
From: Joseph Mercadante <jmercadante@fabricantllp.com>
Sent: Friday, December 12, 2025 9:00 AM
To: Jennifer Huang; Jeremy Monaldo; PTAB
Cc: Peter Lambrianakos; Vincent Rubino; Alfred Fabricant; Julian Pymonto; IPR50095-0245IP1
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

Jennifer, Patent Owner does not oppose your motion to withdraw the challenges to claims 8-11.

Joseph Mercadante
Partner
Fabricant LLP
T: 646-797-4343 | M: 973-420-4011 | jmercadante@fabricantllp.com

From: Jennifer Huang <jhuang@fr.com>
Sent: Thursday, December 11, 2025 9:16 PM
To: Joseph Mercadante <jmercadante@fabricantllp.com>; Jeremy Monaldo <Monaldo@fr.com>; PTAB <PTAB@fabricantllp.com>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Fred Fabricant <ffabricant@fabricantllp.com>; Julian Pymonto <jpymonto@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

Dear Counsel:

The Board's Institution Decision observed that claims 8-11, which are device claims that depend directly from withdrawn claim 6, remain challenged claims in the IPR proceeding for the '101 Patent. Because claims 8-11 depend on withdrawn claim 6, Petitioner intends to request authorization to file a motion to withdraw its challenges to claims 8-11. Please let us know whether Patent Owner opposes a motion to withdraw challenges to claims 8-11 and whether Patent Owner would agree to a joint motion to withdraw the challenges to claims 8-11 to streamline the Board's review of the petition filed in the above-referenced proceeding. A proposed email to the Board follows.

Best,
Jenny

IPR2025-01103 –Motion to Withdraw Challenges to Claims 8-11

Your Honors,

In an effort to further streamline the Board's review of the present petition and to make the most efficient use of Board resources, Petitioner requests authorization to file a motion to withdraw its challenges to claims 8-11 and for the present proceeding to move forward on only the challenges to claims 7 and 12. The Board previously granted Petitioner's motion to withdraw claims 1-6 in response to a district court

Markman order. As the Board noted in its Institution Decision, claims 8-11 are dependent on claim 6, which has been withdrawn.

Petitioner has conferred with Patent Owner and Patent Owner **opposes/does not oppose** a motion to withdraw the challenges to claims 8-11.

The parties are available for a conference call with the Board to discuss the proposed motion, if requested.

Respectfully submitted,

From: Joseph Mercadante <jmercadante@fabricantllp.com>
Sent: Monday, November 03, 2025 11:12 AM
To: Jeremy Monaldo <Monaldo@fr.com>; PTAB <PTAB@fabricantllp.com>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Alfred Fabricant <ffabricant@fabricantllp.com>; Julian Pymento <jpymento@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>
Subject: Re: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

All of those times work for us except for Thursday from noon to 2

Joseph Mercadante
Partner
Fabricant LLP
jmercadante@fabricantllp.com
M: 973-420-4011

From: Jeremy Monaldo <Monaldo@fr.com>
Sent: Monday, November 3, 2025 11:29:32 AM
To: Joseph Mercadante <jmercadante@fabricantllp.com>; PTAB <PTAB@fabricantllp.com>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Fred Fabricant <ffabricant@fabricantllp.com>; Julian Pymento <jpymento@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

Thanks Joseph. Please find below a modified version of the email with availability listed:

IPR2025-01103 – *Markman* Order and Motion to Withdraw Challenges to Claims 1-6

Your Honors,

Petitioner writes to inform the Board of a *Markman* order issued on October 10, 2025 in Patent Owner’s litigation with Google LLC captioned as Case No. 2:24-CV-353-JRG in the United States District Court for the Eastern District of Texas Marshall Division. The *Markman* order found that the claim term “a list information transmission unit...” recited in claims 1 and 6 of U.S. Patent No. 8,230,101 (“the ’101 Patent”) is governed by § 112, ¶ 6 and is indefinite as lacking structural support. The finding of indefiniteness implicates claims 1-6 of the ’101 Patent, but does not implicate claims 7-12 of the ’101 Patent, which do not include the relevant claim term.

In an effort to streamline the Board's review of the present petition and to make the most efficient use of Board resources, Petitioner requests authorization to file a motion to withdraw its challenges to claims 1-6 and for the present proceeding to move forward on only the challenges to claims 7-12.

