

Simran Parmar

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>
Sent: Wednesday, April 16, 2025 4:24 PM
To: Kristina Caggiano Kelly; Jason Eisenberg; Donald McPhail
Cc: Chase Hammond; PTAB Account; Maxwell Furigay; Simran Parmar
Subject: RE: IPR2025-00439 ('394 Patent) - Potential Motion to Strike

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Kristina

Petitioner disagrees with Patent Owner's characterization of the Ernst Declaration and with Patent Owner's characterization that Petitioner failed to comply with the Board's instructions. Accordingly, Petitioner opposes the email to the Board, opposes Patent Owner's request for authorization to file the motion to strike and as a result any of Patent Owner's requests related thereto.

Regards, Dan

Daniel J. Pereira, Ph.D.

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Operating as Merchant & Gould, LLP, in California.

Please consider the environment before printing this email. Thank you.

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>

Sent: Tuesday, April 15, 2025 6:39 PM

To: Kristina Caggiano Kelly <kckelly@sternekessler.com>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>

Cc: Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>

Subject: Re: IPR2025-00439 ('394 Patent) - Potential Motion to Strike

Kristina

We will respond in substance tomorrow.

Regards, Dan

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From: Kristina Caggiano Kelly <kckelly@sternekessler.com>
Sent: Tuesday, April 15, 2025 1:51:12 PM
To: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>
Cc: Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>
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Counsel,

Further to our teleconference last week, we identify the following paragraphs as containing improper substantive changes: ¶¶ 36, 46, 53, 55, 57, 59 (partial), 64, 66, 67, 88, 91, 111, 117, 138, 163, 167, 193, 225 (chart). Each of these paragraphs corresponds to one of the substantive categories that we discussed during our call. For many of them, there may only be part of the paragraph that is substantively changed, but except where otherwise noted, we intend to move that the entire paragraph be stricken and that Petitioner be directed to submit a replacement declaration with these paragraphs redacted.

We will move, in the alternative, that the PTAB simply strike the changes made in these paragraphs, and direct Petitioner to refile the declaration with the paragraphs as they were originally presented. If Petitioner is willing to agree to this relief, then we may be able to file a joint motion for leave to allow Petitioner to do so.

Please let us know your position as we intend to email the Board about this issue tomorrow.

Kristina Caggiano Kelly
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: kckelly@sternekessler.com
Direct: 202.772.8524

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>
Sent: Thursday, April 10, 2025 9:16 PM
To: Kristina Caggiano Kelly <kckelly@sternekessler.com>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>
Cc: Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>
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Confirming 2 works for us. I will send a Teams invite tomorrow morning. We don't have a comparison document to share at this time.

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From: Kristina Caggiano Kelly <kckelly@sternekessler.com>

Sent: Thursday, April 10, 2025 1:24 PM

To: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>

Cc: Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>

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Thank you, 2 PM tomorrow works for our side. Please send an invite. We also think it would be productive for petitioner to send the requested comparison document with enough advanced notice that we can review it before the call, to be sure that we are all starting the discussion from a common nucleus of operative facts.

Kristina Caggiano Kelly

Director

Sterne, Kessler, Goldstein & Fox P.L.L.C.

Email: kckelly@sternekessler.com

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From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>

Sent: Thursday, April 10, 2025 12:59 PM

To: Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>

Cc: Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>

Subject: RE: IPR2025-00439 ('394 Patent) - Potential Motion to Strike

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Jason

We can be available tomorrow after 11 (EST).

Regards, Dan

From: Jason Eisenberg <jasone@sternekessler.com>

Sent: Thursday, April 10, 2025 11:53 AM

To: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Donald McPhail <dmcphail@merchantgould.com>

Cc: Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>

Subject: IPR2025-00439 ('394 Patent) - Potential Motion to Strike

CAUTION - External.

Counsel,

Patent Owner intends to email the Board requesting authorization to file a Motion to Strike portions of Dr. Ernst's Declaration as going beyond the instructions and authorization of the Board. Namely, the Board specified "We understand this to mean that the replacement declaration will be substantively identical to that in the originally filed Goel Declaration." EX3001, 3. In your response email to the Board, you agreed to abide by the Board's instructions. EX3001, 1. Petitioner failed to comply with these instructions.

Patent Owner ran a PDF comparison between the Dr. Goel and Dr. Ernst declarations that appears to show several substantive differences. We suggest Petitioner provide Patent Owner its own comparison document to ensure accuracy.

As one example, we have identified that the POSITA definition was substantively changed, which changes the lens through which the entire Petition and Declaration are analyzed. *Compare* replacement EX1003, ¶ 36: "A POSITA would have comprehensive knowledge and deep understanding of the materials science aspects and the underlying physical, chemical, and mathematical concepts of the science of glasses, as relevant to the '394 patent" to original EX1003, ¶ 36: "A POSITA would have had knowledge of and experience with the concepts of glass science relevant to [sic] '394 patent."

Claim construction, anticipation, and obviousness are based on the definition of a POSITA under *Phillips and Graham*. See, e.g., *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000) ("The determination of the level of ordinary skill in the art is an integral part of the Graham analysis."); *Custom Accessories Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986) ("Without [a determination of the level of ordinary skill in the art], a district court cannot properly assess obviousness because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art."). As the new declaration's change in the POSITA definition is necessarily a substantive change for claim construction, anticipation and obviousness, these changes also result in Petitioner's legal theories being necessarily beyond what the Board had permitted. See, e.g., Pet. at 14 ("As such, this Petition and Dr. Goel's declaration construe claim terms consistent with the understanding a POSITA would have in view of the '394 Patent's intrinsic evidence and, where appropriate, extrinsic evidence."); 15-16 (Dr. Goel's definition of POSITA is now inconsistent with Dr. Ernst), 21 (relying on Dr. Goel's POSITA definition for obviousness and not Dr. Ernst's changes the analysis).

The POSITA and other unauthorized changes prejudice Patent Owner given the Notice of Filing date which starts the discretionary denial and POPR clock was given for the original papers, and not these new arguments. Patent Owner requests a meet and confer with Petitioner so that Petitioner can provide a detailed explanation for how each of the additional changes to the declaration do not violate the Board's instructions. Please provide your availability.

Thank you.

Best regards

Jason



Jason Eisenberg (He/Him/His)

Director

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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