

From: [Kenneth Darby](#)
To: [Trials](#); [Eliot.Williams@BakerBotts.com](#)
Cc: [Potter, Brianna](#); [Engel, Matthew](#); [Liquori, Steve](#); [Deer, Emily](#); [John S. Goetz](#); [Matt Colvin](#); [Baniel, Nick](#)
Subject: RE: IPR2023-00465, Nanobebe vs. Mayborn
Date: Wednesday, July 19, 2023 7:39:37 AM

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To the Board—

Patent Owner opposes Petitioner's request.

Patent Owner is available for a conference call with the panel between 11a and 5p ET on the following days: 7/19, 7/20, 7/24, 7/25, and 7/26.

Respectfully,

Kenneth Darby :: Principal :: Fish & Richardson P.C.
512 226 8126

Counsel for Patent Owner

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, July 18, 2023 9:55 AM
To: Eliot.Williams@BakerBotts.com; Trials <Trials@USPTO.GOV>
Cc: Potter, Brianna <brianna.potter@bakerbotts.com>; Engel, Matthew <matthew.engel@bakerbotts.com>; Liquori, Steve <Steven.Liquori@BakerBotts.com>; Deer, Emily <emily.deer@bakerbotts.com>; John S. Goetz <Goetz@fr.com>; Matt Colvin <colvin@fr.com>; Kenneth Darby <kdarby@fr.com>; Baniel, Nick <nick.baniel@bakerbotts.com>
Subject: RE: IPR2023-00465, Nanobebe vs. Mayborn

[This email originated outside of F&R.]

Counsel,

From the Board –

Please inform the Board whether Patent Owner opposes Petitioner's request. If Patent Owner opposes, the parties should provide times that they are available for a conference call with the panel. If Patent Owner does not oppose, Petitioner should indicate how many pages it needs to file the requested motion and when such motion can be filed.

Regards,

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

From: Williams, Eliot D. <[Eliot.Williams@BakerBotts.com](#)>
Sent: Monday, July 17, 2023 6:32 PM
To: Trials <[Trials@USPTO.GOV](#)>
Cc: Potter, Brianna <[brianna.potter@bakerbotts.com](#)>; Engel, Matthew <[matthew.engel@bakerbotts.com](#)>; Liquori, Steve <[Steven.Liquori@BakerBotts.com](#)>; Deer, Emily <[emily.deer@bakerbotts.com](#)>; John S. Goetz <[Goetz@fr.com](#)>; Matt Colvin <[colvin@fr.com](#)>; Kenneth Darby <[kdarby@fr.com](#)>; Baniel, Nick <[nick.baniel@bakerbotts.com](#)>
Subject: IPR2023-00465, Nanobebe vs. Mayborn

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Dear Honorable Board,

Petitioner seeks authorization to file a motion to submit supplemental information in the above-captioned matters pursuant to 37 CFR § 42.123(a). The supplemental information Petitioner seeks to submit consists of the following:

IPR2023-00465
Ex. 3001

Petitioner seeks to submit a replacement declaration from Petitioner's expert, Mr. Brian Silver, to replace a nearly identical version that was filed with the Petition (Ex. 1005). The version filed with the Petition unintentionally omitted Mr. Silver's analysis of Ishimaru (Ex. 1008) with regard to Claim 23 in Ground 1. Petitioner unintentionally omitted Mr. Silver's analysis of Ishimaru in Ground 1, as evidenced by the fact that the Petition references it with regard to claim 23 in ground 2 (See Paper 1 at 59 (citing Ex. 1005 ¶¶506 - 510); see also Ex. 1005 at iii (identifying Mr. Silver's analysis of Claims 21-24 and explicitly identifying Claim 23 in Section XIII.C)), and his declaration statement that he previously explained how Claim 23 was rendered obvious by Ishimaru (Ex. 1005 ¶506 (citing to §XIII.C)). Petitioner also intends to submit a supplemental Petition to include a summary of Mr. Silver's analysis of Claim 23 in Ground 1.

Petitioner contends that this replacement declaration and petition are appropriate to submit as supplemental information because it is relevant to a claim for which the trial has been instituted, the request is made within one month of the date the trial was instituted, it does not unfairly prejudice Patent Owner, and it will ensure just resolution of this IPR Proceeding. Petitioner's supplementation merely attempts to clarify arguments it attempted to present in the petition, and does not change its theories of unpatentability. Moreover, Petitioner's omission was unintentional and is not a "wait and see" attempt to bolster deficiencies identified by the Patent Owner or Board. Indeed, Patent Owner did not make arguments directed to this issue in the POPR.

Petitioner's counsel has corresponded with Patent Owner's counsel who is currently considering the requested authorization and Motion.

If the Board wishes to conduct a conference call, Petitioner is available:

Wed July 19 from 9am-1:30pm ET, and after 4pm ET.

Thu July 20 from 9am until 12:00pm ET

Fri July 21 from 9am until 5:30pm ET.

Respectfully submitted,

Eliot D. Williams

BAKER BOTTS LLP ■

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