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**From:** Lavenue, Lionel  
**Sent:** Wednesday, August 7, 2024 1:26 PM  
**To:** Davis Jr., Walter D.; Edwards, Cory R.; England, Jonathan; Doshi, Dipu; Soffen, Stephen; Paradkar, Arun V.; Mashack, Mark; CM-200371-00440 EPCC-Inno-IPRS  
**Cc:** Innoscience-EPC-IPRs  
**Subject:** Meet & Confer Planning, PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response

Counsel,

We will send you dial-in information for the meet and confer **Thursday 10:30 am ET**.

We do not agree the Board intended for Petitioner to provide a list before the call. And as we mentioned during the call, 37 CFR §42.51(b)(1)(iii) puts the burden on Patent Owner (not Petitioner) to serve relevant information that is inconsistent with a position advanced in its response.

But in any event, in an effort to have a more productive meet and confer, please find below a list of exemplary documents and citations with relevant information inconsistent with Patent Owner's positions advanced in its response:

1. EPC's Complaint in ITC Inv. No. 337-TA-1366, dated May 26, 2023, at Ex. 28 p. 16; Ex. 32 p. 15.
2. Expert Report of Dr. E. Fred Schubert dated November 13, 2023, at ¶¶ 112, 232, 430, 441; Appx. D Ex. 1C (pp. 26-28), Ex. 5C, Ex. 9C (pp. 12-13), Ex. 13C (pp. 13-14).
3. Transcript of Dr. Schubert Deposition on December 14, 2023, at 30:20-32:18, 215:13-219:15.
4. Transcript of Dr. Schubert Deposition on December 15, 2023, at 198:17-199:8.
5. Transcript of Evidentiary Hearing from February 26 to March 1, 2024, at 103:2-104:18, 212:10-213:9, 532:5-22, 693:4-23, 964:1-9, 1034:3-25.
6. RX-0255 at pp. 374-377, 379-380, 383-384.

Regards,

Lionel

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**From:** Davis Jr., Walter D. <Walter.Davis@BlankRome.com>  
**Sent:** Tuesday, August 6, 2024 11:15 PM  
**To:** Lavenue, Lionel <lionel.lavenue@finnegan.com>; Edwards, Cory R. <Cory.Edwards@BlankRome.com>; England, Jonathan <jonathan.england@blankrome.com>; Doshi, Dipu <dipu.doshi@blankrome.com>; Soffen, Stephen <stephen.soffen@blankrome.com>; Paradkar, Arun V. <arun.paradkar@blankrome.com>; Mashack, Mark <Mark.Mashack@BlankRome.com>; CM-200371-00440 EPCC-Inno-IPRS <EPCC-Inno-IPRS@BlankRome.com>  
**Cc:** Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>  
**Subject:** RE: Meet & Confer Planning, PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response

Counsel,

As written, you suggest that the Board required Petitioner to identify a list of positions **during** the meet and confer. Our recollection (without having the opportunity or ability to review the transcript prepared by your court

reporter) is that while the Board required Petitioner to provide a list, the Board did not indicate whether the list should be provided during or before the meet and confer. Given the context under which we believe the Board made the requirement, however, we believe the Board's intent was for the list to be provided before the meet and confer. Either way, Patent Owner respectfully requests that Petitioner provide a list a reasonable amount of time before the meet and confer to maximize the odds that the parties can resolve some or all of the issues during the meet and confer. To the extent Petitioner believes that Innoscience confidential information is implicated, we suggest that that information be sent to only those attorneys on the EPC team that are subject to the ITC protective order. Related, Patent Owner agrees that all of its meet and confer attendees will be under the ITC's protective order. If any of the alleged conflicting information implicates EPC confidential business information, we ask that all Petitioner attendees also be under the ITC's protective order.

We will take your request that any potential certification be completed by August 14 under advisement, but we note that you told the Board that Petitioner did not need to receive documents produced by Patent Owner under 37 CFR 42.51 until August 21.

Regarding the timing of the meet and confer, we are available on Thursday (8/8) between 10:30 am and 12:00 pm EDT.

