

From: [Saliba, Raja](#)
To: [Trials](#)
Cc: [Keefe, Heidi](#); [Whitt, Samuel K](#); [Iyer, Chid S.](#); [Dzwonczyk, Michael R.](#); [Rachuba, L Roman](#)
Subject: RE: IPR2023-00427, IPR2023-00433
Date: Monday, March 25, 2024 8:40:12 PM

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Honorable Board,

In response to your inquiry below of March 21, 2024, the noted petitions to correct inventorship will not be relied upon and will not affect the IPR proceedings in any way. Under 35 U.S.C. § 256(b), “[t]he error of omitting inventors . . . shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section.” The errors may be corrected under 35 U.S.C. § 256(a).

Patent Owner did not advise the Board of the petitions to correct inventorship under 37 C.F.R. § 42.8 for two reasons.

First, the petitions are not believed to be “related matters” under § 42.8(b)(2), because, as explained above, they would not “affect, or be affected by, a decision in the proceeding.” The petitions were filed on December 17, 2021, long before any of the instant IPRs were filed by Petitioners in January 2023 and before Patent Owner brought suit against Petitioners and Egnyte, Inc. The petitions are also all public record documents as part of the public file histories of the patents and do not relate to any ground that may be raised or adjudicated in an IPR. Petitioners were thus aware of the petitions to correct inventorship in all six patents (one granted, five pending) when the IPRs were filed, but did not object to the lack of Rule 42.8 Notices for them.

Second, counsel for Patent Owner enacted an information barrier protocol whereby the attorneys representing Patent Owner in the IPR (*i.e.*, listed lead and backup counsel) and related litigation proceedings, and attorneys representing Patent Owner for prosecution related matters and non-adversarial matters before the Patent Office do not share information related to the patents involved in each of these proceedings. IPR counsel for Patent Owner did not become aware of Mr. Taska’s email to the Board until last Thursday, when Ms. Goldschlager emailed IPR counsel. Indeed, the only knowledge Patent Owner’s IPR counsel has on the efforts by Mr. Taska (or any other Topia prosecution counsel) to prosecute the petitions for correction of inventorship is from Ms. Goldschlager’s email and the USPTO public record.

Notwithstanding, Patent Owner would be happy to identify the petitions in an updated Notice should the Board so advise.

Respectfully,
Raja Saliba
Lead counsel for Patent Owner

IPR2023-00427, -00433
Ex. 3004

From: Trials <Trials@USPTO.GOV>

Sent: Thursday, March 21, 2024 2:27 PM

To: Saliba, Raja <rsaliba@sughrue.com>; Iyer, Chid S. <ciyer@sughrue.com>; Dzwonczyk, Michael R. <mdzwonczyk@sughrue.com>; Rachuba, L Roman <lrachuba@sughrue.com>

Cc: Keefe, Heidi <hkeefe@cooley.com>; Whitt, Samuel K <swhitt@cooley.com>; Trials <Trials@USPTO.GOV>

Subject: IPR2023-00427, IPR2023-00433

Counsel,

From the Board –

Re: IPR2023-00427, IPR2023-00433

We have been advised that petitions to correct inventorship have been filed by Patent Owner for the patents involved in each of these proceedings, as well as several related patents (see attached email from Andrew J. Taska, Esq.). A complete list follows.

IPR2023-00427 U.S. Patent No. 9,143,561 (12/267,852)
IPR2023-00433 U.S. Patent No. 10,067,942 (14/860,289)
IPR2023-00429 U.S. Patent No. 10,289,607 (16/017,348) (institution denied)
IPR2023-00431 U.S. Patent No. 10,642,787 (16/750,399) (institution denied)
IPR2023-00430 U.S. Patent No. 11,003,622 (16/361,641) (institution denied)

The panel requests Patent Owner to advise us by email whether the proposed inventorship changes will be relied on or are likely to affect in any way these proceedings. Please let us have your response in five calendar days.

Also, please explain why the Board was not advised by Patent Owner of these proposed changes in the papers filed in these proceedings. See 37 C.F.R. 42.8 (Mandatory Notices).

Regards,

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

Raja N. Saliba

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