

From: [Trials](#)
To: [Price, Jeffrey H.](#); [Trials](#)
Cc: [Heintz, James M.](#); [Hannah, James](#); [Fuller, Jenna](#); [Eng, Jeffrey](#); [Miller, Tiffany](#); [Sikorski, Ed](#)
Subject: RE: [EXTERNAL] Conference call - IPR2023-00565 - Authorization for Motion to Strike and Motion for Sanctions
Date: Thursday, December 7, 2023 5:28:00 PM

Counsel,

A conference call is scheduled for **1 pm ET tomorrow, December 8, 2023.**

The dial-in number is: [REDACTED]

Regards,

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

From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Thursday, December 7, 2023 4:36 PM
To: Trials <Trials@USPTO.GOV>
Cc: Heintz, James M. <Jim.Heintz@us.dlapiper.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Eng, Jeffrey <JEng@KRAMERLEVIN.com>; Miller, Tiffany <tiffany.miller@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@us.dlapiper.com>
Subject: Re: [EXTERNAL] Conference call - IPR2023-00565 - Authorization for Motion to Strike and Motion for Sanctions

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Your Honors,

The parties are available between 1-4 PM EST.

Best regards,
Jeff Price, Counsel for Patent Owner

On Dec 7, 2023, at 11:33 AM, Trials <Trials@uspto.gov> wrote:

Counsel,

A telephone conference may be beneficial given the issues outlined in Patent Owner's

email. The panel is available for a half-hour conference call between 12-4 pm ET on Friday December 8, 2023.

Patent Owner shall confer with Petitioner, and no later than 4 pm ET today, shall report back to the Board with a time the parties are both available for a conference call in this window.

Regards,

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

Jeffrey H. Price
Special Counsel

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From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Wednesday, December 6, 2023 9:49 AM
To: Trials <Trials@USPTO.GOV>
Cc: Heintz, James M. <Jim.Heintz@us.dlapiper.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Eng, Jeffrey <JEng@KRAMERLEVIN.com>; Miller, Tiffany <tiffany.miller@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@us.dlapiper.com>
Subject: IPR2023-00565 - Authorization for Motion to Strike and Motion for Sanctions

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Your Honors,

Patent Owner requests authorization to file a Motion to Strike Paper 18, "PETITIONER'S SUPPLEMENTAL BRIEF," because it does not comply with the Director's Order the Board's Order or the Patent Office's Revised Interim Director Review Process Guidance. Petitioner requested—and was granted the opportunity—to address "the vacated Vector Flow decision, responding to Patent Owner's argument regarding Judge Williams' projected time-to-trial, and addressing any arguments based on case

assignment.” Paper 15 at 5-6, Paper 16 at 2. Petitioner did not address any of these issues in its Supplemental Brief.

Patent Owner separately requests authorization to file a Motion for Sanctions under 37 C.F.R. 42.12(a)(2)-(3). Although Petitioner suggests that recent events in the co-pending litigation caused it to drop all grounds that it reasonably could have raised in the IPR, it has not done so. Petitioner’s Final Invalidity Contentions in the co-pending litigation, which Petitioner referenced but did not file, explicitly incorporate its IPR grounds. This fact contradicts its statement that Petitioner already narrowed its grounds to comply with *Sotera*. Patent Owner also requests sanctions under 37 C.F.R. 42.12 (a)(4), (6), and (7) for engaging in dilatory tactics, abuse of process, and causing unnecessary delay or an unnecessary increase in the cost of the proceeding. The Revised Interim Director Review Process Guidance explicitly envisions that sanctions may be imposed on remand for “misconduct committed during the course of Director Review.”

If the panel finds that a conference call would be helpful to resolve these requests, Patent Owner is available at the Board’s convenience on December 8, 11, and 12.

Best regards,
Jeff Price
Counsel for Patent Owner

Jeffrey H. Price
Special Counsel

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Bio

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