Dukmen, Sarah

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, July 06, 2016 11:37 AM
To: Murphy, John; Trials
Cc: Steve (steve@kelberlawgroup.com); Nathan Cristler (ncristler@cristlerip.com); Kiblawi, Fadi N. (fkiblawi@sughrue.com); Mandir, William H. (wmandir@sughrue.com); Park, Peter S.; Goettle, Daniel; Dukmen, Sarah; MSFT-GT
Subject: RE: IPR2015-1023; IPR2015-1147; IPR2015-1148; IPR2015-1149; IPR2015-1150; IPR2015-1151; 2015-1928; 2016-0158

Counsel,

Petitioner's requests to file the corrected declarations, as described in the email dated Monday, July 4, 2016, are authorized. No phone call is necessary.

Thanks,
Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
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From: Murphy, John [mailto:JohnMurphy@bakerlaw.com]
Sent: Monday, July 04, 2016 9:51 PM
To: Trials <Trials@USPTO.GOV>
Cc: Steve (steve@kelberlawgroup.com) <steve@kelberlawgroup.com>; Nathan Cristler (ncristler@cristlerip.com) <ncristler@cristlerip.com>; Kiblawi, Fadi N. (fkiblawi@sughrue.com) <fkiblawi@sughrue.com>; Mandir, William H. (wmandir@sughrue.com) <wmandir@sughrue.com>; Park, Peter S. <pspark@sughrue.com>; Goettle, Daniel <DGoettle@bakerlaw.com>; Dukmen, Sarah <SDukmen@bakerlaw.com>; MSFT-GT <MSFT-GT@bakerlaw.com>
Subject: IPR2015-1023; IPR2015-1147; IPR2015-1148; IPR2015-1149; IPR2015-1150; IPR2015-1151; 2015-1928; 2016-0158

Re: IPR2015-1023; IPR2015-1147; IPR2015-1148; IPR2015-1149; IPR2015-1150; IPR2015-1151; 2015-1928; 2016-0158

Dear Judges Busch, Pettigrew, and Shaw,

Petitioner requests a teleconference to request permission to file 14 corrected expert declarations adding an inadvertently omitted penalty of perjury warning pursuant to 37 C.F.R. § 1.68. The declarations at issue are all by Petitioner's expert Dr. Horenstein, who at all times, in the 14 declarations and in 3 depositions, understood he was under oath subject to the penalties for perjury. The circumstances of Petitioner's request is best explained with reference to two groups of declarations:

Group 1: IPRs 2015-1023 (2 declarations), 2015-1928 (1 declaration), 2016-0158 (1 declaration), and the opening declarations for IPRs 2015-1147,48,49,50, and 51 (5 declarations).

Group 2: Reply declarations for IPRs 2015-1147,48,49,50, and 51 (5 declarations).

With respect to Group 1, Patent Owner never objected to any of these declarations, and never questioned the expert in depositions with regard to the inadvertently omitted warning. In connection with the 9 Group 1 declarations, Petitioner requests to file 9 corrected declarations that would be identical except that they would add the inadvertently omitted perjury warning.

With respect to Group 2, Patent Owner objected to 2 of the 5 declarations (1148 and 1149). This is how Petitioner became aware of the inadvertent omission. In response, Petitioner served two corrected declarations as supplemental evidence. Following that service, Patent Owner deposed Petitioner's expert and questioned the expert about the original and corrected declarations. During the deposition, Petitioner's expert testified that there was an unrelated typographical error in the Group 2 declarations—a transposition of a "520" for a "516." Petitioner seeks to file corrected versions of the 5 Group 2 declarations, but does not want to prejudice Patent Owner's ability to argue the significance of the 520-516 error, or prejudice Patent Owner's ability to refer to the uncorrected declarations that Petitioner's expert was questioned about. Petitioner thus requests that it be permitted to file corrected versions of the Group 2 declarations that would add (i) the perjury warning and (ii) a new paragraph reiterating the deposition testimony that the "520" is an error (without removing the error itself). Petitioner believes that this correction would allow the inadvertently omitted perjury warning to be added, and would preserve the original "520" error in the declaration, so that Patent Owner is free to refer to it in its arguments.

Patent Owner opposes Petitioner's requests with respect to both Group 1 and Group 2. Counsel for the parties have met and conferred but have been unable to resolve the dispute. Counsel for the parties are available at your convenience any time on Thursday, July 7 and Friday, July 8.

Best regards,
John Murphy
Counsel for Petitioner Microsoft

John Murphy
Partner

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