

Katherine D. Cappaert

From: Vignone, Maria <Maria.Vignone@USPTO.GOV> on behalf of Trials <Trials@USPTO.GOV>
Sent: Wednesday, April 29, 2015 4:30 PM
To: Roberto Devoto; Underwood, Cathy; Michael L. Kiklis; dberl@wc.com; tfletcher@wc.com; jberniker@wc.com; csuarez@wc.com; IPR37136-0004IP1; CP Docket McKeown; CP Docket Kiklis; CP Docket Laurence; CP Docket Cappaert; CPDocketRicciuti; CP Docket Cappaert; Trials
Cc: Arlenette Footes; Karl Renner; David Holt
Subject: RE: Requested Conference Call Related To - IPR2014-00687; 00688; 00689

Counsel:

The parties are expected to work together to ensure timely filing of papers so that the Board can effectively deal with the issues arising in these proceedings. Counsel for ION is authorized to file a Motion for Pro Hac Vice for David Healey, which, to accommodate the deposition tomorrow, should be filed by 6pm EST this evening. The motion must indicate if it is unopposed. If it is opposed, an opposition to the same must be filed by 7 pm EST this evening.

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

From: Roberto Devoto [<mailto:devoto@fr.com>]
Sent: Wednesday, April 29, 2015 7:54 AM
To: Underwood, Cathy; Michael L. Kiklis; dberl@wc.com; tfletcher@wc.com; jberniker@wc.com; csuarez@wc.com; IPR37136-0004IP1; CP Docket McKeown; CP Docket Kiklis; CP Docket Laurence; CP Docket Cappaert; CPDocketRicciuti; CP Docket Cappaert; Trials
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?Dear Ms. Underwood

Pursuant to the e-mail sent last night, ION would like to file a Motion for Pro Hac Vice to allow our colleague, David Healey, to observe the deposition scheduled on 4/30/15. Pursuant to the Grant of Motion for Joinder (e.g., Paper 14 of IPR2015-00565), "ION ... is permitted to appear in [the joined proceeding] so that it ... may attend depositions..." As will be reflected in our motion, we wish to designate David to represent ION as an observer at the deposition because: (1) unlike Karl (lead counsel) and me (backup counsel), he is located in Houston, Texas and the deposition is in Houston, Texas; and (2) he has been involved in the counterpart litigation on behalf of ION over the same patents at issue in these proceedings, which makes him uniquely equipped to act on ION's behalf in these matters.

Unfortunately, we are unable to file our Motion via PRPS, which only allows the original petitioner's lead and backup counsel (i.e., PGS's lead and backup counsel) to submit filings. One known workaround for this problem is to have the original petitioner's counsel (i.e. PGS) add the lead and backup counsel of the joining petitioner (i.e., ION) as backup counsels to the joined proceedings on PRPS. However, PGS is not comfortable adding Karl Renner (ION lead counsel) and me (ION Backup counsel) as backup counsel to the proceedings. In view of this, we wish to have a call with the Board to resolve this problem so as to allow ION to submit the Motion for Pro Hac Vice today for expedited consideration by the Board and in advance of the 4/30/15 deposition.

The representatives of the Patent Owner are available between 10am and 5pm. ION's representatives are available between 11am and 5pm, and the representatives of PGS are available this morning and, with this e-mail, may provide further availability if needed.

We look forward to hearing from you about the Board's availability for such a call.

Kind Regards,

-Rob

ION Backup Counsel

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