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VIA EMAIL

February 8, 2016

Lei Mei
Reece Nienstadt
MEI & MARK LLP
P.O. Box 65981
Washington, DC 20035-5981

Re: Nader Ashgari-Kamrani and Kamran Ashgari-Kamrani v. USAA
United District Court- Eastern District of Virginia (Norfolk)
Civil Action No. 2:15-cv-00478-RGD-LRL

Dear Messrs. Mei and Nienstadt:

In the hope of moving this matter forward, we write to provide some detail as to one of the issues that we perceive with U.S. Patent No. 8,266,432, and one reason why we think depositions of prosecution counsel of related and pending applications will be necessary.

The '432 patent purports to be a "continuation of application No. 11/239,046, filed on Sep. 30, 2005, now Pat. No. 7,444,676, which is a continuation of application No. 09/940,635, filed on Aug. 29, 2001, now U.S. Pat. No. 7,356,837." *See* '432 patent at cover. However, (1) the '676 patent is a ***continuation-in-part*** of the '837 patent, not a continuation, (2) the specification of the '676 patent has no overlap whatsoever with the specifications of the '837 and '432 patents,[1] and (3) the '837 patent issued months before the '432 patent application was filed. Accordingly, the '432 patent's priority claim is improper, and its priority date is no earlier than its filing date. *See* 35 U.S.C. § 120; *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997) ("In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112."); MPEP § 211.05.

The publication of the '432 patent's grandparent application on March 6, 2003 anticipates every claim of the '432 patent, in view of the '432 patent's admission that "the current application has the ***exact same specification and Figures*** as those submitted with the [grandparent application that led to the '837 patent]." '432 Patent at col. 1:14-17 (emphasis added); *see also Lockwood*, 107 F.3d at 1571-72 (using parent patents to invalidate a child patent due to a failure to maintain "the continuity of disclosure").

Moreover, it is our view that the single most reasonable inference from the facts is that this misrepresentation to the Patent Office concerning the applicable priority date was made with the

[1] Indeed, the applicants recognized how different the two specifications are: the '676 patent application was filed with a non-publication request whereas the '432 and '837 patent applications—which share the same specification—were not.

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intent to deceive. And since applications are still being prosecuted based on a deceptive priority claim—by Mei & Mark LLP—the inequitable conduct continues to this day.[2] For at least these reasons, we believe that discovery into all of the patent prosecution counsel will be necessary. To the extent you represent prosecution counsel (aside from yourself, of course), kindly ensure that they are advised of their duty to preserve discoverable information. By this note, we so advise Mei & Mark LLP. If there is prosecution counsel that you do not represent, kindly identify which and we will make the necessary notices.

Please be aware that we intend to seek sanctions (including under Rule 11) as well as attorneys' fees. To the extent Plaintiffs are considering a voluntary dismissal, please be on notice that absent an acceptable resolution, USAA will press this issue, and all related issues, in both district court proceedings and the PTAB.

Kindly let us have your position in three business days. If this matter is not resolved to our satisfaction by then, USAA will file a post grant petition on at least the bases herein.

Very truly yours,

/s/Michael T. Zoppo

Michael T. Zoppo

MTZ/khm

[2] As prosecution counsel, we remind Mei & Mark LLP of its Rule 56 duties.