

From: Trials
Sent: Thursday, May 3, 2018 12:10 PM
To: Kayvan Noroozi; Sommer, Andrew R.
Cc: Trials; Woods, Michael; Dunham, Thomas M.; Lisa.Nguyen@lw.com; William Rothwell; jamie.lynn@bakerbotts.com; J. Christopher Carraway (chris.carraway@klarquist.com); Alan.Billharz@lw.com
Subject: RE: IPR2017-00176, -179: Request Under SAS

Counsel,

The Board notes that IPR2017-00176 has been consolidated with IPR2017-00806 and joined with IPR2017-01688, and that IPR2017-00179 has been consolidated with IPR2017-00808 and joined with IPR2017-01690. The Board appreciates the parties' non-opposition to the Board's inclusion in this trial of all grounds raised in the Petitions (including (1) Franaszek and Hsu, and (2) Franaszek, Hsu, and Sebastian) without further briefing, notwithstanding their apparent dispute as to whether the Petitions adequately set forth separate grounds based on (1) Franaszek and Hsu, and (2) Franaszek, Hsu, and Sebastian. The Board notes, however, that even though counsel for the Petitioners in the four joined or consolidated proceedings were copied on the parties' prior emails, these e-mails explicitly referenced only the lead cases (IPR2017-00176 and IPR2017-00179), and counsel for Petitioners in the four joined or consolidated proceedings did not explicitly confirm that they consent to this approach.

In order to ensure that the record is clear, the Board requests that Patent Owner and the Petitioners in the six above-referenced proceedings respond to this e-mail to confirm that they consent to the Board considering and ruling on all patentability arguments set forth in the Petitions (including the Petitioners' unpatentability arguments based on (1) Franaszek and Hsu, and (2) Franaszek, Hsu, and Sebastian) without further briefing, and without further oral argument.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
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From: Kayvan Noroozi [mailto:kayvan@noroozipc.com]
Sent: Wednesday, May 2, 2018 2:55 PM
To: Sommer, Andrew R. <ASommer@winston.com>
Cc: Trials <Trials@USPTO.GOV>; Woods, Michael <MWoods@winston.com>; Dunham, Thomas M. <TDunham@winston.com>; Lisa.Nguyen@lw.com; William Rothwell <william@noroozipc.com>; jamie.lynn@bakerbotts.com; J. Christopher Carraway (chris.carraway@klarquist.com) <chris.carraway@klarquist.com>; Alan.Billharz@lw.com
Subject: Re: IPR2017-00176, -179: Request Under SAS

Your Honors:

To clarify, Patent Owner does not believe there is an SAS issue here. The petitions were instituted on all offered grounds and all challenged claims. Nonetheless, Petitioner correctly states that Patent Owner does not object to the Board addressing, in its final written decision, (1) Franaszek and Hsu; and (2) Franaszek, Hsu, and Sebastian.

Best
Kayvan Noroozi

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On Wed, May 2, 2018 at 11:19 AM, Sommer, Andrew R. <ASommer@winston.com> wrote:

Your Honors:

Petitioner in the above-referenced proceedings requests that the Board consider the two grounds that it identified in the Petition in these matters, namely: (1) Franaszek and Hsu, and (2) Franaszek, Hsu, and Sebastian. Petitioner submits that the panel should evaluate the challenges set forth in the petition. Petitioner has conferred with Patent Owner, who does not object to this approach. The parties to these proceedings agree that all issues have been fully briefed and can be evaluated by the panel without further briefing unless the panel believes further briefing is needed.

Best regards,

Andrew R. Sommer

Reg. No. 53,932

Andrew R. Sommer

Partner

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