Christopher, Angelo

From: Christopher, Angelo
Sent: Monday, June 30, 2025 5:55 PM
To: 'Daniel Zhang'; Sportel, Nathan P.
Cc: Uhlenhake, Peter; Portinga, D. Andrew; Carlton, Jacob L.; Burnham, Daniel; Relatores, Jacqueline; Michael Azzi; Alex Bennett; Keener, Jason J.
Subject: RE: 1:24-cv-00954-RJJ-MV - Solmetex, LLC v. Ascentcare Dental Products, Inc. - Third Party Subpoenas [IMAN-MJ_DMS.FID3679061]

Daniel,

Regarding the stay issue, to clarify, I asked whether Ascentcare would consider offering a stipulation limiting the scope of its invalidity contentions in district court in exchange for an agreement on the stay as an option we could consider with our client, but we understand Ascentcare intends to litigate the same invalidity issues in both forums. We should have our final position for you by tomorrow.

Regarding the doctrine of equivalents ("DoE") issue, none of the cases you identified support Ascentcare's argument that Solmetex's initial contentions are deficient. If Ascentcare wanted the N.D. Ill. local patent rules to govern, it should have proposed that in the Joint Status Report. As set forth in its claim charts, Solmetex contends that each limitation in the asserted claims is literally met by the Accused Products. Based on the currently available information, Solmetex included specific DoE contentions for certain limitations as an alternative argument to the extent a fact finder were to determine there is no literal infringement of those limitations. The contentions provide sufficient notice of Solmetex's theories based on the limited discovery to date.

We are willing to supplement after Ascentcare provides non-infringement contentions and after claim construction, both of which will inform the DoE issues. For example, if Ascentcare does not dispute literal infringement for a given limitation, there is no reason to invoke the DoE and any dispute regarding the sufficiency of the contentions would be moot.

Best regards,

- Angelo

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From: Daniel Zhang <dzhang@irwinip.com>
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Subject: Re: 1:24-cv-00954-RJJ-MV - Solmetex, LLC v. Ascentcare Dental Products, Inc. - Third Party Subpoenas [IMAN-MJ_DMS.FID3679061]

Angelo,

Thanks for taking the time meet and confer with Nathan and me today at 2:00 p.m. Central / 3:00 p.m. Eastern.

As a brief summary, we discussed as follows:

We are going to provide you with redacted infringement contentions for your client shortly.

Regarding the July 25th extension regarding the inventor subpoenas, you indicated that to the extent there is a production, you would endeavor to produce on the 25th. However, you indicated that it may be a rolling production given travel, searching, etc.

Regarding the motion to stay, you indicated that it's safe to assume that you would oppose, but you would consider not opposing the motion to stay to the extent that we would offer something like a *Sotera* stipulation. We indicated that was not likely. Notwithstanding, you said you would have a final position to us likely tomorrow. Given that, you indicated that you'd request an extension so that you could review our invalidity contentions on the opposition if we filed this week, but were unlikely to need an extension should we file next week.

Regarding your contentions on DOE, you indicated that you were not going to supplement at this time given discovery and without seeing our noninfringement contentions. You indicated that you would likely supplement at a later stage in the litigation. We noted that you have the burden to demonstrate infringement, including any DOE arguments to at least identify the function, way, and results of any claim limitation, and that you have the products and the claims to determine, yourself, whether any limitations are missing to the extent you would need to rely on a DOE claim. We also note that our position would be consistent with your own representations, regarding invalidity, to the court that "we think it's only right that we should know what their position is in regard to our invalidity contentions and why they think that their claims remain valid in view of that prior art and those prior art combinations" given that "they have to meet their burden by clear and convincing" evidence. Notwithstanding, you indicated that we can rely on your assertions of DOE in the claim charts and not the boilerplate DOE language above each claim chart asserting DOE on every single claim limitation. Accordingly, it seems that we are at an impasse, and you do not intend to supplement your infringement contentions for DOE analysis.

Let me know if I've missed anything.

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