

From: [Trials](#)
To: [Rich Wojcio](#); [Trials](#)
Cc: [Jon Suder](#); [Glenn Orman](#); [Cindy Dunn](#); [Dawn Hansen Putnam](#); [Johnson, Matthew W.](#); [Ritchie, Thomas W.](#); [Hendershot, Michael C.](#)
Subject: RE: IPR2025-00125 - Request to Supplement Record
Date: Monday, April 7, 2025 3:06:22 PM

Counsel,

The panel thanks counsel for a productive conference call today. Pursuant to the agreement reached during the call, Patent Owner shall enter an updated mandatory notice pursuant to 37 CFR 42.8(b)(2) briefly reflecting the outcome of the decision in related case IPR2024-01416.

Regards,

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

From: Rich Wojcio <wojcio@fsclaw.com>
Sent: Wednesday, April 2, 2025 1:52 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jon Suder <jts@fsclaw.com>; Glenn Orman <orman@fsclaw.com>; Cindy Dunn <dunn@fsclaw.com>; Dawn Hansen Putnam <putnam@fsclaw.com>; Johnson, Matthew W. <mwjohnson@jonesday.com>; Ritchie, Thomas W. <twritchie@jonesday.com>; Hendershot, Michael C. <mhendershot@jonesday.com>
Subject: RE: IPR2025-00125 - Request to Supplement Record

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Mr. Kellogg-

The parties have conferred regarding the Board's request. Counsel for Patent Owner and Petitioner are available at the Board's convenience anytime during the afternoon hours on Monday, April 7th. Alternatively, counsel for Patent Owner and Petitioner are also available at the Board's convenience throughout the morning hours on the following day, Tuesday, April 8th. Please let us know if either day is acceptable, and the specific time preferred by the Board for conference.

Thank you,
Richard A. Wojcio, Jr.
Attorney at Law

F | S | C

FRIEDMAN SUDER & COOKE

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From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, April 1, 2025 1:56 PM

To: Rich Wojcio <wojcio@fsclaw.com>; Trials <Trials@USPTO.GOV>

Cc: Jon Suder <jts@fsclaw.com>; Glenn Orman <orman@fsclaw.com>; Cindy Dunn <dunn@fsclaw.com>; Dawn Hansen Putnam <putnam@fsclaw.com>; Johnson, Matthew W. <mwjohanson@jonesday.com>; Ritchie, Thomas W. <twritchie@jonesday.com>; Hendershot, Michael C. <mhendershot@jonesday.com>

Subject: RE: IPR2025-00125 - Request to Supplement Record

Counsel,

The panel requests that the parties confer and propose times for a conference call with the Board before April 11th to address Petitioner's reasoning for requesting supplementation.

Regards,

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

From: Rich Wojcio <wojcio@fsclaw.com>

Sent: Friday, March 28, 2025 1:05 PM

To: Trials <Trials@USPTO.GOV>

Cc: Jon Suder <jts@fsclaw.com>; Glenn Orman <orman@fsclaw.com>; Cindy Dunn <dunn@fsclaw.com>; Dawn Hansen Putnam <putnam@fsclaw.com>; Johnson, Matthew W. <mwjohanson@jonesday.com>; Ritchie, Thomas W. <twritchie@jonesday.com>; Hendershot, Michael C. <mhendershott@jonesday.com>

Subject: IPR2025-00125 - Request to Supplement Record

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Dear Honorable Board,

Patent Owner respectfully requests authorization to supplement the record in this proceeding via submission of the Decision Denying Institution of *Inter Partes* Review (Paper 11) entered in IPR2024-01416 on March 25, 2025, as Exhibit 2012 in this proceeding. A copy of the Order is attached. IPR2024-01416 challenged the validity of the same patent and claims at issue in this proceeding and is identified in the Petition as a Related Matter pursuant to 37 C.F.R. §42.8(b)(2). Pet. (Paper 2) at 82. Patent Owner contends that the Board's decision to deny institution in this related proceeding is relevant to its consideration of the Petition in this proceeding.

Patent Owner has conferred with Petitioners regarding this request. Petitioners oppose and contend: "the decision denying institution of IPR2024-01416 is not relevant to the instant IPR. In the -01416 decision, the Board exercised its discretion under section 325(d) because the challenges relied on two prior art references (Dummies and Traub) that had been previously presented to the Office. In contrast, section 325(d) favors institution of Petitioners' IPR because the Office never considered the patentability of the Challenged Claims over any of the grounds here, or art substantially similar thereto. IPR2025-00125, Petition at 79-81. For example, Petitioners' challenges relied on Kuhno (Ground 1) and Tilson (Ground 2), which have never been before the Office, for the prior art disclosure of the "limited number of most significant bits" limitations (e.g., elements 1E, 1F) that Patent Owner contends were not known in the prior art."

If the Board wishes to have a conference call regarding this request, the parties can confer and propose times of mutual availability.

Sincerely,
Richard A. Wojcio, Jr.
Attorney at Law

F | S | C

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