

## Worth, Gerald E.

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Tuesday, July 28, 2015 3:34 PM  
**To:** Worth, Gerald E.  
**Cc:** Trials; david.cavanaugh@wilmerhale.com; michaelh.smith@wilmerhale.com; don.steinberg@wilmerhale.com; Capraro, Jr., Joseph A.; PTABMattersBoston  
**Subject:** RE: IPR2015-01375, request for permission to submit a Request for Certificate of Correction

Counsel: Ex parte communication is prohibited in PTAB inter partes proceedings. 37 C.F.R. 42.5(d). All future email correspondence to the Board regarding this case must include (Cc) opposing counsel.

In response to Patent Owner's specific inquiry made in the original email, PO should not file any papers, including a request to a department of the Office outside of the PTAB to issue a Certificate of Correction, while the case is pending before the PTAB. 37 CFR 42.3.

In lieu of a motion, at this time, Patent Owner may address the alleged error(s) in its preliminary response.

Regards,

Derek Taylor  
Patent Trial and Appeal Board  
571-272-7822

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**From:** Worth, Gerald E. [<mailto:gworth@proskauer.com>]  
**Sent:** Tuesday, July 28, 2015 12:41 PM  
**To:** Trials  
**Subject:** IPR2015-01375, request for permission to submit a Request for Certificate of Correction

Dear Sir

The Patent Owner seeks permission to request that the Commissioner issue a Certificate of Correction for U.S. Patent No. 8,048,000. The U.S. Patent and Trademark Office (PTO) issued U.S. Patent No. 9,048,000 on June 2, 2015, which is subject to IPR2015-01375, filed June 12, 2015.

The Patent Owner, Energetiq, Inc., wishes to submit a request asking the PTO to correct errors in issued claim 25, as follows:

...emitted by the plasma and reflecting the plasma-generated ~~[[#]]~~ light toward the sapphire ~~[[window-]]~~ window, wherein the emitted light and laser ~~[[ever-y]]~~ energy pass through the window.

These errors are clearly disclosed in the records of the PTO, e.g., on page 6 of the Amendment and Response filed by the Patent Owner on March 5, 2015 during prosecution of the application.

However, 37 CFR 1.322(a)(3) now recites the following:

"(3) If the request relates to a patent involved in an interference or trial before the Patent Trial and Appeal Board, the request must comply with the requirements of this section and be accompanied by a motion under §41.121(a)(2), §41.121(a)(3), or §42.20 of this title."

The Patent Owner suggests that no motion need be filed with the PTAB for this purpose at this time since a trial has not been granted.

Please let us know if we need to seek permission from the PTAB to submit a Request for Certificate of Correction seeking the above corrections.

Sincerely yours,

Jerry Worth

**Gerald E. Worth, P.E.**  
Patent Counsel

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