

Friday, May 24, 2024 at 14:28:03 Eastern Daylight Time

Subject: RE: IPR2022-01188, -1189, -1190, -1191, -1192, -1193 (Request for Conference Call)
Date: Monday, May 13, 2024 at 11:15:48 AM Eastern Daylight Time
From: Trials
To: Andrew Baluch, Trials
CC: Matthew Smith, carrie.beyer, kirstin.stolldebell, Jason Linger, Stephen Underwood

Counsel,

The Board has reviewed the parties' respective positions as set forth in Petitioner's email dated May 8, 2024.

Patent Owner submits that she will not engage in any *ex parte* communications with the Office in the future concerning her specific cases. Petitioner requests that we enter this as a stipulation into the record in these cases. Therefore, the parties are directed to meet and confer to formalize Patent Owner's position into a formal stipulation to be signed by counsel for Patent Owner and Petitioner. The formalized stipulation signed by counsel should be filed as a paper in each of the referenced cases.

For these reasons, a conference call with the parties is unnecessary at this time. If the parties cannot agree on a stipulation to be filed, the Board will consider convening a conference call for the parties to discuss the reasons for disagreement.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Andrew Baluch <baluch@smithbaluch.com>
Sent: Wednesday, May 8, 2024 3:27 PM
To: Trials <Trials@USPTO.GOV>
Cc: Matthew Smith <smith@smithbaluch.com>; carrie.beyer <carrie.beyer@faegredrinker.com>; kirstin.stolldebell <kirstin.stolldebell@faegredrinker.com>; Jason Linger <jlinger@glaserweil.com>; Stephen Underwood <sunderwood@glaserweil.com>
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Dear Honorable Board:

In response to the Board's recent Paper 34 (entering Exhibits 3003–3006), Petitioners "wish to discuss the matter further" with the Board on a conference call. Paper 34 at 1. The entered Exhibits 3003–3006 show that Ms. Hafeman has had improper *ex parte* communication with members of the Board (specifically Director Vidal and Judge Tierney) in violation of 37 C.F.R. § 42.5(d).

Petitioners are not currently seeking a sanction against Ms. Hafeman for these prior violations, but instead respectfully request an order from the Board stating that § 42.5(d) both: (i) prohibits the type of case-specific communications contained in the emails Ms. Hafeman sent to members of the Board and (ii) contains no distinction between communicating about substantive patentability issues on the one hand, versus communicating about procedural (or in Ms. Hafeman's words "process") issues on the other hand, as Ms. Hafeman appears to believe. Ex. 3005, 1; Ex. 3003, 6 ("again not talking about my claims but the process").

The parties have conferred regarding this matter and have taken the following positions:

Patent Owner's position:

Patent Owner believes such conference call is unnecessary as Ms. Hafeman now understands that she cannot have ex parte communications with the USPTO regarding her cases. Moreover, Patent Owner has filed appeals, and thus, the Federal Circuit now has exclusive jurisdiction over these cases.

Patent Owner agrees with Petitioners that no sanctions are warranted here. The emails filed by the Board, involving Director Vidal, USPTO Advisor Dede Zecher, and Judge Tierney, show that Ms. Hafeman was invited to communicate with them about "a Sotera violation."

Ms. Hafeman first reached out to Director Vidal, who put her in touch with her advisor Dede Zecher. Ms. Zecher responded, asking her "what you need help with." Ms. Hafeman replied that she was seeking information about "a remedy that the USPTO offers for a Sotera violation." Ms. Zecher then added the PTAB's Vice Chief, Mike Tierney, to the email chain. Ms. Zecher stated that Judge Tierney "should be able to answer all your Sotera questions" and that Ms. Hafeman and Judge Tierney should "chat soon." Judge Tierney agreed, and Judge Tierney and Ms. Hafeman participated in a Zoom meeting together.

Again, Ms. Hafeman now understands that she cannot engage in ex parte communications with the USPTO regarding her specific cases (and that she has counsel to communicate with the USPTO on her behalf). If Ms. Hafeman has any further communications with the USPTO, she will not discuss her specific cases except through counsel and with all parties involved in the communications.

Petitioners' position

Petitioners respectfully request this order because Ms. Hafeman does not appear to understand the scope of § 42.5(d), given her repeated insistence to the Office of a purported distinction between substantive patentability issues versus "process" issues. Petitioners also respectfully request that Patent Owner's stipulation above ("If Ms. Hafeman has any further communications with the USPTO, she will not discuss her specific cases except through counsel and with all parties involved in the communications.") be entered into the record so that the stipulation may be enforced by the Board in the event of any future violations. Second, Ms. Hafeman's ex parte communications continued as late as April 22 (see Ex. 3003, 1), nearly a month after she filed her appeal on March 25. The Board retains authority to enforce its rules during an appeal, especially for the purpose of protecting the integrity of these proceedings. Third, Petitioners dispute Patent Owner's characterization of Exhibits 3003–3006 as showing that "Ms. Hafeman was invited to communicate with [Director Vidal and Judge Tierney]"; to the contrary, it was Ms. Hafeman who initiated contact, requested meetings, and urged specific action to be taken in these very

proceedings: “the[se] IPRs should be vacated.” Ex. 3006, 14.

Parties’ Availability

If the Board would like to speak with the parties about this matter, the parties are available for a Board call at the following times:

Monday, May 13, 2pm-4pm ET

Tuesday, May 14, 2pm-4pm ET

Respectfully submitted on behalf of Petitioners,

Andrew Baluch

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