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Subject: IPR2023-00955 and IPR2023-00958
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Further to the parties' call with the Board on Tuesday, June 18, Patent Owner respectfully requests a conference call to seek the Board's permission for Patent Owner to file a motion to terminate IPR Proceedings IPR2023-00955 and IR2023-00958 due to Petitioner's continuing failure to comply with its *Sand Revolution* stipulation in each proceeding and Petitioner's ongoing, active pursuit of the instituted grounds both in district court and before the Board. Subsequent to the filing of these motions to terminate, Patent Owner respectfully proposes that Petitioner be authorized to file an opposition to each motion two weeks later, and that Patent Owner be authorized file a reply in each proceeding one week later. In addition, and as discussed on the June 18 teleconference, Patent Owner respectfully requests guidance as to whether this motion may be filed as a standard motion under 37 C.F.R. § 42.20, or whether in these circumstances Patent Owner should follow the procedures for sanctions motions under 37 C.F.R. § 42.11(d), including with respect to the 21-day waiting period specified in under 37 C.F.R. § 42.11(d)(2). Patent Owner further notes its understanding that Petitioner's inclusion of extensive substantive argument in this email (as it has insisted on doing below) is improper and a violation of the Board's procedures. Patent Owner accordingly does not attempt herein to respond to the substance of those arguments, other than to note that Patent Owner disagrees with Petitioner's assertions and characterizations, including of the call with the Board and of Petitioner's continuing attempts to leverage its noncompliance to its own advantage in the district court, and is prepared to address these issues in the requested call.

Petitioner states that Patent Owner's request is unjustified and contrary to the guidance the parties received during the June 18 teleconference. Patent Owner's request comes just a few days after the June 18 teleconference, where Patent Owner did not request the authorization it now seeks. Nothing has changed since then that would ripen Patent Owner's proposed motion. If anything, circumstances have moved in the opposite direction. Petitioner thus opposes Patent Owner's request and feels it must respond further as set forth below given how incredibly drastic and extreme of a remedy Patent Owner is proposing. Certainly, a motion should not be authorized without further oral discussion with the Board, particularly because there is no transcript of the earlier June 18 teleconference. As Petitioner recalls, the Board stated during the June 18 teleconference that "this was a train that [Petitioner] would have the ability to stop."

First, Patent Owner's request is premature because the district court has not yet ruled on Petitioner's motion to move the district court trial date. Patent Owner's recollection of the June 18 teleconference is that the Board believed it would be beneficial – indeed critical – to have the district court's ruling on this motion. If the district court moves the trial date, Patent Owner's request would be rendered moot. Petitioner recalls that the Board indicated the parties could

continue to wait at least 2-3 weeks for the district court to rule. Nevertheless, only a week after the June 18 teleconference, Patent Owner now requests immediate authorization to terminate the proceedings. Petitioner does not believe this is what the Board had in mind.

Second, and perhaps more important, even if the district court does not move the trial date, Patent Owner's request is unjustified given Petitioner's representations both to the Board and district court. As the Board explained during the June 18 teleconference, its concern was the possibility of Petitioner being permitted to present its defense based on the Linnarsson/McCloskey prior art twice – once to the district court and once to the PTAB. During the June 18 teleconference, Petitioner assured the Board that it had no desire to do this and that if the district court did not move the trial date, Petitioner would not risk termination of the IPRs by insisting on presenting the defense in the district court because its preferred venue was the PTAB. Accordingly, the day after the June 18 teleconference, Petitioner provided an update to the district court regarding the teleconference, wherein Petitioner stated as follows:

Finally, the parties and Board discussed whether it would be appropriate for Parse to be permitted to present the Linnarsson/McCloskey defense to both the PTAB and the district court jury. Parse repeatedly explained that it has no desire to do this, which is precisely why it is requesting to move the trial date. The Board nonetheless stated that if the Court did not move the trial date and Parse still wished to present the Linnarsson/McCloskey reference to the jury, it would consider a motion to terminate the IPR proceedings with respect to the two Brenner patents for which institution was delayed. Parse made clear that if it were forced to choose just one venue to present the Linnarsson/McCloskey reference, it would select the PTAB over the district court. Parse has believed from the outset that the PTAB presents the best and most efficient venue for resolving its defense based on the Linnarsson/McCloskey references.

Parse 6/19/24 Letter to District Court at 2 (emphasis in original). Patent Owner also informed the Court that it would be filing the stipulations the parties discussed at the teleconference. Given the representations Parse has made to both the Board and district court, it is unclear why Patent Owner believes a motion to terminate is suddenly ripe. Petitioner can only assume that Patent Owner is aggressively pursuing this based on strategic considerations, not because it is justified or because the Board invited an immediate motion to terminate.

The Board should not authorize a motion to terminate at this time. Petitioner proposes instead that the parties provide a prompt update to the Board when the district court has ruled on the pending motion to move the trial date, at which point a further teleconference can be held to discuss the matter if needed. To the extent the Board is nonetheless contemplating authorizing Patent Owner's proposed motion now, Petitioner requests that a teleconference be held first given the gravity of the remedy Patent Owner is proposing and because there is no transcript of the June 18 teleconference.

Counsel for both parties can be available for a teleconference 4-5 PM ET on Friday, June 28, and 3-5 PM ET on Monday, July 1, or Tuesday, July 2.

Respectfully submitted,
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