.com); [Petrillo, Kathleen](mailto:kpetrillo@lewisrice.com); revans@lewisrice.com; midwest@caldwellcc.com
Subject: IPR2025-01117, -01118 - Notification of Development and Request for Authorization to File Supplemental Briefing

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Dear Deputy Director and Board,

We write on behalf of Patent Owner and Petitioner in the above-captioned matters to request authorization for Patent Owner to file a five-page Reply in support of its request for discretionary denial. The parties also request that Petitioner be authorized to file a five-page sur-reply one week after Patent Owner files its Reply.

The parties have also conferred regarding the filing of reply briefs to Patent Owner's Preliminary Responses (POPRs), and the Parties request authorization for Petitioner to file a 15-page Preliminary Reply and for Patent Owner to file a 15-page Preliminary Sur-reply in the above captioned matters.

The parties' respective position statements regarding these requests are provided below.

Discretionary Denial Briefing:

Patent Owner's Position:

Pursuant to the Office's September 16, 2025 Memorandum entitled "PTAB consideration of prior findings of fact and conclusions of law," (available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf), Patent Owner is alerting the Board of a memorandum opinion and order ("Memorandum Opinion") denying a motion for judgment as a matter of law entered by the court in *Midwest Energy Emissions Corp., et al. v. Arthur J. Gallagher & Co., et al.*, C.A. 1:19-cv-01334 (D. Del.), which has been identified as a related case in these proceedings. See, e.g., IPR2025-01117, Paper 1, Petition at 2; see also September 16, 2025 Memorandum ("[T]he Board shall consider relevant materials submitted by the parties from the other proceeding (e.g., an opinion, a judgment, trial testimony, or other evidence) and may authorize additional briefing.").

The Memorandum Opinion, attached here, includes findings of fact and conclusions of law that are relevant to Patent Owner's Request for Discretionary Denial in the above-captioned matters.

Pursuant to the Office's September 16, 2025 Memorandum entitled "PTAB consideration of prior findings of fact and conclusions of law," Patent Owner respectfully requests authorization to file a five-page supplemental brief in connection with Patent Owner's Brief in Support of Discretionary Denial regarding the new development in each matter. Patent Owner will submit the Memorandum Opinion as an exhibit in both proceedings. Patent Owner would not be opposed to Petitioners being permitted a five-page response.

Petitioner's Position:

Petitioner does not oppose Patent Owner's Request for a five-page reply so long as Petitioner is authorized to file a five-page sur-reply.

Petitioner further requests authorization to file Replies to the POPRs. Patent Owner has included arguments in both its Requests for Discretionary Denial and its POPRs regarding RPIs and privity. Petitioner understands that pursuant to the Board's FAQ 13, "the Board panel will not consider papers filed by parties relating to discretionary considerations. Parties must

make all their arguments (citing evidence, as needed) on the merits and other non-discretionary considerations in the petition, POPR, and any authorized reply or sur-reply.”
<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

Accordingly, to ensure that the Board panel can consider Petitioner’s response to the RPI and privity issues raised in both the Discretionary Denial briefing, including Patent Owner’s currently Requested Reply, and the POPRs, Petitioner requests a reply to the POPRs as discussed below.

Briefing for the Board Panel:

Petitioner’s Position:

Petitioner requests that it be authorized to file 15-page replies to the POPRs in IPR2025-01117 and -1118 to address: (1) RPI and privity; (2) priority; (3) Patent Owner’s arguments and exhibits submitted with its POPR related to conception and reduction to practice; and (4) Patent Owner’s arguments regarding Vosteen.

As noted above, it is Petitioner’s understanding that the Board Panel will not consider discretionary denial briefs per FAQ 13. Petitioner included RPI and privity arguments in its oppositions to Patent Owner’s discretionary denial briefs. Accordingly, Petitioner requests authorization to address Patent Owner’s RPI and privity arguments in a reply so that they may be considered by the Board Panel.

Petitioner notes that Patent Owner’s RPI and privity arguments are the same in both IPR2025-01117 and -1118. Petitioner’s Preliminary Reply regarding the RPI and privity issues would therefore be the same in both proceedings.

To the extent Petitioner is granted authorization to submit replies to the POPRs, Petitioner does not oppose sur-replies by Patent Owner of the same length.

Patent Owner’s Position:

Patent Owner does not oppose Petitioner's request for replies to the POPRs, provided that Patent Owner is granted sur-replies of the same length.

If the Board or Director wishes to schedule a conference call to discuss the above, the parties will provide their collective availability for a call upon request.

Sincerely,
Hamad Hamad
Lead Counsel for Patent Owner

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