
From: Hartmann, Anthony
Sent: Thursday, July 13, 2023 5:08 PM
To: Douglas, Christopher
Cc: Choi, Nick; Bosch, Michele; Goldberg, Joshua; Klodowski, Daniel; Mills, Gracie
Subject: RE: IPR2023-00586 - Certificate of Correction

Counsel,

Your response does not provide any clarity on the issue. Thus, we take no position on the correctness of your request to correct inventorship, nor on the manner in which you propose to do so. However, solely in the interest of moving this issue forward, you can inform the Board that Petitioner does not oppose ATL's request for authorization. We are available for a call with the Board, if needed on the 17th and 19th and after 11 am on the 18th.

Regards,
Tony
Back-up Counsel for Petitioner

From: Douglas, Christopher <Christopher.Douglas@alston.com>
Sent: Wednesday, July 12, 2023 4:36 PM
To: Hartmann, Anthony <anthony.hartmann@finnegan.com>
Cc: Choi, Nick <Nick.Choi@alston.com>; Bosch, Michele <michele.bosch@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Klodowski, Daniel <Daniel.Klodowski@finnegan.com>; Mills, Gracie <Gracie.Mills@finnegan.com>
Subject: RE: IPR2023-00586 - Certificate of Correction

EXTERNAL Email:

Counsel,

Your understanding regarding our June 30 correspondence is incorrect. Our correspondence solely indicates that, in view of claims 1-12 of the '363 patent, Qiao Zeng and Liangzhen Xiao are incorrectly listed as inventors. Further, our correspondence indicates that Patent Owner meets the requirements of 37 CFR § 1.324.

No position has been taken with respect to the impact, if any, the disclaimer of claims 13-16 had on inventorship because such an inquiry would not be relevant to the request before the PTAB. *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019) (instructing that even after the PTAB had instituted trial, "the Director—not the Board—will evaluate the merits of the patentee's petition" for a certificate of correction). Regardless, we understand that CosMX explored any inventorship issues during the depositions of Qiao Zeng (*see e.g.*, Rough Transcript at 19:17-20:12; 26:16-25; 29:14-19; 35:22-25; 42:2-13; 51:22-52:7; 68:2-25; 71:2-25; 72:14-24) and Liangzhen Xiao (*see e.g.*, Rough Transcript at 20:19-21:2; 22:8-14; 40:8-24; 47:24-48:9; 68:13-69:8; 79:22-82:15).

Please let us know by whether this changes your position. If not, we will inform the Board of your position provided on July 5. Please also let us know your availability July 17 – 19 for a call with Board, if needed.

Chris

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From: Hartmann, Anthony <anthony.hartmann@finnegan.com>
Sent: Wednesday, July 5, 2023 5:39 PM
To: Douglas, Christopher <Christopher.Douglas@alston.com>
Cc: Choi, Nick <Nick.Choi@alston.com>; Bosch, Michele <michele.bosch@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Klodowski, Daniel <Daniel.Klodowski@finnegan.com>; Mills, Gracie <Gracie.Mills@finnegan.com>
Subject: RE: IPR2023-00586 - Certificate of Correction

EXTERNAL SENDER – Proceed with caution

Counsel,

Thank you for the response. In view of your answer, we understand that Qiao Zeng and Liangzhen Xiao were not listed as inventors on the '363 patent "through error" prior to issuance. Rather, we understand the needed correction to inventorship is due to ATL's decision to disclaim claims 13-16 post-issuance. Accordingly, it does not appear that 35 U.S.C. § 256 and 37 CFR § 1.324 provide the mechanism for the relief sought. 37 C.F.R. § 42.20(c).

You can inform the Board: "CosMX does not oppose ATL's request for authorization; however, it is unclear to CosMX whether 35 U.S.C. § 256 and 37 CFR § 1.324 is the proper mechanism to correct inventorship due to disclaimer after issuance rather than an error that existed before issuance."

Regards,
Tony
Back-up Counsel for Petitioner

Anthony A. Hartmann
Of Counsel

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FINNEGAN

From: Douglas, Christopher <Christopher.Douglas@alston.com>
Sent: Friday, June 30, 2023 3:31 PM
To: Hartmann, Anthony <anthony.hartmann@finnegan.com>
Cc: Choi, Nick <Nick.Choi@alston.com>; Bosch, Michele <michele.bosch@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Klodowski, Daniel <Daniel.Klodowski@finnegan.com>; Mills, Gracie <Gracie.Mills@finnegan.com>
Subject: RE: IPR2023-00586 - Certificate of Correction

EXTERNAL Email:

Counsel,

The basis for our request is that in view of claims 1-12 of the '363 patent, Qiao Zeng and Liangzhen Xiao are erroneously listed as inventors. See 37 CFR § 1.324(a). Each of Keifei Wang, Qiao Zeng, Liangzhen Xiao, Fei Wu, and Patent Owner are prepared to submit statements confirming that they agree with the change of inventorship. See 37 CFR § 1.324(b). Nothing further is required under 35 U.S.C. § 256 and 37 CFR § 1.324. Regardless, we understand that CosMX is currently taking inventor depositions in the co-pending district court action. Please provide your position with regard to the request for authorization to file a certificate of correction.

Best,

Chris

Christopher TL Douglas

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From: Hartmann, Anthony <anthony.hartmann@finnegan.com>

Sent: Tuesday, June 27, 2023 10:59 AM

To: Douglas, Christopher <Christopher.Douglas@alston.com>

Cc: Choi, Nick <Nick.Choi@alston.com>; Bosch, Michele <michele.bosch@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Klodowski, Daniel <Daniel.Klodowski@finnegan.com>; Mills, Gracie <Gracie.Mills@finnegan.com>

Subject: RE: IPR2023-00586 - Certificate of Correction

EXTERNAL SENDER – Proceed with caution

Counsel,

In order to provide our position, we request clarification of the basis for the proposed request. Is ATL asserting that there was an error in inventorship in the patent as issued or following the disclaimer of claims 13-16?

Regards,

Tony

Back-up counsel for Petitioner

Anthony A. Hartmann

Of Counsel

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FINNEGAN

From: Douglas, Christopher <Christopher.Douglas@alston.com>

Sent: Monday, June 26, 2023 3:36 PM

To: Hartmann, Anthony <anthony.hartmann@finnegan.com>

Cc: Choi, Nick <Nick.Choi@alston.com>; Bosch, Michele <michele.bosch@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Klodowski, Daniel <Daniel.Klodowski@finnegan.com>; Mills, Gracie <Gracie.Mills@finnegan.com>

Subject: IPR2023-00586 - Certificate of Correction

EXTERNAL Email:

Counsel,

Patent Owner plans to email the Board seeking authorization to file a certificate of correction to correct inventorship pursuant to 35 U.S.C. § 256 and 37 C.F.R. § 1.324 in the patent at issue in the above proceeding. Specifically and upon authorization from the Board, Patent Owner intends to remove Qiao Zeng and Liangzhen Xiao as inventors by way of a certificate of correction and relevant supporting documents.

Please let us know whether you oppose this request and, if so, your availability for a call with the Board Thursday or Friday of this week. We would appreciate your response by 2pm ET on June 27.

Best,

Chris

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