Moore, Ian

From: Dokhanchy, Reza <RDokhanchy@mintz.com>
Sent: Wednesday, August 7, 2024 2:10 PM
To: Pepe, Christopher
Cc: Meunier, William; Renaud, Michael; Van Loy, Michael; Rizk, Adam; Desai, Anish; Ansley, Sutton; Percer, Adrian
Subject: RE: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

Chris,

The stipulations are fine to file. Petitioner confirms that it will not argue in response to a motion to exclude Mr. Wang's declaration that Patent Owner was required to move to compel a deposition of Mr. Wang and/or file a motion for additional discovery regarding the same prior to filing a motion to exclude. We expect that resolves the issue.

Thanks,
Reza

Reza Dokhanchy
Member

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road, Suite 300, San Diego, CA 92130
+1.858.314.1596
RDokhanchy@mintz.com | Mintz.com

From: Pepe, Christopher <Christopher.Pepe@weil.com>
Sent: Tuesday, August 6, 2024 2:02 PM
To: Dokhanchy, Reza <RDokhanchy@mintz.com>
Cc: Meunier, William <WAMeunier@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Van Loy, Michael <MDVanLoy@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Desai, Anish <anish.desai@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: RE: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

Reza, Thanks for confirming on the schedule. Attached are draft stipulations. Let us know if we have consent to file. With respect to the motion, we would be moving to compel JLI to make Mr. Wang available for deposition given that JLI is required to do so under the Board's rules

Reza,

Thanks for confirming on the schedule. Attached are draft stipulations. Let us know if we have consent to file.

With respect to the motion, we would be moving to compel JLI to make Mr. Wang available for deposition given that JLI is required to do so under the Board's rules. *See* Trial Practice Guide at 23 ("[A] party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a

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IPR2024-00161

party as well as experts and non-party witnesses.”). We would be willing to forego filing a motion to compel if Petitioner confirms that it will not argue in response to a motion to exclude Mr. Wang’s declaration that Patent Owner was required to move to compel a deposition of Mr. Wang and/or file a motion for additional discovery regarding the same prior to filing a motion to exclude. Absent confirmation, Patent Owner will need to proceed with requesting authorization from the Board to file its motion.

Thanks,

Chris

Christopher Pepe

Weil, Gotshal & Manges LLP
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christopher.pepe@weil.com
+1 202 682 7153 Direct
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From: Dokhanchy, Reza <RDokhanchy@mintz.com>
Sent: Monday, August 5, 2024 6:27 PM
To: Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: Meunier, William <WAMeunier@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Van Loy, Michael <MDVanLoy@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Desai, Anish <anish.desai@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: RE: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

Chris,

We are available tomorrow from 9:30-11:30 AM ET and 3-5 ET, Wednesday 9-11:30 AM ET, and Thursday 9-10 AM and 2-5 PM ET.

We are fine with your proposal for extension you sent, copied below. Please circulate a joint stipulation.

- Due Date 1 – August 16 to August 23
- Due Date 2 – November 8 to November 15

Regarding your “motion to compel and/or motion for additional discovery,” who are you planning to move to compel, and what are you going to seek discovery of? As we stated, we do not represent Mr. Wang.

Reza Dokhanchy
Member

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From: Pepe, Christopher <Christopher.Pepe@weil.com>
Sent: Monday, August 5, 2024 2:46 PM

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Juul v. NJOY
IPR2024-00161

To: Dokhanchy, Reza <RDokhanchy@mintz.com>
Cc: Meunier, William <WAMeunier@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Van Loy, Michael <MDVanLoy@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Desai, Anish <anish.desai@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: RE: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

Reza, Can you provide your availability this week for a call with the Board? In addition the scheduling issue, we intend to request authorization from the Board to file a motion to compel and/or motion for additional discovery. Let us know your position on the motion. Thanks, Chr

Reza,

Can you provide your availability this week for a call with the Board? In addition the scheduling issue, we intend to request authorization from the Board to file a motion to compel and/or motion for additional discovery. Let us know your position on the motion.

