

From: [Nall, Jennifer](#)
To: [Trials](#); jfitzsimmons-PTAB@sternekessler.com; rbemben-PTAB@sternekessler.com; spappas-PTAB@sternekessler.com; [Robert Mattson](#); [Sal Lim](#); [David Alberti](#)
Cc: [Jason Fitzsimmons](#); [DLA-HD-RW](#); [Ishmael, Safraz](#); [Mueller, Benjamin](#); [Wolfe, Joseph](#); [Heintz, James M.](#); [Steve Pappas](#); [Richard M. Bemben](#); [PTAB Account](#); [KramerAlberti-RavenWhite](#)
Subject: RE: IPR2024-01316, -01420 | Opposed Request for Authorization To File A Motion To Strike
Date: Thursday, December 12, 2024 10:19:05 AM
Attachments: [image002.png](#)
[image003.png](#)

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Dear Honorable Board,

Counsel for the parties jointly write to inform the Board that the respective appearance of patent owners in these actions renders moot Home Depot's planned motion to strike. As such, no motion to strike will be filed tomorrow in these actions.

Best regards,
Jennifer

Jennifer Librach Nall

Partner

T +1 512 457 7249
F +1 512 721 2249
jennifer.nall@us.dlapiper.com

DLA Piper LLP (US)
303 Colorado Street
Suite 3000
Austin, TX 78701-4653



dlapiper.com

From: Nall, Jennifer <Jennifer.Nall@us.dlapiper.com>
Sent: Thursday, November 21, 2024 6:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jason Fitzsimmons <jfitzsimmons@sternekessler.com>; DLA-HD-RW <DLA-HD-RW@us.dlapiper.com>; Ishmael, Safraz <Safraz.Ishmael@us.dlapiper.com>; Mueller, Benjamin <Benjamin.Mueller@us.dlapiper.com>; Wolfe, Joseph <Joseph.Wolfe@us.dlapiper.com>; Heintz, James M. <Jim.Heintz@us.dlapiper.com>; Steve Pappas <SPAPPAS@sternekessler.com>; Richard M. Bemben <rbemben@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; David Alberti <dalberti@krameralberti.com>; Sal Lim <slim@krameralberti.com>; KramerAlberti-RavenWhite <KramerAlberti-RavenWhite@krameralberti.com>
Subject: IPR2024-01316, -01420 | Opposed Request for Authorization To File A Motion To Strike

Dear Honorable Board,

Petitioner requests authorization to file a motion to strike the mandatory notices filed by RavenWhite Licensing LLC, a purported exclusive licensee of the challenged patents, and to preclude RavenWhite Licensing LLC from representing Patent Owner in these IPRs. It is Petitioner's position based on information supplied during the parties' meet and confer that RavenWhite Licensing LLC is not an exclusive licensee with all substantial rights to either of the patents at issue in the above-referenced IPRs, and that there is no regulatory support that allows a purported exclusive licensee of the challenged patents to file mandatory notices. Instead, Patent Owner is required to file mandatory notices. See 37 CFR 42.8; 37 CFR 42.9.

RavenWhite Licensing LLC represents that it is the exclusive licensee of U.S. Patent Nos. 10,594,823 and 11,562,402, and per agreement has been granted the right to defend the validity of these patents. The Board has routinely treated an exclusive licensee with rights to defend the validity of a patent as the patent owner. See, e.g., IPR2016-00681, Paper 29 at 2-3 n.2 (P.T.A.B. Aug. 30, 2017); see also IPR2016-00928, Paper 45 at 1 (P.T.A.B. Jul. 10, 2017). To the extent required, RavenWhite Licensing LLC requests that the Board waive the rule under 37 CFR 42.8 stating that the "patent owner" file mandatory notices.

Counsel for the parties are available for a conference call should the Board so desire on the following dates and times (Eastern):

- 11/22/24: 11am-12:30pm and 4-5pm
- 12/2/24: 12pm-2pm and 2:30pm-4pm
- 12/3/24: 10am-12pm and 12:30pm-2pm
- 12/6/24: 2-3pm or 4-5pm

Best regards,
Jennifer

Jennifer Librach Nall

Partner

T +1 512 457 7249
F +1 512 721 2249
jennifer.nall@us.dlapiper.com

DLA Piper LLP (US)
303 Colorado Street
Suite 3000
Austin, TX 78701-4653



dlapiper.com

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