

From: [Mark Ungerman](#)
To: [David Conrad](#); [Trials](#)
Cc: [Lance Wyatt](#); [IPR53953-0001IP1](#)
Subject: IPR2023-00726
Date: Thursday, August 3, 2023 10:01:43 AM

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Your Honors,

I am lead counsel for the Patent Owners in IPR2023-00726. I confirm my availability for a conference call at the times proposed by Petitioner's counsel in their emails of this morning and last night. Included below for reference only.

I object to the statement provided by the petitioner's counsel in those emails that go to the substance of the matter. During our meet and confer call and in subsequent email correspondence:

- I advised Counsel for Petitioner that the email that they proposed to send (and ultimately did send) "Should not include substantive argument";
- I asked that Counsel for Petitioner delete the third paragraph of their email (addressing good cause) as it goes beyond a statement of the relief requested and constitutes substantive argument;
- I asked that Counsel for Petitioner revise the paragraph concerning our meet and confer to more accurately state:
 - Patent Owner opposes Petitioner's request as seeking to improperly supplement the record on issues where Petitioner failed to carry its threshold burden rather than reply and for the failure of good cause.

Counsel for Petitioner declined my request and admitted that they were attempting to make a showing of good cause in their email. Counsel for Petitioner further stated "If you believe the email needs a response from Patent Owner it is up to you whether to do so."

I ask for an opportunity to be heard on the issue of good cause, which Patent Owner believes is lacking.

Respectfully submitted,

Mark Ungerman
Reg. No. 32,070

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Admitted to practice before the US Patent and Trademark Office and the Supreme Court of the United States. Admitted to the bar in the District of Columbia and California. Not admitted to the State Bar of Texas.

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From: David Conrad <Conrad@fr.com>

Sent: Thursday, August 3, 2023 7:18 AM

To: Trials <Trials@USPTO.GOV>

Cc: Mark Ungerman <mungerman@ungermanip.com>; Lance Wyatt <wyatt@fr.com>; IPR53953-0001IP1 <IPR53953-0001IP1@fr.com>

Subject: Re: IPR53953-001IP1: Request for leave to file reply to Patent Owner's Preliminary Response

Apologies, your honors.

The case number is IPR2023-00726.

David

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, August 3, 2023 7:15 AM
To: David Conrad <Conrad@fr.com>; Trials <Trials@USPTO.GOV>
Cc: mungerman@ungermanip.com <mungerman@ungermanip.com>; Lance Wyatt <wyatt@fr.com>; IPR53953-0001IP1 <IPR53953-0001IP1@fr.com>
Subject: RE: IPR53953-001IP1: Request for leave to file reply to Patent Owner's Preliminary Response

[This email originated outside of F&R.]

Counsel,

Please provide an IPR case number. There is no case IPR53953-001IP1.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: David Conrad <Conrad@fr.com>
Sent: Wednesday, August 2, 2023 8:32 PM
To: Trials <Trials@USPTO.GOV>
Cc: mungerman@ungermanip.com; Lance Wyatt <wyatt@fr.com>; IPR53953-0001IP1 <IPR53953-0001IP1@fr.com>
Subject: IPR53953-001IP1: Request for leave to file reply to Patent Owner's Preliminary Response

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Your Honors,

Petitioner requests a conference call with the Board. The parties are both available:

- Thursday, Aug. 3 at 10am-12:30pm ET
- All day Friday
- Monday Aug. 7, 2pm ET and later.

Pursuant to 37 C.F.R. § 42.108(c), Petition seeks leave to file a five-page reply to Patent Owner's Preliminary Response in the above-captioned proceeding, limited to addressing Patent Owner's discussion of the sufficiency of several declarations filed with the Petition, specifically Exs. MOM-1005, MOM-1007, MOM-1009. In addition, Patent Owner seeks permission to provide supplemental declarations responsive to the discussion in the Preliminary Response.

Petitioner believes good cause exists because Petitioner contends that Patent Owner's Preliminary Response mischaracterizes the evidence provided by the declarations. For example, Petitioner implies that Petitioner has submitted a "manipulated translation," despite possessing other evidence produced in prior litigation that puts the filed evidence in the correct context. See POPR, 21. The issues addressed by this request are relevant to institution, and Petitioners respectfully submit that the Board would benefit from a more fulsome record concerning Patent Owner's contentions regarding whether it would be proper for the Board to rely on Harder and Wolf (and these English translations of these references) as prior art to the '958 Patent.

Petitioner respectfully requests one week to submit the supplemental brief and declarations to accommodate declarants' schedules.

Petitioner contacted Lead Counsel for Patent Owner last week with an offer of a five-page sur-reply, and conferred by telephone with Lead Counsel for Patent Owner on August 2. Petitioner understands that Patent Owner opposes Petitioner's request.

Respectfully,
David Conrad
Reg. No. 60,788
Counsel for Petitioners

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