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Subject: RE: IPR2023-00712 and IPR2023-00713: LifeScan, Inc. v. Facet Technologies, LLC
Date: Monday, August 21, 2023 4:58:53 PM

Counsel:

The Panel authorizes Petitioner to file, on or before August 23, 2023, the district court order concerning trial scheduling identified in Petitioner's correspondence below as an exhibit in the above referenced proceedings. The Panel also authorizes Patent Owner to file, on or before August 23, 2023, the district court order denying a motion for summary judgment identified in Patent Owner's correspondence below as an exhibit in the above referenced proceedings. No additional briefing is authorized at this time.

Both Parties are cautioned against including substantive legal arguments in email correspondence to the Board in violation of our rules. The Panel admonishes Counsel for Petitioner's assertion that it may intentionally violate our Board rules because it has "no alternative, but to respond" to perceived inappropriate substantive legal arguments in prior email correspondence. The Panel expects both Parties to adhere to our Board rules at all times.

Regards,

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

From: Lyons, Michael J. <michael.lyons@morganlewis.com>
Sent: Monday, August 21, 2023 1:56 AM
To: giri.pathmanaban@lw.com; [Trials](#) <Trials@USPTO.GOV>
Cc: facetlifescan.lwteam@lw.com; griffin@clm.com; basrawi@clm.com; spelman@clm.com; Trivigno@clm.com; harp@clm.com; [LifeScan Facet IPRs](#) <LifeScanFacetIPRs@morganlewis.com>; Jonathan.Strang@lw.com; Jeff.Homrig@lw.com; Benjamin.Behrendt@lw.com
Subject: RE: IPR2023-00712 and IPR2023-00713: LifeScan, Inc. v. Facet Technologies, LLC

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Your Honors,

Petitioner objects to PO's email containing substantive arguments in clear violation of the Board's rules. Petitioner previously informed PO's counsel of its objection and declined to join in submitting an argumentative email to the Board. Now, that PO has disregarded the Board's rules and Petitioner's objections, Petitioner has no alternative, but to respond.

PO's characterization of the Order fails to put the Court's decision in context, omitting for example that the Court expressly declined to consider whether lio alone renders the dimensional limitations obvious. Order at 8. PO further omits that the Court said it "declines to consider LifeScan's Section 103 arguments within the context of its summary judgment motion" (Order at 8) and, thus, did not consider lio in combination with other references such with Peckam (Ground 5) or FreeStyle (Ground 6). PO also omits that the Court's reasoning is based on its adopting the *per se* rule advocated by PO that "[f]igures without scale information cannot constitute anticipatory prior art for dimensional limitations." *Id.* at 7. This *per se* rule goes far beyond controlling case authority. *Unified Patents, LLC v. Oceana Innovations LLC*, 2022 WL 500391, *16 (PTAB Feb. 14, 2022) ("[a]lthough Jones does not disclose actual dimensions for the plugs or sockets in Figure 3, Jones discloses relative dimensions and relies on relative dimensions to illustrate the invention" and that "Although [Petitioner's expert] does not provide a detailed explanation about how Figure 3 shows limitation [...], no need exists for a detailed explanation about a clearly shown feature.") Nor did PO inform the Board that contrary to its litigation position, PO relied on the figures in its provisional application as support for the dimensional limitations in question. It is Petitioner's view that to the extent that your Honors even allow the filing of the District Court's MSJ Order, both parties should be given an opportunity to present three-page briefs that will provide the full relevant context for the Board's consideration.

Best regards,

Michael J. Lyons

Morgan, Lewis & Bockius LLP

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From: giri.pathmanaban@lw.com <giri.pathmanaban@lw.com>

Sent: Saturday, August 19, 2023 11:02 AM

To: Lyons, Michael J. <michael.lyons@morganlewis.com>; trials@uspto.gov

Cc: facetlifescan.lwteam@lw.com; griffin@clm.com; basrawi@clm.com; spelman@clm.com; Trivigno@clm.com; harp@clm.com; LifeScan Facet IPRs <LifeScanFacetIPRs@morganlewis.com>; Jonathan.Strang@lw.com; Jeff.Homrig@lw.com; Benjamin.Behrendt@lw.com

Subject: RE: IPR2023-00712 and IPR2023-00713: LifeScan, Inc. v. Facet Technologies, LLC

[EXTERNAL EMAIL]

Your Honors,

Patent Owner Facet Technologies, LLC in IPR2023-00712 and IPR2023-00713 writes to inform the Board about recent events in the related District Court litigation, *Facet Technologies, LLC v. LifeScan Inc.*, Case No. 2:22-cv-1717-MCS-MAR, and request permission to file relevant docket entries as exhibits in the IPR proceedings, which are attached.

The District Court denied Petitioner's motion for summary judgment (MSJ) of invalidity of claims 6, 8, 14, and 18 of the patent-at-issue in the IPR proceedings (U.S. Pat. No. 8,840,635) as anticipated by lio (U.S. Pat. App. Pub. No. 2005/0131441)—one of the grounds for the same challenged claims in IPR2023-00712. The District Court denied the summary judgment motion because the “figures in lio . . . do not disclose the dimensional limitations of the '635 Patent”; lio's figures “do not include any scale information”; and “[f]igures without scale information cannot constitute anticipatory prior art for dimensional limitations.” Dkt. 224 at 7. That reasoning applies equally to IPR2023-00713 because Petitioner relies on references' figures for dimensional claim limitations in that petition too.

Patent Owner respectfully requests authorization to file the District Court's Summary Judgment Order (MSJ Order; attached), and any other document(s) that Your Honors deem necessary, as exhibits in IPR2023-00712 and IPR2023-00713. Patent Owner understands Petitioner opposes this request because Petitioner wants briefing associated with the filing of the MSJ Order and thinks it is only applicable to IPR2023-00712. However, additional briefing on this point is inappropriate—the Board is well equipped to review and give the MSJ Order whatever weight it deems fit.

If the Board deems a conference call is necessary, the parties are available for a conference call with the Board at the following times:

Monday 8/21, between 11.30-5pm eastern.

Tuesday 8/22, between 3-4pm eastern.

Wednesday 8/23, between 1 to 2pm and 3 to 5pm eastern.

Sincerely,

Giri Pathmanaban (counsel for Patent Owner)

Giri Pathmanaban

LATHAM & WATKINS LLP

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From: Lyons, Michael J. <michael.lyons@morganlewis.com>

Sent: Friday, August 18, 2023 5:40 PM

To: trials@uspto.gov

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<Jeff.Homrig@lw.com>; Behrendt, Benjamin (ATX) <Benjamin.Behrendt@lw.com>

Subject: IPR2023-00712 and IPR2023-00713: LifeScan, Inc. v. Facet Technologies, LLC

Your Honors,

Petitioner LifeScan, Inc. in IPR2023-00712 and IPR2023-00713 writes to inform the PTAB about a recent event in the related District Court litigation, Facet Technologies, LLC v. LifeScan Inc., Case No. 2:22-cv-1717-MCS-MAR, and to request permission to file the relevant docket entry as an exhibit in the IPR proceedings, which is attached. The District Court vacated the September trial date and all dates in the Court's scheduling order. Given that the trial date has been vacated, which is relevant to *Fintiv* factor 2, Petitioner respectfully requests authorization to file the District Court's Order vacating these dates (attached), and any other document(s) that Your Honors deem necessary, as exhibits in IPR2023-00712 and IPR2023-00713. Patent Owner does not oppose this request.

Best regards,

Michael J. Lyons

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