From:	Trials
To:	Nguyen, Jean; WalkMe KK; Arjomand, Mehran; Yap, Alex S.; Charles R. Macedo; Thomas Hart; Gary J. Gershik; WalkMe; Whatfix-Walkme-IPR; Kim Kennedy; George Stamatopoulos
Cc:	Trials
Subject:	RE: IPR2023-01368, IPR2023-0179, IPR2024-00065: Expungement of Exhibits 2014-2018
Date:	Friday, December 6, 2024 1:26:59 PM
Attachments:	image001.png

Counsel,

The Board would like the parties to briefly address this request at the hearing on December 18, 2024.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Nguyen, Jean <JNguyen@mofo.com>
Sent: Tuesday, December 3, 2024 1:30 AM
To: Trials <Trials@USPTO.GOV>
Cc: Arjomand, Mehran <MArjomand@mofo.com>; Yap, Alex S. <AYap@mofo.com>; Charles R. Macedo <cmacedo@ARELAW.com>; Thomas Hart <thart@ARELAW.com>; Gary J. Gershik <ggershik@ARELAW.com>; WalkMe <WalkMe@ARELAW.com>; Whatfix-Walkme-IPR <Whatfix-Walkme-IPR@mofo.com>; Kim Kennedy <kim.kennedy@kobrekim.com>; George Stamatopoulos <george.stamatopoulos@kobrekim.com>; WalkMe KK <walkmekk@kobrekim.com>
Subject: IPR2023-01368, IPR2023-0179, IPR2024-00065: Expungement of Exhibits 2014-2018

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Dear Honorable Board,

Petitioner's counsel requests that Exhibit 2014 (Patent Owner's supplemental expert declaration) and accompanying Exhibits 2015-2018 be expunged from the record. Patent Owner responded to Petitioner's Objections to Evidence (IPR2023-01368, Paper 20; IPR2023-0179, Paper 18; IPR2024-00065, Paper 16) by filing Exhibits 2014-2018. Pursuant to 37 C.F.R. § 42.64(b)(2), a party may respond to an objection of evidence by serving (not filing) supplemental evidence. Neither party has filed a Motion to Exclude to allow for the introduction of the Exhibits into the record. Thus, Patent Owner's filing of Exhibits 2014-2018 was improper.

Petitioner's counsel has conferred with Patent Owner's counsel (copied on this email). The parties

reached an agreement to expunge Exhibit 2018, but did not reach an agreement regarding expunging Exhibits 2014-2017. Patent Owner does not agree to expunge Exhibits 2014-2017 because Petitioner's expert, Dr. Beigi, expressly relied upon these exhibits in his Reply Declarations in each of the respective IPRs. Petitioner does not agree with Patent Owner's objections because the alleged reliance was necessary in order to rebut the arguments made in the improperly introduced Exhibits 2014-2017 (which Patent Owner would have otherwise deemed as undisputed issues).

If the Board would like a conference call to discuss this request, the parties are available on Wednesday, Dec. 4 from 2 – 4 pm EST, or Friday, Dec. 6 from 12 – 2 pm EST.

Best,
Jean Nguyen

Counsel for Petitioner, Whatfix Inc.

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