

**From:** [Fernandez, Ben](#)  
**To:** [Trials](#)  
**Subject:** Automatic reply: E2E access for Intel (joined party) in IPR2021-01064 and IPR2021-01229  
**Date:** Friday, August 5, 2022 2:33:59 PM

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**USPTO0001**

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**Cc:** [Trials](#)  
**Subject:** E2E access for Intel (joined party) in IPR2021-01064 and IPR2021-01229  
**Date:** Friday, August 5, 2022 2:33:00 PM

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Dear Counsel,

Please be advised that joined petitioner Intel Corporation's counsel of record is granted E2E access to this proceeding, as Intel Corporation has been properly joined to the proceeding.

Access to confidential information is governed by the Modified Default Protective Order Governing Confidential and Highly Confidential Information.

Regards,

Andrew Kellogg,  
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**USPTO0002**

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**Subject:** FW: IPR2021-01064 Service Copies and Failure of P-TACTS Filing Access  
**Date:** Thursday, October 27, 2022 8:24:58 PM  
**Attachments:** [IPR2021-01064 Petitioner \(Intel\) Opposition to Motion to Terminate.pdf](#)  
[IPR2021-01064 INTEL 1536 \(Intel\) Weatherwax E-mail August 24, 2022.pdf](#)

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Dear Honorable Board,

Please see the below correspondence confirming service of documents in this proceeding in view of an apparent lapse of Petitioner Intel's P-TACTS filing access in this proceeding. Intel will contact the PTAB P-TACTS administrative team during business hours tomorrow to attempt to resolve the issue with P-TACTS access. Thank you.

Respectfully Submitted,

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**Subject:** IPR2021-01064 Service Copies and Failure of P-TACTS Filing Access

Counsel,

Please find attached service copies of documents intended to be filed today in the above-referenced IPR proceeding:

- Petitioner Intel Corporation's Opposition to VLSI's Motion to Terminate Based on Res Judicata and Updated Table of Exhibits for Petitioner Intel Corporation in IPR2021-01064
- Exhibit 1536

Petitioner Intel attempted to file these documents today, but it appears that Petitioner Intel's P-TACTS

**USPTO0003**

filing access was disabled at some point during the day, for unknown reasons.

Per the procedure set forth at Question A6 of the [P-TACTS FAQs](#), Intel has attempted to call the Board to restore its access, but its filing access has not yet been restored. Intel will forward this email to the Board at [trials@uspto.gov](mailto:trials@uspto.gov) and [PTABP-TACTSAdmin@uspto.gov](mailto:PTABP-TACTSAdmin@uspto.gov) to notify the Board of timely service of these documents, and will plan to take any necessary steps for acceptance and/or filing of the documents once its filing access has been restored.

Regards,

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**USPTO0004**



**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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OPENSKY INDUSTRIES, LLC,  
INTEL CORPORATION<sup>1</sup>  
Petitioners,

v.

VLSI TECHNOLOGY LLC,  
Patent Owner.

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Case No. IPR2021-01064  
U.S. Patent No. 7,725,759

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**PETITIONER INTEL CORPORATION'S OPPOSITION TO  
PATENT OWNER'S MOTION TO TERMINATE  
BASED ON RES JUDICATA FROM THE FINAL DISTRICT COURT  
JUDGMENT IN *VLSI TECHNOLOGY LLC V. INTEL CORP.***

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<sup>1</sup> Intel Corporation, which filed a petition in IPR2022-00366, has been joined as a party to this proceeding.

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## **I. INTRODUCTION**

Faced with Board and Director decisions finding the challenged claims of U.S. Patent No. 7,725,759 (“759 patent”) reasonably likely to be unpatentable, VLSI has now hatched its latest attempt to distract from the strong merits of this IPR: a motion seeking to terminate Intel based on supposed claim preclusion or res judicata grounds. As a threshold matter, VLSI’s motion is untimely given that VLSI waited more than three months after it alleges this issue ripened to file its motion. Regardless, VLSI’s motion is without merit because, as a legal matter, claim preclusion is not applicable in an IPR based on an earlier district court judgment. Indeed, the patent system specifically contemplates “different tracks” in the Patent Office and in federal courts “for the review and adjudication of patent claims,” such that “[a] district court may find a patent claim to be valid, and the agency may later cancel that claim in its own review.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 282-283 (2016). The Board should deny VLSI’s motion and proceed to a final written decision regarding the unpatentability of the challenged claims.

## **II. STATEMENT OF MATERIAL FACTS (“SOMF”)**

Intel admits paragraphs 1, 3-5, and 7-10 in VLSI’s SOMF. Intel otherwise denies VLSI’s SOMF as inaccurate and/or incomplete and responds as follows.

### **A. The District Court Litigation**

1. In the Texas district court action, Intel argued at trial that asserted claims 14,



17, 18, and 24 of the '759 patent were invalid based on product prior art that it could not have raised in an IPR. Ex. 1027 at 5. The jury found that Intel failed to prove invalidity on that ground by clear and convincing evidence. *Id.*

2. On April 21, 2022, the district court entered final judgment stating that “[c]laims 14, 17, 18, and 24 of the '759 Patent are not invalid.” Ex. 1515 at 2.

3. On September 14, 2022, Intel filed its opening brief in its appeal from the district court judgment. Ex. 2125. Contrary to VLSI’s SOMF 11, Intel argues on appeal that the judgment should be reversed or, alternatively, vacated and remanded for *a new trial on* infringement, *invalidity*, and damages. *Id.* at 53-54, 72.

#### **B. The IPR Proceedings**

4. On December 23, 2021, the Board granted OpenSky’s IPR petition and instituted review for claims 1, 14, 17-18, 21-22, and 24 of the '759 patent. Paper 17.

5. On April 18, 2022, VLSI filed its Patent Owner Response in which it stated that claim preclusion should apply if Intel were joined to this IPR. Paper 40 at 3 n.2.

6. On June 8, 2022, the Board granted Intel’s joinder motion and instituted Intel’s IPR joinder petition. IPR2022-00366, Paper 14.

7. On August 24, 2022, VLSI requested leave to file this motion. Ex. 1536.

8. On August 30, 2022, the Board entered an order authorizing VLSI to file a motion seeking to terminate Intel based on res judicata. Paper 86.

9. On September 27, 2022, VLSI filed the present motion. Paper 99.

### **III. VLSI'S REQUEST TO TERMINATE INTEL IS UNTIMELY.**

VLSI first identified its claim preclusion argument in its April 18, 2022 Patent Owner Response. Paper 40 at 3 n.2. Yet VLSI did not seek leave to file the present motion until August 24, 2022—eleven weeks after Intel's joinder. Ex. 1536. VLSI then waited four more weeks after the Board authorized this motion before filing it. Papers 86, 99. Given that lengthy delay of fifteen weeks before filing, VLSI's motion to terminate Intel should be denied as untimely. *See* 37 C.F.R. § 42.25(b) (“A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.”); *T-Mobile US, Inc. v. Barkan Wireless Access Techs., L.P.*, IPR2017-01099, Paper 30 at 2-3 (PTAB June 8, 2018) (denying request to file motion where “Patent Owner did not indicate satisfactorily why it could not have identified the alleged issues and sought relief earlier”).

### **IV. VLSI'S REQUEST TO TERMINATE INTEL SHOULD BE DENIED BECAUSE CLAIM PRECLUSION DOES NOT APPLY HERE.**

VLSI's request to terminate Intel also should be denied on the merits for several reasons. First, the America Invents Act (“AIA”) contains no provision for applying claim preclusion to an IPR based on a district court judgment, and applying common-law claim preclusion principles would be contrary to Congress's intent as evidenced by the statutory scheme established for patents. Second, claim preclusion also cannot apply in the way that VLSI proposes because IPRs and district court

proceedings do not involve the same “claim.” And third, in light of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018), claim preclusion cannot apply where, as here, the IPR includes patent claims that were not part of the district court judgment.

**A. The AIA Makes Clear That Congress Did Not Intend For Common-Law Claim Preclusion To Apply To An IPR Proceeding Based On A District Court Judgment.**

Although there is a presumption that common-law preclusion principles apply to administrative actions under certain circumstances, adjudicative bodies “do not ...have free rein to impose rules of preclusion ... when the interpretation of a statute is at hand.” *Astoria Federal Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 108 (1991). Rather, the Supreme Court has explained that “the test for the presumption’s application” is “whether a common-law rule of preclusion would be consistent with Congress’ intent in enacting [the statute].” *Id.* at 110 (citation omitted). Here, application of common-law claim preclusion to an IPR based on a district court judgment would be inconsistent with Congress’s intent in enacting the IPR statute.

The AIA specifically identifies the circumstances under which IPRs should be barred by parallel district court cases, and common-law claim preclusion is not one of those circumstances. Under 35 U.S.C. § 315(a)(1), “[a]n [IPR] may not be instituted if, before the date on which the petition for such a review is filed, the petitioner ... filed a civil action challenging the validity of a claim of the patent.”

Likewise, under 35 U.S.C. § 315(b), “[a]n [IPR] may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner ... is served with a complaint alleging infringement of the patent.”<sup>2</sup>

The AIA also includes two statutory provisions that bar an IPR petitioner, following a final written decision, from asserting certain invalidity grounds in a district court, the ITC, or another Patent Office proceeding. Specifically, 35 U.S.C. § 315(e) estops a petitioner in an IPR of a claim “that results in a final written decision” from (1) “maintain[ing] a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that [IPR]” or (2) “assert[ing] either in a civil action ... or in a proceeding before the [ITC] ... that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that [IPR].” Congress did not, however, enact a parallel statutory provision barring a party from challenging a patent claim in an IPR following a district court judgment concerning that claim’s validity.

By contrast, Congress did codify a form of preclusion based on an earlier district court judgment in the *pre-AIA* patent statute. The statute governing inter partes reexamination—which IPRs replaced—specifically barred a party that lost on

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<sup>2</sup> Neither section applies here because VLSI sued Intel for infringement and Intel was joined to this IPR under 35 U.S.C. § 315(c). See 35 U.S.C. §§ 315(a)(3), 315(b).

invalidity in district court from challenging the same patent claims in reexamination. *See* 35 U.S.C. § 317(b) (pre-AIA) (“Once a final decision has been entered ... in a civil action ... that [a] party has not sustained its burden of proving ... invalidity ... then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues ... raised or [that] could have raised in such civil action[.]”); *Fairchild (Taiwan) Corp. v. Power Integrations, Inc.*, 854 F.3d 1364 (Fed. Cir. 2017) (applying § 317(b) estoppel).

That Congress chose not to include a similar provision for IPRs confirms its clear intent *not* to apply common-law claim preclusion to IPRs based on a district court judgment. *See Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 802-803 (Fed. Cir. 2018) (holding assignor estoppel does not apply in IPRs because, “even assuming that assignor estoppel could be considered such a well-established common law principle, ... ‘a statutory purpose to the contrary is evident’” (quoting *Astoria*, 501 U.S. at 108)); *Astoria*, 501 U.S. at 110-114 (holding Age Act implies Congress’s intent that “federal courts should recognize no [common-law] preclusion by state administrative findings with respect to age-discrimination claims”).

**B. Claim Preclusion Also Cannot Apply Because IPRs And District Court Proceedings Do Not Involve The Same “Claim.”**

Claim preclusion applies only where, among other requirements, “the prior litigation involved the *same* claim or cause of action as the later suit[.]” *Acumed*

*LLC v. Stryker Corp.*, 525 F.3d 1319, 1323 (Fed. Cir. 2008) (emphasis added).<sup>3</sup> IPR and district court proceedings, however, involve *different* claims or causes of action. Claim preclusion therefore cannot apply in an IPR based on a district court judgment.

More specifically, the Federal Circuit has explained that for preclusion purposes “[a]n assertion of invalidity ... by an alleged infringer”—even when asserted as a claim in a declaratory judgment action—“is not a ‘claim’ but a defense to the patent owner’s ‘claim.’” *Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 479 (Fed. Cir. 1991). In other words, in a preclusion analysis, the relevant “claim” from a district court action is infringement. *See id.* A “claim” asserted in a later proceeding can be the “same” only where it “rests on the same transactional facts” as the infringement claim in the first case, meaning that the accused “devices in the two suits [are] essentially the same.” *Id.* at 479-480. Here, infringement is not at issue in this IPR proceeding (nor could it be). Therefore, the IPR does not involve the same “claim” as the earlier district court action and claim preclusion cannot apply.

Moreover, even if invalidity could be considered a “claim” for preclusion purposes, “invalidity” in a district court action would still be a different claim from “unpatentability” in an IPR due to the different burdens of proof. District courts require accused infringers to prove invalidity by clear and convincing evidence,

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<sup>3</sup> VLSI’s motion does not mention this requirement. *See* Paper 99.



*Microsoft Corp. v. i4i Ltd. Partnership*, 564 U.S. 91, 95 (2011), whereas IPRs require petitioners to prove unpatentability under the lower preponderance of the evidence standard, 35 U.S.C. § 316(e). A district court judgment in favor of the patent owner therefore means only that the accused infringer failed to prove invalidity by clear and convincing evidence; it does not mean the challenged claims would not be unpatentable under a lesser burden. Here, because Intel could not have brought an unpatentability challenge under a preponderance standard in the district court, claim preclusion cannot apply. *See Estate of Roman v. City of Newark*, 914 F.3d 789, 804 (3d Cir. 2019) (“The difference in degree of the burden of proof ... precludes application of ... *res judicata*.” (quoting *Helvering v. Mitchell*, 303 U.S. 391, 397 (1938))); *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 571 U.S. 191, 199 (2014) (“[T]he burden of proof” is a ‘substantive aspect of a claim.’”).<sup>4</sup>

Consistent with this distinction, the Supreme Court has explained that the patent system “provides different tracks—one in the Patent Office and one in the courts—for the review and adjudication of patent claims,” and the “different evidentiary burdens mean that the possibility of inconsistent results is inherent to

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<sup>4</sup> That Congress chose to apply the preponderance standard in IPRs rather than the clear and convincing standard applicable in district courts further underscores its intent not to apply claim preclusion in an IPR based on a district court judgment.

Congress’ regulatory design.” *Cuozzo*, 579 U.S. at 282-283. For this reason, the Federal Circuit has held that a district court judgment of validity does *not* bind the Board in an IPR. *Novartis v. Noven Pharms., Inc.*, 853 F.3d 1289, 1293-1294 (Fed. Cir. 2017) (explaining that because “a ‘petitioner in an [IPR] proves unpatentability by a preponderance of the evidence rather than by clear and convincing evidence[]” as in district court, “the PTAB properly may reach a different conclusion”); *see In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1364 (Fed. Cir. 2012) (“[T]he PTO ... and the court system in patent infringement actions ‘take different approaches in determining validity and on the same evidence could quite correctly come to different conclusions.”); *In re Swanson*, 540 F.3d 1368, 1376-1379 (Fed. Cir. 2008) (“[T]he court’s final judgment and the examiner’s rejection are not duplicative—they are differing proceedings with different evidentiary standards for validity.”).

**C. VLSI’s Reliance On “Defensive Claim Preclusion” Is Misplaced And Its Cited Cases Are Distinguishable.**

In asking the Board to invoke claim preclusion against Intel, VLSI does not address the AIA provisions that clearly evince Congress’s intent not to apply claim preclusion to IPRs based on a district court judgment or the different “claims” inherent in IPRs and district court proceedings. Nor does VLSI cite a single case where claim preclusion was applied in an IPR based on a district court judgment. Instead, VLSI asks the Board to apply so-called “defensive claim preclusion”

because “the effect of” Intel’s [IPR] challenge is to collaterally attack” the district court judgment. Paper 99 at 13. VLSI’s overreaching argument should be rejected.

As an initial matter, VLSI’s reliance on “defensive claim preclusion” ignores the statutory scheme that Congress established, which involves two “different tracks” for reviewing patents and specifically allows for situations where “[a] district court may find a patent claim to be valid, and the agency may later cancel that claim in its own review.” *Cuozzo*, 579 U.S. at 282-283. Moreover, defensive claim preclusion can apply only where the second action involves “a claim or defense that was or could have been asserted in the earlier case.” *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1328 (Fed. Cir. 2008); *see First Mortgage Corp. v. United States*, 961 F.3d 1331, 1341 (Fed. Cir. 2020) (defensive claim preclusion can apply only to a “defense that could have been interposed” in the first action); Restatement (Second) of Judgments § 18(2) (similar). But as explained above, Intel could not have brought the same claim or defense asserted in this IPR—unpatentability, based on a preponderance of the evidence—in the district court action. *See supra* pp. 6-9.

Against this backdrop, the cases VLSI relies upon are readily distinguishable. VLSI focuses primarily on *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320 (Fed. Cir. 2008), where the Federal Circuit applied defensive claim preclusion to find that a party’s petition to cancel a trademark registration filed with the Trademark Trial and Appeal Board (“TTAB”) was barred by a district court judgment against

that party for infringement of the trademark. VLSI asserts that Intel should similarly be barred because, according to VLSI, “nothing distinguishes the applicability of claim preclusion to Office trademark cases from its applicability to Office patent cases.” Paper 99 at 10; *see id.* at 3-15. That is incorrect for at least two reasons:

- First, the IPR and trademark statutory schemes are different. As noted above, Congress has enacted statutory estoppel provisions in the AIA but has clearly chosen not to apply common-law claim preclusion to IPRs based on district court judgments. By contrast, the Lanham Act does not include any specialized estoppel provisions governing the interaction between TTAB and district court proceedings. Congress instead provided that “equitable principles of ... estoppel ... may be considered and applied” in trademark inter partes proceedings. 15 U.S.C. § 1069; 6 McCarthy on Trademarks & Unfair Competition § 32:82 (5th ed.) (explaining this provision “specifically allows” res judicata to be raised in trademark inter partes proceedings).
- Second, the applicable burdens of proof are different. As discussed above, a higher burden applies to patent invalidity assertions in district court than to unpatentability challenges in IPRs, such that an IPR does not involve the same claim or defense as a district court action (and further evincing Congress’s intent not to apply common-law preclusion). By contrast, the *same* burdens apply for assessing trademark validity in TTAB and district court proceedings.

*Cold War Museum, Inc. v. Cold War Museum, Inc.*, 586 F.3d 1352, 1356 (Fed. Cir. 2009) (“A party seeking to cancel a registration must overcome the registration’s presumption of validity by a preponderance of the evidence.”); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 216 n.10 (2d Cir. 2012) (same validity standard in district court context). These fundamental differences between the patent system and the trademark system mean that, unlike in *Nasalok*, claim preclusion cannot apply here. *Supra* pp. 4-9.

VLSI also asserts that the Supreme Court “reaffirmed” defensive claim preclusion in *Lucky Brand Dungarees, Inc. v. Marcel Fashions Group, Inc.*, 140 S. Ct. 1589 (2020). But the Court noted in that case that “[t]here may be good reasons to question **any application of claim preclusion to defenses**” and did not “determine when (if ever) applying claim preclusion to defenses may be appropriate, because a necessary predicate—identity of claims [was] lacking.” *Id.* at 1595 n.2.<sup>5</sup>

VLSI’s reliance on *MaxLinear, Inc. v. CF Crespe LLC*, 880 F.3d 1373 (Fed. Cir. 2018), is similarly unavailing. *MaxLinear* applied **issue preclusion** in an IPR

---

<sup>5</sup> VLSI also cites *Hallco Manufacturing Co. v. Foster*, 256 F.3d 1290, 1297 (Fed. Cir. 2001), but that case held that claim preclusion could apply between **two district court actions** to bar a validity challenge and only where the accused device “is the same as” the device accused in the earlier action.

based on *another IPR decision*, not claim preclusion based on a district court judgment. *Id.* at 1376-1378. The Federal Circuit’s statement that “[t]he TTAB ... and the [PTAB] ... are indistinguishable for preclusion purposes” was made in the context of justifying the application of *issue preclusion* in that case, and did not address (or need to consider) the fundamental differences relevant here. *See id.*

**D. In Any Event, Claim Preclusion Cannot Apply Here Because The IPR Includes Patent Claims That Were Not Part Of The District Court Judgment.**

Even if common-law claim preclusion could apply to an IPR based on a district court judgment in some cases (which, as explained above, it cannot), claim preclusion still would not apply here because the IPR and district court proceedings involve *different* patent claims. In particular, claims 1, 21, and 22 of the ’759 patent—which are all challenged in this IPR—were not tried in the district court and were not part of the district court judgment. *See Ex. 1515.*

VLSI suggests the Board should ignore this difference because, according to VLSI, “[c]laims 1 and 21 do not raise any questions of invalidity in this case beyond those questions raised by the claims depending from them that are subject to the District Court’s Final Judgment.” Paper 99 at 14-15.<sup>6</sup> That is simply incorrect.

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<sup>6</sup> VLSI omits claim 22 from this discussion. It mistakenly asserts that claim 22 was part of the district court judgment (Paper 99 at 2-3, 15), but it was not (Ex. 1515).



Unlike the other challenged claims, claim 1 does not require a “programmable clock controller” but does require “monitoring a plurality of master devices.” Ex. 1001 at claim 1. These differences in claim scope mean the Board will need to address the patentability of claim 1 separately from the other claims. *See, e.g.*, Paper 40 at 14-16 (VLSI challenging Petitioners’ obviousness proof for claim 1 (and only claim 1) based on the “monitoring” requirement). Claims 21 and 22 also include material differences because they add substantive limitations to claim 18, and Petitioners must establish that these additional limitations were known and/or would have been obvious to meet their burden of proof for these claims. Ex. 1001 at claims 21, 22.

