

From: [Trials](#)
To: [Wolfe, Michael](#); [Bregman, Dion M.](#); [Patitucci, Alison P.](#); [PH-Lam-Inpria-IPR](#); [MLB-Lam-IPR-Team](#)
Cc: [Trials](#)
Subject: RE: URGENT / IPR2024-00033 / Deposition Dispute
Date: Wednesday, October 16, 2024 3:36:12 PM

Counsel,

The Board has taken account of the information provided by the parties in the following email trail, as well as the information in Exhibit 2008 (Dr. Stowers' declaration) and Exhibit 1032 (Dr. Stowers' deposition transcript). The Board will not permit an additional extension of Due Date 2, originally set for October 9, 2024 (see Paper 14 at 11). We determine that, given the inclusion of a motion to amend and the time constraints imposed by the statutory deadline for a final written decision in the proceeding, the better course is to resolve, next week, any remaining dispute about whether Dr. Stowers should be produced for additional cross-examination via deposition and, only to the extent necessary and appropriate, address any remaining issues through supplemental briefing. In addition, both parties should make every effort to meet-and-confer by phone or in person prior to contacting the Board.

By close of business on Friday, October 18, 2024, the parties shall submit a joint email identifying their preferred dates and times, next week, for a teleconference with the panel to discuss Petitioner's request to further depose Dr. Stowers, with the understanding that the panel is unavailable on Wednesday, October 23, 2024. The Board will enter a copy of this email trail as Exhibit 3006.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office
Phone: (571) 270-0989
E-mail: InterferenceTrialSection@USPTO.GOV

From: Wolfe, Michael <michaelwolfe@paulhastings.com>
Sent: Tuesday, October 15, 2024 7:33 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; Patitucci, Alison P. <alison.patitucci@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>
Subject: RE: URGENT / IPR2024-00033 / Deposition Dispute

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Your Honors,

Patent Owner writes because Petitioner has again sent its email without conferring in any manner whatsoever with Patent Owner. Petitioner did not inform Patent Owner of the telephone

Ex. 3006
IPR2024-00033

conversation referenced in the Board's email, nor did Petitioner confer prior to sending any of its prior emails.

Contrary to what may be implied from Petitioner's email, Patent Owner does not believe Petitioner should be awarded an extension for its Petitioner's Reply and for its Opposition to the Motion to Amend, which would potentially upheave the schedule (e.g., due to upcoming holidays) and would also effectively reward improper district court-oriented questioning that has no bearing on this proceeding. In addition, should the Board determine that Petitioner may question Dr. Stowers regarding the merits of his thesis, even though his three-page declaration was limited to the narrow issue of the public accessibility of his thesis, and should that determination only be made after Petitioner files its papers, the issue could be dealt with in the form of supplemental briefing. Finally, Patent Owner notes that the transcript of Dr. Stowers's deposition is available and could be filed by Petitioner.

Respectfully,
Michael Wolfe

From: Bregman, Dion M. <dion.bregman@morganlewis.com>

Sent: Tuesday, October 15, 2024 5:58 PM

To: Trials <Trials@USPTO.GOV>; Wolfe, Michael <michaelwolfe@paulhastings.com>; Patitucci, Alison P. <alison.patitucci@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>

Subject: [EXT] RE: URGENT / IPR2024-00033 / Deposition Dispute

Ms. Villanueva,

Thank you. We will file the deposition transcript as soon as we receive it, and thereafter renew our request for guidance regarding the witness being instructed not to answer certain deposition questions.

Unfortunately, our Reply to Patent Owner's Response and our Opposition to the Motion to Amend are due next week, and, Board permitting, we would need to conduct a follow-up deposition in advance of filing our briefs. In light of this, we will work with Patent Owner's counsel to extend the briefing dates, but will need the Board to approve extending the briefing date for the Opposition to the Motion to Amend, which the parties cannot move themselves.

When we renew our request for guidance, we will offer a proposed extension of the briefing dates for the Board's consideration.

