

**From:** Hasford, Justin <[Justin.Hasford@finnegan.com](mailto:Justin.Hasford@finnegan.com)>  
**Sent:** Wednesday, July 20, 2022 3:04 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Diner, Bryan <[bryan.diner@finnegan.com](mailto:bryan.diner@finnegan.com)>; Kim, Kyu Yun <[KyuYun.Kim@finnegan.com](mailto:KyuYun.Kim@finnegan.com)>; Eaddy, Geneva <[Geneva.Eaddy@finnegan.com](mailto:Geneva.Eaddy@finnegan.com)>; Mills, Jad <[jmills@wsgr.com](mailto:jmills@wsgr.com)>; Torczon, Richard (External) <[rtorczon@wsgr.com](mailto:rtorczon@wsgr.com)>; EXT- [nstafford@wsgr.com](mailto:nstafford@wsgr.com) <[nstafford@wsgr.com](mailto:nstafford@wsgr.com)>; Gregory, Dennis <[dgregory@wsgr.com](mailto:dgregory@wsgr.com)>; Winschel, Grace <[gwinschel@wsgr.com](mailto:gwinschel@wsgr.com)>  
**Subject:** IPR2022-00722

**CAUTION:** This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

To the Board:

Counsel for Patent Owner and Petitioner in the above-captioned IPR each approach the Board for certain relief about which the parties have met and conferred.

Patent Owner respectfully seeks authorization to move to strike Petitioner's Updated Mandatory Notices (Paper No. 9) submitted on July 11, 2022, for failing to comply with Rule 42.8(a)(3), and Petitioner opposes.

Patent Owner hereby withdraws its request for the Board to deny institution based on parallel litigation (inclusive of Section II, pages 14-26, of the preliminary response, Paper No. 6). Patent Owner requests authorization to file a replacement version of Paper No. 6 that redacts Section II as well as these arguments from the remainder of the preliminary response (without adding any replacement material). Petitioner joins the request.

Petitioner respectfully requests pre-institution reply briefing. Petitioner requests 5 pages to respond to Patent Owner's 35 U.S.C. §325(d) and RPI arguments, with Patent Owner being afforded a sur-reply of equal length. Patent Owner is willing to agree to reply briefing as long as Petitioner refrains from addressing the substantive merits of the case in its reply. Petitioner believes that some merits issues are integral to the §325(d) arguments, making a restriction on how it may address §325(d) unduly prejudicial to Petitioner, and Patent Owner disagrees.

Patent Owner and Petitioner are both available for a teleconference with the Board at the following times:

- **Tuesday, July 26<sup>th</sup>** – any time between 2:00 pm ET and 4:00 pm ET
- **Wednesday, July 27<sup>th</sup>** – any time between 2:00 pm ET and 4:00 pm ET
- **Thursday, July 28<sup>th</sup>** – any time between 2:00 pm ET and 4:00 pm ET

Respectfully submitted,

Justin Hasford

**Justin J. Hasford** |

901 New York Avenue, NW, Washington, DC 20001-4413  
+1 202 408 4000 | fax +1 202 408 4400 | [justin.hasford@finnegan.com](mailto:justin.hasford@finnegan.com)  
[www.finnegan.com](http://www.finnegan.com) | [LinkedIn Profile](#) | [Finnegan AIA Blog](#)

---

FINNEGAN

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.