

From: [Jeremy Monaldo](#)
To: [Trials](#); [brett@etheridgelaw.com](#)
Cc: [PR39521-0060IP1@fr.com](#); [AXF-PTAB](#); [PTAB Inbound](#); [Deepa Acharya](#); [Grace Kim](#); [Jim@EtheridgeLaw.com](#); [Ryan@EtheridgeLaw.com](#); [Jeff Huang](#); [Brian Koide](#); [Karl Renner](#)
Subject: RE: IPR2019-00510 // Re. challenged claim 18
Date: Friday, May 15, 2020 5:57:29 PM

Your Honors,

The Board asked the parties to set forth “whether there is an agreement between the parties to withdraw claim 18 from consideration in IPR2019-00510.” Petitioners understand that it is Uniloc’s position that:

Uniloc is willing to withdraw claim 18 from the IPR, and

Claim 18 of the 079 patent has been finally held invalid, Uniloc is estopped from asserting claim 18 in any pending or future litigation as a result of that finding, and the estoppel is not party specific. Rather, the estoppel applies to claim 18 of the 079 patent and Uniloc is estopped from any assertion of that claim against any party.

Based on this understanding, Petitioners agree to withdraw the challenge to claim 18.

Best Regards,
Jeremy

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, April 29, 2020 1:46 PM
To: Jeremy Monaldo <Monaldo@fr.com>; [brett@etheridgelaw.com](#); Trials <Trials@USPTO.GOV>
Cc: [PR39521-0060IP1@fr.com](#); [AXF-PTAB <AXF-PTAB@fr.com>](#); [PTAB Inbound <PTABInbound@fr.com>](#); [Deepa Acharya <deepaacharya@quinnemanuel.com>](#); [Grace Kim <gkim@fr.com>](#); [Jim@EtheridgeLaw.com](#); [Ryan@EtheridgeLaw.com](#); [Jeff Huang <jhuang@etheridgelaw.com>](#); [Brian Koide <brian@etheridgelaw.com>](#); [Karl Renner <renner@fr.com>](#)
Subject: RE: IPR2019-00510 // Re. challenged claim 18

Counsel,

The Board appreciates the parties attempts to streamline the issues in IPR2019-00510 by discussing the withdrawal of claim 18 (recently held unpatentable by the Federal Circuit) from consideration.

In light of the received emails, the parties shall meet and confer and jointly file an email no later than May 16, 2020 setting forth whether there is an agreement between the parties to withdraw claim 18 from consideration in IPR2019-00510.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Jeremy Monaldo <[Monaldo@fr.com](#)>
Sent: Tuesday, April 28, 2020 11:21 PM
To: [brett@etheridgelaw.com](#); Trials <[Trials@USPTO.GOV](#)>
Cc: [PR39521-0060IP1@fr.com](#); [AXF-PTAB <AXF-PTAB@fr.com>](#); [PTAB Inbound <PTABInbound@fr.com>](#); [Deepa Acharya <deepaacharya@quinnemanuel.com>](#); [Grace Kim <gkim@fr.com>](#); [Jim@EtheridgeLaw.com](#); [Ryan@EtheridgeLaw.com](#); [Jeff Huang <jhuang@etheridgelaw.com>](#); [Brian Koide <brian@etheridgelaw.com>](#); [Karl Renner <renner@fr.com>](#)
Subject: RE: IPR2019-00510 // Re. challenged claim 18

Your Honors,

In response to Uniloc’s indication that it “will not petition for certiorari” on the adverse claim 18 indefiniteness decision in the related matter, we inspired outreach to Uniloc’s litigation counsel to confirm that Uniloc will withdraw the assertion of claim 18 in litigation against each of the Petitioners. The response from Uniloc’s litigation counsel was equivocal, indicating only that “we have not given thought to how to proceed” and “it is not our policy to assert claims that have been finally held invalid.” See, e.g., Attached Email from James Foster at Prince Lobel. Given that Uniloc did not definitively commit to withdraw claim 18 from pending litigations involving Petitioners and that Uniloc likewise was unwilling to confirm non-assertion of claim 18 in any future litigation against Petitioners, Petitioners cannot withdraw the challenge to claim 18 at this time. If,

however, Uniloc definitively commits to withdrawing claim 18 from the pending litigations involving Petitioners and confirms that Uniloc will not assert claim 18 of the '079 patent in any future litigation against Petitioners, Petitioners would agree to withdraw the present challenge to claim 18.

Best Regards,
Jeremy

Jeremy Monaldo :: Principal :: Fish & Richardson P.C.
+1 (202) 626-7717 direct :: Monaldo@fr.com
[fr.com](#) :: [Bio](#) :: [LinkedIn](#) :: [Twitter](#)

From: brett@etheridgelaw.com <brett@etheridgelaw.com>
Sent: Friday, April 24, 2020 10:20 AM
To: Trials <Trials@USPTO.GOV>
Cc: PR39521-0060IP1@fr.com; AXF-PTAB <AXF-PTAB@fr.com>; PTAB Inbound <PTABInbound@fr.com>; Jeremy Monaldo <Monaldo@fr.com>; Deepa Acharya <deepaacharya@quinnemanuel.com>; Grace Kim <gkim@fr.com>; Jim@EtheridgeLaw.com; Ryan@EtheridgeLaw.com; Jeff Huang <jhuang@etheridgelaw.com>; Brian Koide <brian@etheridgelaw.com>
Subject: IPR2019-00510 // Re. challenged claim 18

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Honorable Board:

Pursuant to the Board's instructions, given during oral argument yesterday in IPR2019-00510, that Patent Owner provide an update on its intentions in view of the recent federal circuit affirmance in Appeal. No. 19-2072 (affirming district court judgment of invalidity of claim 18), Patent Owner confirms to the Board that it will not petition for certiorari in that related matter.

Respectfully,
Brett Mangrum
Counsel for Patent Owner
Reg. No. 64,783

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