From:	Director_Discretionary_Decision
To:	Feigelson, Aaron; Director_Discretionary_Decision; Trials
Cc:	Eagle Robinson; Allen White; justin.murray@airliquide.com; chad.wallis@nortonrosefulbright.com; Barone, Stephen; Sullivan, Sally A.; Jeff Andrews
Subject:	RE: Request for leave to file Sur-Reply and Reply | IPR2025-01173
Date:	Friday, October 24, 2025 2:23:20 PM

Petitioner is authorized to file a 3-page Sur-Reply in response to Patent Owner's Reply in Support of Discretionary denial, due no later than Monday, October 27, 2025.

The parties will receive a separate email addressing the request for a reply to the POPR at a later date.

From: Feigelson, Aaron <afeigelson@leydig.com>
Sent: Thursday, October 23, 2025 4:30 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>; Trials <Trials@USPTO.GOV>
Cc: Eagle Robinson <eagle.robinson@nortonrosefulbright.com>; Allen White <ALLEN.WHITE@AIRLIQUIDE.COM>; justin.murray@airliquide.com; chad.wallis@nortonrosefulbright.com; Barone, Stephen <sbarone@leydig.com>; Sullivan, Sally A. <ssullivan@leydig.com>; Jeff Andrews <jandrews@yettercoleman.com>
Subject: Request for leave to file Sur-Reply and Reply | IPR2025-01173

Discretionary Denial Group & Honorable Board,

In the referenced proceeding, Petitioner respectfully requests leave to file two additional briefs, demonstrating good cause for each:

1) a **3-page Sur-Reply** in response to Patent Owner's Reply in Support of Discretionary Denial (Paper 14); and
2) a **5-page Reply** in response to Patent Owner's Preliminary Response brief (Paper 10).

Petitioner submits that this additional briefing is necessary for the Board to fully and fairly evaluate the issues, particularly given the October 17, 2025 Memorandum announcing that the Director will decide institution based on "discretionary considerations, the merits, and non-discretionary considerations."

With respect to Patent Owner's Request for Discretionary Denial, good cause for the additional briefing exists for two reasons:

- Patent Owner's reply brief (Paper 14) improperly introduces new arguments regarding the distinction of numerous examiner search results (vs. a specifically queried patent) from the *Siemens Mobility* case for purposes of the Advanced Bionics framework. These arguments should have been raised in Patent Owner's opening Request. A sur-reply is

therefore necessary to properly inform the Board's consideration of this issue.

- Patent Owner further introduces new and speculative arguments that: (a) an examiner would have reviewed the file-wrapper of a cited reference (Darde-US) to find a figure not on its face, and (b) the examiner could have understood a patent's figure descriptions without viewing the figure. A sur-reply is needed to address these unsupported contentions and ensure a complete record.

With respect to Patent Owner's Preliminary Response, good cause for the additional briefing also exists for several reasons:

- Patent Owner introduces a claim construction issue in its Preliminary Response (Paper 10) by asserting that a feed gas stream FG is "converted" to synthesis gas stream SG1, and that SG1 is "converted" to SG3. This assertion is inconsistent with the plain meaning of the "reforming" language in claim 1, and is unnecessary for the invalidity analysis. A reply is essential to address the merits of Patent Owner's proposed constructions, the sufficiency of its evidence, and the lack of relevance of this proposal to the invalidity analysis,

- Patent Owner mischaracterizes Petitioner's expert testimony regarding the presence of carbon dioxide in the output of the endothermic reforming step. Patent Owner selectively focuses on a single background statement, while disregarding multiple unequivocal statements confirming carbon dioxide's presence in prior art embodiments. A reply is warranted to correct this oversight and aid the Director's proper understanding of the issues.

- Patent Owner cites an incorrect legal standard for showing motivation to combine, relying on a non-precedential B.P.A.I. decision (*Ex parte Rinkevich*) that is inconsistent with the current law. A Reply is necessary to clarify the correct legal standard applicable to the obviousness grounds.

For these reasons, good cause exists for Petitioner's requests to file both a Sur-Reply and a Reply.

Petitioner reached out to Patent Owner in advance of this email, and Patent Owner responded as follows:

- Patent Owner opposes Petitioner's request for a sur-reply on discretionary denial. PO's Reply addressed the issues that it was authorized to address, and Petitioner's Opposition to PO's Request for Discretionary Denial already addressed the Board's *Siemens* decision relative to the present facts.

- Patent Owner opposes Petitioner's request for a reply to the POPR. At the outset, Petitioner's request is untimely given that Petitioner waited two weeks to even raise the possibility. It is unclear why Petitioner believes there to be a claim construction issue given that claim 1 explicitly distinguishes between a feed gas stream and multiple synthesis gas streams entering and exiting the respective reforming steps. Moreover, Petitioner only seeks to supplement what the Petition and Petitioner's expert initially said, or to characterize the law, neither of which seems necessary or helpful to the Board's assessment. If a reply is authorized, PO requests a sur-reply of equal length.

If the Board wishes to schedule a call with the parties, the parties are prepared to make themselves available.

Very truly yours,

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