

From: [Trials](#)
To: [Price, Jeffrey H.](#); [Trials](#)
Cc: [Heintz, James M.](#); [Sikorski, Ed](#); [Hannah, James](#); [Fuller, Jenna](#); [Eng, Jeffrey](#); [Miller, Tiffany](#)
Subject: RE: IPR2023-00565 - Petitioner Request for Authorization to file Exhibits
Date: Tuesday, January 9, 2024 12:23:59 PM
Attachments: [image001.png](#)

Counsel,

From the Board –

In our Order dated December 18, 2023 (Paper 20, 4) we authorized Patent Owner (Cleveland Medical Devices) to file three (3) exhibits: (1) Petitioner’s final invalidity contention, (2) the *Markman* Order, and (3) the expert report filed December 4, 2023 from the parties co-pending district court litigation.

The order did not compel Patent Owner to submit these three exhibits. Patent Owner opted to only submit the *Markman* order (Ex. 2013) from the co-pending district court litigation. Patent Owner noted that the other exhibits were to be used in connection with Cleveland Medical Devices’ request for sanctions (see email communication below).

The Order did not authorize Petitioner to file additional evidence (see Paper 20, 4). Because our Order already authorized the filing of Petitioner’s final invalidity contentions and the expert report filed December 4th from the parties co-pending district court litigation, we grant Petitioner’s request for authorization to file these two exhibits with their reply to Patent Owner’s supplemental brief as this does not go beyond the scope of evidence already authorized in our Order.

Petitioner, however, is not authorized to file as an exhibit Patent Owner’s amended infringement contentions of September 25, 2023 nor a copy of the email chain dated December 11, 2023 between the parties.

We remind Petitioner that its reply may only respond to arguments raised in Patent Owner’s corresponding supplemental brief. See 37 CFR § 42.23(b).

A phone call is not deemed necessary.

Regards,

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

From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Wednesday, January 3, 2024 5:36 PM
To: Trials <Trials@USPTO.GOV>

Cc: Heintz, James M. <Jim.Heintz@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@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>
Subject: RE: IPR2023-00565 - Petitioner Request for Authorization to file Exhibits

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Your Honors,

Patent Owner's position, which Petitioner refused to include in its email, is that these documents were only relevant to Patent Owner's request for authorization to file a Motion for Sanctions:

As we already stated, these documents are not relevant to any of the issues raised in the Responsive Supplemental Brief. Although the Board granted authorization for CleveMed to file these documents on the assumption that we would need them to respond (Ex. 2014, 17:16-19), the Board did not order their filing. Because the documents were not necessary to address ResMed's untimely stipulation, we did not file them. You will recall that CleveMed's initial agreement to file these documents (Ex. 2014, 20:13-23) preceded the Board's denial without prejudice of CleveMed's request to file a Motion for Sanctions, as they were to be used in connection with CleveMed's request for sanctions. Ex. 2014, 22:12-17.

We disagree that any statement in CleveMed's Brief, including the one quoted below, has anything to do with the substance of the Final ICs or Expert Report. To the extent that Petitioner intends to raise new issues that are not within the permissible scope of its Reply under 37 CFR 42.23, CleveMed will take appropriate action, including renewing its request for sanctions.

Because these documents were not relevant to any issue raised in Patent Owner's Responsive Supplemental Brief, and the panel's Order did not compel their filings, Patent Owner did not file them.

It now appears that Petitioner seeks to file a brief not replying to the issues raised in Patent Owner's Responsive Supplemental Brief, but addressing the very issues that Petitioner opposed briefing, the panel ordered the parties to hold in abeyance, and Patent Owner did not discuss. Patent Owner respectfully requests that the Board compel Petitioner to comply with 37 CFR 42.23 and refuse its request to file new evidence with its Reply Supplemental Brief.

Best Regards,
Jeff Price
Counsel for Patent Owner

Jeffrey H. Price
Special Counsel

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From: Miller, Tiffany <tiffany.miller@us.dlapiper.com>
Sent: Wednesday, January 3, 2024 11:34 AM
To: Trials <Trials@USPTO.GOV>
Cc: Heintz, James M. <Jim.Heintz@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@us.dlapiper.com>; Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Eng, Jeffrey <JEng@KRAMERLEVIN.com>
Subject: [EXTERNAL] IPR2023-00565 - Petitioner Request for Authorization to file Exhibits

Dear Honorable Board,

Petitioner requests authorization to file four documents as exhibits to its Reply to Patent Owner's Response filed on December 29th:

1. Petitioner's Expert Report dated December 4, 2023 and served in the parallel district court proceeding between the parties;
2. Petitioner's Final Invalidity Contentions dated November 20, 2012 in the parallel district court proceeding between the parties;
3. Patent Owner's amended infringement contentions of 09/25/2023 that belatedly identified a newly asserted claim of the '269 patent in the parallel district court proceeding between the parties; and
4. An email chain dated December 11 between the parties concerning the filing of the two documents listed above.

Petitioner intends to rely on and cite the first three documents in its Reply to address the false assertion in Patent Owner's Response at page 6 that "Petitioner made a deliberate strategic decision to keep its options open as long as possible, all the while multiplying the cost and complexity of this proceeding and refusing to provide any justification or explanation for its belated filings and strategic staging of arguments." On the December 8th call with the Board, Petitioner clearly indicated that it wanted the first two documents filed and the Board recognized this desire (Ex. 2014 at 18-19). Patent Owner then told the Board that it would file these two documents (Ex. 2014 at 20). However, Patent Owner did not file these two documents as they agreed to do. Patent Owner should not be permitted to make the unilateral decision to withhold these documents from the Board in light of this history.

The fourth document is an email chain dated December 11th. In that email chain, Patent Owner sent an email requesting that Petitioner join with Patent Owner in an email—to be filed *before* the Board's expected order on the supplemental briefing—indicating that the parties believed that it would be premature to file the first two documents above. Petitioner informed Patent Owner that it

disagreed with that position and wanted the two documents filed, and would seek authorization to file the documents if Patent Owner refused to do so. Patent Owner's failure to respond to that email, particularly after the Board's order prohibiting Petitioner from filing any evidence with its Reply, left Petitioner with the impression that Patent Owner would honor its representation to the Board that Patent Owner would file the documents and is the reason for the timing of this request.

Petitioner is available at any time this week or next week for a conference call should the Board so desire. Patent Owner has indicated that it is available tomorrow, Monday between 4-5 PM EST, and Tuesday.

Sincerely,
Tiffany Miller

Tiffany Miller

Partner

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