

From: [Wroblewski, Karlee](#)
To: [Trials](#); ptong@raklaw.com
Cc: [Alex Soto](#); walt@nextgeninov8.com; [Welch, Matt](#); [O'Connor, Dan](#); [Stevens, Scott](#); [Riolo, Mary](#)
Subject: RE: IPR2023-00960 - Pat. 8,238,754 - Leave to File Motion Challenging Service
Date: Tuesday, July 25, 2023 3:35:53 PM

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Petitioner writes with regard to the email correspondence from Patent Owner and with regard to the motion filed in IPR2023-00960. For context, Petitioner provides the following timeline regarding Petitioner's service of IPR2023-000960:

- On June 30, 2023, Petitioner, along with filing its petition, attempted to physically serve the registered address for U.S. 8,238,754 via UPS Next Day Air.
- Additionally on June 30, 2023, Petitioner provided a courtesy service via email of the petition and all accompanying documents to the Patent Owner's counsel of record in the co-pending litigations and three recently filed, related IPRs. Petitioner's records indicate that Patent Owner's counsel of record downloaded the petition and all accompanying documents on July 5, 2023.
- On July 1, 2023, UPS attempted delivery at the address (including the appropriate zip code) as provided on the USPTO Patent Center database. UPS was unable to effect delivery, and indicated that this was due to the street number being "incorrect", despite the package's address being identical to the address registered with the USPTO.
- On July 10, 2023, the Board accorded a filing date to IPR2023-000960 and notified the Patent Owner via email and via letter to the same address provided on the USPTO Patent Center database.
- On July 17, 2023, Petitioner became aware that the physical copies of petition were never delivered and notified Patent Owner's counsel on July 18, 2023, to which counsel responded: "RAK is not authorized to receive service of the Petition and Evidence on behalf of the Soto's under 37 CFR 42.105."
- On July 19, 2023, Petitioner worked to re-effectuate service by re-sending copies of the petition and documents to all known addresses of patent owners, including the address prompting the initial undeliverable message. These packages were all successfully delivered on July 20, 2023.

As of July 20 and in view of the correspondence between Patent Owner and the Board, Petitioner understood that any issues regarding service would be addressed once a panel had been assigned and that no briefing had been authorized. On July 21, Patent Owner filed a motion to vacate the filing date. In order to address the ongoing correspondence and the recently filed motion, Petitioner requests a call with Board once a panel has been assigned to address (1) service of the Petition and exhibits and (2) whether briefing is necessary on Patent Owner's motion to vacate the filing date.

Best,
Karlee

Karlee N. Wroblewski
Associate

ALSTON & BIRD

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Karlee.Wroblewski@alston.com

From: Trials <Trials@USPTO.GOV>

Sent: Monday, July 24, 2023 9:26 AM

To: ptong@raklaw.com

Cc: Alex Soto <alex@nextgeninov8.com>; 'walt@nextgeninov8.com' <walt@nextgeninov8.com>; Wroblewski, Karlee <Karlee.Wroblewski@alston.com>; Welch, Matt <Matt.Welch@alston.com>; O'Connor, Dan <Dan.OConnor@alston.com>; Trials <Trials@USPTO.GOV>; Stevens, Scott <Scott.Stevens@alston.com>; Trials <Trials@USPTO.GOV>

Subject: RE: IPR2023-00960 - Pat. 8,238,754 - Leave to File Motion Challenging Service

EXTERNAL SENDER – Proceed with caution

Counsel,

This case does not have a judge panel associated with it. Your e-mail will be shared with the panel once a panel is assigned.

The Board received Patent Owner's July 21st filings, which were approved today. Any issue regarding that, or any other issue regarding this case, should be addressed with the judge panel once a panel is assigned.

Regards,

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

From: ptong@raklaw.com <ptong@raklaw.com>

Sent: Friday, July 21, 2023 5:40 PM

To: Trials <Trials@USPTO.GOV>

Cc: Alex Soto <alex@nextgeninov8.com>; 'walt@nextgeninov8.com' <walt@nextgeninov8.com>; scott.stevens@alston.com; Karlee.Wroblewski@alston.com; matt.welch@alston.com; dan.oconnor@alston.com; Trials <Trials@USPTO.GOV>

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To the Honorable Board,

On behalf of Patent Owners Alex and Walt Soto, Russ August & Kabat just made a special appearance to file a motion to vacate the filing date and all deadlines due to lack of service of the Petition and evidence in IPR2023-000960.

Due to restrictions of the E2E filing system that prevent us from categorizing filings as "exhibits" or "motions" until the mandatory notices are filed, we filed the motion under the "Mandatory Notice" category with exhibits appended thereto. The panel of Judges will need to rule on the motion once they are assigned in due course.

Respectfully,

Peter Tong
Russ, August & Kabat
4925 Greenville Avenue, Suite 200 | Dallas, Texas 75206
Main +1 310 826 7474 | ptong@raklaw.com | www.raklaw.com

From: Trials <Trials@USPTO.GOV>
Date: Thursday, July 20, 2023 at 8:38 AM
To: ptong@raklaw.com <ptong@raklaw.com>
Cc: Alex Soto <alex@nextgeninov8.com>, 'walt@nextgeninov8.com' <walt@nextgeninov8.com>, scott.stevens@alstoncom <scott.stevens@alstoncom>, Karlee.Wroblewski@alston.com <Karlee.Wroblewski@alston.com>, matt.welch@alston.com <matt.welch@alston.com>, dan.oconnor@alston.com <dan.oconnor@alston.com>, Trials <Trials@USPTO.GOV>
Subject: RE: IPR2023-00960 - Pat. 8,238,754 - Leave to File Motion Challenging Service

Counsel,

This case does not have a judge panel associated with it. Once a judge panel is assigned, your e-mail will be shared with the panel.

Regards,

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

From: ptong@raklaw.com <ptong@raklaw.com>
Sent: Thursday, July 20, 2023 9:25 AM
To: Trials <Trials@USPTO.GOV>
Cc: Alex Soto <alex@nextgeninov8.com>; 'walt@nextgeninov8.com' <walt@nextgeninov8.com>; scott.stevens@alstoncom; Karlee.Wroblewski@alston.com; matt.welch@alston.com; dan.oconnor@alston.com
Subject: IPR2023-00960 - Pat. 8,238,754 - Leave to File Motion Challenging Service
Importance: High

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To the Honorable Board,

On behalf of Patent Owners Alex and Walt Soto, Russ August & Kabat seek the Board's permission to make a special appearance to file a motion to vacate the filing date and all deadlines due to lack of service of the Petition and evidence in IPR2023-000960.

Qi (Peter) Tong
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Russ, August & Kabat
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