

From: [Trials](#)
To: [Arner, Erika](#); [Trials](#)
Cc: sean.burdick@unilocusa.com; RussT@SeedIP.com; Ryan Loveless; Jim Etheridge; Brian Koide; Jeff Huang; brett@etheridgelaw.com; Goldberg, Joshua; Stach, Jason
Subject: RE: Requesting Electronic IPR Service Under 37 CFR 42.5(b) in view of COVID-19
Date: Wednesday, March 25, 2020 11:25:40 AM

EXTERNAL Email:

Counsel,

Thank you for contacting the Board. At this time, Petitioner is authorized to file, with the petition, a motion to waive 37 C.F.R. §§ 42.6(e)(1), 42.105(b) and accept as sufficient, under 37 C.F.R. § 42.6(e)(4), electronic service on Patent Owner. After filing the motion, Petitioner is advised to immediately send an email to trials@uspto.gov and inform the Board that the motion is pending.

Regards,

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

From: Arner, Erika <erika.arnner@finnegan.com>
Sent: Tuesday, March 24, 2020 4:05 PM
To: Trials <Trials@USPTO.GOV>
Cc: sean.burdick@unilocusa.com; RussT@SeedIP.com; Ryan Loveless <ryan@etheridgelaw.com>; Jim Etheridge <jim@etheridgelaw.com>; Brian Koide <brian@etheridgelaw.com>; Jeff Huang <jhuang@etheridgelaw.com>; brett@etheridgelaw.com; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Stach, Jason <Jason.Stach@finnegan.com>
Subject: Requesting Electronic IPR Service Under 37 CFR 42.5(b) in view of COVID-19

Your Honors,

In light of the COVID-19 pandemic and government guidance to minimize social interaction and travel, Google requests authorization to provide service electronically, rather than physically, of IPR petitions it may file in the coming days against patents currently asserted by patent owner Uniloc against Google in district court actions, including U.S. patents 9,564,952 and 6,366,908. Following 37 CFR 42.105(b), Google contacted Uniloc to request an agreement to electronic service in these circumstances, but Uniloc has refused. Google's request and Uniloc's refusal are attached. Like that correspondence, this request is addressed to counsel of record at the USPTO and Uniloc's litigation counsel in these matters. Uniloc's response demonstrates that electronic correspondence to these counsel results in receipt by the patent owner.

For these reasons, Google asks that the Board exercise its discretion under 37 CFR 42.5(b) to suspend the physical service requirement in this situation and authorize electronic service of IPR

petitions that Google may file on one or both of the listed patents in the coming days.

Regards,
Erika Arner
Lead Counsel for Google

Erika H. Arner
Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
11955 Freedom Drive, Reston, VA, 20190

571.203.2754 | fax 202.408.4400 | erika.arner@finnegan.com | [Bio](#)

[Finnegan AIA Blog](#) | www.finnegan.com | [PTAB Book, 2d ed.](#)

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.