

From: [Trials](#)
To: [Andrew Gordon](#); [Rahlin, Katie](#)
Cc: [Trials](#); [Steinert, Adam](#); [Gregory Gonsalves](#)
Subject: RE: Petitioner Request for Permission to File Motions to Withdraw IPRs 2018-01389/91/92/94
Date: Wednesday, July 24, 2019 2:20:33 PM

Counsel,

Petitioner is authorized to file, within 5 business days, a motion to withdraw in each of the identified IPRs, and that each motion is limited to 5 pages.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
Direct: 571-272-5366

From: Andrew Gordon <andrew@agordonlawfirm.com>
Sent: Wednesday, July 24, 2019 12:36 PM
To: Rahlin, Katie <KRahlin@fredlaw.com>
Cc: Trials <Trials@USPTO.GOV>; Steinert, Adam <ASteinert@fredlaw.com>; Gregory Gonsalves <gonsalves@gonsalveslawfirm.com>
Subject: Re: Petitioner Request for Permission to File Motions to Withdraw IPRs 2018-01389/91/92/94

Dear Board,

e-Numerate does not oppose Merrill's request to withdraw. e-Numerate feels that the IPRs should be terminated in view of Merrill's decision to direct its attorneys to stop participating in them.

Regards,

Andrew Gordon (counsel for Patent Owner)

On Jul 24, 2019, at 9:15 AM, Rahlin, Katie <KRahlin@fredlaw.com> wrote:

Dear Board,

Petitioner requests permission to file motions to withdraw from IPRs 2018-01389/91/92/94. Petitioner wishes to withdraw the appearances of its counsel (Katherine J. Rahlin and Adam R. Steinert), as well as withdraw its participation in the IPR proceedings.

The related civil action in the U.S. District Court for the District of Delaware, captioned *e-Numerate Solutions, Inc., and e-Numerate, LLC, v. Mattress Firm Holding Corp., Merrill Communications LLC, and Merrill Corp.*, No. 1:17-cv-00933, has been dismissed, as Patent Owner's infringement allegations are no more extensive than what is covered by the United States of America's authorization and consent. Since dismissal of that case, Patent Owner filed a lawsuit against the United States of America in the Court of Federal Claims, captioned *e-Numerate Solutions, Inc. et al v. The United States of America*, No. COFC-1-19-cv-00859, alleging infringement of the four patents at issue in IPRs 2018-01389/91/92/94. The Government has indicated that it will indemnify Merrill for any claim of infringement of any of the four patents at issue in the IPRs.

Therefore, Petitioner respectfully request the Board grant it permission to file motions to withdraw its counsel from the IPRs, as well as withdraw its participation in the IPR proceedings. Patent Owner has indicated that it does not oppose this request.

Best Regards,

Katherine Rahlin (counsel for Petitioner)

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<image003.jpg>

Katherine J. Rahlin

Attorney

Registered, U.S. Patent Office

krahlin@fredlaw.com

Direct - 612-492-7370

Assistant - 612-492-7651

Main - 612-492-7000

Fredrikson & Byron, P.A.

200 South Sixth Street

Suite 4000

Minneapolis, MN 55402-1425

[Biography](#) | [Download My Contact Info as V-Card](#)

WWW.FREDLAW.COM

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