
From: Trials@uspto.gov
Sent: Tuesday, November 12, 2024 9:14 AM
To: Nicholas T. Matich; Iyer, Chid S.; Arvind Jairam; Emery, David P.; Saliba, Raja; Boland, Mark; Boeing_LST_MS; Callahan, John T.; Rachuba, L Roman
Cc: Trials@uspto.gov
Subject: RE: IPR2024-00761

Follow Up Flag: Follow up
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Counsel,

In response to the November 8, 2024 e-mails from Patent Owner's counsel and Petitioner's counsel, the Board authorizes Patent Owner to file a motion for authorization to apply for a subpoena under 35 U.S.C. § 24 to compel deposition testimony from Ms. LaTonya Morris.

In advance of filing the motion, counsel are to meet and confer with each other and with counsel for Ms. Morris regarding the parameters of the deposition and any accommodations desired by the witness. The motion shall indicate Petitioner's positions and any positions of counsel for the witness. Any agreements that are reached during the meet-and-confer process pertaining to Ms. Morris' deposition shall be memorialized in the motion and/or in exhibits accompanying the motion.

Going forward, the parties are requested to meet and confer on the content of any request for authorization or a conference call, in advance of submitting the request. Dueling e-mails are disfavored.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Nicholas T. Matich <nmatich@McKoolSmith.com>
Sent: Friday, November 8, 2024 11:01 AM
To: Iyer, Chid S. <ciyer@sughrue.com>; Trials <Trials@USPTO.GOV>
Cc: Arvind Jairam <ajairam@McKoolSmith.com>; Emery, David P. <demery@sughrue.com>; Saliba, Raja <rsaliba@sughrue.com>; Boland, Mark <mboland@sughrue.com>; Boeing_LST_MS <Boeing_LST_MS@mckoolsmith.com>; Callahan, John T. <Jcallahan@sughrue.com>; Rachuba, L Roman

<lrachuba@sughrue.com>

Subject: Re: IPR2024-00761

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Dear Board,

Patent Owner did not inform Petitioner that it would be sending the below email, which includes a number of misrepresentations.

Petitioner has been working with Ms. Morris' employer, Pro Quest, to make her available. Pro Quest recently said it does not object to Ms. Morris testifying, but requires a subpoena to make its employee available. (Pro Quest has said it may request accommodations for the convenience of the witness, e.g. remote deposition, but will not otherwise contest the subpoena). Petitioner also does not object to the subpoena.

If the Board is inclined to consider Patent Owner's request to strike Ms. Morris' declaration, Petitioner requests an opportunity to respond before the Board authorizes such a motion which would be inappropriate in these circumstances.

Sincerely,
Nick Matich
Counsel for Petitioner The Boeing Company

McKool Smith

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From: Iyer, Chid S. <ciyer@sughrue.com>
Sent: Friday, November 8, 2024 7:47:30 AM
To: Trials@uspto.gov <Trials@uspto.gov>
Cc: Nicholas T. Matich <nmatich@McKoolSmith.com>; Arvind Jairam <ajairam@McKoolSmith.com>; Emery, David P. <demery@sughrue.com>; Saliba, Raja <rsaliba@sughrue.com>; Boland, Mark <mboland@sughrue.com>; Boeing_LST_MS <Boeing_LST_MS@mckoolsmith.com>; Callahan, John T. <jcallahan@sughrue.com>; Rachuba, L Roman <lrachuba@sughrue.com>
Subject: IPR2024-00761

Dear Honorable Board,

Patent Owner respectfully requests authorization under 35 U.S.C. § 24 to subpoena the deposition of LaTonya Morris, author and declarant of Petitioner's Exhibit 1035, prepared for and relied upon in the Petition (Paper 1) for Petitioner's assertion that the Wang Dissertation qualifies as prior art. In its Institution Decision (Paper 8), the Board on several instances encouraged the Patent Owner to cross-examine Ms. Morris and develop the trial record further. For example, Paper 8, at 16 ("Patent Owner is also free to cross-examine Ms. Morris should it choose to do so.")

Patent Owner is entitled to cross-examination of Ms. Morris under 37 C.F.R. § 42.51(b)(1)(ii). The Patent Owners have been seeking a deposition date since October 7, 2024. Today, Petitioner notified us for the first time that they are refusing to make Ms. Morris voluntarily available for a deposition.

However, Petitioner has confirmed that they do not oppose this instant request to subpoena Ms. Morris.

Should the Board find additional information on the relevancy of Ms. Morris' testimony necessary or helpful, Patent Owner respectfully requests authorization to formally move to compel the testimony of Ms. Morris pursuant to 37 C.F.R. § 42.52(a).

As an alternative to the above, Patent Owner respectfully requests authorization to move to strike Patent Owner's Exhibit No. 1035 for being prejudicially deprived of routine discovery under 37 C.F.R. § 41.51(b)(ii). *1964 Ears, LLC. v. Jerry Harvey Audio Holdings, LLC.*, IPR2016-00494, Paper 40, 4 (PTAB Jan. 30, 2017) (Excluding declaratory exhibits after the producing party refused to make the declarant available for deposition). Patent Owners inquired whether Petitioner would oppose such alternative relief on November 7, 2024, but counsel for Petitioner has indicated that Petitioner would not provide an answer until next week.

Sincerely,

Chidambaram Iyer

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