

From: [Peter M Kohlhepp](#)
To: [Christopher, Angelo](#); [Ryan Rypka](#); [Derek Vandenburg](#); [Aaron W. Pederson](#); [Nate D Louwagie](#)
Cc: [Hayes, Jennifer](#); [Stringfield, Daniel](#); [Zheng, Helena](#); [Krusiewicz, Peter](#); [Holt, Benjamin](#); [Krusiewicz, Peter](#); [Girgis, Diana](#)
Subject: RE: Qualcomm v. NST - IPR2024-00338
Date: Tuesday, November 5, 2024 12:45:22 PM

Hi Angelo,

Thank you for the response, we will let Ms. Hall-Ellis know that the deposition will not proceed this week.

To be clear, the offer to provide a deposition of Ms. Hall-Ellis was not a “demand” but rather a reasonable effort to accommodate the particular circumstances of this case. As we explained below, Ms. Hall Ellis provided a substantively virtually-identical declaration regarding the same Jantsch textbook in the other IPR proceeding between the parties. Petitioner offered a deposition in that IPR, and Patent Owner ultimately declined to take the deposition. Given that Petitioner was recently joined to this IPR, that Patent Owner appears to be challenging the prior art status of that same textbook (including seeking to depose the University of Texas librarian who submitted a declaration regarding the Jantsch textbook), and that Patent Owner objected to the Jantsch textbook excerpts, Petitioner was merely offering the Hall-Ellis evidence again and also again offering Patent Owner the opportunity to take her deposition. Also, as you know, the vast majority of the 154 pages in the Hall-Ellis exhibit you reference are a copy of portions of the Jantsch textbook and her CV.

Best regards,
Peter



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From: Christopher, Angelo <achristopher@nixonpeabody.com>
Sent: Monday, November 4, 2024 8:42 PM
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Cc: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>

Subject: RE: Qualcomm v. NST - IPR2024-00338

Peter,

As we explained below, the Hall-Ellis declaration is not in the record and is not evidence. The Board has not granted Petitioner's motion to file supplemental information. Patent Owner has no obligation to take Ms. Hall-Ellis' deposition at this time and intends to do only if and when the Board grants Petitioner's motion or Petitioner files the declaration with its reply. *Actifio, Inc. v. Delphix Corp.*, IPR2015-00014, Paper 40, 2 (PTAB Dec. 1, 2015) ("Cross-examining a declarant on evidence that may never be filed potentially wastes resources and time. A party cannot rely on an unfiled declaration as evidence").

Petitioner's demand that Patent Owner either take a deposition on a 154 page expert declaration (which was served on Oct. 28) on only one offered date (Nov. 4) or agree to waive its objections has no basis in the Board's rules and is unreasonable. We intend to include this correspondence with our opposition to Petitioner's motion to file supplemental information.

Best regards,

- Angelo



Angelo J. Christopher

Counsel

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From: Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>

Sent: Monday, November 4, 2024 6:54 PM

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Cc: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>

Subject: RE: Qualcomm v. NST - IPR2024-00338

Counsel – is Patent Owner declining to take the deposition of Ms. Hall-Ellis at this time?
Please let us know, as she is still holding the date/time we offered below.

Best,
Peter



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From: Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>

Sent: Thursday, October 31, 2024 7:01 PM

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Subject: RE: Qualcomm v. NST - IPR2024-00338

Counsel,

Petitioner intends to request authorization from the Board to file a motion to also submit the documents served on Monday of this week (October 28) as supplemental information pursuant to 37 C.F.R. § 42.123(a) and in the alternative 37 C.F.R. § 42.123(b). We understand from your correspondence below that Patent Owner opposes. Please let us know your team's earliest availability for a call with the Board.

Best regards,
Peter



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Cc: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>

Subject: RE: Qualcomm v. NST - IPR2024-00338

Counsel,

We disagree that the supplemental evidence was untimely, and we also disagree that a motion to submit supplemental information would be untimely.

As to the declaration of Dr. Hall-Ellis, if Petitioner prefers to depose Dr. Hall-Ellis during the Reply stage rather than at this stage, that is fine with Patent Owner, so long as Petitioner does not object to the Hall-Ellis declaration as untimely or otherwise procedurally improper. The Hall-Ellis declaration concerns the Jantsch textbook and is substantively virtually identical to the declaration Dr. Hall-Ellis provided regarding that same Jantsch textbook in the '052 patent IPR. As you will recall, Patent Owner requested a deposition date for Dr. Hall-Ellis in that IPR, Petitioner provided one, and Patent Owner then withdrew the deposition notice. Given that Petitioner apparently intends to contest the prior art status of the Jantsch textbook in this IPR, we wanted to also provide that declaration in this proceeding now, and provide Patent Owner with another opportunity to depose Dr. Hall-Ellis if it desires.

Best,
Peter



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From: Christopher, Angelo <achristopher@nixonpeabody.com>

Sent: Wednesday, October 30, 2024 8:39 PM

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<dstringfield@nixonpeabody.com>; Zheng, Helena <hzheng@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>

Subject: RE: Qualcomm v. NST - IPR2024-00338

Counsel,

Petitioner's supplemental evidence was not timely served. 37 C.F.R. § 42.64. To the extent Petitioner intended the Hall-Ellis declaration to be supplemental information, it is also untimely and Petitioner did not comply with the Board's rules. 37 C.F.R. § 42.123.

Notwithstanding those issues, the Hall-Ellis declaration is not in the current record. *Fanduel, Inc. v. CG Tech. Dev., LLC*, IPR2017-00902, Paper 45 at 83 (PTAB Oct. 4, 2018) ("supplemental evidence is served pursuant to § 42.64(b)(2), but does not become part of the record"). If Petitioner chooses to submit the Hall-Ellis declaration as an exhibit with its Reply, then Patent Owner would take her deposition during that discovery period. Patent Owner, of course, reserves all rights to object to the declaration and Petitioner's reliance on it at that time. If Petitioner's position is that the Hall-Ellis declaration is currently in evidence and Patent Owner must take the deposition now and cannot to do so later if it is submitted with Petitioner's Reply, we would need to raise this with the Board immediately. Please clarify Petitioner's position as soon as possible.

Additionally, even Patent Owner were somehow required to take the deposition before Petitioner submits the declaration as evidence, as I'm sure you can understand, taking a deposition on a 154 page declaration on 1 weeks' notice when we have another deposition in this case on Monday is unacceptable and we would need additional dates and likely an extension for Due Date 1.

Best regards,

- Angelo



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From: Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>

Sent: Wednesday, October 30, 2024 7:41 AM

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[EXTERNAL E-MAIL]

Be Aware of Links and Attachments

Counsel,

Further to this, please note that Dr. Hall-Ellis can be available for a remote deposition in the IPR2024-00338 matter on Wednesday, November 6 starting at 10am Central.

Best,
Peter



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Subject: Qualcomm v. NST - IPR2024-00338

Counsel,

Please find Qualcomm's supplemental evidence at the link below:

<https://carlsoncaspers.sharefile.com/d-s445e5906e3a34e37ba6b6da57a95489a>

Please note that this link will expire in one week.

Regards,
Ryan



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