Notably, the fact that this IPR includes patent claims that were not part of the district court judgment means that claim preclusion cannot be used to terminate Intel. That is because, as long as *any* claims challenged by Intel are subject to review, the Board must provide a final decision on the merits for *every* claim in Intel’s petition. 35 U.S.C. § 318(a) (“If an [IPR] is instituted and not dismissed . . . , the [Board] shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner[.]”); *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018) (“[T]he Board *must* address *every* claim the petitioner has challenged.”).

**V. UNDER ANY SCENARIO, THE BOARD SHOULD REACH A FINAL DECISION ON THE MERITS FOR ALL CHALLENGED CLAIMS.**

For the reasons discussed above, there is no proper legal basis for VLSI’s

claim preclusion theory. But even if the Board were to apply claim preclusion, it should still reach a final decision on the merits for all challenged claims.

First, as explained above, certain claims challenged in this IPR (claims 1, 21, and 22) were not part of the district court judgment and thus cannot be subject to any claim preclusion. *See supra* pp. 13-14. And, under *SAS*, 138 S. Ct. at 1354, the Board is required to enter a final written decision as to *all* claims challenged by Intel.

Second, claim preclusion cannot apply to Petitioner OpenSky, which was not a party to the district court litigation and has no relationship with Intel. *See* Paper 66 at 10-11; *Acumed*, 525 F.3d at 1323 (noting that claim preclusion requires that “the same parties, or their privies, were involved in the prior litigation”). Therefore, OpenSky cannot be terminated from this proceeding based on VLSI’s motion.

Third, even if Intel and OpenSky were both terminated, the Board should still issue a final written decision on the merits. *See* 35 U.S.C. § 317(a) (“If no petitioner remains in the [IPR], the Office may terminate the review or proceed to a final written decision under section 318(a).”). Doing so would advance the goal of “protect[ing] the public’s ‘paramount interest in seeing that patent [rights] are kept within their legitimate scope.’” *Cuozzo*, 579 U.S. at 279-280.

## **VI. CONCLUSION**

Intel requests that the Board deny VLSI’s motion to terminate Intel.

Dated: October 27, 2022

Respectfully Submitted,

/Benjamin S. Fernandez/  
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David L. Cavanaugh  
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1875 Pennsylvania Avenue NW  
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T: 202-663-6000  
*Attorneys for Petitioner Intel  
Corporation*

**Updated Table of Exhibits for Petitioner Intel Corporation in IPR2021-01064**

<b>Exhibit</b>	<b>Description</b>
1501	Public Version of Intel Corporation's Second Amended Answer, Defenses, and Counterclaims to VLSI Technology LLC's Complaint for Patent Infringement, <i>VLSI Technology LLC v. Intel Corp.</i> , C.A. No. 18-966-CFC, Dkt. 732 (D. Del. July 20, 2021) (Excerpted)
1502	Memorandum Order, <i>VLSI Technology LLC v. Intel Corp.</i> , C.A. No. 18-966-CFC, Dkt. 975 (D. Del. Aug. 1, 2022)
1503	Redacted Version of Second Amended Complaint, <i>Intel Corp. v. Fortress Investment Group, LLC</i> , Case No. 3:19-cv-07651-EMC, Dkt. 236 (N.D. Cal. Mar. 8, 2021) (Excerpted)
1504	Excerpt of Public Transcript of Trial Proceedings on April 25, 2022, <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 1:19-cv-00977, Dkt. 633 (W.D. Tex. May 2, 2022)
1505	Excerpts of Public Transcripts of Trial Proceedings Held on February 22-24, 2021, and March 1, 2021 in <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:21-cv-00057 with Dkt. Nos. 565, 566, 567, 570 (W.D. Tex.)
1506	Declaration of Professor Thomas M. Conte in Support of Plaintiff VLSI Technology LLC's Responsive Claim Construction Brief, <i>VLSI Technology LLC v. Intel Corp.</i> , Case 1:19-cv-00977-ADA, Dkt. 85-1 (W.D. Tex. Nov. 18, 2019)
1507	Declaration of Dr. Thomas M. Conte in Support of Plaintiff VLSI Technology LLC's Opening Claim Construction Brief, <i>VLSI Technology LLC v. Intel Corp.</i> , C.A. No. 18-966-CFC, Dkt. 229-2 Ex. 19 (JA-761-802) (D. Del. Aug. 19, 2019)
1508	Declaration of Prof. Thomas M. Conte in Support of VLSI Technology LLC's Opening Claim Construction Brief, <i>VLSI Technology LLC v. Intel Corp.</i> , No. 5:17-cv-05671-BLF, Dkt. 145 (N.D. Cal. Aug. 30, 2018)
1509	Redacted Version of Defendant Intel Corporation's Rule 59 Motion for a New Trial, <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:21-cv-00057-ADA, Dkt. 602 (W.D. Tex. Apr. 22, 2021)
1510	Redacted Version of Defendant Intel Corporation's Opposed Renewed <i>Daubert</i> Motion to Exclude and Strike the Opinions and Testimony of Ryan Sullivan, Ph.D, <i>VLSI Technology LLC v. Intel</i>

	<i>Corp.</i> , Case No. 6:21-cv-00299-ADA, Dkt. 550 (W.D. Tex. Apr. 22, 2021)
1511	Defendant Intel Corporation's Motion to Transfer Venue Under 28 U.S.C. § 1404(a), <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:19-cv-00254-ADA, Dkt. 24 (W.D. Tex. May 20, 2019)
1512	VLSI Technology LLC's Complaint for Patent Infringement, <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:19-cv-00254, Dkt. 1 (W.D. Tex. Apr. 11, 2019)
1513	David Lisch & David G. Henry, <i>The Newest 'Rocket-Docket': Waco, Texas</i> , IPWatchdog, <a href="https://www.ipwatchdog.com/2019/02/18/newest-patent-rocket-docket-waco-texas/id=106453/">https://www.ipwatchdog.com/2019/02/18/newest-patent-rocket-docket-waco-texas/id=106453/</a> (Feb. 18, 2019)
1514	Agreed Scheduling Order, <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:19-cv-00254-ADA, Dkt. 71 (W.D. Tex. Sept. 9, 2019)
1515	Public Version of Final Judgment, <i>VLSI Technology LLC v. Intel Corp.</i> , Case No. 6:21-cv-00057-ADA, Dkt. 701 (W.D. Tex. May 10, 2022)
1516	Memorandum from USPTO Director Katherine K. Vidal to Members of the Patent Trial and Appeal Board Regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1517	Chief Judge Orlando L. Garcia's Order Assigning the Business of the Court as It Relates to Patent Cases (W.D. Tex. July 25, 2022)
1518	Email from Christopher D. Ivey to William Lee and Joseph Mueller, Dated December 23, 2021
1519	Email from Matthew Hulse to Andrew Oliver, Dated December 24, 2021
1520	Email from Christopher D. Ivey to Joshua Stern, Dated December 27, 2021
1521	Email from Christopher D. Ivey to Joshua Stern, Dated January 7, 2022
1522	Letter from Jeffrey A. Lamken to Benjamin S. Fernandez and David L. Cavanaugh Regarding Preservation Notice to Intel Corporation, Dated May 20, 2022
1523	Email from Ben Fernandez to Andrew Oliver and Vinay Joshi, Dated June 15, 2022
1524	Email from Steven J. Horn to Andrew Oliver, Dated June 21, 2022
1525	Email from Andrew Oliver to Steven J. Horn, Dated June 22, 2022

1526	Email from Steven J. Horn to Andrew Oliver, Dated June 23, 2022
1527	Email from Ben Fernandez to Andrew Oliver, Dated July 8, 2022
1528	Email from Andrew Oliver to Ben Fernandez, Dated July 8, 2022
1529	Email from Andrew Oliver to Ben Fernandez, Dated July 9, 2022
1530	[SEALED] Petitioner Intel Corporation's Privilege Log, Dated August 4, 2022
1531	[SEALED] Letter from Ben Fernandez to Babak Redjaian, Dated August 15, 2022
1532	[SEALED] Patent Owner VLSI Technology LLC's Privilege Log, Dated August 4, 2022
1533	[SEALED] Letter from Ben Fernandez to Andrew Oliver and Babak Redjaian, Dated August 4, 2022
1534	[SEALED] Email from Kenneth Weatherwax to Counsel, Dated August 16, 2022
1535	[SEALED] Email from Charlotte Wen to Ben Fernandez, Dated August 16, 2022
1536	Email from Ken Weatherwax to Trials@uspto.gov, Dated August 24, 2022



**CERTIFICATE OF SERVICE**

I hereby certify that on October 27, 2022, I caused a true and correct copy of the foregoing materials:

- Petitioner Intel Corporation's Opposition to VLSI's Motion to Terminate Based on Res Judicata
- Updated Table of Exhibits for Petitioner Intel Corporation in IPR2021-01064
- Exhibit 1536

to be served via electronic mail on the following correspondents of record as listed in Petitioner OpenSky's and Patent Owner VLSI's Mandatory Notices:

**OpenSky Industries LLC**

Matthew K. Blackburn, Lead Counsel  
Sullivan Blackburn Pratt LLC  
Email: mblackburn@sullivanblackburn.com

Evan Boetticher, First Back-Up Counsel  
Sullivan Blackburn Pratt LLC  
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David Boundy, Second Back-Up Counsel  
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**VLSI Technology LLC:**

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/Benjamin S. Fernandez/  
Benjamin S. Fernandez  
Registration No. 55,172

**From:** [Fernandez, Ben](#)  
**To:** [Director PTABDecision Review](#); [PTAB E2E Admin](#)  
**Cc:** [Cavanaugh, David](#); [Horn, Steven J](#); [Andrew Oliver](#); [Redjaian, Babak](#); [Kenneth Weatherwax](#); [Nathan Lowenstein](#); [VLSI](#); [vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com)  
**Subject:** IPR2021-01064 – Intel’s Request for E2E Filing Access for Director Review Briefing  
**Date:** Monday, August 15, 2022 8:59:54 PM

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Dear Honorable Director,

The *Order Setting Schedule for Director Review*, Paper No. 47 (as extended by the *Order Denying Request for Stay or Two-Month Extension, Granting Two-Week Extension*, Paper No. 51) directs the parties to submit briefing and exhibits in the Office’s E2E system. While Petitioner Intel Corporation currently has *viewing* access to documents in E2E for this proceeding, it does not appear to have *filing permissions* in E2E for this proceeding, and thus respectfully requests the same, so that it can be in a position to file its briefs. Petitioner Intel confirms that it will use such access for Mandated Discovery issues and Director Review briefing, and otherwise only as consistent with its understudy role in the proceeding. Thank you.

Petitioner OpenSky and Patent Owner VLSI do not oppose this request.

Respectfully,

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**USPTO0031**

**From:** [Fernandez, Ben](#)  
**To:** [Director PTABDecision Review](#)  
**Cc:** [Redjaian, Babak](#); [Andrew Oliver](#); [Trials](#); [VLSI](#); [Cavanaugh, David](#); [Horn, Steven J](#); [Nathan Lowenstein](#); [Colette Woo](#); [Wen, Charlotte](#); [Kenneth Weatherwax](#); [Vinay Joshi](#)  
**Subject:** IPR2021-01064: VLSI's Requests for In Camera Review  
**Date:** Wednesday, August 17, 2022 10:43:59 PM

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Director Vidal,

We represent Petitioner Intel in IPR2021-01064 and IPR2021-01229. Consistent with our email in IPR2021-01229, we write regarding the in camera review pursuant to the Director's July 7, 2022 Discovery Order. Intel has not requested in camera review of any documents in either IPR2021-01064 or IPR2021-01229.

VLSI has served unsupported and overbroad requests for in camera review of documents on Intel's privilege log. VLSI has failed to provide any sufficient basis for challenging the privileges and protections asserted by Intel in its privilege log. Further, VLSI is seeking in camera review of materials related to the merits of the patentability challenges, which are not relevant to the subject matter of the Director's review. Intel raised these concerns with VLSI on August 15. On August 16, VLSI withdrew one category of requests in IPR2016-01064, but refused to withdraw its other requests in that proceeding or its requests in IPR2021-01229.

Intel has fully and completely complied with the Director's order. However, VLSI's overbroad requests implicate serious issues of privilege and waiver. Intel believes that these requests have raised important questions regarding the in camera review process in these proceedings, including the purpose and scope of review, the proper threshold for seeking review, protections against waiver, and relevance that should be addressed by the Director before submission of documents for in camera review in IPR2021-01064 and IPR2021-01229. Intel intends to submit objections to the Director by August 18 and respectfully submits that a tolling of the deadline to submit documents for in camera review in each proceeding is appropriate to address Intel's forthcoming objections.

Intel met and conferred with VLSI on August 17. On that call, Intel indicated to VLSI that it intended to submit objections to VLSI's requests for in camera review and raised its proposal for tolling the deadline. VLSI indicated that it opposes Intel's requests and would not agree to withdraw its outstanding requests for in camera review.

Intel can be available to discuss at the Director's or the Board's convenience.

Respectfully submitted,

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**USPTO0032**

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**USPTO0033**

**From:** [Director PTABDecision Review](#)  
**To:** [Truman Fenton](#)  
**Cc:** [ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com); [Cavanaugh, David](#); [yvonne.lee@wilmerhale.com](mailto:yvonne.lee@wilmerhale.com); [Horn, Steven J](#); [Bruce Slayden](#); [Tecuan Flores](#); [bredjaian@irell.com](mailto:bredjaian@irell.com); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [smith@lowensteinweatherwax.com](mailto:smith@lowensteinweatherwax.com); [rose@lowensteinweatherwax.com](mailto:rose@lowensteinweatherwax.com); [hsieh@lowensteinweatherwax.com](mailto:hsieh@lowensteinweatherwax.com); [hendifar@lowensteinweatherwax.com](mailto:hendifar@lowensteinweatherwax.com); [maloney@lowensteinweatherwax.com](mailto:maloney@lowensteinweatherwax.com); [linger@lowensteinweatherwax.com](mailto:linger@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)  
**Subject:** IPR2021-01229 – Exhibit 2076  
**Date:** Friday, September 23, 2022 2:56:00 PM

---

Counsel,

Exhibit 2076, referenced in Patent Owner’s briefing, appears to be an audio file. Please upload this file at your earliest convenience. Please note that PTAB E2E can accept PDF and MPEG format (MPEG, MPG, MP1, MP2, MP3, MP4, M1A, M2A, M1V, MPA, MPV) files. A single uploaded file may not exceed 25 megabytes in size.

Thank you.

**USPTO0034**



**From:** [Fernandez, Ben](#)  
**To:** [Trials](#)  
**Cc:** [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); [litigation@sqbfirm.com](mailto:litigation@sqbfirm.com); [bslayden@sqbfirm.com](mailto:bslayden@sqbfirm.com); [Cavanaugh, David](#); [Horn, Steven J](#); [Lee, Yvonne](#)  
**Subject:** IPR2021-01229 – Joinder Conference  
**Date:** Monday, January 31, 2022 6:16:57 PM

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Dear Honorable Board,

On January 26, 2022, Intel Corporation (“Intel”) filed a petition in IPR2022-00479 along with a motion requesting joinder with instituted IPR2021-01229 filed by Patent Quality Assurance, LLC (“PQA”) challenging certain claims of U.S. Pat. No. 7,523,373.

Pursuant to page 76 of the Consolidated Trial Practice Guide, Intel writes to arrange a conference call with the panel, petitioner, and patent owner of the first proceeding (IPR2021-01229) to timely manage proceedings.

Intel respectfully requests that the Board set a call at its earliest convenience and can be available at any time suitable to the Board. Counsel for PQA and Patent Owner VLSI Technology LLC are both available Wednesday from 1-5 ET, and Thursday from 1-3 or 4-5 ET.

Best regards,

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**USPTO0035**



**From:** [Fernandez, Ben](#)  
**To:** [Trials](#)  
**Cc:** [Cavanaugh, David](#); [Andrew Oliver](#); [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); [Vinay Joshi](#)  
**Subject:** Joinder Conference | IPR2022-00366 Motion for Joinder with IPR2021-01064  
**Date:** Thursday, December 30, 2021 7:05:18 PM

---

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Dear Honorable Board,

On December 27, 2021, Intel Corporation ("Intel") filed a petition in IPR2022-00366 along with a motion requesting joinder with instituted IPR2021-01064 filed by OpenSky Industries, LLC ("OpenSky") challenging certain claims of U.S. Pat. No. 7,725,759.

Pursuant to page 76 of the Consolidated Trial Practice Guide, Intel writes to arrange a conference call with the panel, petitioner, and patent owner of the first proceeding to timely manage proceedings.

Intel respectfully requests that the Board set a call at its earliest convenience and can be available at any time suitable to the Board. OpenSky has indicated that it is available on January 4 after 1:00pm ET or January 11 after 1:00 pm ET. Counsel for Patent Owner VLSI Technology LLC has stated that their first availability is January 11 after 1:00pm ET.

Respectfully,

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**USPTO0036**

**From:** [Trials](#)  
**To:** [Andrew Oliver](#); [Trials](#)  
**Cc:** [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [Nathan Lowenstein](#); [Redjaian, Babak](#); [Fernandez, Ben](#); [Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com); [Cavanaugh, David](#); [Vinay Joshi](#)  
**Subject:** RE: IPR2021-01064 - joint request for demonstrative extension  
**Date:** Friday, September 9, 2022 1:31:26 PM

---

Counsel,

The parties' request regarding service and filing dates for demonstratives is granted.

Thank you,

Megan Carlson  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

---

**From:** Andrew Oliver <aoliver@atwiplaw.com>  
**Sent:** Thursday, September 8, 2022 7:12 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** weatherwax@lowensteinweatherwax.com; Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; Redjaian, Babak <BRedjaian@irell.com>; Fernandez, Ben <Ben.Fernandez@wilmerhale.com>; Steven.Horn@wilmerhale.com; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Vinay Joshi <vjoshi@atwiplaw.com>  
**Subject:** IPR2021-01064 - joint request for demonstrative extension

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Dear Honorable Board,

Due to scheduling issues, all parties jointly and respectfully request an extension of the demonstrative service and filing dates by two business days, to September 15 and September 19, respectively.

Respectfully submitted,  
Andrew Oliver

Andrew T. Oliver  
**Amin, Turocy & Watson, LLP**  
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San Jose, CA 95113

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Web: <http://thepatentattorneys.com/clev/staff-detail.php?pid=20>

**USPTO0037**

**From:** [Trials](#)  
**To:** [Fernandez, Ben](#); [Andrew Oliver](#); [Trials](#)  
**Cc:** [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [Nathan Lowenstein](#); [Cavanaugh, David](#); [Horn, Steven J](#); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)  
**Subject:** RE: IPR2021-01064 - OpenSky v VLSI - consent for joined party Intel to access sealed materials  
**Date:** Tuesday, June 28, 2022 2:43:05 PM

---

Counsel:

Intel's counsel of record in IPR2022-00366 has been granted access to the record in IPR2021-01064.

Thank you,

Megan Carlson  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board  
(571) 272-1650  
[Megan.Carlson@uspto.gov](mailto:Megan.Carlson@uspto.gov)

---

**From:** Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>  
**Sent:** Tuesday, June 28, 2022 2:27 PM  
**To:** Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>; PTAB E2E Admin <[PTABE2EAdmin@USPTO.GOV](mailto:PTABE2EAdmin@USPTO.GOV)>  
**Cc:** Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); Nathan Lowenstein <[lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com)>; Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Horn, Steven J <[Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)>; [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)  
**Subject:** RE: IPR2021-01064 - OpenSky v VLSI - consent for joined party Intel to access sealed materials

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board and PTAB E2E Administrators,

Joinder petitioner Intel Corporation respectfully inquires as to its access of this IPR record in E2E, as requested on June 18 by petitioner OpenSky. Please let us know if any additional steps are required in order for Intel to obtain access to the proceedings. Thank you.

Respectfully,

**Ben Fernandez | WilmerHale**  
1225 Seventeenth Street, Suite 2600  
Denver, CO 80202 USA  
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[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

**USPTO0038**



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---

**From:** Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>

**Sent:** Saturday, June 18, 2022 3:10 AM

**To:** [trials@uspto.gov](mailto:trials@uspto.gov); [PTABE2EAdmin@uspto.gov](mailto:PTABE2EAdmin@uspto.gov)

**Cc:** Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); Nathan Lowenstein <[lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com)>; Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>; Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Horn, Steven J <[Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)>

**Subject:** IPR2021-01064 - OpenSky v VLSI - consent for joined party Intel to access sealed materials

**EXTERNAL SENDER**

Dear Sir or Madam,

I represent OpenSky in the above-referenced inter partes review proceeding. Intel Corp. sought to join this proceeding as an understudy through a motion for joinder in proceeding number IPR2022-00366. The motion was granted on June 8. Intel's counsel now seeks access to the sealed information in this proceeding (i.e., IPR2021-01064). Intel's counsel has informed me that the board needs permission from petitioner OpenSky to gain access to the sealed filings in IPR2021-01064, and has requested that I inform you that OpenSky does not object to such access.

Thus, I write to inform you that OpenSky does not object to the board granting, to Intel's counsel of record in IPR2022-00366, access to the sealed filings in IPR2021-01064.

