

From: [Trials](#)
To: [Thomas Eschweiler](#); [Trials](#)
Cc: [briggsh@gtlaw.com](#); [olsonl@gtlaw.com](#); [Docketing](#); [philip.marsh@apks.com](#); [Nathan Smith](#); [Jim Potashnik](#); [Ningjiao Zhang](#)
Subject: RE: IPR2023-00879, IPR2023-01133 and IPR2023-01175
Date: Wednesday, October 18, 2023 4:03:05 PM
Attachments: [image001.png](#)

Counsel,

The Board is in receipt of and appreciates the parties' joint proposal. The Board will expunge Ex. 1002 in each of the proceedings identified in the parties' email and listed below, and authorizes Petitioner to file the corrected version of Ex. 1002 as a replacement in each proceeding.

1. IPR2023-00879 relating to U.S. Pat. No. 9,584,021
2. IPR2023-01133 relating to U.S. Pat. No. 10,333,405
3. IPR2023-01175 relating to U.S. Pat. No. 9,966,848

The Board understands that Patent Owner will cite to the corrected Ex. 1002 in its Patent Owner Preliminary Responses in IPR2023-01133 and -01175.

The conference call scheduled for October 19, 2023 is cancelled in view of the resolution of this matter.

Regards,

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

From: Thomas Eschweiler <teschweiler@epiplaw.com>
Sent: Wednesday, October 18, 2023 11:58 AM
To: Trials <Trials@USPTO.GOV>
Cc: [briggsh@gtlaw.com](#); [olsonl@gtlaw.com](#); [Docketing](#) <[docketing@epiplaw.com](#)>; [philip.marsh@apks.com](#); [Nathan Smith](#) <[njsmith@epiplaw.com](#)>; [Jim Potashnik](#) <[jpotashnik@epiplaw.com](#)>; [Ningjiao Zhang](#) <[nzhang@epiplaw.com](#)>
Subject: RE: IPR2023-00879

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Dear Honorable Board,

Counsel for Petitioner has conferred with counsel for Patent Owner regarding the Ex. 1002 issue, and the parties jointly write as follows.

The parties agree that no new matter is included in the corrected version of Ex. 1002 supplied by Petitioner. The parties further agree that the best approach here is to expunge originally-filed Ex. 1002 and replace it with the corrected version of Ex. 1002.

The parties further note that the incorrectly paginated version of Ex. 1002 was filed in three different proceedings:

1. IPR2023-00879 relating to U.S. Pat. No. 9,584,021
2. IPR2023-01133 relating to U.S. Pat. No. 10,333,405
3. IPR2023-01175 relating to U.S. Pat. No. 9,966,848

The parties request Petitioner be allowed to expunge original Ex. 1002 in each of these proceedings, filing the corrected version of Ex. 1002 as a replacement.

Patent Owner further notes that its Patent Owner Preliminary Responses (POPRs) in IPRs2023-01133 and -01175 are due October 20 and 26, respectively. Patent Owner intends on filing POPRs in those matters. Given the proposed expungement of original Ex. 1002 with corrected Ex. 1002, and so that the record is clear, Patent Owner plans on citing to the new, corrected version of Ex. 1002 in those POPRs. Patent Owner kindly requests the Board advise if another approach is preferred.

The parties believe this email addresses the Board's concerns and that the call scheduled for 2 PM ET on Thursday, October 19 is no longer necessary. Nonetheless, the parties remain available for the scheduled call if required by the Board.

Sincerely, Tom

Thomas G. Eschweiler

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From: Thomas Eschweiler
Sent: Tuesday, October 17, 2023 4:56 PM
To: Trials <Trials@USPTO.GOV>
Cc: briggsh@gtlaw.com; olsonl@gtlaw.com; Docketing <docketing@epiplaw.com>; philip.marsh@apks.com; Nathan Smith <njsmith@epiplaw.com>; Jim Potashnik <jpotashnik@epiplaw.com>; Ningjiao Zhang <nzhang@epiplaw.com>
Subject: RE: IPR2023-00879

Dear PTAB Board,

Thank you for bringing this issue to our attention. We've reviewed our filed Petition, as well as the electronic copy of Ex.1002 that was filed with the Petition, and while the citations to the figures of Ex.1002 are correct, we concur that an error occurred with respect to the pinpoint citations to the Exhibit in both the Petition and the Expert Report.

In researching the cause of the issue, we found the following:

1. We originally received a verified translation of the Mieth reference (Ex.1002) from our translation service provider in Word format with page numbering and line numbering. We (both counsel and our technical expert) used the pagination and line numbering from this Word format document in generating the pinpoint citations to the Exhibit for the Petition and the Expert Report.
2. At the time of filing the Petition, we converted the Word document to PDF format, and also added the proper footer information to comply with the Exhibit rules.
3. In performing the Word to PDF conversion, the pagination of the Exhibit was altered, thus causing the page and line numbering to differ from the original Word document. We did not discover this change, and thus filed the Exhibit with pagination that did not match the pinpoint citations within both the Petition and the Expert Report. Please note that while the PDF conversion process caused a change in the pagination of the Exhibit, no substantive alteration of the content of the Exhibit occurred.
4. To clearly illustrate the inadvertent error, we are attaching an electronic copy of the original Word version of the Exhibit, a properly converted (i.e., corrected) copy of the Exhibit in PDF format that matches the pagination of the Word document (and thus matches the pinpoint citations in both the Petition and the Expert Report), and an electronic copy of the PDF Exhibit 1002 as originally filed, that has the mistakenly incorrect, shifted pagination due to the PDF conversion process.

Petitioner apologizes for any additional burden this mistake caused either the PTAB board or the Patent Owner. Such mistake was inadvertent, and was not intended to obfuscate the teaching contained within Ex.1002.

As requested in your email below, we will be reaching out to opposing counsel for the Patent Owner to propose a solution to the issue, and we will keep the Board apprised, either before or at the

Conference call scheduled for Thursday, 10/19.

Thanks and best regards, Tom

Thomas G. Eschweiler

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From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, October 10, 2023 2:45 PM

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Cc: briggsh@gtlaw.com; olsonl@gtlaw.com; Trials <Trials@USPTO.GOV>

Subject: IPR2023-00879

Counsel,

From the Board –

It has come to the Board's attention that the Petition in IPR2023-00879 contains inaccurate pinpoint citations to Exhibit 1002 (Mieth). The inaccurate citations are mirrored in Dr. Holberg's declaration (Ex. 1007). The Board requests that Petitioner provide an explanation for the inaccuracies, including whether Petitioner submitted an incorrect version of Exhibit 1002. If Petitioner submitted an incorrect version of Exhibit 1002, the parties shall discuss and propose a mutually agreeable resolution to resolve this error. If the parties cannot agree on a resolution, the Board will convene a conference call at 2pm ET on October 19, 2023.

Regards,

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