

From: [Trials](#)
To: [Stein, Alexander B.](#); Steven.Peters@lw.com; [Trials](#)
Cc: giri.pathmanaban@lw.com; Susan.Tull@lw.com; Jeff.Homrig@lw.com; Benjamin.Behrendt@lw.com; [LifeScan Facet IPRs](#); [Houmand, Corey R.](#)
Subject: RE: IPR2023-00712 - Joint Request Concerning Exhibits 1039, 1046, and 1056
Date: Friday, May 17, 2024 1:58:39 PM

Counsel,

The Panel grants the parties' joint request to file a redacted version of Exhibit 1046, and that the exhibit be filed under seal.

Regards,

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

From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Wednesday, April 17, 2024 6:11 PM
To: Steven.Peters@lw.com; Trials <Trials@USPTO.GOV>
Cc: giri.pathmanaban@lw.com; Susan.Tull@lw.com; Jeff.Homrig@lw.com; Benjamin.Behrendt@lw.com; LifeScan Facet IPRs <LifeScanFacetIPRs@morganlewis.com>; Houmand, Corey R. <corey.houmand@morganlewis.com>
Subject: Re: IPR2023-00712 - Joint Request Concerning Exhibits 1039, 1046, and 1056

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Your Honors,

Patent Owner's characterization of the parties' discussions is generally accurate, but Petitioner would like to add additional context for the Board's consideration of the parties' joint request that redacted Exhibit 1046 be filed under seal.

Petitioner previously agreed with Patent Owner's position that treating secondary indicia evidence from the district court litigation was fairly produced in the PTAB proceeding (and Patent Owner then filed Exs. 2024, 2040, 2044, 2045, 2050, 2051 and 2052 from the district court case with its Patent Owner's Response). With that agreement, Petitioner understood that it was also authorized to treat as produced in the PTAB proceeding the responsive secondary indicia evidence from the underlying district court litigation (e.g., portions of Ex. 1046). Patent Owner disputed Petitioner's understanding that the parties' agreement had been reciprocal, but the parties were still able to talk things over and arrive at a mutually agreeable resolution through the expungement of Exhibits 1039 and 1056 and the redactions to Exhibit 1046. An explanation of the reasons for sealing Exhibit 1046 is provided in Paper 31, which is the motion to seal Exhibit 1046. Those reasons remain applicable to the redacted version of Exhibit 1046 that the parties jointly agreed on.

Respectfully submitted,

Alex Stein (Reg. No. 71.397)
Counsel for Petitioner

Alexander B. Stein

Morgan, Lewis & Bockius LLP (Seattle and Silicon Valley Offices)

Cell: (650) 213-6296 | Seattle: (206) 274-6437 | Silicon Valley: (650) 843-7278

From: Steven.Peters@lw.com <Steven.Peters@lw.com>

Sent: Wednesday, April 17, 2024 10:14:15 AM

To: Trials@USPTO.GOV <Trials@USPTO.GOV>; alexander.stein@morganlewis.com <alexander.stein@morganlewis.com>

Cc: LifeScanFacetIPRs@morganlewis.com <LifeScanFacetIPRs@morganlewis.com>; corey.houmand@morganlewis.com <corey.houmand@morganlewis.com>; giri.pathmanaban@lw.com <giri.pathmanaban@lw.com>; Susan.Tull@lw.com <Susan.Tull@lw.com>; Jeff.Homrig@lw.com <Jeff.Homrig@lw.com>; Benjamin.Behrendt@lw.com <Benjamin.Behrendt@lw.com>

Subject: RE: IPR2023-00712 - Joint Request Concerning Exhibits 1039, 1046, and 1056

[EXTERNAL EMAIL]

Your Honors,

Counsel for Patent Owner Facet Technologies, LLC would like to provide some needed context to Petitioner's request, at least because it involves Facet's confidential information.

With its Reply, Petitioner filed exhibits and papers containing information designated by Facet as confidential in the district court. Facet contends that Petitioner filed these exhibits without Facet's permission and without seeking leave from the district court to deviate from the protective order, which prohibits the use of confidential information outside of that litigation.