Sincerely,  
Andrew

Andrew T. Oliver  
**Amin, Turocy & Watson, LLP**  
160 West Santa Clara Street, Suite 975  
San Jose, CA 95113

E: [aoliver@ATWiplaw.com](mailto:aoliver@ATWiplaw.com) T: (650) 393-0634

Web: <http://thepatentattorneys.com/clev/staff-detail.php?pid=20>

**USPTO0039**

**From:** [Cavanaugh, David](#)  
**To:** [Director\\_PTABDecision\\_Review](#); [Andrew Oliver](#); [vjoshi@atwiplaw.com](#); [Redjaian, Babak](#); [Kenneth Weatherwax](#); [lowenstein@lowensteinweatherwax.com](#); [aheinrich@irell.com](#); "[VLSI\\_IPRs@lowensteinweatherwax.com](#)"  
**Cc:** [Fernandez, Ben](#); [Horn, Steven J](#); [Cavanaugh, David](#)  
**Subject:** RE: IPR2021-01064 - Petitioner expedited request for stay or extension  
**Date:** Tuesday, July 19, 2022 5:33:10 PM

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CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Dear Honorable Director Vidal:

I write on behalf of joined Petitioner Intel Corporation. Intel is prepared to produce materials and to submit briefing on the schedule in Paper No. 47 in this proceeding or any adjusted schedule set by the Director. Intel neither opposes nor joins Petitioner OpenSky's request for a stay or extension of the Mandated Discovery and briefing deadlines in Paper No. 47.

Intel understands that the Director has already found that other deadlines in this proceeding should not be stayed. See Paper No. 41, at 2. For clarity, Intel would oppose any request to stay or delay other deadlines in this proceeding.

Intel would be happy to submit argument to the extent useful to the Director or the Board.

Respectfully submitted,

David Cavanaugh

**David L. Cavanaugh | WilmerHale**

1875 Pennsylvania Avenue NW

Washington, DC 20006 USA

+1 202 663 6025 (t)

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[david.cavanaugh@wilmerhale.com](mailto:david.cavanaugh@wilmerhale.com)

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---

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---

**From:** Director\_PTABDecision\_Review <[Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov)>

**Sent:** Tuesday, July 19, 2022 9:32 AM

**To:** Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>; [vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com); Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; Kenneth Weatherwax <[weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com)>; [lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com); [aheinrich@irell.com](mailto:aheinrich@irell.com); 'VLSI\_IPRs@lowensteinweatherwax.com' <[VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)>; Fernandez, Ben

**USPTO0040**

<Ben.Fernandez@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Horn, Steven J <Steven.Horn@wilmerhale.com>

**Subject:** FW: IPR2021-01064 - Petitioner expedited request for stay or extension

**EXTERNAL SENDER**

Counsel,

The parties are reminded that all parties must be copied on communications to the Office. The parties are also reminded that all requests must indicate whether the other parties oppose the requested relief.

Counsel for joined Petitioner Intel and Patent Owner VLSI shall respond to this email, within 24 hours, and indicate whether they support or oppose Petitioner OpenSky's request that the Director enter "an immediate order either (a) staying the 'Mandated Discovery' and briefing schedule in Paper No. 47 or (b) extending the deadlines set in Paper No. 47 by two months for each deadline." No argument is permitted.

Thank you.

---

**From:** Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>

**Sent:** Friday, July 15, 2022 5:00 PM

**To:** Director\_PTABDecision\_Review <[Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov)>

**Subject:** IPR2021-01064 - Petitioner expedited request for stay or extension

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Dear Director Vidal,

I am counsel for petitioner OpenSky Industries LLC ("OpenSky") in IPR2021-01064 (*OpenSky Industries, LLC and Intel Corporation v. VLSI Technology LLC*).

We are in receipt of your order dated July 7, 2022 (Paper No. 47). At page 12-13 of that Order, the order authorizes parties to contact the Office related to the Director review proceeding by emailing [Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov). I correspond today in accord with that authorization. Because I was at trial in late June with mandatory post-trial briefing due this week as well as the Petitioner Reply in this proceeding, mandatory deadlines in other proceedings, and other pre-existing obligations, this is the first instance that I have had to contact the office regarding the order. I would welcome a telephone call with the Director or the Director's office if that will help to resolve this request.

For the reasons set forth below (which OpenSky will brief more completely if needed), OpenSky requests an immediate order either (a) staying the "Mandated Discovery" and briefing schedule in

**USPTO0041**



Paper No. 47 or (b) extending the deadlines set in Paper No. 47 by two months for each deadline. OpenSky has not located any procedure in the PTAB Consolidated Trial Practice Guide for requesting such a stay and/or extension in a Director review, and accordingly seeks guidance from the Director as to the appropriate procedure. To the extent that an expedited stay or extension is not available from the Director, OpenSky wishes to know that as well, so that it may determine whether to file an appeal to the U.S. Court of Appeals for the Federal Circuit and seek an emergency stay from the Federal Circuit.

OpenSky notes that Director's order starts from a false premise of being "faced with evidence of abuse ...", when in actuality the email upon which the Director review is based is not properly evidence and is hearsay, potentially including hearsay within hearsay, insofar as the undersigned understands that it reflects OpenSky's understanding of VLSI's proposal to settle the proceeding, and does not suggest that either VLSI who proposed the conduct or OpenSky who responded to the proposal would actually reach an agreement or ultimately engage in any conduct. Nor does it suggest that any of the explored concepts would be counter to permitted patent office practice if it was ever implemented.

Based upon the apparent overreach of the Director's order (Paper No. 47) and the false premise noted above, OpenSky seeks an immediate stay and/or an extension of 60 days in which to attempt to retain counsel who is familiar with Constitutional law, administrative procedure, and overreach of administrative agencies. OpenSky's current counsel (including the undersigned) are patent office practitioners who are unfamiliar with the Constitutional law and administrative procedure issues raised by the Director's order. While OpenSky's counsel is unfamiliar with the issues presented by the order, other lawyers have commented that such issues may include, for example, violation of the Fourth Amendment by requiring onerous and extensive discovery unrelated to the merits of the proceeding and threatening sanctions (e.g., Paper No. 47 page 10 ("Any attempt to withhold evidence ... may ... be sanctionable.")) if the parties attempt to object to or interpret the discovery consistently with the scope of the Director's authority and/or relevance and potentially violation of the First Amendment. (For example, there is no standing requirement for filing an IPR petition, but the mandated discovery and briefing order seems to suggest that OpenSky's ownership, business activities, and/or policy goals may bear on the propriety of the petition, even though none appears to be relevant.) Other lawyers have also suggested that the administrative procedure and overreach issues may also include the lack of authority cited in the Director's order and ultimate lack of any authority from the Congress for the Director to seek the onerous and extensive discovery, threaten sanctions, or require briefing disclosing the extensive information sought. Current counsel (including the undersigned) is unfamiliar with such law and even with identification of the particular problematic issues that may be presented by the Director's order. Thus, OpenSky will need time to consider such issues and potentially to seek counsel familiar with the issues.

The undersigned does not want to incur potential malpractice liability by attempting to provide expedited advice to a client in legal fields in which the undersigned has little knowledge and does not practice law.

OpenSky further notes that its counsel of record is the only counsel retained by or currently available to OpenSky to assist with the onerous and expedited discovery and briefing schedules set forth in



the Director's order (Paper No. 47). This counsel maintains full schedules of work obligations for their clients, including intervening obligations in patent office, district courts, and other matters. While the standard deadlines for the proceeding are docketed and appropriate time allocated for such proceedings, the timing of the Director's order was unexpected and set forth exceedingly short (i.e., 14 day) deadlines for compliance. Neither attorney is able to shift any significant load to undertake the onerous and expedited discovery and briefing schedule required by the Director's order. Nor is OpenSky able to obtain other counsel on an expedited basis to address the order.

Accordingly, OpenSky respectfully requests that the Director either issue an immediate stay or two month extension or, in the alternative, inform OpenSky of the procedure to be followed in requesting such relief in a Director review.

Respectfully submitted,  
Andrew T. Oliver

Andrew T. Oliver  
**Amin, Turocy & Watson, LLP**  
160 West Santa Clara Street, Suite 975  
San Jose, CA 95113

E: [aoliver@ATWiplaw.com](mailto:aoliver@ATWiplaw.com) T: (650) 618-6477

Web: <http://thepatentattorneys.com/clev/staff-detail.php?pid=20>

**From:** [Director PTABDecision Review](#)  
**To:** [Andrew Oliver](#)  
**Cc:** [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [Fernandez, Ben](#); [Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com); [Cavanaugh, David](#); [Vinay Joshi](#)  
**Subject:** RE: IPR2021-01064 - submission of exhibits 1054 and 1056  
**Date:** Thursday, September 22, 2022 3:59:00 PM

---

Mr. Oliver,

Exhibits 1054 and 1056 are associated with previously filed exhibits in this case. Please try to file the audio recordings again with new, available exhibit numbers. Please note that PTAB E2E can accept PDF and MPEG format (MPEG, MPG, MP1, MP2, MP3, MP4, M1A, M2A, M1V, MPA, MPV) files. A single uploaded file may not exceed 25 megabytes in size.

Thank you.

---

**From:** Andrew Oliver <aoliver@atwiplaw.com>  
**Sent:** Thursday, September 1, 2022 11:55 PM  
**To:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>  
**Cc:** Redjaian, Babak <BRedjaian@irell.com>; weatherwax@lowensteinweatherwax.com; Fernandez, Ben <Ben.Fernandez@wilmerhale.com>; Steven.Horn@wilmerhale.com; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Vinay Joshi <vjoshi@atwiplaw.com>  
**Subject:** IPR2021-01064 - submission of exhibits 1054 and 1056

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Dear Director Vidal,

I write on behalf of petitioner OpenSky Industries LLC, pursuant to the authorization at Paper No. 47 pp. 12-13, which states that "if a party must contact the Office related to this Director review proceeding, they do so by email to" the above email address. Counsel for all parties are copied on this email.

OpenSky attempted to file Exhibits 1054 and 1056 through the PTAB's online filing system today, but the system would not accept the files, perhaps because they are audio recordings. Exhibits 1054 and 1056 are attached to this email. Please accept them for filing in the Director review proceeding.

Sincerely,  
Andrew

Andrew T. Oliver  
**Amin, Turocy & Watson, LLP**  
160 West Santa Clara Street, Suite 975  
San Jose, CA 95113

**USPTO0044**

E: [aoliver@ATWiplaw.com](mailto:aoliver@ATWiplaw.com) T: (650) 393-0634

Web: <http://thepatentattorneys.com/clev/staff-detail.php?pid=20>

**From:** [Trials](#)  
**To:** [Kenneth Weatherwax](#); [Trials](#)  
**Cc:** [Fernandez, Ben](#); [Cavanaugh, David](#); [Steven.Horn@wilmerhale.com](#); [Redjaian, Babak](#); [Nathan Lowenstein](#); [Colette Woo](#); [Vinay Joshi](#); [aoliver@atwiplaw.com](#); ["aheinrich@irell.com"](#); [Director\\_PTABDecision\\_Review](#); [Warrick, Philip](#); [Wen, Charlotte](#); [Hattenbach, Ben](#)  
**Subject:** RE: IPR2021-01064 (OpenSky v. VLSI) - Request for remote hearing time accommodating counsel location  
**Date:** Friday, September 9, 2022 1:32:26 PM

---

Counsel,

Patent Owner's request is granted. The remote hearing will begin at 11:00am ET.

Thank you,

Megan Carlson  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

---

**From:** Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>  
**Sent:** Thursday, September 8, 2022 7:25 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** Fernandez, Ben <Ben.Fernandez@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Steven.Horn@wilmerhale.com; Redjaian, Babak <BRedjaian@irell.com>; Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; Colette Woo <woo@lowensteinweatherwax.com>; Vinay Joshi <vjoshi@atwiplaw.com>; aoliver@atwiplaw.com; 'aheinrich@irell.com' <AHeinrich@irell.com>; Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>; Warrick, Philip <pwarrick@irell.com>; Wen, Charlotte <cwen@irell.com>; Hattenbach, Ben <BHattenbach@irell.com>  
**Subject:** IPR2021-01064 (OpenSky v. VLSI) - Request for remote hearing time accommodating counsel location

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Honorable Board,

Under the terms of the September 1 Order setting oral argument in this case ("Order"), the Board will "not conduct an in-person hearing unless requested by all parties." Order at 1. VLSI desires an in-person hearing but Petitioners advise that they wish a remote hearing, so under the terms of the Order the oral argument will necessarily be remote.

The Order sets 9:00 AM Eastern Time as the oral argument start time. *Id.* This time is 6:00 AM local time, which will be well before dawn, for counsel in the Pacific Time zone, which includes every counsel of record for patent owner VLSI. In light of this fact and the fact that the hearing will necessarily be remote, a later start time is respectfully requested to accommodate counsel's location.

**USPTO0046**

VLSI has met and conferred on this request. In response, OpenSky and Intel jointly provided the following statement that they have asked be included in this email to the Board: 'Petitioners OpenSky and Intel are both available for oral argument at 9 AM ET and take no position on VLSI's request for a later start time.'

VLSI is available for a conference call if one is deemed helpful.

Respectfully submitted,

Kenneth Weatherwax  
Counsel for patent owner VLSI Technology LLC

**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile:** 310.936.3088



**From:** [Fernandez, Ben](#)  
**To:** [Trials](#); [Kenneth Weatherwax](#)  
**Cc:** [aoliver@atwiplaw.com](#); [vjoshi@atwiplaw.com](#); [Horn, Steven J](#); [Cavanaugh, David](#); [Redjaian, Babak](#); [Nathan Lowenstein](#); [Colette Woo](#)  
**Subject:** RE: IPR2021-01064 (VLSI Tech. LLC v. Intel Corp.): Patent owner request for Board guidance  
**Date:** Friday, August 26, 2022 2:19:40 PM

---

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Dear Honorable Board,

Petitioner Intel respectfully wishes to confirm that Intel will have an opportunity to submit *its own* brief in opposition to the motion to terminate. VLSI included Intel's statement in its email to the panel, "Should the Panel authorize a motion on this issue, Intel requests, based on the principles of due process, its own opposition brief of equal length to the motion."

Petitioner Intel wishes to confirm that Intel will be afforded the opportunity to file its own brief of equal length to the motion which the Board has authorized.

Respectfully,

**Ben Fernandez | WilmerHale**

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Denver, CO 80202 USA  
+1 720 274 3163 (t)  
+1 720 274 3133 (f)  
[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

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---

**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Friday, August 26, 2022 6:42 AM  
**To:** Kenneth Weatherwax <[weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com)>; Trials <Trials@USPTO.GOV>  
**Cc:** [aoliver@atwiplaw.com](#); [vjoshi@atwiplaw.com](#); [Horn, Steven J](#) <[Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)>; [Cavanaugh, David](#) <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; [Redjaian, Babak](#) <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [Fernandez, Ben](#) <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>; [Nathan Lowenstein](#) <[lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com)>; [Colette Woo](#) <[woo@lowensteinweatherwax.com](mailto:woo@lowensteinweatherwax.com)>  
**Subject:** RE: IPR2021-01064 (VLSI Tech. LLC v. Intel Corp.): Patent owner request for Board guidance

**EXTERNAL SENDER**

**USPTO0048**

Counsel:

Patent Owner's motion to terminate is authorized. The panel will provide briefing particulars next week.

Thank you,

Megan Carlson  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

---

**From:** Kenneth Weatherwax <[weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com)>  
**Sent:** Wednesday, August 24, 2022 4:31 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com); [vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com); Horn, Steven J <[Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)>; Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>; Nathan Lowenstein <[lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com)>; Colette Woo <[woo@lowensteinweatherwax.com](mailto:woo@lowensteinweatherwax.com)>  
**Subject:** IPR2021-01064 (VLSI Tech. LLC v. Intel Corp.): Patent owner request for Board guidance

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Honorable Board:

Patent Owner VLSI respectfully requests the Board's guidance regarding an argument based on events that have occurred since VLSI filed its Response to the Petition. VLSI believes this argument is more efficiently presented in an authorized motion to terminate, rather than in the Sur-Reply.

Accordingly, VLSI seeks the Board's guidance, and requests such authorization subject to such guidance, before it files its Sur-Reply, currently due in two days, Friday, August 26.

The argument in question is res judicata in view of the final judgment of the District Court in *VLSI Technology LLC v. Intel Corporation*. VLSI's Response did not address the court's Final Judgment or its effect on Intel as a party: at that time, the Court had not yet issued its Final Judgment, and Intel had not yet been joined as a party or acted as a party. If the Board desires further information about this preclusion argument, VLSI is ready to provide it.

The Sur-Reply is generally not intended for raising new arguments. Moreover, if VLSI presents this argument in its Sur-Reply it expects Petitioner will request post-Sur-Reply briefing to respond. In light of the inefficiency of a Sur-Reply presentation and such further briefing requests, VLSI believes it is more efficient for this argument to be made in a separate motion to terminate the proceeding as to at least Intel. VLSI suggests such an authorized motion to terminate could be due 9/2, with opposition due 9/9 and reply due 9/16.

If the Board deems a conference necessary, counsel for VLSI is available 8/25 from 10a-1:30p and

**USPTO0049**



3p-5p and 8/26 from 10a and 5p, Eastern Time, and as noted below, counsel for Intel is also available at those times.

VLSI has conferred with Petitioner OpenSky and Intel. OpenSky has not yet responded. Intel responded as follows: "VLSI sent its first email on these topics at 11:16 am ET seeking a response by 3:45pm ET or an agreement to delay the filing of an already extended sur-reply. Intel opposes VLSI's request for a motion to terminate or a request for an extension of time to file its sur-reply as untimely, contrary to established procedures at the PTAB, and lacking in merit. Should the Panel authorize a motion on this issue, Intel requests, based on the principles of due process, its own opposition brief of equal length to the motion. To the extent that the Panel sets a phone conference, Intel can be available at the times proposed by VLSI on August 26." VLSI respectfully notes in response that i) VLSI did not request another extension of time to file its sur-reply and ii) the rules already provide for oppositions to authorized motions and that "the page limits for oppositions are the same as those for corresponding motions" (37 C.F.R. 42.24(b)(3)).

Respectfully submitted to the Board,

Kenneth Weatherwax  
Counsel for Patent Owner VLSI Technology LLC

**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile:** 310.936.3088

**From:** [Hawthorne, Eric W.](#)  
**To:** [Fernandez, Ben](#); [Director\\_PTABDecision\\_Review](#); [PTAB E2E Admin](#)  
**Cc:** [Cavanaugh, David](#); [Horn, Steven J](#); [Lee, Yvonne](#); [Truman Fenton](#); [Bruce Slayden](#); [Brian Banner](#); [Tecuan Flores](#); [SGB Litigation](#); [Redjaian, Babak](#); [Kenneth Weatherwax](#); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); [Nathan Lowenstein](#)  
**Subject:** RE: IPR2021-01229 – Intel’s Request for E2E Filing Access for Director Review Briefing  
**Date:** Tuesday, August 16, 2022 11:00:16 AM

---

Dear Mr. Fernandez, the PTABE2E system has been updated in cases IPR2021-01064 and IPR2021-01229 to accord filing permissions to you as First Back-up counsel.

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

---

**From:** Fernandez, Ben <Ben.Fernandez@wilmerhale.com>  
**Sent:** Monday, August 15, 2022 9:00 PM  
**To:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>; PTAB E2E Admin <PTABE2EAdmin@USPTO.GOV>  
**Cc:** Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Horn, Steven J <Steven.Horn@wilmerhale.com>; Lee, Yvonne <Yvonne.Lee@wilmerhale.com>; Truman Fenton <tfenton@sbgfirm.com>; Bruce Slayden <bslayden@sbgfirm.com>; Brian Banner <bbanner@sbgfirm.com>; Tecuan Flores <tflores@sbgfirm.com>; SGB Litigation <litigation@sbgfirm.com>; Redjaian, Babak <bredjaian@irell.com>; Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>; VLSI\_IPRs@lowensteinweatherwax.com; Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>  
**Subject:** IPR2021-01229 – Intel’s Request for E2E Filing Access for Director Review Briefing

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Dear Honorable Director,

The *Order Setting Schedule for Director Review*, Paper No. 35 (as extended by the *Order Granting Two-Week Extension*, Paper No. 37) directs the parties to submit briefing and exhibits in the Office’s E2E system. While Petitioner Intel Corporation currently has *viewing* access to documents in E2E for this proceeding, it does not appear to have *filing permissions* in E2E for this proceeding, and thus respectfully requests the same, so that it can be in a position to file its briefs. Petitioner Intel confirms that it will use such access for Mandated Discovery issues and Director Review briefing, and otherwise only as consistent with its understudy role in the proceeding. Thank you.

Petitioner PQA and Patent Owner VLSI do not oppose this request.

Respectfully,

**Ben Fernandez | WilmerHale**  
1225 Seventeenth Street, Suite 2600

**USPTO0051**

Denver, CO 80202 USA  
+1 720 274 3163 (t)  
+1 720 274 3133 (f)  
[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

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**USPTO0052**

**From:** [Trials](#)  
**To:** [Kenneth Weatherwax](#); [Trials](#)  
**Cc:** [Wen, Charlotte](#); [Nathan Lowenstein](#); [VLSI](#); [Hattenbach, Ben](#); [Heinrich, Alan](#); [Redjaian, Babak](#); [Slusarczyk, Dominik](#); [Truman Fenton](#); [Tecuan Flores](#); [Bruce Slayden](#); [SGB Litigation](#); [Fernandez, Ben](#); [Cavanaugh, David](#); [Lee, Yvonne](#); [Horn, Steven J](#)  
**Subject:** RE: IPR2021-01229 - request to extend times for serving and filing hearing demonstratives  
**Date:** Friday, October 14, 2022 10:04:40 AM

---

Counsel:

The parties' requested extensions are authorized.

