

**From:** [Sommer, Andrew R.](#)  
**To:** [Trials](#)  
**Cc:** [Mathas, Kurt A.](#); [Nutter, Michael K.](#); [UT507-IPR@foley.com](#); [ssnader@unither.com](#); [dcarsten@wsgr.com](#); [rtorczon@wsgr.com](#); [bdeffield@wsgr.com](#); [vascarrunz@wsgr.com](#); [GQuillin@foley.com](#)  
**Subject:** RE: IPR2017-01621, IPR2017-01622: Requests for Authorization  
**Date:** Wednesday, February 14, 2018 1:03:09 PM  
**Attachments:** [image005.png](#)  
[image002.png](#)

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Your Honors,

In response to Mr. Kellog's email from February 12, the parties have conferred and provide the following times that they are available for a conference call: Thursday, February 22 at 1-2 or 4-5 or Friday, February 23 at 1-noon, 1-2, and 3-5 (all times eastern).

The following briefly describes the factual basis for the motions Petitioner requests authorization to file:

**1. Supplemental Information Under Rule 42.123(a):**

One issue in this proceeding is whether the Ghofrani reference is "by another." Petitioner would like authorization to supplement the record with the following documents, which Petitioner contends relates to the aforementioned issue:

- Two documents related to a proceeding in Maryland state court between one of the named inventors and Patent Owner, in which the inventor disputed the inventorship and ownership of the involved patent.
- A declaration from the prosecution history of a parent patent application that includes as an attachment correspondence between certain named inventors and the prosecuting attorney in which inventorship of the challenged patents is discussed.

**2. Motion for Additional Discovery Under Rule 42.51(b)(2):**

The prosecution history declaration identified in the second bullet point includes redactions. The sole information sought by Petitioner in its motion for additional discovery is an un-redacted copy of the declaration and its attachments.

Please let us know if the panel requires any additional information, or would like copies of the documents in question in advance of any teleconference.

Best regards,

Andrew R. Sommer  
Reg. No. 53,932

**Andrew R. Sommer**

Partner

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**From:** Trials [mailto:Trials@USPTO.GOV]

**Sent:** Monday, February 12, 2018 3:03 PM

**To:** Sommer, Andrew R. <ASommer@winston.com>; Trials <Trials@USPTO.GOV>

**Cc:** Mathas, Kurt A. <KMathas@winston.com>; Nutter, Michael K. <MNutter@winston.com>; UT507-IPR@foley.com; ssnader@unither.com; dcarsten@wsgr.com; rtorczon@wsgr.com; bdelafield@wsgr.com; vascarrunz@wsgr.com; GQuillin@foley.com

**Subject:** RE: IPR2017-01621, IPR2017-01622: Requests for Authorization

Counsel, we have received Petitioner's request for authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. 42.123(a) and a motion for additional discovery under 37 C.F.R. 42.51(b)(2).

The parties should meet and confer and send several times that they are available for a conference call to the trials mailbox. Please provide times on February 8 or later as the panel is not available before that time. We also request that Petitioner briefly describe the factual basis for both proposed motions in the email in one or two sentences, without providing any argument.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
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**From:** Sommer, Andrew R. [mailto:ASommer@winston.com]

**Sent:** Friday, February 9, 2018 3:15 PM

**To:** Trials <Trials@USPTO.GOV>

**Cc:** Mathas, Kurt A. <KMathas@winston.com>; Nutter, Michael K. <MNutter@winston.com>; UT507-IPR@foley.com; ssnader@unither.com; dcarsten@wsgr.com; rtorczon@wsgr.com; bdelafield@wsgr.com; vascarrunz@wsgr.com; GQuillin@foley.com

**Subject:** IPR2017-01621, IPR2017-01622: Requests for Authorization

Your Honors,

Petitioner seeks authorization to file 2 motions: a motion to submit supplemental information pursuant to 37 C.F.R. 42.123(a) and a motion for additional discovery under 37 C.F.R. 42.51(b)(2). Petitioner and Patent Owner have conferred about Petitioner's request, and Patent Owner opposes both requests for authorization to file the motions.

Please let us know if the panel would like to schedule a call with counsel for the parties or would like additional information about the discovery sought or the supplemental information to be filed. Petitioner has provided details to Patent Owner already but is not providing them here at Patent Owner's request.

Best regards,

Andrew R. Sommer  
Reg. No. 53,923

**Andrew R. Sommer**

Partner

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