

From: Ian Soule
Sent: Tuesday, April 30, 2024 10:23 PM
To: Schroeder, John R.
Cc: Foley, Amanda N.; James, Kurt F.; Levitt, Steven; Pollmann, Jonathan; Kim, David S.; Jason Eisenberg; Yangbeini Wang; PTAB Account
Subject: RE: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

Hi John,

Thanks for your response, we will note Patent Owner opposes Petitioner's request in our email to the Board and will note that the parties can provide times available for a call if the panel would find one helpful.

Best,
Ian

Ian Soule (he/him)
Director
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From: Schroeder, John R. <john.schroeder@stinson.com>
Sent: Monday, April 29, 2024 6:08 PM
To: Ian Soule <ISOULE@sternekessler.com>
Cc: Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>; Jason Eisenberg <jasone@sternekessler.com>; Yangbeini Wang <BWANG@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

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Ian,

Thank you for speaking to me as well.

Patent Owner does not believe good cause exists for seeking a pre-institution reply. Both the '760 patent and Wong listed that they were assigned to Patent Owner on their face and the assignments were recorded and publically available, such that the issue of common ownership should have been easily foreseen and any alleged inconsistencies in the assignments should have been addressed in the Petition.

The only alleged omission that you have identified to me was that there was a later assignment from only one of the inventors that was recorded against at least one of the '760 Patent's family members—but not the '760 Patent. Having looked into the matter, I am informed that the inventor from whom this additional assignment was received—Mr.

Gniadek—is extremely ill and that the assignment was prepared as catch-all for any IP that Mr. Gniadek had worked on in his career in case he were to pass or become permanently incapacitated.

While I do not have a full explanation—beyond likely inadvertence—as to why the catch-all assignment was recorded for certain applications/issued patents and not others, the omission does not have any legal significance. Specifically, the catch-all assignment is 100% consistent with the assignment that was submitted as Exhibit 2007 and merely reiterates that the subject matter is assigned to Senko Advanced Components, Inc.

You are correct that the assignment submitted as Exhibit 2007 was for the great-grandparent of the '760 Patent. But this was the effective assignment as of the filing date of the application that issued as the '760 Patent in that it unambiguously assigned rights in any future continuations—such as the '760 Patent—to Patent Owner. I note that this was adequately addressed in the Preliminary Response at page 15. The fact that the assignment was signed and filed concurrently with the great-grandparent application provides logical explanation as to why the later catch-all assignment was able to identify the application which granted as the '760 Patent by number—amongst the five page long appendix listing of patent applications for which Mr. Gniadek was named as an inventor—while the original and legally effective assignment did not include the application numbers. Nor is it inconsistent that only Mr. Gniadek signed the later assignment, as it was meant as a catch-all for his entire employment with Senko—and not limited to the subject matter of the '760 Patent—in case any assignments had been inadvertently missed or might be found defective for some unforeseen reason and he is not available to cure any assignment issues at a later date due to his illness.

Despite it being US Conec's burden as the Petitioner to establish a reasonable likelihood of success within its Petition, including establishing that the relied-upon references qualified as prior art, US Conec entirely failed to address common ownership of Wong in its Petition. Senko opposes US Conec's request to file a pre-institution reply on the issue of common ownership and any alleged inconsistencies in the assignments, as permitting such a reply would be (1) highly prejudicial procedurally in that it would be tantamount to providing additional pages for the petition and (2) presents evidentiary prejudice—even were Senko granted an expedited opportunity to file a pre-institution sur-reply with additional evidence—in that one of the key witnesses that can corroborate the assignment is ill as discussed above.

If you still want to push for additional briefing, we ask that you include this e-mail thread in your correspondence with the Board. Should the Board request a conference call, Patent Owner's counsel would be available tomorrow (4/30) from 3:00-6:00 pm ET, Wednesday (5/1) 1:00-2:30 pm ET, or Thursday (5/2) 11:00 am – 5:00 pm ET. I can also provide additional availability for this Friday or next week, so long as the Board would excuse Patent Owner's lead counsel from joining the call.

Best regards,
John

John R. Schroeder
Partner

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From: Ian Soule <ISOULE@sternekessler.com>

Sent: Monday, April 29, 2024 1:46 PM

To: Schroeder, John R. <john.schroeder@stinson.com>

Cc: Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S.

<david.kim@stinson.com>; Jason Eisenberg <jasone@sternekessler.com>; Yangbeini Wang
<BWANG@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>

Subject: RE: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

Hi John,

Thanks for speaking with me earlier this afternoon.

During our discussion, I explained (as reflected in our prior email) that good cause exists for the Board to grant leave at least because it was unforeseen Patent Owner's Preliminary Response arguments would: (1) improperly rely on incomplete assignment records and (2) would not acknowledge several irregularities with the recorded assignments for both the '760 patent and Wong.