Best regards,  
Esther

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
(571) 272-7822

---

**From:** Kenneth Weatherwax <[weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com)>  
**Sent:** Thursday, October 13, 2022 5:48 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Wen, Charlotte <[cwen@irell.com](mailto:cwen@irell.com)>; Nathan Lowenstein <[lowenstein@lowensteinweatherwax.com](mailto:lowenstein@lowensteinweatherwax.com)>; VLSI <[VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)>; Hattenbach, Ben <[BHattenbach@irell.com](mailto:BHattenbach@irell.com)>; Heinrich, Alan <[AHeinrich@irell.com](mailto:AHeinrich@irell.com)>; Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; Slusarczyk, Dominik <[DSlusarczyk@irell.com](mailto:DSlusarczyk@irell.com)>; Truman Fenton <[tfenton@sbgfirm.com](mailto:tfenton@sbgfirm.com)>; Tecuan Flores <[tflores@sbgfirm.com](mailto:tflores@sbgfirm.com)>; Bruce Slayden <[bslayden@sbgfirm.com](mailto:bslayden@sbgfirm.com)>; SGB Litigation <[litigation@sbgfirm.com](mailto:litigation@sbgfirm.com)>; Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>; Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Lee, Yvonne <[Yvonne.Lee@wilmerhale.com](mailto:Yvonne.Lee@wilmerhale.com)>; Horn, Steven J <[Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)>  
**Subject:** IPR2021-01229 - request to extend times for serving and filing hearing demonstratives

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Honorable Board,

Due to scheduling conflicts, the parties jointly respectfully request an extension of the demonstrative service and filing due dates under the Order Setting Oral Argument (Paper 92, 2) by three business days each, to October 20 and October 24 respectively.

The parties are available for a call if desired.

Respectfully,

Kenneth Weatherwax

**USPTO0053**

Counsel for Patent Owner

**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile:** 310.936.3088



**From:** [Director\\_PTABDecision\\_Review](#)  
**To:** [Truman Fenton](#); [Director\\_PTABDecision\\_Review](#); [Trials](#)  
**Cc:** [ben.fernandez@wilmerhale.com](#); [Cavanaugh, David](#); [yvonne.lee@wilmerhale.com](#); [Horn, Steven J](#); [Bruce Slayden](#); [Tecuan Flores](#); [bredjaian@irell.com](#); [weatherwax@lowensteinweatherwax.com](#); [smith@lowensteinweatherwax.com](#); [rose@lowensteinweatherwax.com](#); [hsieh@lowensteinweatherwax.com](#); [hendifar@lowensteinweatherwax.com](#); [maloney@lowensteinweatherwax.com](#); [linger@lowensteinweatherwax.com](#); [VLSI\\_IPRs@lowensteinweatherwax.com](#)  
**Subject:** RE: IPR2021-01229 – Urgent request to seal Paper 65 in view of a protective order violation  
**Date:** Friday, August 19, 2022 5:50:39 PM

---

Counsel,

Petitioner-PQA's counsel requested that Paper 65 be removed from public availability for violating the Modified Default Protective Order. To address this issue, the Board designated Papers 65 and 52 as confidential materials viewable by the Board and Parties only.

The parties are required to meet and confer as to the required redactions for any confidential briefs, and to provide agreed-upon redacted briefs by August 26, 2022.

---

**From:** Truman Fenton <tfenton@sbgfirm.com>  
**Sent:** Friday, August 19, 2022 5:47 PM  
**To:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>; Trials <Trials@USPTO.GOV>  
**Cc:** ben.fernandez@wilmerhale.com; Cavanaugh, David <david.cavanaugh@wilmerhale.com>; yvonne.lee@wilmerhale.com; Horn, Steven J <steven.horn@wilmerhale.com>; Bruce Slayden <bslayden@sbgfirm.com>; Truman Fenton <tfenton@sbgfirm.com>; Tecuan Flores <tflores@sbgfirm.com>; bredjaian@irell.com; weatherwax@lowensteinweatherwax.com; smith@lowensteinweatherwax.com; rose@lowensteinweatherwax.com; hsieh@lowensteinweatherwax.com; hendifar@lowensteinweatherwax.com; maloney@lowensteinweatherwax.com; linger@lowensteinweatherwax.com; VLSI\_IPRs@lowensteinweatherwax.com  
**Subject:** IPR2021-01229 – Urgent request to seal Paper 65 in view of a protective order violation

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Dear Director and Board,

At approximately 4pm ET today, Friday 8/19, Patent Owner VLSI filed Paper 65 in IPR2021-01229 purporting to be a redacted and public version of its response to the Director's order initiating Director Review. Paper 65 contains material designated under the Modified Default Protective Order (Ex. 3003, entered by Paper 36) that should not have been filed publicly. Counsel for petitioner PQA attempted to call counsel for Patent Owner VLSI and emailed the same, but was unable to obtain a response.

Petitioner provides two clear examples for reference only. First, each sentence but the last of the second paragraph of page 6 continuing to page 7 report or characterize the substance of documents

**USPTO0055**

designated CONFIDENTIAL under the Protective Order and should have been redacted in full. Second, the first sentence of the first full paragraph on page 3 has two characters redacted when the unredacted portion of the sentence discloses the substance of a document designated CONFIDENTIAL under the Protective Order. The sentence should have been redacted in full.

Petitioner PQA requests the immediate sealing of Paper 65 until the parties have had an opportunity to resolve the apparent protective order violation.

Truman H. Fenton

**sgb | SLAYDEN GRUBERT BEARD PLLC**

401 Congress Avenue, Suite 1650  
Austin, Texas 78701  
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Mobile 512.468.7623  
[www.sgbfirm.com](http://www.sgbfirm.com)

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**USPTO0056**



**From:** [Trials](#)  
**To:** [Nicholas Yakoobian](#); [Trials](#)  
**Cc:** [bbanner@sgbfirm.com](#); [bslayden@sgbfirm.com](#); [tfenton@sgbfirm.com](#); [tflores@sgbfirm.com](#); [Ben.Fernandez@wilmerhale.com](#); [David.Cavanaugh@wilmerhale.com](#); [Yvonne.Lee@wilmerhale.com](#); [Steven.Horn@wilmerhale.com](#); [Nathan Lowenstein](#); [Colette Woo](#); [Redjaian, Babak](#); [DSLusarczyk@irell.com](#); [Kenneth Weatherwax](#)  
**Subject:** RE: IPR2021-01229: Patent Owner's request to file revised versions of, and expunge, Paper 88 in view of asserted protective order material  
**Date:** Thursday, September 29, 2022 8:11:04 AM

---

Counsel:

Patent Owner's request is authorized.

Thank you,

Megan Carlson  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

---

**From:** Nicholas Yakoobian <Yakoobian@lowensteinweatherwax.com>  
**Sent:** Wednesday, September 28, 2022 5:54 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** [bbanner@sgbfirm.com](#); [bslayden@sgbfirm.com](#); [tfenton@sgbfirm.com](#); [tflores@sgbfirm.com](#); [Ben.Fernandez@wilmerhale.com](#); [David.Cavanaugh@wilmerhale.com](#); [Yvonne.Lee@wilmerhale.com](#); [Steven.Horn@wilmerhale.com](#); [Nathan Lowenstein](#) <lowenstein@lowensteinweatherwax.com>; [Colette Woo](#) <woo@lowensteinweatherwax.com>; [Redjaian, Babak](#) <bredjaian@irell.com>; [DSLusarczyk@irell.com](#); [Kenneth Weatherwax](#) <weatherwax@lowensteinweatherwax.com>  
**Subject:** IPR2021-01229: Patent Owner's request to file revised versions of, and expunge, Paper 88 in view of asserted protective order material

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Honorable Board,

Yesterday Patent Owner filed a motion in this proceeding (Paper 88), which includes an exhibit list that, on pages ix and x, contains material that petitioner Patent Quality Assurance LLC asserts to be confidential under the protective order in this proceeding. In light of PQA's position, Patent Owner respectfully requests authorization to file two revised versions of yesterday's motion:

- (i) a sealed version, which modifies the motion only by adding a

**USPTO0057**

statement on the cover

page that it contains asserted PROTECTIVE ORDER MATERIAL, in accordance with the protective order's procedures; and,

(ii) a public version, which modifies the sealed version only by 1) striking through the

PROTECTIVE ORDER MATERIAL language on the cover and 2) redacting the assertedly confidential material on pages ix-x.

As part of this request Patent Owner further requests that the originally-filed motion be expunged or sealed.

Petitioner PQA does not oppose this request.

Respectfully submitted,

Nick Yakoobian o/b/o

Kenneth Weatherwax

Counsel for Patent Owner VLSI Technology LLC

**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile: 310.936.3088**

**From:** [Director\\_PTABDecision\\_Review](#)  
**To:** [Truman Fenton](#); [Director\\_PTABDecision\\_Review](#); [Trials](#)  
**Cc:** [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); [Fernandez, Ben](#); [Cavanaugh, David](#); [Lee, Yvonne](#); [Horn, Steven J](#); [Bruce Slayden](#); [Tecuan Flores](#); [Brian Banner](#); [SGB Litigation](#)  
**Subject:** RE: IPR2021-01229: Urgent – Request to Seal Exhibits 2084 and 2085  
**Date:** Tuesday, August 23, 2022 12:37:37 PM

---

Counsel,

Petitioner-PQA's counsel requests that Exhibits 2084 and 2085 be removed from public availability and that VLSI does not oppose. The Board has designated Exhibits 2084 and 2085 as confidential materials viewable by the Board and Parties only.

The parties are required to meet and confer by August 26, 2022 as to whether these documents will remain sealed.

Thank you.

---

**From:** Truman Fenton <tfenton@sgbfirm.com>  
**Sent:** Tuesday, August 23, 2022 11:47 AM  
**To:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>; Trials <Trials@USPTO.GOV>  
**Cc:** Redjaian, Babak <bredjaian@irell.com>; weatherwax@lowensteinweatherwax.com; VLSI\_IPRs@lowensteinweatherwax.com; Fernandez, Ben <Ben.Fernandez@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Lee, Yvonne <Yvonne.Lee@wilmerhale.com>; Horn, Steven J <Steven.Horn@wilmerhale.com>; Bruce Slayden <bslayden@sgbfirm.com>; Tecuan Flores <tflores@sgbfirm.com>; Brian Banner <bbanner@sgbfirm.com>; SGB Litigation <litigation@sgbfirm.com>  
**Subject:** IPR2021-01229: Urgent – Request to Seal Exhibits 2084 and 2085

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PQA requests the Director (or Board) change the public availability of Exhibits 2084 and 2085 to "Board and Parties Only" until the parties have had an opportunity to resolve certain Protective Order issues, which the parties expect to be resolved by August 26.

Counsel for PQA discussed this request with counsel for VLSI and has been told that VLSI does not oppose this request.

Truman H. Fenton

**sgb | SLAYDEN GRUBERT BEARD PLLC**

401 Congress Avenue, Suite 1650  
Austin, Texas 78701  
[M] 512.468.7623

**USPTO0059**

[O] 512.402.3572

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**USPTO0060**

**From:** [Fernandez, Ben](#)  
**To:** [Trials](#)  
**Cc:** [Cavanaugh, David](#); [Andrew Oliver](#); [Redjaian, Babak](#); [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); [Vinay Joshi](mailto:Vinay_Joshi); [litigation@sgbfirm.com](mailto:litigation@sgbfirm.com); [bslayden@sgbfirm.com](mailto:bslayden@sgbfirm.com)  
**Subject:** RE: Joinder Conference | IPR2022-00366 Motion for Joinder with IPR2021-01064  
**Date:** Tuesday, February 1, 2022 11:50:36 AM

---

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Dear Honorable Board,

After further conferring with OpenSky and VLSI, as well as the new joinder petitioner in IPR2022-00480, Patent Quality Assurance, LLC (“PQA”), Intel writes to inform the Board that counsel for each party is available for a joinder conference this week on Thursday, February 3, from 1-3 or 4-5 Eastern time.

Respectfully,

**Ben Fernandez | WilmerHale**

1225 Seventeenth Street, Suite 2600  
Denver, CO 80202 USA  
+1 720 274 3163 (t)  
+1 720 274 3133 (f)  
[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Friday, January 14, 2022 1:17 PM  
**To:** Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>; Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); Vinay Joshi <[vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com)>  
**Subject:** RE: Joinder Conference | IPR2022-00366 Motion for Joinder with IPR2021-01064

**EXTERNAL SENDER**

We do not have a panel for this case. Please check back in a couple of weeks.  
Thank you,

**USPTO0061**



Maria King  
Deputy Chief Clerk for Trials  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
703-756-1288

---

**From:** Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>  
**Sent:** Friday, January 14, 2022 3:05 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>; Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); Vinay Joshi <[vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com)>  
**Subject:** RE: Joinder Conference | IPR2022-00366 Motion for Joinder with IPR2021-01064

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Dear Honorable Board,

After further conferring with OpenSky and VLSI, Intel writes to inform the Board that counsel for each party is available for a joinder conference on Thursday, January 20 or Friday, January 21, in each case after 1:00pm Eastern time.

Respectfully,

**Ben Fernandez | WilmerHale**  
1225 Seventeenth Street, Suite 2600  
Denver, CO 80202 USA  
+1 720 274 3163 (t)  
+1 720 274 3133 (f)  
[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

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---

**From:** Fernandez, Ben <[Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com)>  
**Sent:** Thursday, December 30, 2021 5:05 PM  
**To:** [trials@uspto.gov](mailto:trials@uspto.gov)

**USPTO0062**

**Cc:** Cavanaugh, David <[David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com)>; Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>; Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; [weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com); [VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com); Vinay Joshi <[vjoshi@atwiplaw.com](mailto:vjoshi@atwiplaw.com)>

**Subject:** Joinder Conference | IPR2022-00366 Motion for Joinder with IPR2021-01064

Dear Honorable Board,

On December 27, 2021, Intel Corporation (“Intel”) filed a petition in IPR2022-00366 along with a motion requesting joinder with instituted IPR2021-01064 filed by OpenSky Industries, LLC (“OpenSky”) challenging certain claims of U.S. Pat. No. 7,725,759.

Pursuant to page 76 of the Consolidated Trial Practice Guide, Intel writes to arrange a conference call with the panel, petitioner, and patent owner of the first proceeding to timely manage proceedings.

Intel respectfully requests that the Board set a call at its earliest convenience and can be available at any time suitable to the Board. OpenSky has indicated that it is available on January 4 after 1:00pm ET or January 11 after 1:00 pm ET. Counsel for Patent Owner VLSI Technology LLC has stated that their first availability is January 11 after 1:00pm ET.

Respectfully,

**Ben Fernandez | WilmerHale**

1225 Seventeenth Street, Suite 2600

Denver, CO 80202 USA

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+1 720 274 3133 (f)

[ben.fernandez@wilmerhale.com](mailto:ben.fernandez@wilmerhale.com)

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**USPTO0063**

**From:** [Fernandez, Ben](#)  
**To:** [Director PTABDecision Review](#)  
**Cc:** [Brian Banner](#); [Trials](#); [Redjaian, Babak](#); [VLSI](#); [Bruce Slayden](#); [Tecuan Flores](#); [Truman Fenton](#); [Cavanaugh, David](#); [Lee, Yvonne](#); [Horn, Steven J](#); [Nathan Lowenstein](#); [Colette Woo](#); [Slusarczyk, Dominik](#); [Wen, Charlotte](#); ["aheinrich@irell.com"](#); [Kenneth Weatherwax](#)  
**Subject:** RE: PQA, LLC et al. v. VLSI Tech. LLC, IPR2021-01229 (PTAB): PQA's Request Pursuant to Paper 35  
**Date:** Wednesday, August 17, 2022 10:38:46 PM

---

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Director Vidal,

We represent Petitioner Intel in IPR2021-01064 and IPR2021-01229 and write in response to VLSI's request to the Director regarding in camera review pursuant to the Director's July 7, 2022 Discovery Order.

Intel is not a party to the dispute between VLSI and PQA regarding PQA's request for in camera review of documents on VLSI's privilege log and has not taken a position on VLSI's request for guidance to the Director. Intel has not requested in camera review of any documents in either IPR2021-01064 or IPR2021-01229.

VLSI has itself served unsupported and overbroad requests for in camera review of documents on Intel's privilege log, and the grounds asserted for many of VLSI's objections to PQA's requests apply with equal force to VLSI's requests of Intel. VLSI has failed to provide any sufficient basis for challenging the privileges and protections asserted by Intel in its privilege log. Further, VLSI is seeking in camera review of materials related to the merits of the patentability challenges, which are not relevant to the subject matter of the Director's review. Intel raised these concerns with VLSI on August 15. On August 16, VLSI withdrew one category of requests in IPR2016-01064, but refused to withdraw its other requests in that proceeding or its requests in IPR2021-01229.

Intel has fully and completely complied with the Director's order. However, VLSI's overbroad requests implicate serious issues of privilege and waiver. Intel believes that these requests have raised important questions regarding the in camera review process in these proceedings, including the purpose and scope of review, the proper threshold for seeking review, protections against waiver, and relevance that should be addressed by the Director before submission of documents for in camera review in IPR2021-01064 and IPR2021-01229. Intel intends to submit objections to the Director by August 18 and respectfully submits that a tolling of the deadline to submit documents for in camera review in each proceeding is appropriate to address VLSI's objections and Intel's forthcoming objections.

Intel met and conferred with VLSI on August 17. On that call, Intel indicated to VLSI that it intended to submit objections to VLSI's requests for in camera review and raised its proposal for tolling the deadline. VLSI indicated that it opposes Intel's requests and would not agree to withdraw its outstanding requests for in camera review.

Intel can be available to discuss at the Director's or the Board's convenience.

Respectfully submitted,

**Ben Fernandez | WilmerHale**

1225 Seventeenth Street, Suite 2600

Denver, CO 80202 USA

+1 720 274 3163 (t)

**USPTO0064**



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---

**From:** Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>  
**Sent:** Tuesday, August 16, 2022 9:05 PM  
**To:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>  
**Cc:** Brian Banner <bbanner@sgbfirm.com>; Trials@uspto.gov; Redjaian, Babak <BRedjaian@irell.com>; VLSI <VLSI\_IPRs@lowensteinweatherwax.com>; Bruce Slayden <bslayden@sgbfirm.com>; Tecuan Flores <tflores@sgbfirm.com>; Truman Fenton <tfenton@sgbfirm.com>; Fernandez, Ben <Ben.Fernandez@wilmerhale.com>; Cavanaugh, David <David.Cavanaugh@wilmerhale.com>; Lee, Yvonne <Yvonne.Lee@wilmerhale.com>; Horn, Steven J <Steven.Horn@wilmerhale.com>; Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; Colette Woo <woo@lowensteinweatherwax.com>; Slusarczyk, Dominik <DSlusarczyk@irell.com>; Wen, Charlotte <cwen@irell.com>; 'aheinrich@irell.com' <AHeinrich@irell.com>  
**Subject:** FW: PQA, LLC et al. v. VLSI Tech. LLC, IPR2021-01229 (PTAB): PQA's Request Pursuant to Paper 35

**EXTERNAL SENDER**

Director Vidal:

VLSI writes to seek guidance regarding PQA's request (see below) for in camera review of VLSI's privilege-logged communications, under circumstances that were likely not anticipated at the time of the Director's July 7, 2022 Discovery Order. VLSI has met and conferred and requested that PQA withdraw their request for in camera review. PQA has stated that it disagrees and does not withdraw its request. Intel has not provided its position.

The Order required each party to produce a privilege log, and permitted the parties to identify documents they assert "the Director should review in camera." Paper 35, 11. On August 4, the deadline for the Director's mandated discovery, VLSI and Intel both produced detailed privilege logs. As VLSI has already shown in its own in camera review communication concerning PQA, Paper 43, 3-4, PQA did not produce a privilege log, only a limited work product redaction log. PQA's limited log failed to identify any communications between PQA and its counsel, or assert attorney-client privilege as to any document. *Id.* PQA also failed to produce many mandated categories of documents, as described further below. Despite PQA's failure to comply with the Director's order, PQA has ironically now identified for in camera review all but six of the 266 communications

**USPTO0065**

itized on VLSI's privilege log. See Email from B. Banner, below.

PQA's request is improper for multiple reasons.

**First**, PQA has made no attempt to assert that VLSI's logged communications are not privileged or are otherwise improperly withheld. Nor could PQA reasonably do so—every communication is between VLSI and its counsel, and every entry is supported by a proper description of the basis for VLSI's privilege assertion.