Thanks,

Chris

Christopher Pepe

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From: Trials <Trials@USPTO.GOV>
Sent: Monday, August 5, 2024 10:16 AM
To: Pepe, Christopher <Christopher.Pepe@weil.com>; Trials <Trials@USPTO.GOV>
Cc: Dokhanchy, Reza <RDokhanchy@mintz.com>; Meunier, William <WAMeunier@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Van Loy, Michael <MDVanLoy@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Desai, Anish <anish.desai@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: RE: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

Counsel,

From the Board –

The parties may stipulate to changes to due dates 1 and 2 without Board involvement. The parties are encouraged to meet and confer in order to reach an agreement as to the movement of these due dates. If, after meeting and conferring, the parties remain unable to reach agreement, Patent Owner may renew its request for a conference call with the Board to discuss modifying the schedule. If this occurs, both parties should be prepared to discuss why an agreement could not be reached.

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Regarding Patent Owner's request for guidance on how to respond to declaration testimony prepared for another proceeding by a declarant who will not be made available for deposition, we will not pre-judge an issue not placed before us. Instead, we direct the parties to the Board's rules regarding discovery and motions to exclude.

Regards,

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

From: Pepe, Christopher <Christopher.Pepe@weil.com>
Sent: Tuesday, July 30, 2024 2:20 PM
To: Trials <Trials@USPTO.GOV>
Cc: Dokhanchy, Reza <RDokhanchy@mintz.com>; Meunier, William <WAMeunier@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Van Loy, Michael <MDVanLoy@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Desai, Anish <anish.desai@weil.com>; Ansley, Sutton <sutton.ansley@weil.com>; Percer, Adrian <adrian.percer@weil.com>
Subject: IPR2024-00160 and IPR2024-00161 - Request for Guidance and Scheduling Order

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Your Honors,

I write on behalf of Patent Owner concerning two issues that have arisen in IPR2024-00160 and IPR2024-00161.

First, Patent Owner seeks guidance from the Board regarding Exhibit 1017, which includes a declaration submitted by Petitioner in both proceedings. The declaration included in Exhibit 1017 was not prepared for these proceedings, but was submitted by R.J. Reynolds Vapor Company in a prior district court litigation against Fuma International LLC, which is the entity that owned the challenged patents prior to Patent Owner NJOY LLC. Patent Owner has requested that Petitioner make the declarant available for deposition in these proceedings, but Petitioner has indicated that it will not do so because it does not represent the declarant. Patent Owner intends to move to exclude Exhibit 1017 at the appropriate time if it does not have the opportunity to depose the declarant, but seeks guidance from the Board regarding whether Patent Owner needs to file a motion to compel or motion for additional discovery for a deposition of the declarant prior to filing a motion to exclude.

Second, Patent Owner respectfully requests a modification of Due Dates 1 and 2 in the Scheduling Order in each proceeding. Petitioner has offered its expert for deposition on August 9, and Due Date 1 is August 16. Pursuant to 37 C.F.R. § 42.53(d)(2), the deposition "should ordinarily take place…more than a week before" Due Date 1. Accordingly, Patent Owner requests an extension of Due Date 1 from August 16 to August 23 to provide sufficient time to address the deposition testimony of Petitioner's expert in the Patent Owner Response and comport with § 42.53(d)(2). Patent Owner is also amenable to a corresponding extension of Due Date 2 from November 8 to November 15 so that Petitioner's time for Reply is not shortened. Patent Owner does not intend to file a motion to amend, and no other Due Dates would be changed.

Patent Owner has conferred with Petitioner regarding the scheduling adjustment, and Petitioner opposes Patent Owner's request.

To the extent the Board would like to schedule a conference call regarding the issues above, the parties are available at the following times: Wednesday 7/31 from 3:30 – 5 PM ET; Thursday 8/1 from 11 AM – 2:30 PM ET; or Friday 8/2 from 11 AM – 5 PM ET.

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IPR2024-00161

Respectfully,

Christopher Pepe
Counsel for Patent Owner

Christopher Pepe

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