

## Adam Fitzgerald

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Thursday, March 21, 2024 12:35 PM  
**To:** John Wittenzellner; Trials  
**Cc:** alexander.stein@morganlewis.com; Hsu-Hoffman, Ahren C.; austin.zuck@morganlewis.com; IPR Dynapass WSL  
**Subject:** RE: IPR2024-00283 | Request for Disclosure of Information Relevant to General Plastic Factors

### [EXTERNAL EMAIL]

Counsel,

The panel authorizes Patent Owner to file a Motion for Additional Discovery limited to the issue of whether Petitioner has ever been a direct or indirect member of Unified Patents. The Motion is limited to no more than 5 pages and is due by close of business on March 29<sup>th</sup>. Petitioner is authorized to file an Opposition to the Motion. The Opposition is also limited to 5 pages in length and is due by close of business on April 5<sup>th</sup>. Patent Owner must file a copy of this email as authorization for its Motion.

Regards,

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

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**From:** John Wittenzellner <johnw@wsltrial.com>  
**Sent:** Wednesday, March 20, 2024 1:00 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** alexander.stein@morganlewis.com; Hsu-Hoffman, Ahren C. <ahren.hsu-hoffman@morganlewis.com>; austin.zuck@morganlewis.com; IPR Dynapass WSL <iprdynapasswsl@wsltrial.com>  
**Subject:** Re: IPR2024-00283 | Request for Disclosure of Information Relevant to General Plastic Factors

**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 conducted a telephonic meet and confer on March 11 to discuss Patent Owner's request that Petitioner identify whether it is or has ever been a direct or indirect member of Unified Patents. The parties have reached an impasse because Petitioner contends that it is not required to disclose that information and that the Board does not have authority to order Petitioner to provide that information to Patent Owner.

Patent Owner contends that identification of whether Petitioner has ever been a direct or indirect member of Unified Patents (i.e., whether there is a relationship between Petitioner and Unified Patents) is highly relevant to at least the first factor of *General Plastic* because Unified Patents filed a petition for *inter partes* review of the same patent subject to this proceeding (IPR2023-00425), and Petitioner filed its Petition eight months after the Unified Petition, as well as two months after the Board issued its Institution Decision in the Unified IPR (IPR2023-00425). See *Velvo Corp. v. ...*

*Electronic Scripting Products, Inc.*, IPR2019-00062, -00063, -00084, Paper 11 at 2 (P.T.A.B. Apr. 2, 2019) (“However, our application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”). Because the requested discovery regarding the relationship between Petitioner and Unified Patents pertains to the *General Plastic* analysis, pre-institution discovery is necessary. Contrary to Petitioner’s position, the Board has discretion to grant pre-institution discovery. See, e.g., *Clear-Vu Lighting LLC v. University of Strathclyde*, IPR2019-00588, -00747, Paper 13, pp. 12-13 (P.T.A.B. Apr. 19, 2019) (granting request for pre-institution additional discovery); see also 85 Fed. Reg. 79125 (Dec. 9, 2020) (“Moreover, consistent with existing practice, limited pre-institution discovery may be granted at the discretion of the Board.”).

Patent Owner respectfully requests that the Board grant its request for pre-institution additional discovery on the narrow question of whether Petitioner is or has ever been a direct or indirect member of Unified Patents. Alternatively, Patent Owner respectfully requests authorization to file a motion for pre-institution additional discovery on the same question. Patent Owner is available for a conference call with the Board any day this week, at the Board’s convenience.

Best regards,  
John

**John Wittenzellner**  
**Williams Simons & Landis PLLC**  
1735 Market Street, Suite A #453  
Philadelphia, PA 19103  
Direct: 512.543.1373



