

**From:** [Trials](#)  
**To:** [Hamad Hamad](#); [MidAmerican@fredlaw.com](mailto:MidAmerican@fredlaw.com); [midwest@caldwellcc.com](mailto:midwest@caldwellcc.com); [dtobin@mwe.com](mailto:dtobin@mwe.com); [Boaks@mwe.com](mailto:Boaks@mwe.com); [PacifiCorp-PTAB-ME2C@mwe.com](mailto:PacifiCorp-PTAB-ME2C@mwe.com); [rsjohnson@fredlaw.com](mailto:rsjohnson@fredlaw.com); [tpatton@fredlaw.com](mailto:tpatton@fredlaw.com); [cdonels@fredlaw.com](mailto:cdonels@fredlaw.com)  
**Cc:** [Trials](#)  
**Subject:** RE: IPR2025-00274, -278, -280, -281, -422 -423, -424, -425 // Deposition and Discovery Requests  
**Date:** Wednesday, December 10, 2025 1:30:04 PM  
**Attachments:** [image001.png](#)

---

Counsel,

Patent Owner is authorized to file a Motion for Additional Discovery related to real parties-in-interest issues in the above-captioned matters. Patent Owner's Motion shall be filed on or before December 15, 2025 and shall be limited to 5 pages, and no evidence may be submitted with the motion.

Petitioner is authorized to file a Response to Patent Owner's Motion. Petitioner's Response shall be filed on or Before December 19, 2025 and shall be limited to 5 pages, and no evidence may be submitted with the response.

Patent Owner's request that the Board extend the case deadlines by up to six months is denied at this time. Our intent is stay within the one year statutory period for issuing a Final Written Decision. We expect to allow the parties to brief RPI issues separately from issues relating to patentability to make it easier for them to be expeditiously resolved. Accordingly, there is no need to move the deadline for the Patent Owner Response to accommodate RPI discovery. To the extent Patent Owner has concerns regarding the appealability of our decision on RPI, Petitioner has indicated that it is willing to stipulate to steps to preserve appealability of the RPI issue. In addition, Patent Owner is authorized to style its briefing on the RPI issue as a supplement to Patent Owner's Response. Further, as set forth in our Scheduling Order, the parties are free to stipulate to move many of the deadlines in this case. We expect that this freedom will allow Patent Owner's scheduling concerns to be resolved by agreement of the parties.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571) 272-5366



---

**From:** Hamad Hamad <[hhamad@caldwellcc.com](mailto:hhamad@caldwellcc.com)>

**Sent:** Friday, December 5, 2025 6:36 PM

**To:** Trials <Trials@USPTO.GOV>

**Cc:** midwest@caldwellcc.com; dtobin@mwe.com; Boaks@mwe.com; PacifiCorp-PTAB-ME2C@mwe.com; rsjohnson@fredlaw.com; tpatton@fredlaw.com; cdonels@fredlaw.com; MidAmerican@fredlaw.com

**Subject:** RE: IPR2025-00274, -278, -280, -281, -422 -423, -424, -425 // Deposition and Discovery Requests

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

Dear Board,

I write on behalf of the Parties in response to the Board's December 3, 2025, email regarding Additional Discovery, and to raise a scheduling issue that could impact quickly approaching deadlines.

### **Scope of Additional Discovery**

First, the Parties could not come to an agreement regarding the scope of Additional Discovery. Patent Owner requests that the Board order the discovery identified in its November 10, 2025 email. Petitioners contend that no Additional Discovery is necessary in view of documents already produced to Patent Owner, but further discovery (if any) should be more "narrowly tailored." Petitioners further state that if Patent Owner is allowed to take discovery into Petitioners' litigation "contentions" and "communications" regarding those contentions, Petitioners would request reciprocal discovery into Patent Owner's "contentions" and surrounding "communications." Accordingly, the Parties jointly present the below proposed schedule for briefing on the scope of Additional Discovery.

- December 12, 2025: Patent Owner's Brief Regarding Additional Discovery
- December 19, 2025: Petitioners' Responsive Brief Regarding Additional Discovery

### **Timeline for Additional Briefing on RPI/Privity Issues**

Second, because the Parties could not agree on the scope of Additional Discovery, neither Patent Owner nor Petitioners believed they had the information necessary to propose a briefing schedule regarding the merits of new evidence addressing RPI/time-bar issues, per the Board's instruction below. The scope of Additional Discovery will necessarily impact the time needed to complete it. Therefore, the Parties jointly propose that, after the Board decides the scope of Additional Discovery, the parties will further meet-and-confer and propose a schedule for briefing regarding the merits of new evidence addressing RPI/time-bar issues.

