

From: Sullivan, Denis J. <DSullivan@barclaydamon.com>

Sent: Wednesday, July 30, 2025 8:27 AM

To: Trials <Trials@USPTO.GOV>

Cc: Phil Caspers <PCaspers@carlsoncaspers.com>; PTAB AIA Conference Calls <PTABAIAConferenceCalls@uspto.gov>; Sam A Hamer <SHamer@carlsoncaspers.com>; Cory Bell - Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P. (cory.bell@finnegan.com) <cory.bell@finnegan.com>

Subject: RE: IPR2024-01218, 01227, -01228, -01382 - Regarding PO's Request for Leave to Withdraw Motions to Amend and Terminate Proceedings [IMAN-ACTIVE.FID3336386]

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Hello – Patent Owner writes with an update concerning the parties' discussions concerning the subject matter of the to-be-rescheduled conference call after yesterday's call was postponed due to technical difficulties.

In the four related IPR proceedings (IPR2024-01218, 01227, -01228, -01382), Patent Owner initially requested leave to (i) withdraw the pending non-contingent motions to amend and (ii) move to terminate the proceedings without entering adverse judgment under 37 C.F.R.

42.72. After a further meet and confer with Petitioner, Patent Owner now requests leave to (i) withdraw the pending non-contingent motions to amend (request unchanged) and (ii) move to terminate the proceedings with adverse judgment entered against the claims that were challenged in the petition. Petitioner does not oppose either request and asked that the following language be included in this email to the Board:

“As previously stated, Petitioner does not oppose Patent Owner's withdrawing its proposed amended claims. Because there would no longer be any claims at issue in the trial, Petitioner believes the Board must interpret Patent Owner's disclaimer and withdrawal actions as a request for adverse judgment under 37 CFR 42.73(b)(2). If Patent Owner revises its proposal to the Board to request that the result of Patent Owner's actions should be adverse judgments against all claims challenged in the petitions, then Petitioner would not oppose a motion to end these matters with such adverse judgments. No commentary on the proposed amended claims would be needed in the Board's adverse judgments. To make the record clear, there has been no settlement, nor does Petitioner agree that anything in the amended claims or the continuation applications or patents cited in your earlier email to the Board recite anything patentably distinct from the claims challenged in the petitions.”

Although Patent Owner is aware that substantive argument should not be included in these emails to the Board, given Petitioner's insistence on allegedly “mak[ing] the record clear” in its communications, Patent Owner wishes to similarly make its position clear that the limitations in the amended claims and the continuation applications and newly issued patents recite patentably distinct subject matter from the claims challenged in the petitions. Patent Owner respectfully

submits that this dispute does not impact its current unopposed requests to withdraw and terminate.

Thank you.

Denis Sullivan

Counsel for Patent Owner

From: Sam A Hamer <SHamer@carlsoncaspers.com>

Sent: Thursday, July 24, 2025 1:27 PM

To: Trials <trials@uspto.gov>

Cc: Phil Caspers <PCaspers@carlsoncaspers.com>; Cory Bell - Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P. (cory.bell@finnegan.com) <cory.bell@finnegan.com>; Sullivan, Denis J. <DSullivan@barclaydamon.com>

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Petitioner writes to make the record clear that Petitioner does not agree that there is anything in the proposed amendments (that Patent Owner now seeks to withdraw) or in the related continuation patents and applications referenced by Patent Owner's email that defines a patentable distinction over the claims Patent Owner has now disclaimed. Also, Petitioner opposes any termination other than by the Board entering adverse judgment under 37 C.F.R. 42.73(b)(2), because Patent Owner's actions would result in no remaining claims in the trials.

Petitioner is available at the times indicated by Patent Owner below for a telephone conference to address these issues.

Samuel A. Hamer

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From: Sullivan, Denis J. <DSullivan@barclaydamon.com>

Sent: Thursday, July 24, 2025 10:53 AM

To: Trials <trials@uspto.gov>

Cc: Phil Caspers <PCaspers@carlsoncaspers.com>; Sam A Hamer

<SHamer@carlsoncaspers.com>; Cory Bell - Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P. (cory.bell@finnegan.com) <cory.bell@finnegan.com>

Subject: IPR2024-01218, 01227, -01228, -01382 - PO Request for Leave to Withdraw Motions to Amend and Terminate Proceedings [IMAN-ACTIVE.FID3336386]

Patent Owner writes regarding four related IPR proceedings (IPR2024-01218, 01227, -01228, -01382) to request leave to (i) withdraw the pending non-contingent motions to amend and (ii) move to terminate the proceedings without entering adverse judgment under 37 C.F.R. 42.72.

In the non-contingent motions to amend filed May 21, 2025, Patent Owner proposed substitute claims and moved to cancel all challenged claims. Petitioner's oppositions to the motions to amend are due August 13, 2025.

As indicated in its updated mandatory notices filed earlier this week, Patent Owner recently filed statutory disclaimers disclaiming all challenged claims in each of the four proceedings. The updated mandatory notices also report that two new patents in the same patent family have issued since the motions to amend were filed, and a second patent infringement lawsuit has been filed against Petitioner based on those two new patents. The claims of these new patents issued over the same prior art involved in these proceedings and include claim elements added in the substitute claims in the motions to amend. Furthermore, Patent Owner filed a continuation application in the patent family that also includes claim elements added in the substitute claims in the motions to amend. In light of these developments and in the interest of judicial and economic efficiency, Patent Owner requests leave to withdraw the pending motions to amend and terminate each of the four proceedings without entering adverse judgment.

Petitioner does not oppose the request for withdrawal of the motions to amend. Petitioner opposes any termination unless that termination includes the Board entering adverse judgment under 37 C.F.R. 42.73(b)(2).

Should the Board wish to have a conference call, the parties provide their availability over the next week below (all times are ET):

7/25 (FRI) 10:00 AM to 1:00; 2:00 PM to 4:00 PM

7/28 (MON) 10:00 AM to 12:30 PM; 2:00 PM to 5:00 PM
7/29 (TUES) 10:00 AM to 1:00 PM; 2:00 PM to 5:00 PM
7/30 (WED) 10:00 AM to 1:00 PM; 2:00 PM to 5:00 PM
7/31 (THUR) 10:00 AM to 1:00 PM; 2:00 PM to 5:00 PM
8/1 (FRI) 10:00 AM to 1:00 PM; 2:00 PM to 4:00 PM

Thank you.

Denis Sullivan
Counsel for Patent Owner

Denis J. Sullivan

Pronouns: he/him/his

Partner

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