Best,  
Wally

**Walter D. Davis Jr. | BLANKROME**  
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**From:** Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>  
**Sent:** Tuesday, August 6, 2024 6:25 PM  
**To:** Davis Jr., Walter D. <[Walter.Davis@BlankRome.com](mailto:Walter.Davis@BlankRome.com)>; Edwards, Cory R. <[Cory.Edwards@BlankRome.com](mailto:Cory.Edwards@BlankRome.com)>; England, Jonathan <[jonathan.england@blankrome.com](mailto:jonathan.england@blankrome.com)>; Doshi, Dipu <[dipu.doshi@blankrome.com](mailto:dipu.doshi@blankrome.com)>; Soffen, Stephen <[stephen.soffen@blankrome.com](mailto:stephen.soffen@blankrome.com)>; Paradkar, Arun V. <[arun.paradkar@blankrome.com](mailto:arun.paradkar@blankrome.com)>; Mashack, Mark <[Mark.Mashack@BlankRome.com](mailto:Mark.Mashack@BlankRome.com)>; CM-200371-00440 EPCC-Inno-IPRS <[EPCC-Inno-IPRS@BlankRome.com](mailto:EPCC-Inno-IPRS@BlankRome.com)>  
**Cc:** Innoscience-EPC-IPRs <[Innoscience-EPC-IPRs@finnegan.com](mailto:Innoscience-EPC-IPRs@finnegan.com)>  
**Subject:** Meet & Confer Planning, PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response

Counsel,

Pursuant to the Board's instructions during today's hearing, please provide your availability to meet and confer on the issues, as mandated by the Board. We are available:

1. Tomorrow Wednesday (8/7/2024) at 11:30 AM, 12 PM, or 12:30 PM ET.
2. Thursday (8/8/2024) between 9 AM and 12 PM ET.

As required by the Board, during the meet and confer we will identify a list of the main positions about the scope of the '294 patent, its claims, and relevant prior art that Patent Owner has presented inconsistently in the IPR versus the ITC, and that Patent Owner should have already addressed per its discovery obligations in 37 CFR §42.51(b)(1)(iii).

During the meet and confer, as required by the Board, we will identify certain inconsistent positions from the confidential record of ITC investigation 337-TA-1366, so all attendees to the meet and confer must be under the

ITC's protective order. To facilitate the discussion, we will require confirmation that all attendees for Patent Owner be under the ITC's protective order.

Finally, as discussed during the hearing, if the parties agree that a motion to compel is not required at this time, we will ask you during the meet and confer to confirm a date certain for a certification of compliance with 37 CFR §42.51(b)(1)(iii). And, because Petitioner's reply is due September 4, 2024, we would ask that such certification be completed by August 14, 2024 at the latest.

Regards,

Lionel

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**From:** Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>

**Sent:** Thursday, July 11, 2024 7:03 PM

**To:** Davis Jr., Walter D. <[Walter.Davis@BlankRome.com](mailto:Walter.Davis@BlankRome.com)>; Edwards, Cory R. <[Cory.Edwards@BlankRome.com](mailto:Cory.Edwards@BlankRome.com)>; England, Jonathan <[jonathan.england@blankrome.com](mailto:jonathan.england@blankrome.com)>; Doshi, Dipu <[dipu.doshi@blankrome.com](mailto:dipu.doshi@blankrome.com)>; Soffen, Stephen <[stephen.soffen@blankrome.com](mailto:stephen.soffen@blankrome.com)>; Paradkar, Arun V. <[arun.paradkar@blankrome.com](mailto:arun.paradkar@blankrome.com)>; Mashack, Mark <[Mark.Mashack@BlankRome.com](mailto:Mark.Mashack@BlankRome.com)>; CM-200371-00440 EPCC-Inno-IPRS <[EPCC-Inno-IPRS@BlankRome.com](mailto:EPCC-Inno-IPRS@BlankRome.com)>

**Cc:** Innoscience-EPC-IPRs <[Innoscience-EPC-IPRs@finnegan.com](mailto:Innoscience-EPC-IPRs@finnegan.com)>

**Subject:** PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response

Wally,

We will contact the Board for a call and note your availability.

