

Subject: RE: IPR2021-00144 Joint Request to Limit the Petition

Date: Friday, February 25, 2022 at 1:26:13 PM Pacific Standard Time

From: Trials

To: Parham Hendifar, Trials

CC: Nathan Lowenstein, Kenneth Weatherwax, Vinson Lin, Philip Graves, David Holt, Tiffany.miller@dlapiper.com, Jim.heintz@dlapiper.com, IPR50095-0015IP1, Karl Renner

Counsel,

The Board agrees with the parties' request to limit the Petition in IPR2021-00144. The parties shall memorialize their agreement in writing and file the agreement as a Paper in the docket of the proceeding. The parties should state in the agreement that they are filing the agreement with the Board's authorization.

Thank you,

Maria King

Deputy Chief Clerk for Trials
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
703-756-1288

From: Parham Hendifar <hendifar@lowensteinweatherwax.com>

Sent: Thursday, February 24, 2022 1:10 PM

To: Trials <Trials@USPTO.GOV>

Cc: Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>; Vinson Lin <Lin@lowensteinweatherwax.com>; Philip Graves <philipg@hbsslaw.com>; David Holt <DTH@fr.com>; Tiffany.miller@dlapiper.com; Jim.heintz@dlapiper.com; IPR50095-0015IP1 <IPR50095-0015IP1@fr.com>; Karl Renner <renner@fr.com>

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Dear Honorable Board,

The Parties jointly write to request that the Board limit the Petition and the proceeding in IPR2021-00144 to

grounds 2A, 2B, 2C and 2D stated in the Petition or, in the alternative, authorize the parties to file a joint motion to limit the Petition and the proceeding to grounds 2A, 2B, 2C and 2D stated in the Petition. This request is pursuant to Petitioners' statement in their rehearing request that "Petitioners hereby withdraw Grounds 1A-1E and 3 and stipulate not to pursue these grounds in any proceeding that is instituted from this rehearing request." Paper 25 at 1 n. 1.

The request is further pursuant to the parties' stipulation that: (1) the Petition will be limited to grounds 2A, 2B, 2C and 2D as stated in the Petition, and grounds 1A-1E, and 3 shall be excluded from this proceeding ("excluded grounds"); (2) Patent Owner shall not pursue any decision by the Board on the excluded grounds; (3) any question by Patent Owner for Petitioner's expert at deposition that is unrelated to grounds 2A-2D shall be subject to a relevance/scope objection, and the proper motion to exclude, if necessary; and (4) Patent Owner shall not otherwise present arguments in this proceeding as to the excluded grounds for any reason unrelated to grounds 2A-2D.

Should the Board wish to have a call with the parties, the parties are generally available for a call with the Board on Thursday 2/24, Friday 2/25 and Tuesday 3/1.

Regards,

Parham Hendifar | Lowenstein & Weatherwax LLP
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