Regards,

-Dion

Dion M. Bregman

Morgan, Lewis & Bockius LLP

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From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, October 15, 2024 1:13 PM

To: Wolfe, Michael <michaelwolfe@paulhastings.com>; Bregman, Dion M. <dion.bregman@morganlewis.com>; Patitucci, Alison P. <alison.patitucci@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: URGENT / IPR2024-00033 / Deposition Dispute

[EXTERNAL EMAIL]

Counsel,

This communication addresses Petitioner's request that the Board hold a teleconference this week, regarding a dispute that arose during the deposition of Dr. Jason Stowers, which was taken on Friday, October 11, 2024. The Board is not available this week for a call. Petitioner may renew its request for a teleconference after the parties file the deposition transcript. The Board will enter a copy of this email trail as Exhibit 3005.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office
Phone: (571) 270-0989
E-mail: InterferenceTrialSection@USPTO.GOV

From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, October 15, 2024 3:43 PM

To: Wolfe, Michael <michaelwolfe@paulhastings.com>; Bregman, Dion M. <dion.bregman@morganlewis.com>; Patitucci, Alison P. <alison.patitucci@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: URGENT / IPR2024-00033 / Deposition Dispute

Counsel,

Thank you for the communications below about the dispute that arose during a deposition on the afternoon of Friday, October 11, 2024. At 3:39 PM Eastern Time that day, the Board (specifically, Judge Obermann) called the phone number provided by counsel and spoke briefly (for a duration of 56 seconds) to Petitioner's counsel, Ms. Alison Patitucci, who

explained that the deposition had concluded and that the parties would be in touch with the Board this week to discuss next steps. The call was terminated due to its ex parte nature, and no other aspects of the case were discussed. The Board will enter a copy of this email trail as Exhibit 3004.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office
Phone: (571) 270-0989
E-mail: InterferenceTrialSection@USPTO.GOV

From: Wolfe, Michael <michaelwolfe@paulhastings.com>
Sent: Tuesday, October 15, 2024 7:23 AM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; Patitucci, Alison P. <alison.patitucci@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>
Subject: RE: URGENT / IPR2024-00033 / Deposition Dispute

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Your Honors,

Patent Owner writes to provide context, given Petitioner Lam did not confer with Patent Owner Inpria regarding the content of its emails before sending them to the Board.

During the deposition, Lam asked questions about several topics without objection. However, at one point in the deposition, Lam began to ask questions directed to the technical merits of Dr. Stowers's thesis. As the Board may recall, Patent Owner raised this as a concern during the last conference call with the Board given that Dr. Stowers is a named inventor but whose declaration was limited to the public accessibility of his thesis. Inpria indicated to Lam that this line of questions was inappropriately outside of the scope of Dr. Stowers's declaration. Lam responded by suggesting a call with the Board. The parties paused the deposition to call the Board. The Office indicated the Board would call the parties back, if available.

While the parties waited for a potential call, the parties agreed that Lam should continue its questions to exhaust any line of questions that were not disputed. Lam's remaining questions proceeded without interruption due to scope issues.

Inpria does not believe a call is necessary and suggests that the parties submit the deposition transcript that the Board may then review.

Respectfully,

Michael Wolfe

From: Patitucci, Alison P. <alison.patitucci@morganlewis.com>
Sent: Monday, October 14, 2024 1:36 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; Wolfe, Michael <michaelwolfe@paulhastings.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>
Subject: [EXT] RE: URGENT / IPR2024-00033 / Deposition Dispute

Your Honors:

Further to the email below which we sent to the board during a deposition on Friday, Petitioner and Patent Owner were unable to resolve the dispute regarding Patent Owner's instructions for the witness not to answer certain questions based on a scope objection. Petitioner completed what it could at the deposition, and the remainder of the deposition was postponed until the Board is able to address this issue. Petitioner therefore requests a conference call with the Board this week.

Respectfully,
Alison

Alison P. Patitucci, Ph.D.

Pronouns: She/Her/Hers

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From: Patitucci, Alison P.
Sent: Friday, October 11, 2024 2:28 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; 'Wolfe, Michael' <michaelwolfe@paulhastings.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>
Subject: URGENT / IPR2024-00033 / Deposition Dispute

Board,

Petitioner is currently taking the deposition of Dr. Jason Stowers in IPR2024-00033 and requires the Board's immediate assistance regarding the witness being instructed not to answer questions based on a scope objection. We are available for a conference call whenever the Board has time today.

Thank you,
Alison

Alison P. Patitucci, Ph.D.

Pronouns: She/Her/Hers

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