From: Director_Discretionary_Decision
To: Eagle Robinson; Director_Discretionary_Decision
Cc: Barone, Stephen; Sullivan, Sally A.; Andrews, Jeff; Feigelson, Aaron; WHITE, Allen; justin.murray@airliquide.com; Chad Wallis
Subject: RE: Request for leave to file Reply | IPR2025-01173
Date: Thursday, October 16, 2025 5:15:14 PM

Patent Owner is authorized to file a 5-page reply in IPR2025-01173 due no later than Monday, October 20, 2025, limited to addressing the arguments raised below.

From: Eagle Robinson <eagle.robinson@nortonrosefulbright.com>
Sent: Thursday, October 16, 2025 11:24 AM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Barone, Stephen <sbarone@leydig.com>; Sullivan, Sally A. <ssullivan@leydig.com>; Andrews, Jeff <jandrews@yettercoleman.com>; Feigelson, Aaron <afeigelson@leydig.com>; WHITE, Allen <allen.white@airliquide.com>; justin.murray@airliquide.com; Chad Wallis <chad.wallis@nortonrosefulbright.com>; Eagle Robinson <eagle.robinson@nortonrosefulbright.com>
Subject: Request for leave to file Reply | IPR2025-01173

Discretionary Denial Group –

Patent Owner respectfully requests leave to file a short (5-page) Reply in the referenced proceeding. Good cause exists for two reasons:

- The discretionary denial briefs address an issue that does not appear to have been previously addressed, namely whether a listing of a small subset of examiner search *results* (vs. the search *query* addressed in *Siemens Mobility*) was before the Examiner for purposes of part one of the *Advanced Bionics* framework. Petitioner chose not to address in the Petition the fact that two of its primary references were identified by the Examiner, and Patent Owner therefore believes a reply may be helpful for the Board's consideration of the issue.
- Petitioner in its Response brief takes a new position that is opposite to the position taken in the Petition with respect to whether the Darde reference (relied upon for all obviousness grounds) was before the Examiner for purposes of part one of the *Advanced Bionics* framework. *Compare* Paper 1, 12-13 ("While Darde is cited in the file history of the '805 patent, it was not considered *in the context of the combinations…*") *with* Paper 11, 12 ("Darde Was Not Presented").

The parties have conferred by email and Petitioner provides the following statement of its position:

Petitioner opposes Patent Owner's request to file a Reply because neither of the reasons provided illustrate good cause. Specifically:

1. Patent Owner already has made the alleged "search query" / "search result" distinction in its Request for Discretionary Denial (Paper 9, 7), and had a full opportunity to present all of its arguments there. Petitioner's Opposition brief did not introduce any unforeseeable arguments or new evidence that might permit Patent Owner's belated presentation now. Patent Owner already had the opportunity, for example, to explain its position as to why a specifically queried reference (as in *Siemens Mobility*) is somehow *less* of an indicator of the reference's consideration than its inclusion on a list of search results. In such situations, a reply is improper. 37 CFR § 42.23(b).

2. Petitioner's Opposition brief is entirely consistent with its Petition in arguing that only Darde-US, and *not* Darde (PCT), was cited during prosecution. This is readily apparent from the immediate context of the Petition sentence you quote, i.e., "U.S. Publication 2015/0321914, which corresponds to the U.S. national stage of Darde, is referenced in the specification of the '805 patent and was cited during prosecution." Paper 1, 12. See also, Paper 1, 8 ("A Notice of Allowance was mailed on February 3, 2023, allowing claims 1–12, wherein the examiner referred to US20150321914 (U.S. national stage of Darde (EX1007)).") Petitioner has taken no "new position," and a reply brief will not change the clear prosecution history regarding which reference was cited by the examiner, and which was not.

For these reasons, Petitioner opposes Patent Owner's request to file a Reply brief, which would unnecessarily burden the Board and the parties, and on issues that will ultimately have no bearing on the outcome.

Respectfully,

Eagle Robinson
Reg. No. 61,361
Lead Counsel for Patent Owner