### **Moving the Merits Briefing Under Section 316(a)(11)**

Third, in light of these developments and the Director's Remand Order, Patent Owner respectfully requests that the Board extend the case deadlines by up to six months pursuant to 35 U.S.C. § 316(a) (11). As the Director pointed out in his Remand Order, "RPI and privity issues should be resolved as early as possible in a proceeding," and that these issues should be settled before institution. See, e.g., Paper 57 at 3 n.4 (citing Memorandum entitled Precedential Designation of *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (Oct. 28, 2025) at 4, 23-24). Additionally, Patent Owner will need to address these issues in its Patent Owner Responses. In view of the above, Patent Owner believes that the Board's reconsideration of the RPI and privity issues should be completed before the post-institution case deadlines (including Patent Owner's upcoming deadline to file Patent Owner Responses in four of the matters on December 15, 2025), so that Patent Owner may fully address these issues and preserve them for appeal (if necessary) in its Patent Owner Responses. Because the underlying district court litigation is stayed, Patent Owner does not believe that this moderate extension will not prejudice Petitioners, but will instead ensure a fair process for both sides.

Accordingly, Patent Owner respectfully submits that there is good cause for the Board to extend the case schedule by up to six months to accommodate the following:

- Time to address the Parties' disputes regarding the scope of Additional Discovery;
- Time for the Parties to complete the Additional Discovery;
- Time for the Parties to submit additional briefing;
- Time for the Board to determine whether the Petitions are time-barred under § 315(b);
- Time for any additional Director Review Requests, as contemplated by the Remand Order, see Paper 57 at 5.

Petitioners have provided the following position statement with respect to Patent Owner's request to extend the case schedule: Petitioners oppose modifying the schedule or extending the case deadlines under Section 316(a)(11). Petitioners have already provided routine discovery in the form of cross-examination of their expert declarant, Dr. Niksa. The Director Remand Order has provided for a separate set of briefing limited to RPI and privity issues. Thus, the Additional Discovery and RPI/privity issues are wholly unrelated to the merits briefing (e.g., anticipation/obviousness) in Due Dates 1-3. The RPI/privity briefing can proceed in parallel with the briefing on the merits in Due Dates 1-3. To alleviate Patent Owner's concerns about appealability of the RPI and privity issues, if the case schedule is left unchanged, Petitioners are willing to stipulate that: (a) the RPI/privity arguments presented in the additional briefing would be preserved for appeal; (b) the RPI/privity issues need not be raised in Due Dates 1-3; (c) Patent Owner's additional (opening) brief on RPI/privity issues would be treated as a "Patent Owner Response" for those RPI/privity issues and deemed filed under 37 CFR § 42.120; and (d) Petitioners' response brief on RPI/privity issues would be treated as a "Petitioners' Reply" and deemed filed under 37 CFR § 42.23. In this way, the merits briefing (Due Dates 1-3) and additional briefing (from Director Remand Order) can all proceed apace without extending the hearing date, final written decision date, or case schedule under Section 316(a)(11).

Patent Owner appreciates Petitioners' proposal, but it appears to run afoul 37 CFR § 42.120's requirement that Patent Owner "may file a **single** response to the petition and/or decision on institution." Furthermore, Patent Owner submits that section 120 highlights the need for additional time: Patent Owner is entitled to receive a decision on institution so that it can respond to that decision in the single Patent Owner Response.

To the extent the Board maintains Due Dates 1-3, Patent Owner and Petitioner jointly request that the Board waive the requirement of a "single response to the petition" under Rule 42.120(a).

Given the upcoming deadline to submit its Patent Owner Responses on December 15, 2025, Patent Owner respectfully requests that the Board rule on this request or schedule a conference call at its earliest convenience.

\* \* \*

Please let us know if you have any questions. The Parties will provide their availability for a conference call at the Board's request.

Sincerely,  
Hamad Hamad  
Counsel for Patent Owner

---

**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Sent:** Wednesday, December 3, 2025 11:53 AM

**To:** Hamad Hamad <[hhamad@caldwellcc.com](mailto:hhamad@caldwellcc.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** [midwest@caldwellcc.com](mailto:midwest@caldwellcc.com); [dtobin@mwe.com](mailto:dtobin@mwe.com); [Boaks@mwe.com](mailto:Boaks@mwe.com); [PacifiCorp-PTAB-ME2C@mwe.com](mailto:PacifiCorp-PTAB-ME2C@mwe.com); [rsjohnson@fredlaw.com](mailto:rsjohnson@fredlaw.com); [tpatton@fredlaw.com](mailto:tpatton@fredlaw.com); [cdonels@fredlaw.com](mailto:cdonels@fredlaw.com); [MidAmerican@fredlaw.com](mailto:MidAmerican@fredlaw.com)

**Subject:** RE: IPR2025-00274, -278, -280, -281, -422 -423, -424, -425 // Deposition and Discovery Requests

**Warning: Unusual sender** <[trials@uspto.gov](mailto:trials@uspto.gov)>

You don't usually receive emails from this address. Make sure you trust this sender before taking any actions.

