
From: Trials
Sent: Tuesday, December 1, 2020 4:37 PM
To: Jason Fitzsimmons
Cc: td-ptab@devlinlawfirm.com; Timothy Devlin; Robyn Williams; Michelle McClain; Feng Xu; Michael Specht; Daniel E. Yonan; Richard M. Bemben; Tyler Dutton; PTAB Account
Subject: RE: IPR2020-00446 (US 6,763,804) // Request for Board Call - Motion to Strike Motion to Amend

Counsel,

Although not a recommended practice, the panel does not view the failure to request a conference with the panel prior to filing the Motion to Amend (“MTA”) as sufficient to bar the right to file the MTA in this case. If the MTA is deficient in ways that could have been cleared up in such a conference, Patent Owner will not be in a position to claim lack of notice or awareness of our procedures and practices. Similarly, the panel does not view the failure to request a conference with the panel to notify us that it would not be filing a Response as warranting the requested Motion to Strike. Notably, by filing the MTA, Patent Owner has indicated that it does not intend to abandon the proceeding.

Accordingly, Petitioner’s request to file a Motion to Strike the Motion to Amend is denied.

Thank you,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Jason Fitzsimmons <JFITZSIMMONS@sternekessler.com>
Sent: Sunday, November 29, 2020 9:15 PM
To: Trials <Trials@USPTO.GOV>
Cc: td-ptab@devlinlawfirm.com; Timothy Devlin <tdevlin@devlinlawfirm.com>; Robyn Williams <rwilliams@devlinlawfirm.com>; Michelle McClain <mmclain@devlinlawfirm.com>; Feng Xu <fxu@devlinlawfirm.com>; Michael Specht <MSPECHT@sternekessler.com>; Daniel E. Yonan <DYONAN@sternekessler.com>; Richard M. Bemben <RBEMBEN@sternekessler.com>; Tyler Dutton <TDUTTON@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: IPR2020-00446 (US 6,763,804) // Request for Board Call - Motion to Strike Motion to Amend

RE: IPR2020-00446 (US 6,763,804)

Dear Board,

Petitioner Volkswagen Group of America, Inc. respectfully requests a Board call to seek authorization to file a Motion to Strike Patent Owner’s Motion to Amend (Paper 16). Patent Owner did not notify Petitioner or the Board that it would be filing a Motion to Amend, as required by 37 C.F.R. § 42.121(a). *See also* Scheduling Order, Paper 10 at 5 (“Patent Owner **must** confer with the Board before filing such a motion.”) Likewise, Patent Owner did not notify Petitioner or the Board that it would not be filing a Patent Owner Response, as required by the Board’s Scheduling Order. Paper 10 at 11 (“If

Patent Owner elects not to file a response, Patent Owner **must** arrange a conference call with the parties and the Board.”)

The parties have conferred and are available for a call at the times below (all Eastern). If these times are inconvenient for the Board, please let us know and we will submit additional times. We appreciate your consideration of this matter.

- Wednesday, December 2nd from 12:30-2:30pm
- Monday, December 7th from 1-4pm
- Tuesday, December 8th from 3-4pm

Best regards,
Jason Fitzsimmons
Counsel for Petitioner Volkswagen Group of America, Inc.



Jason A. Fitzsimmons
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