Petitioner could not have foreseen such incomplete arguments from Patent Owner since the Petition sufficiently showed Wong qualifies as prior art. Petitioner immediately reached out once this was determined. And we held a meet and confer at the earliest possible date you provided as being available.

During our meet and confer Petitioner explained that Patent Owner has omitted from its Preliminary Response the only recorded assignment that actually includes the application number for the '760 patent. That assignment was executed and recorded after the '760 patent filing date. That assignment also only includes one of the inventors of the '760 patent. Additionally, the exhibit submitted with the Preliminary Response appears on its face to potentially be an assignment of a great-grandparent of the '760 patent, but it contains no application number, and the title of the assignment does not match the '760 patent.

During the call you mentioned potential "agreements to assign" or potential employment agreements, and I noted that none of those are presented in the Preliminary Response. There are other irregularities and inconsistencies in both the '760 patent and Wong's assignment records submitted and omitted by Patent Owner in its Preliminary Reply, but as I explained, it is not efficient use of the parties' time to exchange out-of-proceeding briefing prior to the Board granting Petitioner's leave.

From our discussion, I understand that Patent Owner may oppose Petitioner's request for leave for briefing on this issue, but please confirm. You also mentioned potentially requesting a reply, and potentially including "additional evidence." We request you write up Patent Owner's full position and requests so that we can submit a joint email to the Board highlighting all issues that are requested for additional briefing.

While we may be amendable to a Patent Owner sur-sur reply, we would oppose any "additional evidence" not allowed/not properly introduced under the relevant statutes, rules, CTPG, and FRE.

We generally think a Board call is not necessary, so we are only planning to ask for briefing rather than a call. To the extent the Board deems a call necessary, I also understand you will provide times you may be available. To avoid a lengthy requesting email to the Board, please let us know if you would accept a general statement that "The parties can provide times available for a call if the panel would find one helpful."

Best,
Ian

Ian Soule (he/him)
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From: Schroeder, John R. <john.schroeder@stinson.com>
Sent: Monday, April 29, 2024 10:03 AM
To: Ian Soule <ISOULE@sternekessler.com>
Cc: Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>; Jason Eisenberg <jasone@sternekessler.com>; Yangbeini Wang <BWANG@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
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Ian,

I will make sure to be at my desk at that time.

John

John R. Schroeder

Partner

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From: Ian Soule <ISOULE@sternekessler.com>
Sent: Sunday, April 28, 2024 1:59 PM
To: Schroeder, John R. <john.schroeder@stinson.com>
Cc: Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>; Jason Eisenberg <jasone@sternekessler.com>; Yangbeini Wang <BWANG@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: Re: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

Thanks, John - I can plan to call you at 1p eastern tomorrow to discuss.

Best,
Ian

Ian Soule (he/him)

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On Apr 25, 2024, at 6:12 PM, Schroeder, John R. <john.schroeder@stinson.com> wrote:

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Ian,

We would be available Monday from 10-11 am or 1-5 pm ET to meet and confer. As a courtesy, we ask that you identify the basis of your allegation that Senko's arguments rely on incomplete assignment records and identify the supposed irregularities with the recorded assignments for Wong and the '760 patent itself.

Best regards,

John R. Schroeder

Partner

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From: Ian Soule <ISOULE@sternekessler.com>

Sent: Thursday, April 25, 2024 3:19 PM

To: Foley, Amanda N. <amanda.foley@stinson.com>; James, Kurt F. <kurt.james@stinson.com>;

Schroeder, John R. <john.schroeder@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>;

Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>

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Subject: RE: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

External Email – Use Caution

Counsel,

Petitioner intends to seek leave from the Board to file a reply to Patent Owner's preliminary response in accordance with 37 C.F.R. §§ 42.23, 42.24(c), in order to address Patent Owner's arguments that Wong does not qualify as prior art. CTPG, 51-52, citing 37 C.F.R. §§ 42.108(c). Good cause exists for the Board to grant leave at least because Patent Owner's Preliminary Response arguments relies on incomplete assignment records and does not acknowledge several irregularities with the recorded assignments for both Wong and the '760 patent itself.

Please confirm Patent Owner will not oppose this request. Alternatively, please provide a few times next week you can be available for a meet and confer.

Best,

Ian

Ian Soule (he/him)

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Sent: Thursday, April 18, 2024 4:29 PM
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Cc: James, Kurt F. <kurt.james@stinson.com>; Schroeder, John R. <john.schroeder@stinson.com>; Levitt, Steven <steven.levitt@stinson.com>; Pollmann, Jonathan <jonathan.pollmann@stinson.com>; Kim, David S. <david.kim@stinson.com>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: US Conec Ltd. v. Senko Advanced Components Inc. - IPR2024-00119

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Counsel –

Please see the link below attaching the documents that were filed in the above-referenced matter today.

<https://stinson.sharefile.com/public/share/web-s7959b60d78f14e8f8204e7bf6b98624b>

Should you have any questions, please contact me. Thank you.

Regards,
Amanda N. Foley
Legal Administrative Assistant
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