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**From:** John Wittenzellner <[johnw@wsltrial.com](mailto:johnw@wsltrial.com)>  
**Date:** Wednesday, March 6, 2024 at 12:29 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [alexander.stein@morganlewis.com](mailto:alexander.stein@morganlewis.com) <[alexander.stein@morganlewis.com](mailto:alexander.stein@morganlewis.com)>, Hsu-Hoffman, Ahren C. <[ahren.hsu-hoffman@morganlewis.com](mailto:ahren.hsu-hoffman@morganlewis.com)>, [austin.zuck@morganlewis.com](mailto:austin.zuck@morganlewis.com) <[austin.zuck@morganlewis.com](mailto:austin.zuck@morganlewis.com)>, IPR Dynapass WSL <[iprdynapasswsl@wsltrial.com](mailto:iprdynapasswsl@wsltrial.com)>  
**Subject:** Re: IPR2024-00283 | Request for Disclosure of Information Relevant to General Plastic Factors

Good morning. Patent Owner and Petitioner had previously discussed Patent Owner’s request via email (that correspondence was attached to our original email to the Board). The parties are schedule to meet and confer by telephone on March 11. We will apprise the Board of the outcome of that meet and confer.

Please let me know if any additional information would be helpful.

Best regards,  
John Wittenzellner

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Date:** Thursday, February 22, 2024 at 2:35 PM  
**To:** John Wittenzellner <[johnw@wsltrial.com](mailto:johnw@wsltrial.com)>, Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [alexander.stein@morganlewis.com](mailto:alexander.stein@morganlewis.com) <[alexander.stein@morganlewis.com](mailto:alexander.stein@morganlewis.com)>, Hsu-Hoffman, Ahren C.

<[ahren.hsu-hoffman@morganlewis.com](mailto:ahren.hsu-hoffman@morganlewis.com)>, [austin.zuck@morganlewis.com](mailto:austin.zuck@morganlewis.com)  
<[austin.zuck@morganlewis.com](mailto:austin.zuck@morganlewis.com)>, IPR Dynapass WSL <[iprdynapasswsl@wsltrial.com](mailto:iprdynapasswsl@wsltrial.com)>  
**Subject:** RE: IPR2024-00283 | Request for Disclosure of Information Relevant to General Plastic Factors

[EXTERNAL EMAIL]

Counsel,

From the Board –

It is unclear what relief Patent Owner is requesting. Further, it is unclear if Petitioner is aware of Patent Owner's request. Patent Owner and Petitioner should meet and confer, and if they cannot reach an agreement, request a conference call with the Panel. The Panel is unavailable until March 5<sup>th</sup> and has limited availability for the remainder of that week.

Regards,

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

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**From:** John Wittenzellner <[johnw@wsltrial.com](mailto:johnw@wsltrial.com)>  
**Sent:** Tuesday, February 20, 2024 4:23 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [alexander.stein@morganlewis.com](mailto:alexander.stein@morganlewis.com); Hsu-Hoffman, Ahren C. <[ahren.hsu-hoffman@morganlewis.com](mailto:ahren.hsu-hoffman@morganlewis.com)>; [austin.zuck@morganlewis.com](mailto:austin.zuck@morganlewis.com); IPR Dynapass WSL <[iprdynapasswsl@wsltrial.com](mailto:iprdynapasswsl@wsltrial.com)>  
**Subject:** IPR2024-00283 | Request for Disclosure of Information Relevant to General Plastic Factors

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To the Board:

I wrote on Behalf of Patent Owner in the above-referenced *inter partes* review proceeding. Patent Owner seeks information regarding whether Petitioner is or has ever been a direct or indirect member of Unified Patents. Unified Patents filed a petition for *inter partes* review, which is currently pending, of the same patent subject to this proceeding. Whether Petitioner is or has ever been a direct or indirect member of Unified Patents is highly relevant to at least the first factor of *General Plastic*. See *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, -00063, -00084, Paper 11 at 2 (P.T.A.B. Apr. 2, 2019) (“However, our application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”).

Patent Owner has been seeking this information since January 2. Unfortunately, however, Petitioner has refused to provide the requested information. In addition, Patent Owner has even refused to provide its availability for a call with the Board, despite multiple requests by Patent Owner over the past two weeks (correspondence attached).

Patent Owner is available anytime Wednesday or Friday of this week, at the Board's convenience.

Best regards,  
John

**John Wittenzellner**  
**Williams Simons & Landis PLLC**  
1735 Market Street, Suite A #453  
Philadelphia, PA 19103  
Direct: 512.543.1373



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