

From: [Trials](#)
To: [Martin \(DeWerff\), Mackenzie](#); [Michael D. Saunders](#); [Trials](#)
Cc: [Bryan D. Atkinson](#); [*DAL - Force MOS IPRs](#); [Lines, Aaron](#)
Subject: RE: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS
Date: Thursday, April 18, 2024 12:55:21 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)

Counsel,

From the Board –

The parties must request and receive panel authorization before filing exhibits in these proceedings, unless the exhibits are filed properly in support of a brief. All future requests directed to the panel must attest that the parties have met and conferred in good faith and shall indicate whether a party opposes the request.

Petitioner's request to file copies of the relevant dockets entries of the parties' claim construction positions advanced in the parallel district court litigation is denied. However, Petitioner is authorized to file a copy of any district court order that includes claim construction findings when that order is available.

Regards,

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

From: Martin (DeWerff), Mackenzie <Mackenzie.Martin@BakerMckenzie.com>
Sent: Wednesday, April 17, 2024 5:27 PM
To: Michael D. Saunders <MSaunders@dickinson-wright.com>; Trials <Trials@USPTO.GOV>
Cc: Bryan D. Atkinson <BATkinson@dickinson-wright.com>; *DAL - Force MOS IPRs <DAL-ForceMOSIPRs@bakermckenzie.com>; Lines, Aaron <Aaron.Lines@bakermckenzie.com>
Subject: RE: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS

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Your Honors,

We regret that this issue has caused any objection or dispute. As stated in my first email, we proactively sought guidance from the Trial Division for the proper procedure for this matter in view of our obligation under 37 CFR § 42.11. As we were not able to receive an answer on the proper procedure on the call, the Trial Division recommended that we send an email to Trials@USPTO.Gov to get guidance on the procedure.

With my first email, we have not sought relief from the Board. We have not sought additional briefing or substantive argument on claim construction, and we are mindful of the Board's denial for subsequent briefing.

We sought clarification on the proper procedure for notifying the Board of related claim construction developments and positions, including last week's *Markman* hearing, in view of our obligations under 37 CFR § 42.11 and pursuant to the Trial Division's recommendation.

Kind regards,

Mackenzie Martin
Counsel for Petitioner

Mackenzie Martin
Partner, Intellectual Property & Technology
Tel: +1 214 978 3048
Cell: +1 214 534 0345

**Baker
McKenzie.**

From: Michael D. Saunders <MSaunders@dickinson-wright.com>

Sent: Wednesday, April 17, 2024 4:00 PM

To: Trials@USPTO.Gov

Cc: Bryan D. Atkinson <BAtkinson@dickinson-wright.com>; *DAL - Force MOS IPRs <DAL-ForceMOSIPRs@bakermckenzie.com>; Lines, Aaron <Aaron.Lines@bakermckenzie.com>; Martin (DeWerff), Mackenzie <Mackenzie.Martin@BakerMcKenzie.com>

Subject: [EXTERNAL] RE: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS

To the Honorable Board:

Patent Owner was not apprised in advance of Petitioner's intent to send the below email to the Board and was not provided prior notice of, nor an opportunity to participate in, Petitioner's communications with the Trial Division referenced in Petitioner's email. Patent Owner notes that the claim construction briefing in the *Force MOS v. Asustek* case—a case in which Petitioner's counsel represents Defendant Asustek—closed nearly a month ago with the filing of Force MOS's claim construction reply brief on March 19, 2024.

Accordingly, for the same reasons Patent Owner explained regarding Petitioner's prior request for supplemental briefing in these IPRs (Ex. 3001), Patent Owner opposes and objects to Petitioner's below request. In particular, Patent Owner objects to the characterizations of Patent Owner's claim construction positions in Petitioner's email, which appear to be another tardy attempt by Petitioner to present additional substantive claim construction arguments—a request that the Board has already rejected. As to the substantive merits of Petitioner's request, Patent Owner disputes that there are inconsistencies in Force MOS's claim construction positions, but would be happy to provide the Board with whatever material the Board requests.

Regards,
Michael Saunders
Counsel for Patent Owner



[Michael D. Saunders](#)

Member

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For docketing purposes of patent & trademark matters only, please add the appropriate email of dwpatents@dickinson-wright.com or dwtrademarks@dickinson-wright.com to any emails being sent to our office. Thank you.

From: Martin (DeWerff), Mackenzie <Mackenzie.Martin@BakerMckenzie.com>

Sent: Wednesday, April 17, 2024 12:54 PM

To: Trials@USPTO.Gov

Cc: Michael D. Saunders <MSaunders@dickinson-wright.com>; Bryan D. Atkinson <BATkinson@dickinson-wright.com>; *DAL - Force MOS IPRs <DAL-ForceMOSIPRs@bakermckenzie.com>; Lines, Aaron <Aaron.Lines@bakermckenzie.com>

Subject: IPR2024-00093, IPR2024-00094 ('634 and '409 Patent IPRs) – Inergy v. Force MOS

Your Honors,

Pursuant to our obligations under 37 CFR § 42.11, we respectfully seek the Board's guidance on the proper procedure in light of different claim construction positions taken by Patent Owner in Related Matter, *Force Mos Technology, Co. Ltd. v. Asustek Computer, Inc.*, No. 2:22-cv-00460 (E.D. Tex.). The Trial Division recommended that we send this email requesting instructions on the proper procedure and authorization (as needed) on this matter.

Specifically, in view of the claim construction positions advanced and recent *Markman* hearing conducted in the Related Matter (e.g., Dkts. 37, 37-1, 42, 58, 62, 64, 66, 73, and 75), we write to confirm whether the Board is aware of the claim construction positions made in the Related Matter. We also write to determine whether we should file a notice providing the Board with copies of relevant docket entries, pursuant to 37 CFR § 42.11, and, if so, to confirm that Petitioner has authorization to file such notice.

Kind regards,
Mackenzie Martin
Counsel for Petitioner

Mackenzie Martin
Partner, Intellectual Property & Technology

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