Regards,

Lionel

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**From:** Davis Jr., Walter D. <[Walter.Davis@BlankRome.com](mailto:Walter.Davis@BlankRome.com)>

**Sent:** Wednesday, July 10, 2024 5:20 PM

**To:** Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>; Edwards, Cory R. <[Cory.Edwards@BlankRome.com](mailto:Cory.Edwards@BlankRome.com)>; England, Jonathan <[jonathan.england@blankrome.com](mailto:jonathan.england@blankrome.com)>; Doshi, Dipu <[dipu.doshi@blankrome.com](mailto:dipu.doshi@blankrome.com)>; Soffen, Stephen <[stephen.soffen@blankrome.com](mailto:stephen.soffen@blankrome.com)>; Paradkar, Arun V. <[arun.paradkar@blankrome.com](mailto:arun.paradkar@blankrome.com)>; Mashack, Mark <[Mark.Mashack@BlankRome.com](mailto:Mark.Mashack@BlankRome.com)>; CM-200371-00440 EPCC-Inno-IPRS <[EPCC-Inno-IPRS@BlankRome.com](mailto:EPCC-Inno-IPRS@BlankRome.com)>

**Cc:** Innoscience-EPC-IPRs <[Innoscience-EPC-IPRs@finnegan.com](mailto:Innoscience-EPC-IPRs@finnegan.com)>

**Subject:** RE: PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response

Lionel,

I suggest we go ahead and schedule a conference call with the Board. I am unavailable the week of July 15, but backup counsel can be available. Below, please find Patent Owner's availability for the weeks of July 15 and 22.

July 17: 10 am -12 pm

July 18: 10 am -12 pm

July 23: 10 am – 4 pm

July 24: 10 am – 4 pm

July 25: 10 am – 4 pm

Best,

Wally

Walter D. Davis Jr. | BLANKROME

**From:** Lavenue, Lionel <[lionel.lavenue@finnegan.com](mailto:lionel.lavenue@finnegan.com)>

**Sent:** Wednesday, July 3, 2024 4:11 PM

**To:** Davis Jr., Walter D. <[Walter.Davis@BlankRome.com](mailto:Walter.Davis@BlankRome.com)>; Edwards, Cory R. <[Cory.Edwards@BlankRome.com](mailto:Cory.Edwards@BlankRome.com)>; England, Jonathan <[jonathan.england@blankrome.com](mailto:jonathan.england@blankrome.com)>; Doshi, Dipu <[dipu.doshi@blankrome.com](mailto:dipu.doshi@blankrome.com)>; Soffen, Stephen <[stephen.soffen@blankrome.com](mailto:stephen.soffen@blankrome.com)>; Paradkar, Arun V. <[arun.paradkar@blankrome.com](mailto:arun.paradkar@blankrome.com)>; Mashack, Mark <[Mark.Mashack@BlankRome.com](mailto:Mark.Mashack@BlankRome.com)>; CM-200371-00440 EPCC-Inno-IPRS <[EPCC-Inno-IPRS@BlankRome.com](mailto:EPCC-Inno-IPRS@BlankRome.com)>

**Cc:** Innoscience-EPC-IPRs <[Innoscience-EPC-IPRs@finnegan.com](mailto:Innoscience-EPC-IPRs@finnegan.com)>

**Subject:** PTAB-IPR2023-01381 - Incomplete Discovery in Patent Owner's Response Counsel,

The IPR rules, specifically 37 CFR § 42.51, require that "a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency." 37 CFR §42.51(b)(1)(iii). Patent Owner has not complied with this rule in PTAB-IPR2023-01381, regarding the '294 patent.

At least during ITC investigation 337-TA-1366, the Patent Owner and its expert, Dr. E. Fred Schubert, made statements about the scope of the '294 patent, its claims, and relevant prior art that are inconsistent with positions advanced in Patent Owner's Response. Information and documents with the relevant statements from ITC investigation 337-TA-1366, where the Patent Owner presents positions that are inconsistent with Patent Owner positions in PTAB-IPR2023-01381 that should have been produced with Patent Owner's response. The Patent Owner did not do so, and therefore, Patent Owner has not complied with its discovery obligations under 37 CFR §42.51(b)(1)(iii).

To correct its breach of 37 CFR §42.51(b)(1)(iii), the Patent Owner must supplement its discovery in PTAB-IPR2023-01381 to comply with 37 CFR §42.51(b)(1)(iii).

Please let us know by July 10, 2024, if Patent Owner will be serving documents with the relevant inconsistent information. Alternatively, please let us know your availability to schedule an initial conference call with the Board the week of July 15, 2024.

Regards,

Lionel

**Lionel M. Lavenue** | [Bio](#)  
**Attorney at Law**

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**"U.S. PTAB Firm of the Year"** *Managing Intellectual Property Americas IP Awards*, 2019, 2021, 2022

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