

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOBEBE US INC.,
Petitioner

v.

MAYBORN (UK) LIMITED,
Patent Owner

Case IPR2023-00467
Patent 10,952,930

DECLARATION OF JOHN S. GOETZ

I, John S. Goetz, hereby declare the following:

1. I am a principal of Fish & Richardson P.C. I am fully familiar with the facts, background, and circumstances of this action. I have personal knowledge of the facts stated in this declaration, and they are true and correct to the best of my knowledge.
2. This Declaration is respectfully submitted in support of the Patent

Owner's Preliminary Sur-Reply to Petitioner's Preliminary Reply being filed herewith.

3. In November of 2021, shortly after the case was filed, the business people from Mayborn (UK) Limited ("Mayborn") spoke with Ayal Lanternari and the other co-founder of Nanobebe US Inc. ("Nanobebe").

4. On January 5, 2022, the parties sent a form letter to the Court (Dkt. 20), where we requested "referral to the SDNY Mediation Program" in Section 5 of the letter. Judge Woods ordered the parties to participate in the SDNY Mediation Program, but also put in place a Scheduling Order (Dkt. 22) that included infringement contentions, invalidity contentions, and *Markman* deadlines. The Court refused to stay discovery until after the *Markman*, as Mayborn, but not Nanobebe, had requested. As such, the parties negotiated a protective order in February (Dkt. 39) and the following discovery was exchanged through September of 2022. This discovery was not limited to *Markman* issues but instead included all issues in the case, including liability and damages.

5. Both parties served their initial disclosures on January 26, 2022.

6. Nanobebe served its first set of requests for production (nos. 1-47) and its first set of interrogatories (nos. 1-13) on Mayborn on February 17, 2022.

7. Mayborn served its first set of requests for production (nos. 1-72) and its first set of interrogatories (nos. 1-16) on Nanobebe on February 18, 2022.

8. Mayborn served its infringement contentions on Nanobebe on February 28, 2022.

9. Mayborn served its responses to Nanobebe's first set of requests for production and interrogatories on March 28, 2022. Nanobebe also served its responses to Mayborn's first set of requests for production and interrogatories on March 28, 2022.

10. Nanobebe served its first supplemental responses to Mayborn's first set of requests for production on April 8, 2022.

11. Nanobebe served its invalidity contentions on Mayborn on April 14, 2022.

12. Nanobebe served its supplemental responses to Mayborn's interrogatories on April 18, 2022 while Mayborn also served its supplemental responses to Nanobebe's interrogatories on April 18, 2022.

13. Mayborn served its identification of terms for construction on Nanobebe on April 28, 2022. Nanobebe also served its proposed claim terms for construction on Mayborn on April 28, 2022.

14. Mayborn served a corrected version of its infringement cover pleading on Nanobebe on May 3, 2022.

15. Nanobebe served additional supplemental responses to Mayborn's interrogatories on May 6, 2022.

16. Mayborn served its proposed constructions of disputed terms on Nanobebe on May 12, 2022. Nanobebe also served its proposed claim constructions on Mayborn on May 12, 2022.

17. Nanobebe served a corrected version of its invalidity contentions on May 20, 2022.

18. Nanobebe served deposition notices for Ian Webb and Arnold Rees on June 8, 2022.

19. Nanobebe served its second set of requests for production (nos. 48-58) on Mayborn on August 30, 2022 and a 30(b)(6) deposition notice on August 31, 2022.

20. Mayborn responded to Nanobebe's 30(b)(6) deposition notice on September 8, 2022.

21. Nanobebe served its first set of supplemental invalidity contentions on September 15, 2022.

22. Mayborn served its responses to Nanobebe's second set of requests for production on September 29, 2022.

I declare under penalty of perjury that the foregoing is true and correct.

Date: May 12, 2023

/s/ John S. Goetz
John S. Goetz