
From: Trials <Trials@USPTO.GOV>
Sent: Thursday, August 8, 2024 2:16 PM
To: Lavenue, Lionel; Trials
Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs
Subject: RE: IPR2023-01381 - (U.S. Patent No. 8,350,294)



Counsel,

From the Board –

Petitioner is authorized to file a Motion to Compel in IPR2023-01381 and Patent Owner is authorized to file an Opposition to the motion. Petitioner's motion is to be no more than 10 pages in length and is due on or before August 13, 2024. Patent Owner's Opposition is to be no more than 10 pages in length and is due within 5 business days of the filing of the Motion to Compel.

Regards,

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

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>
Sent: Thursday, August 8, 2024 12:06 PM
To: Trials <Trials@USPTO.GOV>
Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>
Subject: IPR2023-01381 - (U.S. Patent No. 8,350,294)

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

Dear Board –

Per your instructions, the Parties conducted a meet and confer this morning regarding Petitioner's request for Patent Owner to comply with its routine discovery obligations.

No agreement was reached on the call. Patent Owner disputes the merits of the inconsistent statements, and thus, a Motion to Compel is now necessary.

Therefore, Petitioner requests authorization to file its requested Motion to Compel, and it is prepared to file its Motion upon authorization by the Board.

Regards,

Lionel Lavenue

Lead Counsel for Petitioner

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, July 24, 2024 8:42 AM
To: Lavenue, Lionel <lionel.lavenue@finnegan.com>; Trials <Trials@USPTO.GOV>
Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>
Subject: RE: IPR2023-01381 - (U.S. Patent No. 8,350,294)

Counsel,

A conference call is scheduled with the Board at **3:00 pm ET on August 6, 2024**.

The dial-in number is: 866-917-7697 and the passcode is: 6276855#.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>
Sent: Monday, July 22, 2024 7:09 PM
To: Trials <Trials@USPTO.GOV>
Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>
Subject: IPR2023-01381 - (U.S. Patent No. 8,350,294)

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Dear Board –

The parties have conferred and are available between 10am and 4pm on August 5 or August 6.

Regards,

Lionel Lavenue

Lead Counsel for Petitioners

From: Trials <Trials@USPTO.GOV>
Sent: Monday, July 22, 2024 10:44 AM
To: Trials <Trials@USPTO.GOV>; Lavenue, Lionel <lionel.lavenue@finnegan.com>
Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>
Subject: RE: IPR2023-01381 - (U.S. Patent No. 8,350,294)

Counsel,

A message from the judge panel –

We apologize for the short notice and any inconvenience, but we need to postpone the conference call with the parties originally set for **11:00 AM on July 23, 2024**.

We ask that the parties please provide us with their availability for a call during the week of August 5-9.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, July 16, 2024 11:55 AM

To: Lavenue, Lionel <lionel.lavenue@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>

Subject: RE: IPR2023-01381 - (U.S. Patent No. 8,350,294)

Counsel,

A conference call is scheduled with the Board at **11:00 AM on July 23, 2024**.

The dial-in number is: 866-917-7697 and the passcode is: 6276855#.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>

Sent: Saturday, July 13, 2024 10:55 AM

To: Trials <Trials@USPTO.GOV>

Cc: EPCC-Inno-IPRS@BlankRome.com; Walter.Davis@BlankRome.com; mark.mashack@blankrome.com; Cory.Edwards@BlankRome.com; jonathan.england@blankrome.com; dipu.doshi@blankrome.com; stephen.soffen@blankrome.com; arun.paradkar@blankrome.com; Innoscience-EPC-IPRs <Innoscience-EPC-IPRs@finnegan.com>

Subject: IPR2023-01381 - (U.S. Patent No. 8,350,294)

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Dear Board,

Petitioner requests a call with the Board for Patent Owner's failure to comply with its discovery obligations under 37 CFR §42.51(b)(1)(iii).

During the parallel ITC investigation 337-TA-1366, 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.

Patent Owner, however, has not produced such information and documents that are inconsistent with Patent Owner positions in PTAB-IPR2023-01381. Patent Owner, thus, failed to comply with rule 37 CFR § 42.51, requiring 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).

Petitioner asked Patent Owner to produce discovery of its documents with the relevant inconsistent information. Patent Owner refused Petitioner's request and asked for a call with the Board.

The Parties have conferred and are available for a call at the following times:

- 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 regards,

Lionel Lavenue

Counsel for Petitioner

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

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
1875 Explorer Street, Suite 800, Reston, VA 20190-6023

571.203.2750 | fax: 202.408.4400 | Lionel.Lavenue@finnegan.com | www.finnegan.com | 

FINNEGAN

“#1 Tier National Ranking for Intellectual Property Law” *U.S. News—Best Lawyers Best Law Firms*, 2010-2023

“Practice Group of the Year” *Law360*, 2017, 2019, 2022

“Intimidating Opponent: The Most Feared Firms in Litigation” *BTI Consulting Group Litigation Outlook*, 2022, 2023

“#1 Tier National Ranking for Intellectual Property Litigation” *Benchmark Litigation*, 2022

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

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