

Michael Chakansky

Subject: FW: IPR2016-00281 and IPR2016-00282

From: Vignone, Maria [mailto:Maria.Vignone@USPTO.GOV] On Behalf Of Trials
Sent: Friday, January 08, 2016 2:32 PM
To: Michael Chakansky; Trials
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Michael Chakansky; 514IPR
Subject: RE: IPR2016-00281 and IPR2016-00282

Counsel: We do not have a panel for these cases yet. Please check back in another week or so.

Thank you,

Maria Vignone
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From: Michael Chakansky [mailto:mchakansky@optonline.net]<mailto:[mailto:mchakansky@optonline.net]>
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'Daniel Scola'; 'Michael Chakansky'; 514ipr@hbiplaw.com<mailto:514ipr@hbiplaw.com>
Subject: IPR2016-00281 and IPR2016-00282

RE: IPR2016-00281 (US Patent No. 8,603,514 ('514 Patent)) and IPR2016-00282 (US Patent No. 8,017,150 ('150Patent))
Request for Conference to Discuss Correcting Filing Dates for Both Petitions

Dear Trial Board:

We represent Patent Owner, MonoSol Rx LLC and we request a conference with the Board to discuss, in connection with the above-referenced IPRs, Petitioner's incomplete service and incorrect statement in certificate of service as to the date of deposit with FedEx of the incomplete service. Patent Owner seeks guidance in how to have the filing dates corrected. Petitioner is the same for the foregoing IPRs and we have met and conferred with Counsel for Petitioner on the issues below.

As the incomplete service involved both the above-referenced IPRs as well as a third IPR some detail is necessary. As counsel of record for Patent Owner we received, on December 7, 2015, three banker's size boxes of materials regarding petitions for IPRs of the '514 Patent (281 IPR) and US Patent No. 8,475,832 ('832 Patent) (IPR2016-00280)(280 IPR). The 280 IPR is being handled by Counsel for the current Patent Owner of the '832 Patent. We only found out serendipitously that the documents also related to an IPR for the '150 Patent. As the documents provided in the three boxes only contained petitions for the 280 and 281 IPRs, they did not disclose the existence of the 282 IPR. However, when we went online to the PTAB website, and searched, the results, in addition to the '280 and 281 IPRs, also disclosed a 282 IPR.

In sum, the three boxes contained incomplete sets of documents, for which we later found out were for these three separate IPRs. Moreover, these documents were all intermixed and not bates-stamped in accordance with the PTAB rules. Additionally, the filings with the PTAB were also incomplete. In particular, we briefly make note of the following material deficiencies in the completeness of service and in the certificate of service, separately for the 281 and 282 IPRs:

IPR2016-00282 (8,017,150):

In the bankers' boxes served on Patent Owner's counsel of record:

(1) There was no copy of the IPR Petition for the 8,017,150 patent.

(2) There was no copy of Exhibit 3 (Expert Declaration of Nandita Das).

(3) The Certificate of Service stated that it was served on December 3, 2015 by FedEx, even though the bankers' boxes were not tendered to FedEx until 3:02 am the next day, December 4, 2015.

IPR2016-00281 (8,603,514):

In the bankers' boxes served on Patent Owner's counsel of record:

(1) There was no copy of Exhibit 3 (Expert Declaration of Jayanth Panyam);

(2) The Certificate of Service stated that it was served on December 3, 2015 by FedEx, even though the bankers' boxes were not tendered to FedEx until 3:02 am the next day, December 4, 2015.

(3) Several documents were not stamped with Exhibit bates stamp markings.

Petitioner subsequently served an additional fourth banker's box of documents, which we received on December 18, 2015, presumably made as part of Petitioner's responses to Papers No. 3 in the IPRs. The fourth banker's box did not provide the documents or address any of the itemized infirmities (1), (2) and (3) for the 281 IPR and 280 IPR as noted above. In particular, the fourth banker's box did not contain the '150 Petition or the '150 and '514 expert declarations.

Finally, after requesting a meet and confer with Counsel for Petitioner's, which request recited the above, we received, via electronic service on December 24, 2015, the missing and corrected documents.

As service of the petition and supporting evidence is a prerequisite to being afforded a filing date for an IPR the Patent Owner requests guidance on correcting the filing date of the Petitions to December 24, 2015.

the date service of the missing petition and the two missing declarations and the other noted infirmities was finally completed. The filing dates currently afforded both the Petitions is December 4 (see Paper 3 in each file). However, it is our understanding that Petitioner will be requesting that the filing dates for both be changed to December 3, 2015.

The filing dates are important as they are dispositive, at this stage of the process, as Patent Owners' complaint alleging infringement of the above three patents was served on Petitioner on December 3, 2014, thus bringing into play the 1 year bar of 35 U.S.C. 315(b). Moreover, we would like to discuss the incorrect statement in the certificates of service.

Counsel for Patent Owner and Petitioner met and conferred on Thursday, January 7, 2016.

If it is convenient for the Board, Counsel for Patent Owner and Petitioner are available for a conference next Thursday, January 14, 2016, between 2 pm and 5 pm, or next Friday, January 15, 2016 between 10 am and 12 noon. If these dates are not convenient, Patent Owner will try and be available whenever it is convenient for the Board.

With the Board's permission, Petitioner intends to have a court reporter record the conference, and further requests permission to file a copy of the transcript as part of the record in each of these actions.

Thank you for your consideration of this matter.

Sincerely,

Michael Chakansky.

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