

From: [Howe, Steve](#)
To: [Trials](#)
Cc: [Mizerk, Don](#); [Segrest, Philip](#); [Sportel, Nathan](#); [Hitchens, A. Lauren](#); [McGuffin, Asher S.](#); [cindy.kan@wilmerhale.com](#); [Bassett, David](#); [Geng, Deric](#); [Whelan, Emily](#); [Farrell, Gillian](#); [Pheng, Mary](#); [Bertulli, Scott](#); [Ferrera, Vinita](#)
Subject: RE: IPR2023-00049 / IPR2023-00050 - Request for Conference
Date: Wednesday, May 29, 2024 10:36:53 AM

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Your Honors,

We write to provide a status update on the issues we would like to discuss at today's conference. As we indicated below, the parties are at an impasse with regard to additional discovery that Petitioner believes is warranted and necessary. Patent Owner has also failed to comply with certain routine discovery obligations, and in particular, has repeatedly instructed third party fact witnesses Dandiker and Bodor not to answer questions on the basis of privilege during their depositions, which we believe is improper. We wish to discuss these issues and seek authorization to file motions for the necessary relief. We can provide more information on the foregoing during our conference this afternoon.

Regards,
Steve

Steve Howe
Partner
Direct: 414-978-5393
Steve.Howe@huschblackwell.com

From: Trials <Trials@USPTO.GOV>
Sent: Friday, May 17, 2024 4:00 PM
To: Howe, Steve <Steve.Howe@huschblackwell.com>; Trials <Trials@USPTO.GOV>
Cc: Mizerk, Don <Don.Mizerk@huschblackwell.com>; Segrest, Philip <Philip.Segrest@huschblackwell.com>; Sportel, Nathan <Nathan.Sportel@huschblackwell.com>; Hitchens, A. Lauren <Lauren.Hitchens@huschblackwell.com>; McGuffin, Asher S. <Asher.McGuffin@wilmerhale.com>; cindy.kan@wilmerhale.com; Bassett, David <David.Bassett@wilmerhale.com>; Geng, Deric <Deric.Geng@wilmerhale.com>; Whelan, Emily <Emily.Whelan@wilmerhale.com>; Farrell, Gillian <Gillian.Farrell@wilmerhale.com>; Pheng, Mary <Mary.Pheng@wilmerhale.com>; Bertulli, Scott <Scott.Bertulli@wilmerhale.com>; Ferrera, Vinita <Vinita.Ferrera@wilmerhale.com>
Subject: RE: IPR2023-00049 / IPR2023-00050 - Request for Conference

[EXTERNAL EMAIL]

Counsel,

A conference call is scheduled with the Board on **May 29th at 10 am PT (1 pm ET)**.

The dial-in number is: [REDACTED] and the passcode is: [REDACTED]

Regards,

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

From: Howe, Steve <Steve.Howe@huschblackwell.com>
Sent: Friday, May 17, 2024 1:44 PM
To: Trials <Trials@USPTO.GOV>
Cc: Mizerk, Don <Don.Mizerk@huschblackwell.com>; Segrest, Philip <Philip.Segrest@huschblackwell.com>; Sportel, Nathan <Nathan.Sportel@huschblackwell.com>; Hitchens, A. Lauren <Lauren.Hitchens@huschblackwell.com>; McGuffin, Asher S. <Asher.McGuffin@wilmerhale.com>; cindy.kan@wilmerhale.com; Bassett, David <David.Bassett@wilmerhale.com>; Geng, Deric <Deric.Geng@wilmerhale.com>; Whelan, Emily <Emily.Whelan@wilmerhale.com>; Farrell, Gillian <Gillian.Farrell@wilmerhale.com>; Pheng, Mary <Mary.Pheng@wilmerhale.com>; Bertulli, Scott <Scott.Bertulli@wilmerhale.com>; Ferrera, Vinita <Vinita.Ferrera@wilmerhale.com>
Subject: RE: IPR2023-0049 / IPR2023-0050 - Request for Conference

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attachments.

Mr. Hawthorne,

All parties are available on May 29th from 9:30am-12:00pm and 2:00-3:00pm PT.

To clarify our earlier email, Petitioner is requesting authorization to file a motion for additional discovery.

Petitioner also believes there may be issues with Patent Owner's compliance with routine discovery requirements, in that certain deponents may not be made available for deposition for the entirety of the allotted time. We will know by the date of the conference whether this ultimately becomes an issue, as the deposition in question is currently scheduled for May 28th. We will apprise the Board promptly if this issue is not resolved prior to the conference.