Counsel,

The parties are hereby instructed to meet and confer on the appropriate scope of discovery required to address RPI and privity issues in view of the Director's instruction in the Decision on Patent Owner's Request for Director Review to "allow discovery, narrowly tailored to resolve the RPI and privity issues"

including “at least materials sufficient to clarify the evidence the Board found to be ‘ambiguous’ and to avoid the need for the Board to ‘speculate as to the nature of the redacted material.’” In addition, the parties are instructed to meet and confer on a schedule for briefing new evidence addressing RPI issues. The parties shall provide the Board with a proposed briefing schedule by email on or before December 15, 2025.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571) 272-5366



---

**From:** Hamad Hamad <[hhamad@caldwellcc.com](mailto:hhamad@caldwellcc.com)>  
**Sent:** Monday, November 10, 2025 4:16 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** [midwest@caldwellcc.com](mailto:midwest@caldwellcc.com); [dtobin@mwe.com](mailto:dtobin@mwe.com); [Boaks@mwe.com](mailto:Boaks@mwe.com); [PacifiCorp-PTAB-ME2C@mwe.com](mailto:PacifiCorp-PTAB-ME2C@mwe.com); [rsjohnson@fredlaw.com](mailto:rsjohnson@fredlaw.com); [tpatton@fredlaw.com](mailto:tpatton@fredlaw.com); [cdonels@fredlaw.com](mailto:cdonels@fredlaw.com); [MidAmerican@fredlaw.com](mailto:MidAmerican@fredlaw.com)  
**Subject:** IPR2025-00274, -278, -280, -281, -422 -423, -424, -425 // Deposition and Discovery Requests

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

Dear Board,

Patent Owner respectfully requests authorization to file a Motion for Additional Discovery related to real parties-in-interest issues in the above-captioned matters.

First, Patent Owner requests a deposition of the person at PacifiCorp most knowledgeable the Talen license agreement, and a corporate designee that can testify on the following topics:

1. PacifiCorp’s knowledge of the Talen Agreement.
2. PacifiCorp’s contentions regarding the extent to which PacifiCorp is entitled to enforce the Talen Agreement.
3. PacifiCorp’s relationship with Talen, including the existence of (1) an agreement between the

parties to be bound; (2) pre-existing substantive legal relationships between the parties; (3) adequate representation of PacifiCorp by Talen with respect to the Delaware Litigation; (4) the Talen's control of the prior litigation.

4. PacifiCorp's communications with Talen regarding ME2C, ME2C's patents, and/or the Talen Agreement.

Second, Patent Owner also requests a deposition of a corporate designee from BHE that can testify on the following topics:

1. BHE's corporate relationship with MidAmerican and PacifiCorp, including its exercise of control over those entities.
2. BHE's knowledge of MidAmerican's relationship with any Defendants in the Delaware litigation.
3. BHE's knowledge of the Talen Agreement.
4. BHE's and its subsidiaries' relationship with Chem-Mod and any Chem-Mod licensees, including the existence of (1) an agreement between the parties to be bound; (2) pre-existing substantive legal relationships between the parties; (3) adequate representation of BHE by Chem-Mod and/or its licensees with respect to the Delaware Litigation; (4) the Chem-Mod's and/or its licensee's control of the prior litigation.
5. BHE's relationship with Talen, including the existence of (1) an agreement between the parties to be bound; (2) pre-existing substantive legal relationships between the parties; (3) adequate representation of BHE by Talen with respect to the Delaware Litigation; (4) the Talen's control of the prior litigation.
6. Any indemnity requests or responses exchanged between BHE and/or its subsidiaries and any Defendants named in the Delaware Litigation.

Third, Patent Owner also requests that Petitioners produce documents that are relevant to real party-in-interest issues, including at least:

1. Documents related to BHE's corporate relationship with MidAmerican and PacifiCorp, including its exercise of control over those entities.
2. Documents and communications related to or describing the Petitioners' relationships with past or current Defendants in the Delaware litigation, including Talen.
3. Documents and communications related to or describing Petitioners' knowledge of the Talen Agreement and the negotiations leading up to the Talen Agreement.
4. Petitioners' communications with Talen (or its affiliates) regarding ME2C, ME2C's patents, and/or the Talen Agreement.

Given the issues before the Board in these matters, this requested discovery is "necessary in the interests of justice," 35 U.S.C. § 316(a)(5)(B), and meets the standard laid out in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential).

Patent Owner has conferred via email with counsel for Petitioners, who provided the following statement:

Petitioners state that they have already produced agreements with defendants in the Delaware litigation, to the extent there are any, and Patent Owner has cited such agreements in its POPR briefing. Patent Owner has not explained the relevance (if any) of each discovery request, how the request is appropriately tailored, or how the request meets the *Garmin* factors, and thus Petitioners oppose the above-requested discovery.

If the Board wishes to schedule a conference call to discuss the above, the Parties will provide their collective availability for a call upon request.

Sincerely,  
Hamad Hamad  
Counsel for Patent Owner

Hamad Hamad /// Caldwell Cassidy Curry P.C.

2121 North Pearl Street, Suite 1200

Dallas, Texas 75201

Direct: 214.888.4843

Firm: 214.888.4848

Fax: 214.888.4849

[hhamad@caldwellcc.com](mailto:hhamad@caldwellcc.com)

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

NOTICE OF CONFIDENTIALITY:

The information contained in this e-mail is subject to the ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the recipient(s) designated above. Any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the recipient(s) designated by the sender is unauthorized and prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.