**Second**, PQA requests that the Director review VLSI's communications in camera "to see if there is evidence" to support or refute various arguments being made in the underlying proceedings, *i.e.*, to use VLSI's privileged communications in a factfinding exercise rather than to assess the propriety of suspect privilege claims. See, *e.g.*, *Billy Goat IP LLC v. Billy Goat Chip Co. LLC*, No. 17-CV-9154, 2019 WL 10250940, at \*4 (N.D. Ill. Feb. 1, 2019) ("Federal courts should certainly not be in the business of always conducting in camera reviews every time a party moves to compel documents identified on a privilege log. Privilege logs are the means by which the opposing party and the Court identify the basis of the privilege and ascertain whether the privilege is properly invoked without the need to go further."); *Kerr v. U.S. Dist. Ct. for the N.D. of Cal.*, 426 U.S. 394, 404 (1976) (purpose of in camera review is to provide an "informed determination by the district court" of whether a privilege applies); *Jordan v. U.S. Dep't of Labor*, 273 F. Supp. 3d 214, 234 (D.D.C. 2017) ("ALJs are judicial actors who, in the matters pending before them, must make determinations on the propriety of privilege claims asserted by the parties before them ... [and may use] in camera review as a useful tool in making those determinations. If submission of information to such review jettisoned privilege, the review would have no purpose....").

**Third**, the Director's Order was directed in no small part toward discovering information about **PQA**, not VLSI. See Paper 35, 9-10 ("**PQA** shall provide to other parties in this proceeding: ...") (emphasis added). Yet PQA failed to produce any internal communications involving any of its still-identified members (as required by category (i)); no documents regarding PQA's "business plan" or "funding" and no documents regarding "future allocation of any of its profits" (as required by category (ii)); and no "documents and communications relating to any real party in interest" (as required by category (vi)). See Paper 35, 9-10. PQA did not even produce its communications with VLSI. Under these circumstances, PQA's request for in camera review of nearly all of VLSI's properly logged, plainly privileged communications should not be countenanced.

VLSI requests guidance from the Director as to whether it should submit any or all of the 260 logged communications for in camera review. To be clear, VLSI has prepared copies of the logged communications indiscriminately listed by PQA and, if ordered, will make those available to the Director by the deadline. VLSI respectfully requests the Director's guidance as to how to proceed.

Respectfully submitted to the Director,

Kenneth Weatherwax  
Counsel for Patent Owner VLSI Technology, LLC



**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile:** 310.936.3088

---

**From:** Brian Banner <[bbanner@sgbfirm.com](mailto:bbanner@sgbfirm.com)>

**Sent:** Thursday, August 11, 2022 8:57 PM

**To:** [Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov)

**Cc:** Redjaian, Babak <[BRedjaian@irell.com](mailto:BRedjaian@irell.com)>; Kenneth Weatherwax <[weatherwax@lowensteinweatherwax.com](mailto:weatherwax@lowensteinweatherwax.com)>; VLSI <[VLSI\\_IPRs@lowensteinweatherwax.com](mailto:VLSI_IPRs@lowensteinweatherwax.com)>; Bruce Slayden <[bslayden@sgbfirm.com](mailto:bslayden@sgbfirm.com)>; Tecuan Flores <[tflores@sgbfirm.com](mailto:tflores@sgbfirm.com)>; Truman Fenton <[tfenton@sgbfirm.com](mailto:tfenton@sgbfirm.com)>; [Ben.Fernandez@wilmerhale.com](mailto:Ben.Fernandez@wilmerhale.com); [David.Cavanaugh@wilmerhale.com](mailto:David.Cavanaugh@wilmerhale.com); [Yvonne.Lee@wilmerhale.com](mailto:Yvonne.Lee@wilmerhale.com); [Steven.Horn@wilmerhale.com](mailto:Steven.Horn@wilmerhale.com)

**Subject:** PQA, LLC et al. v. VLSI Tech. LLC, IPR2021-01229 (PTAB): PQA's Request Pursuant to Paper 35

Dear Director Vidal,

PQA maintains its objections to the Director's orders as filed in Exhibit 1039 and nothing herein is intended to constitute or shall be deemed a waiver or curtailment of those objections. Pursuant to the Director's Order (Paper 35 at 11), however, and to avoid waiving its right under the Director's orders to request Director review of materials on VLSI's privilege log, PQA respectfully requests in camera review of certain VLSI documents.

PQA believes the Director should review the following documents on VLSI's privilege log:

- Entries 1-249 (from first mention in log of "settlement" on 7/8/21 to 1/25/2022 (day before institution decision)): to see if there is evidence of VLSI manipulating the proceedings by inducing settlement discussions with PQA and entering a nondisclosure agreement with the intent of using those discussions as purported evidence of PQA's alleged abuse of process, and to see whether VLSI's breach of the parties' NDA was premeditated and/or intentional.
- Entries 250-259 (from 2/1/2022 to 2/23/2022 (day of Ivey email, Ex. 2029 in IPR2022-00645)): to see if there is evidence of VLSI suggesting, internally or with its attorneys, an agreement between VLSI and OpenSky that includes sabotaging the '759 proceeding, e.g., by not producing the expert witness for cross examination.

PQA further notes VLSI's privilege log does not contain entries for the timeframe 2/25/2022 through 8/1/2022, entries for internal communications of VLSI, Fortress Investment Group, and/or other VLSI affiliates, or entries for communications solely among VLSI's attorneys. During this time, VLSI sent numerous emails to the POP panel and to PQA's attorneys and undoubtedly communicated internally and with its counsel regarding at least topics iii and iv (Paper 35 at 9). For example, during this timeframe, VLSI violated the terms of the NDA between PQA and VLSI by providing Confidential Information under the NDA (including information regarding the parties' settlement discussions) to the POP panel and attaching Confidential Information to its Patent Owner Response (Ex. 2029). Thus, these withheld documents may contain evidence that VLSI's breach of the parties' NDA was

**USPTO0067**

premeditated and/or intentional and that VLSI acted fraudulently in its dealings with PQA relating to this proceeding.

Warm regards,

Brian C. Banner

**sgb** | **SLAYDEN GRUBERT BEARD** PLLC

401 Congress Ave, Ste 1650 | Austin, TX 78701 | USA

[O] 512.402.3569 | [C] 512.468.6297 | [sgbfirm.com](http://sgbfirm.com)

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**USPTO0068**

**From:** Bonilla, Jacqueline  
**Sent:** Mon, 3 Oct 2022 20:45:58 +0000  
**To:** Ahn, James (Federal); Kiernan, Leslie (Federal)  
**Cc:** Didiuk, Lauren; Zecher, Dede; Bidel-Niyat, Shirin; Berdan, David; Duckworth, Cara; McLaren, Ellen  
**Subject:** Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Dear James and Leslie,

Director Vidal will issue a decision on Director review in a high-profile Patent Trial and Appeal Board (PTAB) case involving a patent also at issue in a large jury verdict in district court. The case is *OpenSky Industries LLC v. VLSI Technology LLC*, IPR2021-01604.

(b)(5)

We expect some notable press in relation to this decision, as prior articles have discussed it on numerous occasions, and several Senators have asked questions about the case and the ability of the Office to issue sanctions for abuse of process. **This decision will issue tomorrow, October 4, 2022.** Please let us know if you have any questions or would like to discuss.

Best regards,  
Jackie

**Jacqueline D. Wright Bonilla**

Deputy Chief Administrative Patent Judge & Senior Legal Advisor

U.S. Patent and Trademark Office

Office: (571) 272-4775

Email: [jacqueline.bonilla@uspto.gov](mailto:jacqueline.bonilla@uspto.gov)



**USPTO0069**

**From:** Bonilla, Jacqueline  
**Sent:** Tue, 4 Oct 2022 13:48:46 +0000  
**To:** Feliz, Susie; Ahn, James (Federal); Didiuk, Lauren; Kiernan, Leslie (Federal); Caplin, Brittany (Detailee)  
**Cc:** Zecher, Dede; Bidel-Niyat, Shirin; Berdan, David; Duckworth, Cara; McLaren, Ellen; Choksi, Rachit (Federal)  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Hi all,

I know this goes without saying but, in an abundance of caution, the issuance of a Director review decision (or any decision of PTAB), or even the summary of one, is confidential and pre-decisional until the decision actually issues. It will issue later today, but should remain confidential until then.

Thank you!!  
Jackie

---

**From:** Feliz, Susie (Federal) (b)(6)  
**Sent:** Tuesday, October 4, 2022 9:35 AM  
**To:** Ahn, James (Federal) (b)(6); Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>; Didiuk, Lauren (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detailee) (b)(6)  
**Cc:** Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Berdan, David <David.Berdan@uspto.gov>; Duckworth, Cara <Cara.Duckworth@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Choksi, Rachit (Federal) (b)(6)  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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+Rachit



**Susie Feliz (She/her)**

Assistant Secretary  
for Legislative and Intergovernmental Affairs

---

US Department of Commerce  
1401 Constitution Ave, NW  
Washington, DC 20230  
(202) 482-3663 (Office)

(b)(6)

(b)(6)

**USPTO0070**



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**From:** Ahn, James (Federal) (b)(6)  
**Sent:** Monday, October 3, 2022 5:20 PM  
**To:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>; Didiuk, Lauren (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detaillee) (b)(6); Feliz, Susie (Federal) (b)(6)  
**Cc:** Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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PTAB stands for Patent Trial and Appeal Board, which is housed at PTO.

Basically, IPR is an administrative proceeding before the PTAB to challenge a patent.

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**From:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Sent:** Monday, October 3, 2022 5:18 PM  
**To:** Didiuk, Lauren (Federal) (b)(6); Ahn, James (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detaillee) (b)(6); Feliz, Susie (Federal) (b)(6)  
**Cc:** Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Hi Lauren,

We had flagged for James earlier, but not Brittany or Susie, so thank you for doing that now.

Best regards,  
Jackie

---

**From:** Didiuk, Lauren (Federal) (b)(6)  
**Sent:** Monday, October 3, 2022 5:07 PM  
**To:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>; Ahn, James (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detaillee) (b)(6); Feliz, Susie (Federal) (b)(6)



**Cc:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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Thank you, Jaclyn. Has PTO already flagged this for [@Caplin, Brittany \(Detailee\)](#) in OPA and [@Feliz, Susie \(Federal\)](#) in OLIA?

Lauren Didiuk  
Chief of Staff and Senior Counsel  
to the General Counsel  
U.S. Department of Commerce  
[REDACTED]

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**From:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>

**Sent:** Monday, October 3, 2022 4:46 PM

**To:** Ahn, James (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6)

**Cc:** Didiuk, Lauren (Federal) (b)(6); Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Subject:** Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Dear James and Leslie,

Director Vidal will issue a decision on Director review in a high-profile Patent Trial and Appeal Board (PTAB) case involving a patent also at issue in a large jury verdict in district court. The case is *OpenSky Industries LLC v. VLSI Technology LLC*, IPR2021-01604.

(b)(5) Delib Proc Priv

**USPTO0072**

We expect some notable press in relation to this decision, as prior articles have discussed it on numerous occasions, and several Senators have asked questions about the case and the ability of the Office to issue sanctions for abuse of process. **This decision will issue tomorrow, October 4, 2022.** Please let us know if you have any questions or would like to discuss.

Best regards,  
Jackie

**Jacqueline D. Wright Bonilla**

Deputy Chief Administrative Patent Judge & Senior Legal Advisor

U.S. Patent and Trademark Office

Office: (571) 272-4775

Email: [jacqueline.bonilla@uspto.gov](mailto:jacqueline.bonilla@uspto.gov)



**USPTO0073**

**From:** Ahn, James (Federal)  
**Sent:** Mon, 3 Oct 2022 21:22:05 +0000  
**To:** Bonilla, Jacqueline  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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Your welcome!

---

**From:** Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>  
**Sent:** Monday, October 3, 2022 5:21 PM  
**To:** Ahn, James (Federal) (b)(6)  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Thanks James!

---

**From:** Ahn, James (Federal) (b)(6)  
**Sent:** Monday, October 3, 2022 5:20 PM  
**To:** Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>; Didiuk, Lauren (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detaillee) (b)(6); Feliz, Susie (b)(6)  
**Cc:** Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Berdan, David <David.Berdan@uspto.gov>; Duckworth, Cara <Cara.Duckworth@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>  
**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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---

**From:** Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>  
**Sent:** Monday, October 3, 2022 5:18 PM  
**To:** Didiuk, Lauren (Federal) (b)(6); Ahn, James (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detaillee) (b)(6); Feliz, Susie (Federal)

**USPTO0074**



(b)(6)

**Cc:** Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Hi Lauren,

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Best regards,  
Jackie

---

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**To:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>; Ahn, James (Federal) (b)(6); Kiernan, Leslie (Federal) (b)(6); Caplin, Brittany (Detailee) (b)(6); Feliz, Susie (b)(6)

**Cc:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Subject:** RE: Director review decision ordering sanctions for inter partes review (IPR) abuse of process

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Thank you, Jaclyn. Has PTO already flagged this for [@Caplin, Brittany \(Detailee\)](#) in OPA and [@Feliz, Susie \(Federal\)](#) in OLIA?

Lauren Didiuk  
Chief of Staff and Senior Counsel  
to the General Counsel  
U.S. Department of Commerce  
Phone (b)(6)

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**USPTO0075**

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**From:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>

**Sent:** Monday, October 3, 2022 4:46 PM

**To:** Ahn, James (Federal) <(b)(6)>; Kiernan, Leslie (Federal) <(b)(6)>

**Cc:** Didiuk, Lauren (Federal) <(b)(6)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Subject:** Director review decision ordering sanctions for inter partes review (IPR) abuse of process

Dear James and Leslie,

Director Vidal will issue a decision on Director review in a high-profile Patent Trial and Appeal Board (PTAB) case involving a patent also at issue in a large jury verdict in district court. The case is *OpenSky Industries LLC v. VLSI Technology LLC*, IPR2021-01604.

(b)(5) Delib Proc Priv

We expect some notable press in relation to this decision, as prior articles have discussed it on numerous occasions, and several Senators have asked questions about the case and the ability of the Office to issue sanctions for abuse of process. **This decision will issue tomorrow, October 4, 2022.** Please let us know if you have any questions or would like to discuss.

Best regards,  
Jackie

**Jacqueline D. Wright Bonilla**

Deputy Chief Administrative Patent Judge & Senior Legal Advisor  
U.S. Patent and Trademark Office  
Office: (571) 272-4775  
Email: [jacqueline.bonilla@uspto.gov](mailto:jacqueline.bonilla@uspto.gov)



**USPTO0076**



**From:** Ladino, Marie  
**Sent:** Wed, 14 Dec 2022 14:47:05 +0000  
**To:** DepSecBriefingBook  
**Cc:** Twitty, Anthony; Houser, Robert C.; Ramdat, Grace; Zecher, Dede; Bidel-Niyat, Shirin; McLaren, Ellen; Baily, Shannon; DManners-weber@doc.gov  
**Subject:** Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, December 16  
**Attachments:** DepSec Meeting with USPTO Director Vidal - December 16 2022 - final.docx

Good morning,

Attached please find the agenda for Deputy Secretary Graves's upcoming meeting with USPTO Director Kathi Vidal, scheduled for Friday, December 16. The USPTO's OGC has cleared the agenda. If you have questions or need any additional information, please let me know.

Thank you,  
Marie Ladino



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**USPTO0077**

**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**CONTACT:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182

**DATE:** Friday, December 16, 2022

**REQUESTED BY:** Requested by Deputy Secretary Graves as a regular check-in regarding USPTO initiatives

**LOCATION:** Virtual

**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO

**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:
  - Cancer Moonshot Expedited Examination Pilot Program (4 minutes)
    - To further accelerate innovation in the health and medical fields, on December 8 the USPTO announced the upcoming launch of the Cancer Moonshot Expedited Examination Pilot Program. The new program replaces the Cancer Immunotherapy Pilot Program, which was implemented in 2016 and expedited examination for eligible patent applications pertaining to methods of treating a cancer using immunotherapy. The new program broadens the scope of qualifying technologies. It will begin on February 1, 2023.
  - U.S.-Africa Business Forum (4 minutes)
    - On December 14, Director Vidal attended the U.S.-Africa Business Forum and provided remarks on the importance of protecting IP. The event was co-hosted by the National Black Chamber of Commerce and the Global Diversity Export Initiative of the International Trade Administration. (b)(5)
  - (b)(5)
    - (b)(5)
  - (b)(5)
    - (b)(5)

(b)(5)

## BACKGROUND

- You last met with Director Vidal on November 4.
- Due-outs from that meeting were:
  - (b)(5)
    - (b)(5)
  - Update on the *OpenSky* case
    - Director Vidal will provide an update on Patent Trial and Appeal Board matters, including the *OpenSky* case.
  - (b)(5)
    - (b)(5)

## PARTICIPANTS

### *USPTO*

- Shirin Bidel-Niyat, Chief of Staff

### *Office of Policy and Strategic Planning*

- James Ahn, Senior Policy Advisor

### *Office of the Deputy Secretary*

- Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

## ATTACHMENT LIST

- (1) Principals' Biweekly Report

**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029

## CLEARED BY

- Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO
- Shirin Bidel-Niyat, Chief of Staff
- Cordelia (Dede) Zecher, Chief Advisor
- Ellen McLaren, Director, Office of Governmental Affairs
- David Shewchuk, Deputy General Counsel for General Law

**From:** Ladino, Marie  
**Sent:** Tue, 14 Jun 2022 21:29:17 +0000  
**To:** Vidal, Kathi  
**Cc:** Zecher, Dede; Siridavong, Minh; Ramdat, Grace; Bidel-Niyat, Shirin; Baily, Shannon  
**Subject:** For Your Review and Approval - Report for the Cabinet Secretary  
**Attachments:** USPTO Weekly Report 06152022 v.3.docx, USPTO Weekly Report 06082022 - final.docx

Hi Kathi,

Attached for your review and approval is this week's Report for the Cabinet Secretary. It covers events and updates from June 9-17. Dede, Shirin, and Dave Berdan have already reviewed the report. Please note that it's due to DOC by 7 p.m. on Wednesday. I've also attached last week's final report for reference. If you have any questions, please let me know.

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)

Tel: 571-270-3186

**USPTO0080**

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act



Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act



Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

**From:** Ladino, Marie  
**Sent:** Wed, 5 Oct 2022 13:58:44 +0000  
**To:** Ramdat, Grace; Mallari, Patricia; Bryan-Johnson, Hellen; Horner, Linda; Munasifi, Lena; McLaren, Ellen; Lashley-Johnson, Deborah; Bonilla, Jacqueline; Johnson, Anastasia  
**Cc:** Houser, Robert C.; Zecher, Dede; Baily, Shannon; Bidel-Niyat, Shirin; Corbin, Rhonda  
**Subject:** FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022 - feedback due by 2 p.m. today  
**Attachments:** USPTO Biweekly Report\_10.07.2022 v.2.pptx

Hello all,

Attached for your review is a draft of the Biweekly Report to the Secretary and Deputy Secretary for the week ending October 7. The report covers events and updates from September 26-October 21. Please take a look and let me know by 2 p.m. today if you have any edits or suggestions for additional content.

I've also included a draft of the email that will accompany the report below. I'll delete anything we don't need before sending.

Thank you,  
Marie

---

(b)(5)

**USPTO0091**



(b)(5)

Thank you,  
Marie Ladino



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act



**From:** Ladino, Marie  
**Sent:** Wed, 27 Jul 2022 13:54:08 +0000  
**To:** Bidel-Niyat, Shirin; Zecher, Dede; McLaren, Ellen  
**Subject:** FW: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29  
**Attachments:** 03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final w ML comments.docx

Hi Shirin, Dede, and Ellen,

James Ahn had a few comments on the agenda for Kathi's upcoming meeting with the Deputy Secretary. I've included some possible responses in the attached document. Please let me know how you'd like to proceed.

Thank you,  
Marie

---

**From:** Ladino, Marie <>  
**Sent:** Wednesday, July 27, 2022 8:52 AM  
**To:** 'DepSecBriefingBook' <(b)(6)>  
**Cc:** Twitty, Anthony <Anthony.Twitty@USPTO.GOV>; Houser, Robert C. <Robert.Houser@USPTO.GOV>; Ramdat, Grace <Grace.Ramdat@USPTO.GOV>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Baily, Shannon <Shannon.Baily1@USPTO.GOV>; (b)(6)  
**Subject:** Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

Good morning,

Attached please find the agenda and email attachment for Deputy Secretary Graves's upcoming meeting with USPTO Director Kathi Vidal, scheduled for Friday, July 29. The USPTO's OGC has cleared the agenda. If you have questions or need any additional information, please let me know.

Thank you,  
Marie Ladino



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**USPTO0097**

**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182  
**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029  
**DATE:** Friday, July 29, 2022  
**LOCATION:** Virtual  
**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO  
**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:

(b)(5) Delib Proc Priv; Draft

(b)(5) Delib Proc Priv; Draft

(b)(5) Delib Proc Priv; Draft

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

**From:** Kenneth Weatherwax  
**Sent:** Wed, 20 Jul 2022 01:30:30 +0000  
**To:** Director\_PTABDecision\_Review; Andrew Oliver; vjoshi@atwiplaw.com; Redjaian, Babak; Nathan Lowenstein; aheinrich@irell.com; VLSI; ben.fernandez@wilmerhale.com; david.cavanaugh@wilmerhale.com; steven.horn@wilmerhale.com  
**Subject:** RE: IPR2021-01064 - Petitioner expedited request for stay or extension

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Director Vidal:

Patent Owner opposes Petitioner OpenSky's *ex parte* request. If authorized, Patent Owner would be happy to respond to OpenSky's arguments.

