

From: [Trials](#)
To: [Deborah Sterling](#); [David H. Holman](#); [Tyler Liu](#); [Gary J Speier](#); [Peter M Kohlhepp](#); [NLouwagie@carlsoncaspers.com](#)
Cc: [Trials](#)
Subject: RE: IPR2024-00834 - Seeking Authorization to Terminate Proceeding
Date: Monday, February 3, 2025 12:02:45 PM
Attachments: [image001.png](#)
[image002.png](#)

Counsel,

During the telephone conference on January 31, 2025, the parties indicated that they do not oppose entry of adverse judgment against Patent Owner in IPR2024-00834. Accordingly, and as the Board indicated during the call, the parties shall jointly submit a Motion to Terminate Proceeding and for Entry of Adverse Judgment, attaching as an exhibit the disclaimer of all claims at issue in IPR2024-00834.

The parties shall submit the motion no later than 7 days after the date of this email.

In addition, Petitioner filed, on January 30, 2025, a notice of intent to designate Mr. Kohlhepp as back-up counsel. In light of the joint motion that will be filed to terminate this proceeding, the Board asks Petitioner to indicate, within 2 business days, whether Petitioner still seeks pro hac vice admission of Mr. Kohlhepp.

Regards,

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

From: Deborah Sterling <DSTERLING@sternekessler.com>
Sent: Thursday, January 30, 2025 12:39 PM
To: Trials <Trials@USPTO.GOV>
Cc: David H. Holman <DHOLMAN@sternekessler.com>; Tyler Liu <TLIU@sternekessler.com>; Gary J Speier <GSpeier@carlsoncaspers.com>; Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>; NLouwagie@carlsoncaspers.com
Subject: IPR2024-00834 - Seeking Authorization to Terminate Proceeding

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responding, clicking on links, or opening attachments.

Dear Board:

Patent Owner disclaimed every claim in the proceeding on January 28, 2025 (see attached). As such, Patent Owner is seeking authorization to file a Motion to Terminate the Proceeding so that the Board can enter an Order of Adverse Judgment under 37. C.F.R. § 42.73.

The parties have met and conferred and Petitioner has indicated that it disagrees with Patent Owner's request and instead intends to seek authorization to file a Motion for Adverse Judgement. Patent Owner disagrees with Petitioner's request since Patent Owner's disclaimer is already construed as a request for Adverse Judgment.

Because the parties appear to be aligned with the intended outcome, but are not aligned on the means by which to efficiently achieve that outcome, we welcome the Board's insight on the path forward that best avoids filing unnecessary papers and/or unnecessary use of the Board's time.

If needed, the parties can be available for a conference call with the Board at the following times (EST):

Friday, January 31, at 10 – 11 am or noon – 2 pm;
Monday, February 3, at 3 – 5 pm; and
Tuesday, February 4, at 10 – 11:30 am or 12:30 – 2 pm.

Respectfully submitted,
Deborah Sterling
Counsel for Patent Owner



Deborah Sterling, Ph.D. (she/her)
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1101 K St. NW, Washington, DC 20005

Email: dsterling@sternekessler.com
Direct: 202.772.8501

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