

---

**From:** Trials  
**Sent:** Monday, October 29, 2018 4:45 PM  
**To:** Chad Nydegger  
**Cc:** Carter, R. Trevor; Jonas, Victor P.; Sullivan, Timothy M.; David R. Todd; Anderson, Nick M.; Mike Frodsham  
**Subject:** RE: IPR2015-01691 [WNDMS-DMS1.FID1642524]

**Counsel:**

No conference call is necessary. An order will be rendered in due course.

Regards,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

---

**From:** Chad Nydegger <CNydegger@WNLaw.com>  
**Sent:** Monday, October 29, 2018 1:06 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** Carter, R. Trevor <Trevor.Carter@FaegreBD.com>; Jonas, Victor P. <Victor.Jonas@FaegreBD.com>; Sullivan, Timothy M. <Timothy.Sullivan@faegrebd.com>; David R. Todd <DTodd@WNLaw.com>; Anderson, Nick M. <nick.anderson@faegrebd.com>; Mike Frodsham <MFrodsham@WNLaw.com>  
**Subject:** IPR2015-01691 [WNDMS-DMS1.FID1642524]

Dear Board,

I represent the Patent Owner in IPR2015-01691. On September 17, 2018, the Board issued an order (Paper 47) authorizing, *inter alia*, Petitioner to file a brief and supporting expert declaration to address claims that were initially not instituted for trial, but were recently instituted on remand from the Court of Appeals for the Federal Circuit based on *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018) (see Paper 46 at 2). In authorizing Petitioner to file a brief and supporting declaration on the newly instituted claims, the Board admonished that "Petitioner may not submit new evidence, issues, or argument that it could have presented earlier, e.g. to make out a prima facie case of unpatentability." (Paper 47, p. 8.) On October 19, 2018, Petitioner filed *Petitioner's Supplemental Brief Addressing Newly Instituted Claims 8, 11, 13 and 21-23* ("Supplemental Brief") and the *Supplemental Declaration of Joseph J. Beaman Jr.* ("Supplemental Beaman Declaration"). (Paper 48 and Exh. 1038.) Contrary to the Board's instructions, the Supplemental Brief and Supplemental Beaman Declaration contain new argument and evidence to make out a prima facie case of unpatentability that could have been presented earlier in connection with the original Petition. Thus, Patent Owner seeks authorization from the Board to file a motion to strike the improper portions of the Supplement Brief and to exclude the improper portions of the Supplemental Beaman Declaration.

Counsel for Patent Owner are generally available Monday through Wednesday this week to hold a conference call with the Board should it like to discuss this issue.

Yours truly,  
Chad Nydegger

IP2015-01691  
Ex. 3003

**CHAD E. NYDEGGER**

WORKMAN | NYDEGGER

OFFICE DIRECT: 801-321-8810

EMAIL: [CNYDEGGER@WNLAW.COM](mailto:CNYDEGGER@WNLAW.COM)

BIOGRAPHY: [CNYDEGGER](#)

**workman  
nydegger**

Intellectual Property Law

60 East South Temple • Suite 1000  
Salt Lake City, UT 84111

T: (801) 533-8800 • F: (801) 328-1707  
[www.wnlaw.com](http://www.wnlaw.com)

PRIVACY: This e-mail may contain information that is privileged or confidential. If you are not the intended recipient, please delete the e-mail and any attachments and notify the sender immediately, and do not use, copy, or disclose to anyone any of the contents hereof.