

From: Brett Schatz <bschatz@whe-law.com>

Sent: Tuesday, December 23, 2025 11:37 AM

To: Baker, W. Todd <todd.baker@kirkland.com>; Trials <Trials@USPTO.GOV>

Cc: Lou H. Sitler <lsitler@whe-law.com>; #BWHITTLE_PGR_KE
<BWHITTLE_PGR_KE@kirkland.com>

Subject: RE: MCC v. Brook + Whittle Ltd., PGR2025-00025 -- Patent Owner's Motion to Compel

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Dear Board,

As noted below, Petitioner's Response to Patent Owner's Motion to Compel was unintentionally a few pages longer than allowed by 37 C.F.R. § 42.24(b)(3). The page length of Petitioner's Response was an oversight. Petitioner respectfully requests leave to file an Amended Response, which would be limited to 15 pages and would only delete information from the original Response. No new arguments would be presented.

Respectfully submitted,

Brett Schatz

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From: Baker, W. Todd <todd.baker@kirkland.com>

Sent: Monday, December 22, 2025 12:20 PM

To: trials@uspto.gov

Cc: Brett Schatz <bschatz@whe-law.com>; Lou H. Sitler <lsitler@whe-law.com>;

#BWHITTLE_PGR_KE <BWHITTLE_PGR_KE@kirkland.com>

Subject: MCC v. Brook + Whittle Ltd., PGR2025-00025 -- Patent Owner's Motion to Compel

Dear Board,

Patent Owner respectfully requests leave to file a reply to Petitioner's opposition to Patent Owner's motion to compel. Patent Owner believes a reply is necessary to address several points raised in the opposition and to clarify the scope and basis of the discovery requests at issue.

In the proposed reply, Patent Owner intends to:

- **Clarify the Nature of the Discovery Requests:** Emphasize that the primary discovery requests are for routine discovery under 37 C.F.R. § 42.51(b)(1), and that the "good cause" standard for additional discovery does not apply to these requests.
- **Address the Good Cause Standard (if Applicable):** To the extent any request is considered additional discovery, explain that the motion addresses the good cause standard by detailing the relevance and necessity of the requested information.
- **Respond to Work Product Assertions:** Address Petitioner's assertion that all communications between counsel and Dr. Deible are protected by attorney work product,

and clarify that facts, data, and assumptions provided to and considered by an expert are not protected and must be disclosed, even if transmitted through counsel.

- **Clarify Scope of Routine Discovery:** Reiterate that the scope of routine discovery under § 42.51(b)(1) includes communications conveying facts, data, or assumptions considered by an expert, regardless of the form of the communication.
- **Clarify Silver Ink Testing Requests:** Clarify that the request for silver ink testing is not limited to testing conducted in preparation of the Petition, but includes any relevant testing performed by or for Petitioner that is inconsistent with its positions, and is within the scope of routine discovery.
- **Address Reference to § 42.51(b)(2):** Clarify that referencing § 42.51(b)(2) in the motion does not concede that all requests are for additional discovery or that the good cause standard is required for the primary categories of information sought.
- **Request to Strike Excess Pages:** Request that pages 16-18 of the opposition be stricken for exceeding the 15-page limit prescribed by 37 C.F.R. § 42.24(b)(3).

Patent Owner respectfully submits that a reply will assist the Board in resolving the issues presented by ensuring the record is clear and complete. Patent Owner therefore request leave to file a reply addressing the above points. Pursuant to Rule 42.24(c)(2) Patent Owner requests a 5-page reply.

Petitioner's responsive positions are provided in the attached email and repeated next:

1. As the moving party, Patent Owner was obligated to include in its Motion all grounds for the relief it seeks. Any clarification should have been included in the Motion.
2. Once again, as the moving party, Patent Owner should have addressed the good cause standard in its Motion. Patent Owner was fully aware that the requested discovery is additional discovery, including because the issue of privilege was discussed with the Board.
3. Once again, as the moving party, Patent Owner should have addressed the fact that the communications sought are work product, in its Motion. Patent Owner was fully aware that the requested discovery is additional discovery, including because the issue of privilege was discussed with the Board.

4. Any “reiteration” should have been included in the Motion and is also duplicative.
5. Petitioner fully addressed Patent Owner’s request regarding silver ink, and if Patent Owner seeks more than sought in the Motion, raising that in a reply is not proper.
6. As the moving party, Patent Owner was obligated to include all grounds for the relief it seeks in its Motion. Any clarification should have been included in the Motion.
7. The page length of Petitioner’s Response was an oversight. We will be requesting leave to submit an Amended Response, which would be limited to 15 pages and would only delete information from the original paper. No new arguments would be presented. Please advise if Patent Owner opposes by the close of business today.

Patent Owner opposes Petitioner’s request to file an Amended Response limited to 15 pages.

Respectfully submitted,

Todd Baker

Counsel for Patent Owner

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