Regards,
Steve

Steve Howe
Partner
Direct: 414-978-5393
Steve.Howe@huschblackwell.com

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, May 16, 2024 3:52 PM
To: Howe, Steve <Steve.Howe@huschblackwell.com>; Trials <Trials@USPTO.GOV>
Cc: Mizerk, Don <Don.Mizerk@huschblackwell.com>; Segrest, Philip <Philip.Segrest@huschblackwell.com>; Sportel, Nathan <Nathan.Sportel@huschblackwell.com>; Hitchens, A. Lauren <Lauren.Hitchens@huschblackwell.com>; McGuffin, Asher S. <Asher.McGuffin@wilmerhale.com>; cindy.kan@wilmerhale.com; Bassett, David <David.Bassett@wilmerhale.com>; Geng, Deric <Deric.Geng@wilmerhale.com>; Whelan, Emily <Emily.Whelan@wilmerhale.com>; Farrell, Gillian <Gillian.Farrell@wilmerhale.com>; Pheng, Mary <Mary.Pheng@wilmerhale.com>; Bertulli, Scott <Scott.Bertulli@wilmerhale.com>; Ferrera, Vinita <Vinita.Ferrera@wilmerhale.com>
Subject: RE: IPR2023-0049 / IPR2023-0050 - Request for Conference

[EXTERNAL EMAIL]

Counsel,

The panel has consulted their schedule and the earliest available times for a telephone conference are:

May 28th 1:30-2:20 pm PT
May 29th 9:30 am-12 pm PT or 2-3 pm PT

We note that it is not clear from Petitioner's email communication whether it is requesting authorization to file a motion for additional discovery or whether Petitioner contends that Patent Owner is not complying with routine discovery requirements.

Petitioner should clarify its request in response to this email and let us know which of the times above are amenable to the parties for a telephone conference with the panel. In the meantime, we encourage the parties to continue to meet and confer to try to resolve their dispute, obviating the need for the conference call.

Regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Howe, Steve <Steve.Howe@huschblackwell.com>
Sent: Thursday, May 16, 2024 1:22 PM
To: Trials <Trials@USPTO.GOV>
Cc: Mizerk, Don <Don.Mizerk@huschblackwell.com>; Segrest, Philip <Philip.Segrest@huschblackwell.com>; Sportel, Nathan <Nathan.Sportel@huschblackwell.com>; Hitchens, A. Lauren <Lauren.Hitchens@huschblackwell.com>; McGuffin, Asher S. <Asher.McGuffin@wilmerhale.com>; cindy.kan@wilmerhale.com; Bassett, David <David.Bassett@wilmerhale.com>; Geng, Deric <Deric.Geng@wilmerhale.com>; Whelan, Emily <Emily.Whelan@wilmerhale.com>; Farrell, Gillian <Gillian.Farrell@wilmerhale.com>;

Pheng, Mary <Mary.Pheng@wilmerhale.com>; Bertulli, Scott <Scott.Bertulli@wilmerhale.com>; Ferrera, Vinita <Vinita.Ferrera@wilmerhale.com>

Subject: IPR2023-0049 / IPR2023-0050 - Request for Conference

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IPR2023-0049, U.S. Patent No. 7,713,947 B2

IPR2023-0050, U.S. Patent No. 8,377,903 B2

Your Honors:

We represent Petitioner TWi Pharmaceuticals, Inc. (“Petitioner”) in the above-referenced matters. Petitioner seeks an order requiring Patent Owner Merck Serono SA (“Patent Owner”) to respond to targeted discovery requests regarding declarants Bodor and Dandiker’s communications with Patent Owner, as well as materials underlying their declarations submitted herein. In accordance with the Board’s December 20, 2023 Scheduling Order (Paper 16 in IPR2023-00049; Paper 14 in IPR2023-00050), the parties met and conferred on May 14, 2024 in an attempt to resolve this dispute but were unable to reach agreement. Accordingly, please accept this email as a request for a conference call to discuss this request.

Petitioner and Patent Owner have conferred and are available for a conference call at the Board’s convenience on Friday, May 17 between 11:30am Eastern and 5:00pm Eastern. If the Board would prefer a conference the week of May 20, the parties will confer and apprise the Board of their availability.

Thank you for your courtesies and attention to this matter.

Best regards,
Steve

Steve Howe
Partner

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Technology, Manufacturing & Transportation
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