Respectfully submitted,

Kenneth Weatherwax

**Kenneth Weatherwax | Lowenstein & Weatherwax LLP**

1016 Pico Boulevard

Santa Monica, California 90405

**Mobile:** 310.936.3088

---

**From:** Director\_PTABDecision\_Review <Director\_PTABDecision\_Review@uspto.gov>  
**Sent:** Tuesday, July 19, 2022 6:32 AM  
**To:** Andrew Oliver <aoliver@atwiplaw.com>; vjoshi@atwiplaw.com; Redjaian, Babak <BRedjaian@irell.com>; Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>; Nathan Lowenstein <lowenstein@lowensteinweatherwax.com>; aheinrich@irell.com; VLSI <VLSI\_IPRs@lowensteinweatherwax.com>; ben.fernandez@wilmerhale.com; david.cavanaugh@wilmerhale.com; steven.horn@wilmerhale.com  
**Subject:** FW: IPR2021-01064 - Petitioner expedited request for stay or extension

Counsel,

The parties are reminded that all parties must be copied on communications to the Office. The parties are also reminded that all requests must indicate whether the other parties oppose the requested relief.

Counsel for joined Petitioner Intel and Patent Owner VLSI shall respond to this email, within 24 hours, and indicate whether they support or oppose Petitioner OpenSky's request that the Director enter "an immediate order either (a) staying the 'Mandated Discovery' and briefing schedule in Paper No. 47 or (b) extending the deadlines set in Paper No. 47 by two months for each deadline." No argument is permitted.

**USPTO0100**



Thank you.

---

**From:** Andrew Oliver <[aoliver@atwiplaw.com](mailto:aoliver@atwiplaw.com)>

**Sent:** Friday, July 15, 2022 5:00 PM

**To:** Director\_PTABDecision\_Review <[Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov)>

**Subject:** IPR2021-01064 - Petitioner expedited request for stay or extension

**CAUTION:** This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Dear Director Vidal,

I am counsel for petitioner OpenSky Industries LLC (“OpenSky”) in IPR2021-01064 (*OpenSky Industries, LLC and Intel Corporation v. VLSI Technology LLC*).

We are in receipt of your order dated July 7, 2022 (Paper No. 47). At page 12-13 of that Order, the order authorizes parties to contact the Office related to the Director review proceeding by emailing [Director\\_PTABDecision\\_Review@uspto.gov](mailto:Director_PTABDecision_Review@uspto.gov). I correspond today in accord with that authorization. Because I was at trial in late June with mandatory post-trial briefing due this week as well as the Petitioner Reply in this proceeding, mandatory deadlines in other proceedings, and other pre-existing obligations, this is the first instance that I have had to contact the office regarding the order. I would welcome a telephone call with the Director or the Director’s office if that will help to resolve this request.

For the reasons set forth below (which OpenSky will brief more completely if needed), OpenSky requests an immediate order either (a) staying the “Mandated Discovery” and briefing schedule in Paper No. 47 or (b) extending the deadlines set in Paper No. 47 by two months for each deadline. OpenSky has not located any procedure in the PTAB Consolidated Trial Practice Guide for requesting such a stay and/or extension in a Director review, and accordingly seeks guidance from the Director as to the appropriate procedure. To the extent that an expedited stay or extension is not available from the Director, OpenSky wishes to know that as well, so that it may determine whether to file an appeal to the U.S. Court of Appeals for the Federal Circuit and seek an emergency stay from the Federal Circuit.

OpenSky notes that Director’s order starts from a false premise of being “faced with evidence of abuse ...”, when in actuality the email upon which the Director review is based is not properly evidence and is hearsay, potentially including hearsay within hearsay, insofar as the undersigned understands that it reflects OpenSky’s understanding of VLSI’s proposal to settle the proceeding, and does not suggest that either VLSI who proposed the conduct or OpenSky who responded to the proposal would actually reach an agreement or ultimately engage in any conduct. Nor does it suggest that any of the explored concepts would be counter to permitted patent office practice if it was ever implemented.

Based upon the apparent overreach of the Director’s order (Paper No. 47) and the false premise noted above, OpenSky seeks an immediate stay and/or an extension of 60 days in which to attempt to retain counsel who is familiar with Constitutional law, administrative procedure, and overreach of administrative agencies. OpenSky’s current counsel (including the undersigned) are patent office practitioners who are unfamiliar with the Constitutional law and administrative procedure issues raised by the Director’s order. While OpenSky’s counsel is unfamiliar with the issues presented by the order,

**USPTO0101**

other lawyers have commented that such issues may include, for example, violation of the Fourth Amendment by requiring onerous and extensive discovery unrelated to the merits of the proceeding and threatening sanctions (e.g., Paper No. 47 page 10 (“Any attempt to withhold evidence ... may ... be sanctionable.”)) if the parties attempt to object to or interpret the discovery consistently with the scope of the Director’s authority and/or relevance and potentially violation of the First Amendment. (For example, there is no standing requirement for filing an IPR petition, but the mandated discovery and briefing order seems to suggest that OpenSky’s ownership, business activities, and/or policy goals may bear on the propriety of the petition, even though none appears to be relevant.) Other lawyers have also suggested that the administrative procedure and overreach issues may also include the lack of authority cited in the Director’s order and ultimate lack of any authority from the Congress for the Director to seek the onerous and extensive discovery, threaten sanctions, or require briefing disclosing the extensive information sought. Current counsel (including the undersigned) is unfamiliar with such law and even with identification of the particular problematic issues that may be presented by the Director’s order. Thus, OpenSky will need time to consider such issues and potentially to seek counsel familiar with the issues.

The undersigned does not want to incur potential malpractice liability by attempting to provide expedited advice to a client in legal fields in which the undersigned has little knowledge and does not practice law.

OpenSky further notes that its counsel of record is the only counsel retained by or currently available to OpenSky to assist with the onerous and expedited discovery and briefing schedules set forth in the Director’s order (Paper No. 47). This counsel maintains full schedules of work obligations for their clients, including intervening obligations in patent office, district courts, and other matters. While the standard deadlines for the proceeding are docketed and appropriate time allocated for such proceedings, the timing of the Director’s order was unexpected and set forth exceedingly short (i.e., 14 day) deadlines for compliance. Neither attorney is able to shift any significant load to undertake the onerous and expedited discovery and briefing schedule required by the Director’s order. Nor is OpenSky able to obtain other counsel on an expedited basis to address the order.

Accordingly, OpenSky respectfully requests that the Director either issue an immediate stay or two month extension or, in the alternative, inform OpenSky of the procedure to be followed in requesting such relief in a Director review.

Respectfully submitted,  
Andrew T. Oliver

Andrew T. Oliver  
**Amin, Turocy & Watson, LLP**  
160 West Santa Clara Street, Suite 975  
San Jose, CA 95113

E: [aoliver@ATWiplaw.com](mailto:aoliver@ATWiplaw.com) T: (650) 618-6477  
Web: <http://thepatentattorneys.com/clev/staff-detail.php?pid=20>



**From:** Ladino, Marie  
**Sent:** Wed, 27 Jul 2022 12:28:46 +0000  
**To:** Bidel-Niyat, Shirin; Zecher, Dede  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

Thank you both!

---

**From:** Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>  
**Sent:** Tuesday, July 26, 2022 8:51 PM  
**To:** Ladino, Marie <Marie.Ladino@USPTO.GOV>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Shewchuk, David <David.Shewchuk@USPTO.GOV>; McLaren, Ellen <Ellen.McLaren@uspto.gov>  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

"Magical Marie thing" is my favorite email line of the day, and entirely accurate!

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Tuesday, July 26, 2022 2:51 PM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

Thanks for your review, Dede. I'll trim those bullets and will share an updated draft of the agenda with everyone.

Best wishes,  
Marie

---

**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Tuesday, July 26, 2022 2:30 PM  
**To:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

Thanks, Marie. I think this document is perfect for Kathi to prepare on these topics for the Deputy Secretary. (b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

---

**From:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>  
**Sent:** Tuesday, July 26, 2022 12:55 PM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>;  
Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

No comments/concerns here, Marie – thank you!

David Shewchuk  
Deputy General Counsel for General Law, USPTO  
571-272-8515

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Tuesday, July 26, 2022 12:15 PM  
**To:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, July 29

Hello all,

Attached for your review and approval is a draft of the agenda for Kathi's meeting with Deputy Secretary Graves this Friday. Please let me know by 5 p.m. today, if possible, if you have any edits or if you approve the document. The agenda is due to DOC by 9 a.m. tomorrow (Wednesday).

Please also note that DOC's template for the agenda asks that we include just one sentence describing each of the agenda items, so the sentences we have there are currently quite long. Please let me know if you have suggestions for trimming them.

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor

**USPTO0104**

U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)

Tel: 571-270-3186

**From:** Ladino, Marie  
**Sent:** Wed, 21 Sep 2022 21:36:57 +0000  
**To:** Loya, Eliana  
**Cc:** Twitty, Anthony; Ramdat, Grace; Zecher, Dede; Bidel-Niyat, Shirin; McLaren, Ellen; Baily, Shannon; Houser, Robert  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, September 23  
**Attachments:** DepSec Meeting with USPTO Director Vidal - September 23 2022 - final v.2.docx

Hello Eliana,

Please find attached a revised draft of the agenda for Deputy Secretary Graves's meeting with Director Vidal. I've added the do-outs you provided, as well as updates on them. Please let us know if you need additional information.

Thank you,  
Marie

---

**From:** Loya, Eliana (Federal) (b)(6)  
**Sent:** Wednesday, September 21, 2022 11:27 AM  
**To:** Ladino, Marie <Marie.Ladino@USPTO.GOV>  
**Cc:** Twitty, Anthony <Anthony.Twitty@USPTO.GOV>; Ramdat, Grace <Grace.Ramdat@USPTO.GOV>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Baily, Shannon <Shannon.Baily@USPTO.GOV>; Houser, Robert <robert.houser@census.gov>  
**Subject:** RE: Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, September 23

**CAUTION:** This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Hello Marie and Team,

OPSP reached out to me and asked if someone from the team can include the below do-outs in the memo and address progress on each.

1. (b)(5) Delib Proc Priv
- 2.
- 3.

4 (b)(5) Delib Proc Priv

Please let me know if you have any questions.

Thank you!

Eliana M. Loya  
Special Assistant, Executive Secretariat  
U.S. Department of Commerce

(b)(6)

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Wednesday, September 21, 2022 11:03 AM  
**To:** DepSecBriefingBook <(b)(6)>  
**Cc:** Twitty, Anthony <[Anthony.Twitty@USPTO.GOV](mailto:Anthony.Twitty@USPTO.GOV)>; Houser, Robert <[Robert.Houser@USPTO.GOV](mailto:Robert.Houser@USPTO.GOV)>; Ramdat, Grace <[Grace.Ramdat@USPTO.GOV](mailto:Grace.Ramdat@USPTO.GOV)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; David Manners-Weber <(b)(6)>  
**Subject:** Agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal - Friday, September 23

Good morning,

Attached please find the agenda for Deputy Secretary Graves's upcoming meeting with USPTO Director Kathi Vidal, scheduled for Friday, September 23. The USPTO's OGC has cleared the agenda. If you have questions or need any additional information, please let me know.

Thank you,  
Marie Ladino



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**USPTO0107**



**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182

**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029

**DATE:** Thursday, September 22, 2022

**LOCATION:** DepSec Office 5838, Department of Commerce

**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO

**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:
  - USPTO employee engagement and well-being (4 minutes)
    - On September 13, the security team at the USPTO's Alexandria campus responded to an employee in distress. (b)(5)  
(b)(5)  
(b)(5) (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv
  - Update on Director Vidal's trip to Southeast Asia (4 minutes)
    - Director Vidal's successful trip to Southeast Asia provided an excellent opportunity to identify ways to expand the USPTO's involvement in the Indo-Pacific Economic Framework. It also provided an occasion to convey to leaders of the Association of Southeast Asian Nations (ASEAN) region its importance to the Administration. Director Vidal visited with both IP office heads and ministerial officials in Singapore, Malaysia, Thailand, Laos, and Vietnam, where she conveyed the USPTO's interest in expanding cooperative activities, technical assistance, and training and capacity building opportunities. (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv
  - (b)(5)
    - (b)(5)  
(b)(5)  
(b)(5)
  - USPTO's anti-counterfeiting efforts (3 minutes)

- The USPTO is working across government and with international organizations to curb the physical and economic harm caused by counterfeit products. In August, the USPTO, in partnership with the National Crime Prevention Council, launched a new phase of the Go for Real ad campaign, including announcements in both English and Spanish. In early September, Director Vidal delivered pre-recorded remarks at an event celebrating the launch of a new website for Mexico’s version of the Go for Real campaign, “Elige el original.” The USPTO also recently signed an MOU with Cinequest, a nonprofit film organization based in San Jose, California, to use the story-telling power of our youth to produce anti-counterfeiting videos and messaging.
  - Director review cases at the Patent Trial and Appeal Board (PTAB) (3 minutes)
    - Under the current process post-*Arthrex*, the USPTO has seen over 200 requests for Director review, with 15 granted so far, including five based on party requests and 10 involving sua sponte review. A Request for Comments on the interim Director review process and other PTAB processes has been published, with comments due October 19. Cases currently pending include *OpenSky v. VLSI*, which involves allegations of abusive filing of inter partes review petitions after a district court awarded large damages in an infringement suit involving the same patent. (b)(5)

(b)(5)

(b)(5)

- Update on the TRIPS waiver (b)(5) Delib Proc Priv

- (b)(5) Delib Proc Priv

**BACKGROUND**

- You last met with Director Vidal on August 26.
- Due outs from that meeting were:

- (b)(5) Delib Proc Priv
  - 
  -

(b)(5) Delib Proc Priv

■ (b)(5) Delib Proc Priv

● (b)(5) Delib Proc Priv

## **PARTICIPANTS**

### *USPTO*

- Shirin Bidel-Niyat, Chief of Staff

### *Office of Policy and Strategic Planning*

- James Ahn, Senior Policy Advisor

### *Office of the Deputy Secretary*

- Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

## **ATTACHMENT LIST**

(1) Biweekly tracker

## **CLEARED BY:**

- Shirin Bidel-Niyat, Chief of Staff
- Cordelia (Dede) Zecher, Chief Advisor
- Ellen McLaren, Director, Office of Governmental Affairs
- David Shewchuk, Deputy General Counsel for General Law

**From:** Ladino, Marie  
**Sent:** Thu, 28 Jul 2022 17:00:13 +0000  
**To:** Zecher, Dede; Bidel-Niyat, Shirin  
**Cc:** McLaren, Ellen  
**Subject:** RE: Agenda for Director Vidal's meeting with the Deputy Secretary  
**Attachments:** 03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022  
- final w responses to comments v.2.docx

- Mary

Attached is an updated draft of tomorrow's meeting agenda. We were asked to send edits to DOC in tracked changes, so I've included this new language in the most recent document and highlighted it. Please let me know if you approve.

Thank you,  
Marie

---

**From:** Critharis, Mary <Mary.Critharis@USPTO.GOV>  
**Sent:** Thursday, July 28, 2022 12:39 PM  
**To:** Ladino, Marie <Marie.Ladino@USPTO.GOV>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>  
**Cc:** McLaren, Ellen <Ellen.McLaren@uspto.gov>  
**Subject:** RE: Agenda for Director Vidal's meeting with the Deputy Secretary

How's this...

(b)(5) Delib Proc Priv

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Thursday, July 28, 2022 11:49 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Cc:** Critharis, Mary <[Mary.Critharis@USPTO.GOV](mailto:Mary.Critharis@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Director Vidal's meeting with the Deputy Secretary

Hello all,

**USPTO0111**



Once Mary has a chance to provide the language Shirin requested, I can update and resubmit the agenda for Kathi's meeting with the Deputy Secretary. I can add it to the Biweekly Report, too. Please note that the Biweekly Report is due to DOC by 3 p.m. today.

Thank you,  
Marie

---

**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Thursday, July 28, 2022 6:29 AM  
**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Cc:** Critharis, Mary <[Mary.Critharis@USPTO.GOV](mailto:Mary.Critharis@USPTO.GOV)>  
**Subject:** RE: Agenda for Director Vidal's meeting with the Deputy Secretary

+Mary to assist with that language.

---

**From:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Sent:** Wednesday, July 27, 2022 8:00 PM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Subject:** FW: Agenda for Director Vidal's meeting with the Deputy Secretary

(b)(5)	(b)(5) Delib Proc Priv
(b)(5) Delib Proc Priv	
(b)(5) Delib Proc Priv	

(b)(5) Delib Proc Priv
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**From:** David Manners-Weber <(b)(6)>  
**Sent:** Wednesday, July 27, 2022 6:14 PM  
**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** Agenda for Director Vidal's meeting with the Deputy Secretary

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CUI//PRIV  
PRE-DECISIONAL/DELIBERATIVE



Hi Shirin,

Would you be able to give me a quick ring tomorrow on the briefing memo for Director Vidal's Friday meeting with DepSec? (Also around for another hour if tonight is easier)

Thanks so much!

David

David Manners-Weber  
Counsel to the General Counsel  
Department of Commerce

(b)(6)

**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182  
**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029  
**DATE:** Friday, July 29, 2022  
**LOCATION:** Virtual  
**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO  
**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- (b)(5) Delib Proc Priv; Draft

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

**From:** Zecher, Dede  
**Sent:** Wed, 14 Dec 2022 14:36:00 +0000  
**To:** Ladino, Marie; Bidel-Niyat, Shirin; McLaren, Ellen  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, December 16  
**Attachments:** DepSec Meeting with USPTO Director Vidal - December 16 2022 v.2.docx

Good here. [@Bidel-Niyat, Shirin?](#)

---

**From:** Ladino, Marie <Marie.Ladino@USPTO.GOV>  
**Sent:** Wednesday, December 14, 2022 9:01 AM  
**To:** Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, December 16

Hello all,

Attached is an updated draft of the agenda, with a few tweaks (highlighted) based on my conversation this morning with Shirin. Please let me know if you approve and if Kathi should see the agenda, too.

Thank you,  
Marie

---

**From:** Ladino, Marie  
**Sent:** Wednesday, December 14, 2022 8:22 AM  
**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** FW: Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, December 16

Good morning Shirin, Dede, and Ellen,

Please let me know if you have any edits or suggestions for the attached agenda for Kathi's upcoming meeting with Deputy Secretary Graves. Please note that the agenda is due to DOC by 9 a.m. today.

Thank you,  
Marie

---

**From:** Ladino, Marie  
**Sent:** Tuesday, December 13, 2022 2:04 PM  
**To:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, December 16

Hello all,

**USPTO0116**

Attached for your review and approval is a draft of the agenda for Kathi's meeting with Deputy Secretary Graves this Friday. Please let me know if you have any edits or suggestions for the agenda. Please also note that it is **due to DOC by 9 a.m. tomorrow (Wednesday)**.

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)

Tel: 571-270-3186



**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**CONTACT:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182

**DATE:** Friday, December 16, 2022

**REQUESTED BY:** Requested by Deputy Secretary Graves as a regular check-in regarding USPTO initiatives

**LOCATION:** Virtual

**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO

**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:

- (b)(5) Delib Proc Priv
- U
- 
-

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

**From:** Ladino, Marie  
**Sent:** Wed, 21 Sep 2022 14:47:45 +0000  
**To:** Zecher, Dede; Bidel-Niyat, Shirin; McLaren, Ellen  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves  
**Attachments:** DepSec Meeting with USPTO Director Vidal - September 23 2022 v.4.docx

Thanks, Dede. I've accepted your edits and attached an updated copy.

Best,  
Marie

---

**From:** Zecher, Dede <Cordelia.Zecher@uspto.gov>  
**Sent:** Wednesday, September 21, 2022 10:42 AM  
**To:** Ladino, Marie <Marie.Ladino@USPTO.GOV>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves

(b)(5) Going to try and get Shirin to give a quick read before 11.

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Wednesday, September 21, 2022 8:22 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** Agenda for Kathi's meeting with Deputy Secretary Graves

Good morning Dede, Shirin, and Ellen,

Attached is an updated draft of the agenda for Kathi's meeting with Deputy Secretary Graves this Friday.

(b)(5) Please let me know if you approve or if Kathi should see this again. Please note that it's due to DOC today at 9 a.m.

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**USPTO0120**

**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182

**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029

**DATE:** Friday, September 23, 2022

**LOCATION:** DepSec Office 5838, Department of Commerce

**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO

**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:

<ul style="list-style-type: none"><li>○</li><li>○</li><li>○</li><li>○</li></ul>	<p>(b)(5)</p>
---	---------------

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act



Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

**From:** Ahn, James (Federal)  
**Sent:** Fri, 29 Apr 2022 21:00:07 +0000  
**To:** Duckworth, Cara; Legacki, Caitlin (Federal); Edwards, Jeremy (Federal); Andrejat, Jacob; McLaren, Ellen  
**Cc:** Bidel-Niyat, Shirin; Zecher, Dede; Horner, Linda; Fucito, Paul; Atkisson, Eric; Grom, JD (Federal); Morrissette, Eric (Federal); Didiuk, Lauren  
**Subject:** RE: clearance items for next week release - one urgent (reporter inquiry)  
**Attachments:** 2022.04.27 Letter to PTO re IPR Abuse (Final).pdf, kv edits PTAB Judges Draft 04292022 +dbedit and cleared (003)\_JBA.docx

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My initial comments attached. I would appreciate DOC OGC reviewing along with ethics.

[@McLaren, Ellen](#) and OLIA, I would also appreciate your spidey senses on this.

