

From: [Trials](#)
To: [Stein, Alexander B.](#); [Trials](#)
Cc: [Tesla-Graphite243-IPR](#); [Jason Shapiro](#); [Michael Siem](#); [Cedric Tan](#); [Lynn Lehnert](#); [Nadiia Loizides](#); [DLF- Lit Paras](#); [Paul Margulies](#)
Subject: RE: IPR2024-00388: Authorization for Motion to Stay Reexam Control No. 90/019,303
Date: Monday, July 22, 2024 3:03:49 PM

Counsel,

From the Board –

Petitioner’s request for authorization to file a motion for a stay of the reexamination is premature, and is denied without prejudice. The Board has not decided, yet, whether to institute an *inter partes* review. Cf. Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16657 (Apr. 22, 2019) (“The Board typically will consider motions to stay a concurrent Office proceeding (or may impose a stay sua sponte) any time after institution of an AIA trial proceeding . . .”). Petitioner may, if an *inter partes* review is instituted in IPR2024-00388, resubmit its request for authorization to file a motion for a stay of the reexamination.

Regards,

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

From: Stein, Alexander B. <alexander.stein@morganlewis.com>
Sent: Friday, July 19, 2024 5:08 PM
To: Trials <Trials@USPTO.GOV>
Cc: Tesla-Graphite243-IPR <Tesla-Graphite243-IPR@morganlewis.com>; Jason Shapiro <jshapiro@devlinlawfirm.com>; Michael Siem <msiem@devlinlawfirm.com>; Cedric Tan <ctan@devlinlawfirm.com>; Lynn Lehnert <llehnt@devlinlawfirm.com>; Nadiia Loizides <nloizides@devlinlawfirm.com>; DLF- Lit Paras <dlflitparas@devlinlawfirm.com>; Paul Margulies <pmargulies@tesla.com>
Subject: RE: IPR2024-00388: Authorization for Motion to Stay Reexam Control No. 90/019,303

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Resending the message below to add Jason Shapiro (jshapiro@devlinlawfirm.com) to this thread.

Respectfully,

Alex Stein (Reg. No. 71,397)
Counsel for Petitioner

From: Stein, Alexander B.

Sent: Friday, July 19, 2024 1:19 PM

To: 'trials@uspto.gov' <trials@uspto.gov>

Cc: Tesla-Graphite243-IPR <Tesla-Graphite243-IPR@morganlewis.com>; Michael Siem <msiem@devlinlawfirm.com>; Cedric Tan <ctan@devlinlawfirm.com>; Lynn Lehnert <[llehnert@devlinlawfirm.com](mailto:llehner@devlinlawfirm.com)>; Nadiia Loizides <nloizides@devlinlawfirm.com>; DLF- Lit Paras <dlflitparas@devlinlawfirm.com>; 'Paul Margulies' <pmargulies@tesla.com>

Subject: IPR2024-00388: Authorization for Motion to Stay Reexam Control No. 90/019,303

Your Honors,

On behalf of the petitioner in IPR2024-00388, I am writing to respectfully request authorization to file a motion to stay reexamination control no. 90/019,303 during pendency of IPR2024-00388 (the same patent is involved in both proceedings). *See, e.g.*, 37 C.F.R. § 42.122(a).

Patent Owner's counsel indicated that it opposes this request.

If a conference call is needed, the parties are available at the following dates and times:

1. Wednesday, July 24th between 2 PM – 5 PM EDT; and
2. Friday, July 26th between 10 AM – noon EDT; and
3. Monday, July 29th between 11 AM – 4 PM EDT.

Respectfully submitted,

Alex Stein (Reg. No. 71,397)

Counsel for Petitioner

Alexander B. Stein

Morgan, Lewis & Bockius LLP

1301 Second Avenue, Suite 3000 | Seattle, WA 98101

Direct: +1.206.274.6437 | Main: +1.206.274.6400 | Fax: +1.206.274.6401

Assistant: Ange Ambriz | +1.650.843.7868 | ange.ambriz@morganlewis.com

1400 Page Mill Road | Palo Alto, CA 94304-1124

Direct: | Main: +1.650.843.4000 | Fax: +1.650.843.4001

alexander.stein@morganlewis.com | www.morganlewis.com

