

Argenti, Matthew

From: Vignone, Maria <Maria.Vignone@USPTO.GOV> on behalf of Trials <Trials@USPTO.GOV>
Sent: Thursday, November 12, 2015 7:44 AM
To: Rosato, Michael; Trials
Cc: Argenti, Matthew; Torczon, Richard; Eliot.Williams@bakerbotts.com; hop.guy@bakerbotts.com
Subject: RE: IPR2015-00059

Counsel,

For this particular request, the panel does not wish to hold a conference call. Patent Owner is hereby authorized to file a combined motion to exclude and motion to strike in accord with applicable rules. Petitioner may oppose, also in accord with applicable rules.

Thank you,

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

From: Rosato, Michael [<mailto:mrosato@wsgr.com>]
Sent: Thursday, November 12, 2015 7:09 AM
To: Trials
Cc: Argenti, Matthew; Torczon, Richard; Eliot.Williams@bakerbotts.com; hop.guy@bakerbotts.com
Subject: IPR2015-00059

Dear Trials,

Caltech (Patent Owner) requests authorization to file a motion to strike certain evidence and portions of the Hughes (Petitioner) Reply to Patent Owner Response (Paper 29, "Petitioner's Reply"). Specifically, the motion to strike would address the following:

Evidence and New Argument Relating to Divsalar Reference and Status as a Printed Publication

- Exhibit 1064 (Declaration of Robin Fradenburgh), based on Petitioner's failure to make Ms. Fradenburgh available for cross-examination, subsequent refusal to withdraw the testimony, and continued reliance; and
- Portions of Petitioner's Reply raising new theory of unpatentability contending that the Divsalar reference constitutes prior art under 102(a), based on failure to raise this argument in the Petition.

New Evidence Related to Real Party-in-Interest Issue

- Exhibit 1076 (Declaration of Timothy Jezek), based on the Board's previous decision to expunge an identical exhibit (see Paper 21 p. 4) and Petitioner's failure to request authorization to file a motion to submit supplemental information.

New Evidence Going to the Merits of the Instituted Ground

- Exhibit 1074 (Supplemental Declaration of Henry Pfister), based on the prejudice of new claim constructions first appearing in Petitioner's Reply rather than in the Petition.

In the interest of efficiency Caltech is willing to combine the requested motion to strike with its motion to exclude evidence, currently due on December 21, 2015. The Board might decide to authorize the requested filing by email – otherwise, the parties are available for conference call at the following times:

- Monday 11/16 between 1:00 and 3:00 eastern
- Tuesday 11/17 between 1:30 and 5:00 eastern

The Petitioner has been consulted and has indicated that it will oppose this request.

Regards,

Michael T Rosato

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