---

**From:** Duckworth, Cara <Cara.Duckworth@uspto.gov>  
**Sent:** Friday, April 29, 2022 4:14 PM  
**To:** Legacki, Caitlin (Federal) (b)(6); Ahn, James (Federal) (b)(6); Edwards, Jeremy (Federal) (b)(6); Andrejat, Jacob (Federal) (b)(6)  
**Cc:** Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Cordelia <Cordelia.Zecher@uspto.gov>; Horner, Linda <Linda.Horner@USPTO.GOV>; Fucito, Paul <Paul.Fucito@USPTO.GOV>; Atkisson, Eric <Eric.Atkisson@USPTO.GOV>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Grom, JD (Federal) (b)(6); Morrissette, Eric (Federal) (b)(6)  
**Subject:** RE: clearance items for next week release - one urgent (reporter inquiry)

Ok. We'll go with that.

(b)(5)  
(b)(5) (b)(5)  
(b)(5)  
(b)(5)

Thanks.

---

**From:** Legacki, Caitlin (Federal) (b)(6)  
**Sent:** Friday, April 29, 2022 4:08 PM  
**To:** Duckworth, Cara <Cara.Duckworth@uspto.gov>; Ahn, James (Federal) (b)(6); Edwards, Jeremy (Federal) (b)(6); Andrejat, Jacob (b)(6)  
**Cc:** Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Horner, Linda <Linda.Horner@USPTO.GOV>; Fucito, Paul <Paul.Fucito@USPTO.GOV>; Atkisson, Eric <Eric.Atkisson@USPTO.GOV>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Grom, JD (Federal) (b)(6); Morrissette, Eric (Federal) (b)(6)  
**Subject:** Re: clearance items for next week release - one urgent (reporter inquiry)

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Our approved response is typically:

(b)(5)

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**From:** Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>  
**Sent:** Friday, April 29, 2022 4:06:20 PM  
**To:** Ahn, James (Federal) <(b)(6)>; Legacki, Caitlin (Federal) <(b)(6)>; Edwards, Jeremy (Federal) <(b)(6)>; Andrejat, Jacob (Federal) <(b)(6)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Fucito, Paul <[Paul.Fucito@USPTO.GOV](mailto:Paul.Fucito@USPTO.GOV)>; Atkisson, Eric <[Eric.Atkisson@USPTO.GOV](mailto:Eric.Atkisson@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Grom, JD (Federal) <(b)(6)>; Morrissette, Eric (Federal) <(b)(6)>  
**Subject:** RE: clearance items for next week release - one urgent (reporter inquiry)

(b)(6)  
(b)(6)

---

**From:** Ahn, James (Federal) <(b)(6)>  
**Sent:** Friday, April 29, 2022 3:17 PM  
**To:** Legacki, Caitlin (Federal) <(b)(6)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Edwards, Jeremy (Federal) <(b)(6)>; Andrejat, Jacob <(b)(6)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Fucito, Paul <[Paul.Fucito@USPTO.GOV](mailto:Paul.Fucito@USPTO.GOV)>; Atkisson, Eric <[Eric.Atkisson@USPTO.GOV](mailto:Eric.Atkisson@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Grom, JD (Federal) <(b)(6)>; Morrissette, Eric (Federal) <(b)(6)>  
**Subject:** RE: clearance items for next week release - one urgent (reporter inquiry)

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I agree and make the same recommendation.

(b)(6)  
(b)(6)

---

**From:** Legacki, Caitlin (Federal) <(b)(6)>  
**Sent:** Friday, April 29, 2022 3:14 PM  
**To:** Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Edwards, Jeremy (Federal) <(b)(6)>; Andrejat, Jacob (Federal) <(b)(6)>; Ahn, James (Federal) <(b)(6)>

**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Fucito, Paul <[Paul.Fucito@USPTO.GOV](mailto:Paul.Fucito@USPTO.GOV)>; Atkisson, Eric <[Eric.Atkisson@USPTO.GOV](mailto:Eric.Atkisson@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Grom, JD (Federal) <(b)(6)>; Morrissette, Eric (Federal) <(b)(6)>  
**Subject:** Re: clearance items for next week release - one urgent (reporter inquiry)

(b)(6)

Adding OLIA here

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---

**From:** Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>  
**Sent:** Friday, April 29, 2022 2:43:27 PM  
**To:** Edwards, Jeremy (Federal) <(b)(6)>; Andrejat, Jacob (Federal) <(b)(6)>; Legacki, Caitlin (Federal) <(b)(6)>; Ahn, James (Federal) <(b)(6)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Fucito, Paul <[Paul.Fucito@USPTO.GOV](mailto:Paul.Fucito@USPTO.GOV)>; Atkisson, Eric <[Eric.Atkisson@USPTO.GOV](mailto:Eric.Atkisson@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** clearance items for next week release - one urgent (reporter inquiry)

Team OPA/James:

As mentioned during our OPA sync yesterday, I'm sending a few things for your clearance/approval, in order of timeliness:

1. Comment on Hirono/Tillis letter. (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv  
a. (b)(5) Delib Proc Priv
  
2. Kathi letter to PTAB judges (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv
  
3. Draft pro bono program certificate press release. (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

4. (b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

5. Kathi is also planning to give scripted remarks at the NIHF induction ceremony at the Anthem (b)(5)

(b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

Please let me know if you have any questions – and if we can issue the comment in #1 ASAP.

Many thanks,  
Cara

**Cara A. Duckworth**

Chief Corporate Communications Officer

U.S. Patent and Trademark Office

[cara.duckworth@uspto.gov](mailto:cara.duckworth@uspto.gov)

Tel: 571-272-4989

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# United States Senate

## VIA ELECTRONIC TRANSMISSION

April 27, 2022

The Honorable Kathi Vidal  
Under Secretary of Commerce for Intellectual Property and  
Director United States Patent and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Dear Director Vidal:

We write to express our concern about the Patent Trial and Appeal Board's (PTAB's) recent decisions to institute inter partes reviews (IPRs) in *OpenSky Industries, LLC v. VLSI Technology LLC*<sup>1</sup> and *Patent Quality Assurance, LLC v. VLSI Technology LLC*.<sup>2</sup> The facts and circumstances around these proceedings suggest petitioners OpenSky Industries, LLC (OpenSky) and Patent Quality Assurance, LLC (PQA) brought the proceedings to manipulate the U.S. Patent and Trademark Office (USPTO) for their own financial gain. The PTAB's decisions to endorse this scheme are troubling and undermine the USPTO's recent efforts to ensure post-issuance proceedings are not used to harass patent owners.

The United States has long held the position as the world's leader in innovation. Our country's patent system has played a key role in securing this status. By granting inventors the exclusive right to practice their inventions for a limited period of time, the patent system incentivizes individuals and companies alike to invest their time, energy, and resources into the next generation of products and services. The result is a string of breakthroughs, including the light bulb, the telephone, the microchip, and many more.

In 2011, Congress enacted the America Invents Act. The centerpiece of this law was a new suite of post-issuance proceedings, including IPRs, to allow petitioners to challenge the validity of U.S. patents. Supporters of this law claimed such proceedings were necessary to "create an inexpensive and faster alternative to litigation."<sup>3</sup>

Unfortunately, a variety of petitioners have sought to weaponize the IPR process for their own financial gain.

For example, in 2015, hedge fund manager Kyle Bass formed the so-called Coalition for Affordable Drugs as a front group to file IPR petitions against patents held by pharmaceutical

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<sup>1</sup> Case No. IPR2021-01064.

<sup>2</sup> Case No. IPR2021-01229.

<sup>3</sup> 157 Cong. Rec. H4496 (2011) (statement of Rep. Lamar Smith).



companies. All the while, his fund shorted the stocks of those companies and profited off the price drops caused by the very petitions Bass filed.<sup>4</sup>

More recently, OpenSky and PQA filed petitions challenging U.S. Patent Nos. 7,523,373 and 7,725,759 in an apparent attempt to extort money from patent owner VLSI Technology LLC. The motives behind these IPR petitions were suspect from the outset. For example,

- The companies were formed shortly before filing their petitions.
- The companies did not make, use, sell, or import *any* products, let alone any products that could subject them to claims of infringement.
- The companies filed their petitions only after VLSI had secured a \$2.2 billion infringement judgment against Intel.
- And, most egregiously, the petitions filed by the companies were near “carbon copies” of petitions previously filed by Intel that had been rejected by the USPTO.<sup>5</sup>

Any doubt about OpenSky’s motives was extinguished when VLSI filed with the USPTO an e-mail received from OpenSky’s counsel. In the e-mail, OpenSky’s counsel proposed a scheme in which the company would actively work to undermine the IPR it brought—thereby protecting VLSI’s patents from other challenges—in exchange for monetary payment.<sup>6</sup>

These activities represent clear abuses of the IPR system. Yet, to date, it does not appear the USPTO has taken any steps to sanction those involved or otherwise act to deter future copycats. In fact, the PTAB has thus far granted two of the petitions filed by OpenSky and PQA. In one institution decision, the PTAB actually cited the timing of OpenSky’s petition as a reason the petition should be granted.<sup>7</sup>

In recent years, the USPTO has made great strides in making the IPR process more fair and equitable. By adopting the *Phillips* claim construction standard, the USPTO ensured that PTAB reviews would more closely align with district court validity challenges. And, by adopting the *Fintiv* factors, the USPTO has reduced the burden faced by patent owners who too often are forced to defend their patents simultaneously on multiple fronts.

However, the abuses described above show that the USPTO’s work is not finished. The USPTO must therefore review its policies and take all necessary actions to ensure the IPR process is not abused by parties filing petitions in bad faith and for reasons outside the intent of the America Invents Act.

To that end, please respond to the following questions no later than May 27, 2022.

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<sup>4</sup> <https://www.reuters.com/article/celgene-lawsuit-hedgefund/hedge-fund-manager-kyle-bass-escapes-sanctions-in-drug-patent-case-idUSL1N11Y1S120150928>.

<sup>5</sup> <https://news.bloomberglaw.com/ip-law/review-of-vlsi-patents-in-intel-fight-seen-enticing-opportunists>.

<sup>6</sup> <https://news.bloomberglaw.com/ip-law/intel-patent-verdict-tensions-spark-reveal-of-unusual-offer>.

<sup>7</sup> Case No. IPR2021-01064, Paper No. 17 at 13 (“We determine that OpenSky has offered a reasonable explanation for the timing of the Petition. Here, it was reasonable for OpenSky to take interest in the ’759 patent after a substantial damages award, and choose to challenge the patent at that time.”)

1. Does the USPTO consider filing an IPR petition for the purpose of profiting from a resulting decrease in the price of the patent owner's stock a proper use of the IPR system? Why or why not?
2. Does the USPTO consider filing an IPR petition for the purpose of extorting money from the patent owner a proper use of the IPR system? Why or why not?
3. The America Invents Act gives the Director of the USPTO discretionary authority to deny IPR petitions. Do you consider it a proper use of that discretion to (1) deny an IPR petition filed for the purpose of profiting from the resulting decrease in the price of the patent owner's stock; or (2) deny an IPR petition filed for the purpose of extorting money from the patent owner? Why or why not?
4. What sanctions can the USPTO impose on parties that file IPR petitions in bad faith? Has the USPTO exercised this authority to date? If so, please describe the circumstances.
5. What additional authorities, if any, does the USPTO require to ensure that parties do not file IPR petitions in bad faith and for reasons outside the intent of the America Invents Act?

We appreciate your attention to this matter. If you have any questions, please do not hesitate to contact us.

Sincerely,



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Mazie K. Hirono  
United States Senator



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Thom Tillis  
United States Senator

Withheld pursuant to exemption

(b)(5) Delib Proc Priv

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv

of the Freedom of Information Act



**From:** Zecher, Dede  
**Sent:** Tue, 13 Dec 2022 15:22:23 +0000  
**To:** Ladino, Marie  
**Cc:** Bidel-Niyat, Shirin  
**Subject:** RE: DSDG agenda

(b)(5) Delib Proc Priv

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Date:** Tuesday, Dec 13, 2022 at 10:21 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** RE: DSDG agenda

(b)(5) Delib Proc Priv

---

**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Tuesday, December 13, 2022 10:20 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** RE: DSDG agenda

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Shirin - can you comment on the third bullet?

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([www.blackberry.com](http://www.blackberry.com))

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Date:** Tuesday, Dec 13, 2022 at 10:18 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** RE: DSDG agenda

Thank you, Dede. I'll incorporate these items into the agenda. The only other things we'll need are updates on our due-outs from the last meeting:

○ (b)(5) Delib Proc Priv

▪

- Update on the *OpenSky* case

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- (b)(5) Delib Proc Priv

Best,  
Marie

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**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Tuesday, December 13, 2022 10:11 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** DSDG agenda

Marie,

We discussed the DSDG agenda with Kathi this morning. In addition to cancer moonshot, please include:

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Is that enough to get things started?

Dede

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([www.blackberry.com](http://www.blackberry.com))

**USPTO0135**

**From:** Bidel-Niyat, Shirin  
**Sent:** Tue, 20 Sep 2022 17:41:30 +0000  
**To:** Ladino, Marie; McLaren, Ellen  
**Cc:** Zecher, Dede  
**Subject:** RE: For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

Yes- (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Date:** Tuesday, Sep 20, 2022, 11:30 AM  
**To:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Cc:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>, Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Subject:** FW: For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

Hi Ellen,

(b)(5) Delib Proc Priv

Thank you,  
Marie

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**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Tuesday, September 20, 2022 1:26 PM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Subject:** RE: For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

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(b)(5) Delib Proc Priv

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Tuesday, September 20, 2022 1:24 PM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Subject:** FW: For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

Hi Dede,

(b)(5) Delib Proc Priv

Thank you,  
Marie

---

**From:** Vidal, Kathi <[Kathi.Vidal@uspto.gov](mailto:Kathi.Vidal@uspto.gov)>  
**Sent:** Tuesday, September 20, 2022 1:12 PM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Ramdat, Grace <[Grace.Ramdat@USPTO.GOV](mailto:Grace.Ramdat@USPTO.GOV)>  
**Subject:** RE: For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

(b)(5) Delib Proc Priv

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**From:** Ladino, Marie  
**Sent:** Tuesday, September 20, 2022 10:08 AM  
**To:** Vidal, Kathi <[Kathi.Vidal@uspto.gov](mailto:Kathi.Vidal@uspto.gov)>  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Ramdat, Grace <[Grace.Ramdat@USPTO.GOV](mailto:Grace.Ramdat@USPTO.GOV)>  
**Subject:** For Your Review and Approval: Agenda for your meeting with Deputy Secretary Graves - Friday, September 23

Hi Kathi,

Attached for your review and approval is a draft of the agenda for your meeting with Deputy Secretary Graves this Friday. Please let me know if you would like to make any edits. Please also note that the agenda is due to DOC by 9 a.m. tomorrow (Wednesday).

Thank you,  
Marie

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**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Tuesday, September 20, 2022 1:00 PM  
**To:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, September 23

(b)(5) Delib Proc Priv

**USPTO0137**

Shirin is on a plane so that might not be feasible...

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**From:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>  
**Sent:** Tuesday, September 20, 2022 10:32 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** RE: Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, September 23

No comments/concerns here, Marie – thanks!

David Shewchuk  
Deputy General Counsel for General Law, USPTO  
571-272-8515

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Tuesday, September 20, 2022 10:15 AM  
**To:** Shewchuk, David <[David.Shewchuk@USPTO.GOV](mailto:David.Shewchuk@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Subject:** Agenda for Kathi's meeting with Deputy Secretary Graves - Friday, September 23

Hello all,

Attached for your review and approval is a draft of the agenda for Kathi's meeting with Deputy Secretary Graves this Friday. Please let me know at your soonest convenience if you have any edits or if you approve the document. Since Kathi would like to review the agenda, I'm aiming to get it to her before COB today. It's due to DOC by 9 a.m. tomorrow (Wednesday).

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**USPTO0138**



**From:** Ladino, Marie  
**Sent:** Thu, 6 Oct 2022 16:17:34 +0000  
**To:** Bonilla, Jacqueline; Zecher, Dede; Bidel-Niyat, Shirin; McLaren, Ellen; Berdan, David  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thank you, Jackie. I haven't sent the report yet, and I'll incorporate the language you suggested. I appreciate your help.

Best wishes,  
Marie

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**From:** Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>  
**Sent:** Thursday, October 6, 2022 12:15 PM  
**To:** Zecher, Dede <Cordelia.Zecher@uspto.gov>; Ladino, Marie <Marie.Ladino@USPTO.GOV>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Berdan, David <David.Berdan@uspto.gov>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Sorry, just saw this—much going on simultaneously. It's fine either way, if you already sent it.

---

**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>  
**Sent:** Thursday, October 6, 2022 11:57 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>  
**Cc:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Totally fine to send by the deadline if you don't hear back from Jackie.

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([www.blackberry.com](http://www.blackberry.com))

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Date:** Thursday, Oct 06, 2022, 11:55 AM  
**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>, McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>, Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>, Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>  
**Cc:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thank you, Shirin.

Jackie – When you have a chance, please let me know your thoughts about the language regarding the press on the *OpenSky* decision.

Best wishes,  
Marie

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**From:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Sent:** Thursday, October 6, 2022 11:48 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Good here.

---

**From:** Ladino, Marie  
**Sent:** Thursday, October 6, 2022 11:39 AM  
**To:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thank you, Ellen. I've attached an updated draft of the report that incorporates your changes.

Best,  
Marie

---

**From:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Sent:** Thursday, October 6, 2022 11:23 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thanks Dede and Marie! (b)(5)

(b)(5)

- (b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

**Ellen C. McLaren**



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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>

**Sent:** Thursday, October 6, 2022 11:15

**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>;

Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn)

<[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda

<[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>

**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thank you, Dede.

Jackie, Ellen, and Shirin – Please let me know your thoughts on Dede’s comments.

Kind regards,  
Marie

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**From:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>

**Sent:** Thursday, October 6, 2022 11:10 AM

**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>;

Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn)

<[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda

<[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>

**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

This is good with me but with two comments:

(b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

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([www.blackberry.com](http://www.blackberry.com))

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>

**USPTO0141**



---

**Date:** Thursday, Oct 06, 2022, 11:00 AM

**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>, Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>, Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>, McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>, Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>, Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>, Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>

**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Hi all,

(b)(5) Delib Proc Priv

**Please also note that the report is due to DOC by 3 p.m. today.**

Thank you,

Marie

---

**From:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>

**Sent:** Wednesday, October 5, 2022 6:25 PM

**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>

**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thanks- was thinking along the same lines.

---

**From:** Ladino, Marie

**Sent:** Wednesday, October 5, 2022 5:52 PM

**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>

**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>

**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thank you, Shirin and Dave.

(b)(5) Delib Proc Priv

Best wishes,

Marie

---

**From:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>

**Sent:** Wednesday, October 5, 2022 5:44 PM

**USPTO0142**

**To:** Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Thanks Marie. (b)(5) Delib Proc Priv

(b)(5) Delib Proc Priv

---

**From:** Berdan, David  
**Sent:** Wednesday, October 5, 2022 5:29 PM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>  
**Subject:** RE: FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Marie:

Looks good to me. No edits or comments.

Thanks,  
Dave

David Berdan  
General Counsel  
United States Patent and Trademark Office  
Phone: (571) 272-7000  
[david.berdan@uspto.gov](mailto:david.berdan@uspto.gov)

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---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Wednesday, October 5, 2022 2:00 PM  
**To:** Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Cc:** Munasifi, Lena <[Lena.Munasifi@USPTO.GOV](mailto:Lena.Munasifi@USPTO.GOV)>; Walker, Robert (Shawn) <[Robert.Walker@USPTO.GOV](mailto:Robert.Walker@USPTO.GOV)>; Baily, Shannon <[Shannon.Baily@USPTO.GOV](mailto:Shannon.Baily@USPTO.GOV)>; Corbin, Rhonda <[Rhonda.Corbin@uspto.gov](mailto:Rhonda.Corbin@uspto.gov)>  
**Subject:** FOR YOUR REVIEW: USPTO Biweekly Report - Week ending October 7, 2022

Hello Dave, Dede, Shirin, and Ellen,

**USPTO0143**



Attached for your review is a draft of the Biweekly Report to the Secretary and Deputy Secretary for the week ending October 7. The report covers events and updates from September 26-October 21. Please send any edits or suggestions to me by COB today, if possible. Please note that the report is due to DOC by 3 p.m. tomorrow (Thursday).

I've also included a draft of the email that will accompany the report below. I'll delete anything we don't need before sending.

Thank you,  
Marie

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(b)(5) Delib Proc Priv; Draft

Please let me know if you have any questions or require additional information.

Thank you,  
Marie Ladino

**USPTO0144**



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**From:** Ladino, Marie  
**Sent:** Mon, 25 Jul 2022 13:57:40 +0000  
**To:** Zecher, Dede; Bidel-Niyat, Shirin  
**Cc:** Ramdat, Grace  
**Subject:** RE: Kathi's upcoming meeting with Deputy Secretary Graves

Thanks, Dede. I'll start pulling together the information.

Best wishes,  
Marie

---

**From:** Zecher, Dede <Cordelia.Zecher@uspto.gov>  
**Sent:** Monday, July 25, 2022 9:46 AM  
**To:** Ladino, Marie <Marie.Ladino@USPTO.GOV>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>  
**Cc:** Ramdat, Grace <Grace.Ramdat@USPTO.GOV>  
**Subject:** RE: Kathi's upcoming meeting with Deputy Secretary Graves

Marie,

Kathi would like to discuss:

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-

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([www.blackberry.com](http://www.blackberry.com))

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**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Date:** Monday, Jul 25, 2022, 8:45 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>, Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Cc:** Ramdat, Grace <[Grace.Ramdat@USPTO.GOV](mailto:Grace.Ramdat@USPTO.GOV)>  
**Subject:** RE: Kathi's upcoming meeting with Deputy Secretary Graves

Good morning Dede and Shirin,

Just a quick reminder that we'll need to submit the agenda for Kathi's upcoming meeting with Deputy Secretary Graves by 9 a.m. on Wednesday. When you can, please let me know what I should include in the agenda.

