
From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, January 7, 2025 8:46 AM
To: Casey L. Shomaker; Emery, David P.; Boeing_LST_MS; Saliba, Raja; Boland, Mark; Callahan, John T.; Rachuba, L Roman
Cc: Trials@uspto.gov
Subject: RE: IPR2024-00761

Counsel,

Petitioner is authorized to file an amended Declaration of Ms. LaTonya Morris. The amended Declaration shall be accompanied by a redline indicating the changes from the original Declaration. Both the original and amended versions of Ms. Morris' declaration shall remain in the record. Patent Owner is free to question Ms. Morris about either version of the declaration at the upcoming deposition. In light of this opportunity to explore the content in and circumstances of the amended declaration, Patent Owner's request for authorization to file a motion for additional discovery is denied.

Regards,

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

From: Casey L. Shomaker <cshomaker@McKoolSmith.com>
Sent: Thursday, January 2, 2025 6:16 PM
To: Trials <Trials@USPTO.GOV>
Cc: Emery, David P. <demery@sughrue.com>; Saliba, Raja <rsaliba@sughrue.com>; Boland, Mark <mboland@sughrue.com>; Callahan, John T. <Jcallahan@sughrue.com>; Rachuba, L Roman <lrachuba@sughrue.com>; Boeing_LST_MS <Boeing_LST_MS@mckoolsmith.com>
Subject: IPR2024-00761

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Dear Honorable Board,

Petitioner respectfully requests authorization under 37 C.F.R. §§ 42.5, 42.11 to file a Motion for Leave to Amend the Declaration of LaTonya Morris (EX 1035). Ms. Morris' attorney informed the parties that her declaration included an inadvertent error and served a revised declaration on December 18. Petitioner seeks leave so Ms. Morris's declaration may be formally admitted to the record in this matter.

Patent Owner does not oppose Petitioner's request. Further, Patent Owner will be deposing Ms. Morris later this month. Nevertheless, Patent Owner insisted on providing the argumentative statement below, misrepresenting the facts and indicating that it intends to seek further speculative discovery. Patent Owner's statement does not provide any basis for the discovery it says it plans to seek. *See Garmin Int'l, Inc. v. Cuozzo Speed Tech. L.L.C.*, IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013). The Board should disregard Patent Owner's statement. If Patent Owner does seek discovery, Petitioner requests the opportunity to provide its position on the merits of the request.

Patent Owner's Statement: Counsel for third party LaTonya Morris contacted Patent Owner on December 18, 2024 and provided a purported "corrected declaration of Ms. Morris" that materially changes the date of which Ex. 1017 (Wang), the primary basis for Petitioner's Grounds 1-3, was "loaded into" the ProQuest® Digital Dissertations and Theses database — from "2003-03-04" to "2010-09-06".

Patent Owner asked Petitioner about the circumstances surrounding the change, but Petitioner did not explain the reason. Patent Owner requested on December 19, 2024, "all communications between Ms. Morris (including her counsel) and Boeing (including its counsel) regarding the new declaration, including communications concerning the identification of the alleged "error" in the date of searchability, and the decision to draft a new declaration to correct the 'error,'" but Petitioner refused to provide this information.

At this juncture, assuming Petitioner intends to submit the new version of the Morris declaration shared with Patent Owner on December 18, 2024, Patent Owner does not oppose entry thereof into the record. However, absent further discovery, Patent Owner cannot agree that the original Morris declaration "included an inadvertent error," and requests authorization to move for additional discovery from Petitioner and Ms. Morris under 37 C.F.R. § 42.51(b)(2) on all communications between Ms. Morris (including her counsel) and Boeing (including its counsel) regarding the new declaration, including communications concerning the identification of the alleged "error" in the date of searchability, and the decision to draft a new declaration to correct the "error."

Additionally, regarding the deposition of Ms. Morris, Patent Owner is set to meet and confer with Ms. Morris' counsel on January 3, 2025 regarding the scope of Patent Owner's subpoena previously authorized by the Board. Patent Owner will notify the Board if there are any remaining issues that the relevant parties may have that require the Board's assistance in resolving.

We are available for a conference at the Board's convenience.

Sincerely,

	Casey L. Shomaker Associate Dallas, TX Tel: (214) 978-4218 www.mckoolsmith.com
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