Petitioner disputes that it violated the protective order.

After conferring, the Parties agreed on the below request from Petitioner in lieu of motions practice before the Court and the Board.

Exhibit 1046 includes a report from Petitioner's damages expert, Mr. Rosenfarb, which is designated as Highly Confidential – Attorney's Eyes Only in the district court. The report contains hundreds of paragraphs of confidential discussion that do not relate to this IPR and are not relied upon in Petitioner's Reply.

The Parties' agreement to address the dispute includes a corrected Exhibit 1046 that would redact portions of Mr. Rosenfarb's report to minimize the spread of Facet's confidential information. The replacement exhibit will redact portions of the Rosenfarb report that are not relied upon in Petitioner's Reply. The redacted exhibit will still contain some of Facet's confidential information and will still need to be filed under seal.

To the extent the Board is not inclined to grant Petitioner's request, Facet continues to reserve its rights to correct Petitioner's violation of the protective order through other means.

We hope this clarifies the issue for the Board.

Respectfully,
Steven Peters
Counsel for Patent Owner

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, April 17, 2024 2:30 PM
To: Stein, Alexander B. <alexander.stein@morganlewis.com>; Trials <Trials@USPTO.GOV>
Cc: LifeScan Facet IPRs <LifeScanFacetIPRs@morganlewis.com>; Houmand, Corey R. <corey.houmand@morganlewis.com>; Peters, Steven (DC) <Steven.Peters@lw.com>; Pathmanaban, Giri (ATX-Bay Area) <giri.pathmanaban@lw.com>; Tull, Susan (DC) <Susan.Tull@lw.com>; Homrig, Jeff (ATX) <Jeff.Homrig@lw.com>; Behrendt, Benjamin (ATX) <Benjamin.Behrendt@lw.com>
Subject: RE: IPR2023-00712 - Joint Request Concerning Exhibits 1039, 1046, and 1056

Counsel,

The Panel grants Petitioner's unopposed request to expunge Exhibit 1039 and Exhibit 1056 in IPR2023-00712.

The Panel appreciates the efforts by the Parties to reach agreement in regard to Exhibit 1046, however, the correspondence from Petitioner does not explain why Exhibit 1046 was originally filed by Petitioner under seal without a corresponding redacted, publicly accessible version, or why the record would remain complete if the original, unredacted version were to be expunged and replaced with a redacted version. Petitioner also does not state that the redacted version would be filed as publicly accessible. The Panel asks Petitioner to provide further explanation of its request, including the nature of the portions it intends to redact from Exhibit 1046 (for example, complete sentences or only portions of sentences), as well as confirmation that the redacted version will not be filed under seal.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
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From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Tuesday, April 16, 2024 2:46 PM
To: Trials <Trials@USPTO.GOV>
Cc: LifeScan Facet IPRs <LifeScanFacetIPRs@morganlewis.com>; Houmand, Corey R. <corey.houmand@morganlewis.com>; Steven.Peters@lw.com; giri.pathmanaban@lw.com; Susan.Tull@lw.com; Jeff.Homrig@lw.com; Benjamin.Behrendt@lw.com
Subject: IPR2023-00712 - Joint Request Concerning Exhibits 1039, 1046, and 1056

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Dear Board,

I write on behalf of the Petitioner, LifeScan, Inc., in IPR2023-00712 to notify the Board that both Petitioner and Patent Owner have jointly agreed and respectfully request expungement of Exhibits 1039, 1046, and 1056.

In place of Ex. 1046, Petitioner respectfully requests the Board's authorization to file a redacted version of Ex. 1046, which Patent Owner has reviewed and approved.

Counsel for Patent Owner is copied on this email.

Respectfully submitted,

Alex Stein (Reg. No. 71.397)
Counsel for Petitioner

Alexander B. Stein

Morgan, Lewis & Bockius LLP (Seattle and Silicon Valley Offices)

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