Thank you,  
Marie

---

**From:** Ladino, Marie <>  
**Sent:** Wednesday, July 20, 2022 10:00 AM  
**To:** Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>  
**Cc:** Ramdat, Grace <[Grace.Ramdat@USPTO.GOV](mailto:Grace.Ramdat@USPTO.GOV)>  
**Subject:** Kathi's upcoming meeting with Deputy Secretary Graves

Hi Dede and Shirin,

Kathi's next check-in with Deputy Secretary Graves is currently scheduled for next Friday, July 29. We'll need to submit the agenda to DOC by 9 a.m. on Wednesday, July 27. If there are items you'd like me to start including in the agenda, please let me know.

Thank you,  
Marie



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186

**From:** Ladino, Marie  
**Sent:** Thu, 28 Jul 2022 17:29:36 +0000  
**To:** Loya, Eliana  
**Cc:** Ramdat, Grace; Zecher, Dede; Bidel-Niyat, Shirin; McLaren, Ellen; Baily, Shannon  
**Subject:** RE: Loya, Eliana (Federal) shared "03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final" with you.  
**Attachments:** 03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final w responses to comments v.2.docx

Hi Eliana,

We have one additional edit we'd like to make to the agenda for Deputy Secretary Graves's meeting with USPTO Director Kathi Vidal tomorrow, if possible. I've highlighted it in the attached version of the agenda, which is otherwise the same as what I submitted yesterday. Please let me know if you have any questions.

Kind regards,  
Marie

---

**From:** Ladino, Marie <>  
**Sent:** Wednesday, July 27, 2022 11:37 AM  
**To:** Loya, Eliana (Federal) <(b)(6)>  
**Cc:** Ramdat, Grace <Grace.Ramdat@USPTO.GOV>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Baily, Shannon <Shannon.Baily1@USPTO.GOV>  
**Subject:** RE: Loya, Eliana (Federal) shared "03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final" with you.

Thank you, Eliana. Attached is an updated draft of the agenda that includes responses to James Ahn's comments. Please let me know if you need anything else.

Kind regards,  
Marie

---

**From:** Loya, Eliana (Federal) <(b)(6)>  
**Sent:** Wednesday, July 27, 2022 9:38 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Subject:** RE: Loya, Eliana (Federal) shared "03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final" with you.

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Good morning Marie,  
Attached is the document. Please make any changes in track changes.  
Thank you!

**USPTO0148**



Eliana M. Loya  
Special Assistant, Executive Secretariat  
U.S. Department of Commerce

(b)(6)

---

**From:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Sent:** Wednesday, July 27, 2022 9:31 AM  
**To:** Loya, Eliana (Federal) <(b)(6)>  
**Subject:** RE: Loya, Eliana (Federal) shared "03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final" with you.

Good morning Eliana,

Unfortunately, I'm not able to access this document. Is it possible for you to send it to me as an email attachment?

Thank you,  
Marie

---

**From:** Loya, Eliana (Federal) <(b)(6)>  
**Sent:** Wednesday, July 27, 2022 9:19 AM  
**To:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>  
**Subject:** Loya, Eliana (Federal) shared "03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final" with you.

**CAUTION:** This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.



**Loya, Eliana (Federal) shared a file with you**

Good morning! Can you please address the comments on this memo? Thank you!

**USPTO0149**



[03 NEEDS CLEARANCE DepSec Meeting with USPTO Director Vidal - July 29 2022 - final](#)



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**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182  
**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029  
**DATE:** Friday, July 29, 2022  
**LOCATION:** Virtual  
**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO  
**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:

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(b)(5) Delib Proc Priv

Withheld pursuant to exemption

(b)(5) ; Draft

of the Freedom of Information Act

**From:** Bonilla, Jacqueline  
**Sent:** Wed, 22 Jun 2022 17:00:48 +0000  
**To:** Vidal, Kathi; McLaren, Ellen; Alton, Kimberley N.; Foley, Tamara; Bidel-Niyat, Shirin; Zecher, Dede; Duckworth, Cara; Bryan-Johnson, Hellen  
**Cc:** Horner, Linda  
**Subject:** RE: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

Thanks Kathi. Yes, we have a draft but it's still with PTAB for final drafting/review. With everything else going on, this fell off for a small bit, but we will turn to it now.

---

**From:** Vidal, Kathi <Kathi.Vidal@uspto.gov>  
**Sent:** Wednesday, June 22, 2022 12:34 PM  
**To:** Bonilla, Jacqueline <Jacqueline.Bonilla@USPTO.GOV>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Alton, Kimberley N. <Kimberley.Alton@USPTO.GOV>; Foley, Tamara <Tamara.Foley@USPTO.GOV>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Dede <Cordelia.Zecher@uspto.gov>; Duckworth, Cara <Cara.Duckworth@uspto.gov>; Bryan-Johnson, Hellen <Hellen.Johnson2@USPTO.GOV>  
**Cc:** Horner, Linda <Linda.Horner@USPTO.GOV>  
**Subject:** RE: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

Thank you, Jackie. Do you have the draft of our updating response to the letter mentioning OpenSky? I  
(b)(5) Delib Proc Priv thank you, Kathi

---

**From:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Sent:** Wednesday, June 22, 2022 8:36 AM  
**To:** Vidal, Kathi <[Kathi.Vidal@uspto.gov](mailto:Kathi.Vidal@uspto.gov)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Alton, Kimberley N. <[Kimberley.Alton@USPTO.GOV](mailto:Kimberley.Alton@USPTO.GOV)>; Foley, Tamara <[Tamara.Foley@USPTO.GOV](mailto:Tamara.Foley@USPTO.GOV)>; Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Bryan-Johnson, Hellen <[Hellen.Johnson2@USPTO.GOV](mailto:Hellen.Johnson2@USPTO.GOV)>  
**Cc:** Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>  
**Subject:** FW: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

As just mentioned, see below and attached for the final draft responses to the two Hill letters. They look good to me.

---

**From:** Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>  
**Sent:** Tuesday, June 21, 2022 11:17 AM  
**To:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Cc:** Tierney, Michael <[Michael.Tierney@USPTO.GOV](mailto:Michael.Tierney@USPTO.GOV)>; Boalick, Scott <[Scott.Boalick@USPTO.GOV](mailto:Scott.Boalick@USPTO.GOV)>  
**Subject:** RE: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release



Hi Ellen,

We received input from James and Lauren on these Congressional letters (attached with my response to James's comments). (b)(5) Delib Proc Priv

I finalized the letters to incorporate James and Lauren's edits (see clean versions attached). (b)(5) Delib Proc Priv

Linda

---

**From:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Sent:** Thursday, June 9, 2022 9:57 AM  
**To:** Bonilla, Jacqueline <[Jacqueline.Bonilla@USPTO.GOV](mailto:Jacqueline.Bonilla@USPTO.GOV)>  
**Cc:** Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>  
**Subject:** FW: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

Looping Jackie on these docs for review

**Ellen C. McLaren**



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**From:** Didiuk, Lauren (Federal) <(b)(6)>  
**Sent:** Thursday, June 9, 2022 9:42 AM  
**To:** Ahn, James (Federal) <(b)(6)>; McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Grom, JD (Federal) <(b)(6)>; Andrejat, Jacob <(b)(6)>; Choksi, Rachit (Federal) <(b)(6)>; Abernathy, Nell (Federal) <(b)(6)>  
**Cc:** Bidet-Niyat, Shirin <[Shirin.Bidet-Niyat@uspto.gov](mailto:Shirin.Bidet-Niyat@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Alton, Kimberley N. <[Kimberley.Alton@USPTO.GOV](mailto:Kimberley.Alton@USPTO.GOV)>  
**Subject:** RE: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

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Lauren Didiuk  
Chief of Staff and Senior Counsel  
to the General Counsel  
U.S. Department of Commerce

(b)(6)

**USPTO0154**

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**From:** Ahn, James (Federal) (b)(6) >  
**Sent:** Wednesday, June 8, 2022 9:19 AM  
**To:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>; Didiuk, Lauren (Federal) (b)(6) >; Grom, JD (Federal) (b)(6) >; Andrejat, Jacob (Federal) (b)(6) >; Choksi, Rachit (Federal) (b)(6) >; Abernathy, Nell (Federal) (b)(6) >  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Alton, Kimberley <[Kimberley.Alton@USPTO.GOV](mailto:Kimberley.Alton@USPTO.GOV)>  
**Subject:** RE: Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

Team PTO...these are GREAT.

Thank you. The donut graphs are particularly helpful in showing folks the Fintiv facts and stats.

(b)(5)

So no comments in any of the pdf documents.

For everyone else who also needs to review, all the attachments PTO sent last Friday are re-attached here.

Thanks again.

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**From:** McLaren, Ellen <[Ellen.McLaren@uspto.gov](mailto:Ellen.McLaren@uspto.gov)>  
**Sent:** Friday, June 3, 2022 5:20 PM  
**To:** Didiuk, Lauren (Federal) (b)(6) >; Ahn, James (Federal) (b)(6) >; Grom, JD (Federal) (b)(6) >; Andrejat, Jacob (Federal) (b)(6) >; Choksi, Rachit (Federal) (b)(6) >; Abernathy, Nell (Federal) (b)(6) >  
**Cc:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Horner, Linda <[Linda.Horner@USPTO.GOV](mailto:Linda.Horner@USPTO.GOV)>; Duckworth, Cara <[Cara.Duckworth@uspto.gov](mailto:Cara.Duckworth@uspto.gov)>; Berdan, David <[David.Berdan@uspto.gov](mailto:David.Berdan@uspto.gov)>; Zecher, Cordelia <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>; Alton, Kimberley <[Kimberley.Alton@USPTO.GOV](mailto:Kimberley.Alton@USPTO.GOV)>  
**Subject:** Review Requested: Parallel Litigation ("fintiv") data study, guidance memo, Congressional letters, and press release

**USPTO0155**

Team Commerce,

I am attaching a package of documents that we are hoping you can review and clear-- all focused on the issue of Fintiv and our related guidance. While not all the pieces are relevant to everyone in this chain, we thought it would be helpful for folks to see them together in context.

(b)(5) Delib Proc Priv

Thanks so much!

Ellen

**Ellen C. McLaren**



**From:** Ladino, Marie  
**Sent:** Tue, 20 Sep 2022 21:21:32 +0000  
**To:** Critharis, Mary; Bidel-Niyat, Shirin; Zecher, Dede  
**Subject:** RE: Update on TRIPS Council meetings  
**Attachments:** DepSec Meeting with USPTO Director Vidal - September 23 2022 v.2.docx

Hi Mary,

(b)(5)

(b)(5)

The agenda is due to DOC by 9 a.m. tomorrow (Wednesday). I'm attaching the current draft for reference.

Thank you,  
Marie

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**From:** Ladino, Marie  
**Sent:** Tuesday, September 20, 2022 2:00 PM  
**To:** Critharis, Mary <Mary.Critharis@USPTO.GOV>; Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Dede <Cordelia.Zecher@uspto.gov>  
**Subject:** RE: Update on TRIPS Council meetings

Thank you, Mary. (b)(5)

(b)(5)

(b)(5)

(b)(5)

Thank you again,  
Marie

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**From:** Critharis, Mary <[Mary.Critharis@USPTO.GOV](mailto:Mary.Critharis@USPTO.GOV)>  
**Sent:** Tuesday, September 20, 2022 1:47 PM  
**To:** Bidel-Niyat, Shirin <[Shirin.Bidel-Niyat@uspto.gov](mailto:Shirin.Bidel-Niyat@uspto.gov)>; Zecher, Dede <[Cordelia.Zecher@uspto.gov](mailto:Cordelia.Zecher@uspto.gov)>

**USPTO0157**

**Cc:** Ladino, Marie <[Marie.Ladino@USPTO.GOV](mailto:Marie.Ladino@USPTO.GOV)>

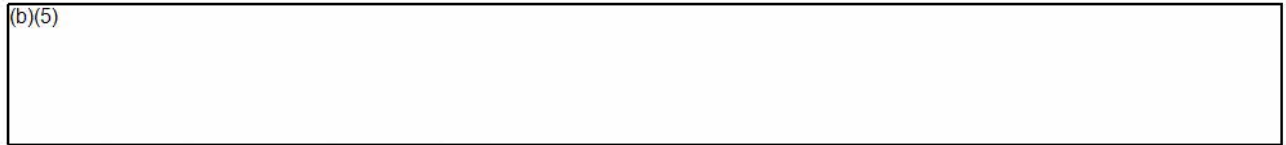
**Subject:** Update on TRIPS Council meetings

Shirin and Dede,

(b)(5)



(b)(5)



Please let me know if you have any further questions.

Thanks,  
Mary

**Mary Critharis**

Chief Policy Officer and Director for International Affairs

Office of Policy and International Affairs

Office: (571)-272-8839

Mobile: (703)-609-6279



**USPTO0158**



**BRIEFING MEMO FOR THE DEPUTY SECRETARY'S MEETING  
WITH USPTO DIRECTOR KATHI VIDAL  
(PRE-DECISIONAL/DELIBERATIVE)**

**FROM:** Shirin Bidel-Niyat, Chief of Staff, USPTO, 703-254-3182

**PREPARED BY:** Marie Ladino, Writer-Editor, USPTO, 571-299-8029

**DATE:** Friday, September 23, 2022

**LOCATION:** DepSec Office 5838, Department of Commerce

**KEY PARTICIPANTS:** Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO

**STAFF:** James Ahn, Senior Policy Advisor; Mira Patel, Senior Advisor to the Deputy Secretary of Commerce

**GOAL AND PURPOSE**

- You are meeting with USPTO Director Kathi Vidal to discuss her progress meeting the Department's and the USPTO's strategic objectives as well as other topics she wishes to raise.
- The proposed agenda is:

- (b)(5) Delib Proc Priv, Draft
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Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

Withheld pursuant to exemption

(b)(5) Delib Proc Priv ; Draft

of the Freedom of Information Act

**From:** Ahn, James (Federal)  
**Sent:** Thu, 6 Oct 2022 20:48:43 +0000  
**To:** Ladino, Marie; Castillo, Serame  
**Cc:** Bidel-Niyat, Shirin; Zecher, Dede; McLaren, Ellen; Ramdat, Grace; Baily, Shannon; Corbin, Rhonda  
**Subject:** RE: USPTO Biweekly Report - Week Ending October 7, 2022  
**Attachments:** USPTO Biweekly Report\_10.07.2022 - final.pptx

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Being included in this makes me feel like I made the PTO newspaper!

(b)(5) Delib Proc Priv

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**From:** Ladino, Marie <Marie.Ladino@USPTO.GOV>  
**Sent:** Thursday, October 6, 2022 2:01 PM  
**To:** Castillo, Serame (Federal) (b)(6); Ahn, James (Federal) (b)(6)  
**Cc:** Bidel-Niyat, Shirin <Shirin.Bidel-Niyat@uspto.gov>; Zecher, Cordelia <Cordelia.Zecher@uspto.gov>; McLaren, Ellen <Ellen.McLaren@uspto.gov>; Ramdat, Grace <Grace.Ramdat@USPTO.GOV>; Baily, Shannon <Shannon.Baily@USPTO.GOV>; Corbin, Rhonda <Rhonda.Corbin@uspto.gov>  
**Subject:** USPTO Biweekly Report - Week Ending October 7, 2022

Hello all,

Attached is the biweekly report to the Secretary and Deputy Secretary for the USPTO for the **week ending 7 October 2022**.

This report was cleared by:

Shirin Bidel-Niyat, Chief of Staff  
Ellen McLaren, Director of the Office of Governmental Affairs  
Cordelia (Dede) Zecher, Chief Advisor  
David Berdan, General Counsel

2-Week Look-Ahead:

**Requests for the Secretary**

**USPTO0162**

- N/A

**Requests for the Deputy Secretary**

- N/A

**Requests for the Chief of Staff**

- N/A

Please let me know if you have any questions or require additional information.

Thank you,  
Marie Ladino



**Marie Ladino**  
Writer-Editor  
U.S. Patent and Trademark Office

[Marie.Ladino@uspto.gov](mailto:Marie.Ladino@uspto.gov)  
Tel: 571-270-3186



*USPTO Input for Potential Inclusion in:*  
**Principals' Biweekly Report**  
Bureau Developments, Events, Priorities, and Risks  
**09/26/22 – 10/21/22**



**USPTO0164**

Outlined below are major developments across the USPTO, key upcoming events, status of key priorities, and risks, issues, and concerns.

## 1. Major Developments Across the Bureau

- **USPTO’s Council for Inclusive Innovation (CI<sup>2</sup>) Added Government Leaders to Top Spots:** On September 27, Secretary Raimondo, Chair of the USPTO’s CI<sup>2</sup>, and Director Vidal, Vice Chair of CI<sup>2</sup>, announced the addition of new Co-Vice Chairs to the Council: Alejandra Castillo, Assistant Secretary of Commerce for Economic Development; Laurie Locascio, Under Secretary of Commerce for Standards and Technology and Director of the National Institute of Standards and Technology; Shira Perlmutter, Register of Copyrights and Director of the U.S. Copyright Office; Dr. Sethuraman Panchanathan, Director of the National Science Foundation; and Don Cravins Jr., Under Secretary of Commerce for Minority Business Development. These government leaders will help guide the Council in developing a national strategy to build a more inclusive and diverse innovation ecosystem.

## 2. Operating Metrics

- As of September 30, over 103,000 trademark applicants and practitioners had successfully verified their identities for their USPTO.gov accounts.
- As of September 30, 80% of mailed actions regarding patent applications met pendency targets, and 85% of remaining patent application inventory met pendency targets.
- As of October 2, first action pendency for trademark applications remained steady from the previous week at 8.4 months.
- (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv During the week of September 25, the USPTO sent offers to approximately 50 new examining attorneys to begin October 24.

## 3. Status of Key Priorities

- **Protect Innovation in the U.S. and Around the Globe:** On October 4, the USPTO published a request for comments on initiatives directed at bolstering the robustness and reliability of patents. (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv
- **Bring Innovation to Impact:** On September 28, the USPTO published a Federal Register Notice extending the Cancer Immunotherapy Pilot Program until January 31, 2023. (b)(5)  
(b)(5) Delib Proc Priv

## 4.

(b)(5)

- On October 4, Director Vidal issued a precedential Director review decision regarding abuse of the IPR process in *OpenSky Industries, LLC v. VLSI Technology LLC*. Although most Director review decisions garner some IP press, the *OpenSky* case received significant attention from both the press and Congress even before the decision issued, and the USPTO has seen quite a bit of press on the Director’s decision itself (b)(5) Delib Proc Priv  
(b)(5) Delib Proc Priv
- (b)(5) Delib Proc Priv



Outlined below are additional status updates for the Secretary and Deputy Secretary. Note this slide is not required.

- **USPTO Extended Public Comment Period for Feedback on Director Review, Precedential Opinion Panel (POP) Review, and Internal Circulation and Review of Patent Trial and Appeal Board (PTAB) Decisions:** On September 26, the USPTO published a Federal Register Notice announcing an extension of the public comment period until October 19 for feedback on Director review, POP review, and the internal circulation and review of PTAB decisions.
- **USPTO's PTAB Extended the Fast-Track Appeals Pilot Program:** On September 29, the USPTO's PTAB announced the second extension of the Fast-Track Appeals Pilot Program. Under this program, appellants with a docketed ex parte appeal may file a petition to expedite review of the appeal by the PTAB. The extension continues the program through July 2, 2024.
- **USPTO's PTAB Extended Motion to Amend (MTA) Pilot Program:** On September 30, the USPTO's PTAB announced an extension of the MTA Pilot Program until September 16, 2024. The program provides a patent owner who files an MTA with options to request preliminary guidance from the PTAB on the MTA and to file a revised MTA.
- **USPTO Hosted Webinar with WIPO on the Use of Alternative Dispute Resolution (ADR) for Disputes Related to Standard Essential Patents (SEPs):** On October 6, the USPTO and WIPO hosted a webinar on the use of ADR for disputes involving SEPs. This event resulted from the MOU the USPTO and WIPO signed in July regarding efforts to facilitate dispute resolution related to SEPs.
- **USPTO Co-hosts 2022 Fall Virtual Forum:** On October 11 and 13, the USPTO, in collaboration with the League of United Latin American Citizens Federal Training Institute and the National Council of Hispanic Employment Program Managers, will host the 2022 Fall Virtual Forum. This event will focus on assisting agencies in recruiting, retaining, and developing Hispanics and other talented people from under-represented groups.
- **USPTO Hosts 2022 Hispanic Innovation and Entrepreneurship Program:** On October 12, the USPTO will host the 2022 Hispanic Innovation and Entrepreneurship Program. During the event, participants will learn from successful Hispanic innovators about their creative and business journeys and from experts about resources and funding that can help inventors and entrepreneurs.

# Strategic Plan Appendix: 6-Month Goals

Please list and briefly describe up to five 6-month (by December 2022) policy goals for your bureau.  
Indicate the Strategic Objective they correspond to.

## 6-Month Goals

(b)(5) Delib Proc Priv

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