Petitioner has conferred with Patent Owner and Patent Owner does not oppose a motion to withdraw the challenges to claims 1-6.

The parties are available for a conference call with the Board to discuss the proposed motion at the following dates and times:

Wednesday, November 5, 2025 10 AM – 1 PM and 2 PM – 5 PM ET

Thursday, November 6, 2025 – 11 AM – 3 PM ET

Friday, November 7, 2025 before 2:30 PM ET

Respectfully submitted,

From: Joseph Mercadante <jmercadante@fabricantllp.com>
Sent: Monday, November 03, 2025 9:19 AM
To: Jeremy Monaldo <Monaldo@fr.com>; PTAB <PTAB@fabricantllp.com>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Alfred Fabricant <ffabricant@fabricantllp.com>; Julian Pymento <jpymento@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

[This email originated outside of F&R.]

Jeremy, we do not oppose a motion to withdraw the challenges to claims 1-6. Let us know what times you are thinking of proposing for potential calls with the Board, if necessary, and we will let you know if those work for us.

Joseph Mercadante

Partner
Fabricant LLP
T: 646-797-4343 | M: 973-420-4011 | jmercadante@fabricantllp.com

From: Jeremy Monaldo <Monaldo@fr.com>
Sent: Monday, November 3, 2025 7:41 AM
To: PTAB <PTAB@fabricantllp.com>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Fred Fabricant <ffabricant@fabricantllp.com>; Joseph Mercadante <jmercadante@fabricantllp.com>; Julian Pymento <jpymento@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

Counsel,

We wanted to follow up on the below email. Absent a response by COB today, we intend to email the Board tomorrow morning, noting Patent Owner's lack of response.

Best Regards,
Jeremy

Jeremy Monaldo

Principal ■ Fish & Richardson P.C.

T: 202 626 7717

Monaldo@fr.com | [Bio](#) | [LinkedIn](#) | [fr.com](#)

1000 Maine Avenue SW, Suite 1000, Washington, DC 20024

From: Jeremy Monaldo

Sent: Wednesday, October 29, 2025 3:40 PM

To: 'PTAB' <ptab@fabricantllp.com>

Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Alfred Fabricant <ffabricant@fabricantllp.com>; jmercadante@fabricantllp.com; jpymento@fabricantllp.com; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>

Subject: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

Counsel,

We were recently informed of a finding of invalidity in the Google litigation, where Judge Gilstrap issued the attached claim construction order determining that one of the terms recited in the '101 patent is indefinite. Petitioner intends to request authorization to file a motion to withdraw its challenges to claims 1-6 given the finding of indefiniteness. Please let us know of whether Patent Owner opposes a motion to withdraw challenges to claims 1-6 and whether Patent Owner would agree to a joint motion to withdraw the challenges to claims 1-6 to streamline the Board's review of the petition filed in the above-referenced proceeding. A proposed email to the Board follows.

IPR2025-01103 – *Markman* Order and Motion to Withdraw Challenges to Claims 1-6

Your Honors,

Petitioner writes to inform the Board of a *Markman* order issued on October 10, 2025 in Patent Owner's litigation with Google LLC captioned as Case No. 2:24-CV-353-JRG in the United States District Court for the Eastern District of Texas Marshall Division. The *Markman* order found that the claim term "a list information transmission unit..." recited in claims 1 and 6 of U.S. Patent No. 8,230,101 ("the '101 Patent") is governed by § 112, ¶ 6 and is indefinite as lacking structural support. The finding of indefiniteness implicates claims 1-6 of the '101 Patent, but does not implicate claims 7-12 of the '101 Patent, which do not include the relevant claim term.

In an effort to streamline the Board's review of the present petition and to make the most efficient use of Board resources, Petitioner requests authorization to file a motion to withdraw its challenges to claims 1-6 and for the present proceeding to move forward on only the challenges to claims 7-12.

Petitioner has conferred with Patent Owner and Patent Owner [opposes Petitioner's request for a motion to withdraw the challenges to claims 1-6/does not oppose Petitioner's request for a motion to withdraw its challenges to claims 1-6/agrees to a joint motion to withdraw the challenges to claims 1-6].

The parties are available for a conference call with the Board to discuss the proposed motion at the following dates and times:

[Insert Availability]

Respectfully submitted,

Best Regards,
Jeremy

Jeremy Monaldo
Principal ■ Fish & Richardson P.C.

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