Exhibit B

RUSS AUGUST & KABAT LAWYERS

Jacob Buczko
jbuczko@raklaw.com

12424
Wilshire Boulevard
12th Floor
Los Angeles
California
90025

Tel 310.826.7474
Fax 310.826.6991
www.raklaw.com

September 30, 2019

Via Email

Andrew Trask
Williams & Connelly LLP
725 Twelfth Street, N.W.
Washington, DC 20005
atrask@wc.com

Re: *Network-1 Techs., Inc. v. Google LLC et al.*, Case Nos. 14-cv-2396 & 14-cv-9558 (S.D.N.Y.)

Dear Andrew:

I write in response to your September 12, 2019 letter and today's email regarding Amster Rothstein & Ebenstein LLP's privilege log.

First, I want to reiterate ARE's objections to Google's overbroad subpoena and Google's accompanying demand for a privilege log. ARE is, of course, a law firm and is trial counsel in this case. Requiring a privilege log based on overbroad document requests in these circumstances is unduly burdensome and not proportional to the needs of this case. *See* Local Civil Rule 26.2 (Committee Notes); Dkt. 3 at ¶ 2(D). I note that in your entire September 12 letter, you did not once explain any purported relevance of documents sought by Google.

Notwithstanding, to move forward and avoid burdening the Court with privilege log disputes, ARE served an Amended Privilege Log the previous business day. ARE also produced a number of documents it previously withheld as privileged. Every log entry Google raised in its letter were either produced or amended. The Amended Log includes the same reference numbers as the previous log, so Google should easily be able to discern how ARE addressed Google's issues.

To address Google's issues:

1. Communications regarding "marketing and sale:" We disagree with Google's position that the topic of "marketing and sale" cannot include legal advice or be made in anticipation of litigation. *See, e.g., Intellectual Ventures I LLC v. Altera Corp.*, No. CV 10-1065-LPS, 2013 WL 12322005, at *3 (D. Del. July 25, 2013) ("patent valuation, while in this instance tied to business decisions of patent acquisition, may be intertwined with legal analysis, including considerations of claim scope, validity, and licensing power"). We have reviewed again the specific entries identified by Google (fns. 1 and 2 of 9/12 letter). The Amended Privilege Log clarifies that Google's listed entries involve legal advice and/or were made in anticipation of litigation. We note, *e.g.*, Amended Log Ref IDs 2-8, 639, 1008-1009, 1037-1038, 1079-1080, and 1138-1139, which show continuous anticipation of litigation going back to 2006.

Regarding entries protected under the Common Interest doctrine, it is well established in the law that patent licensing and enforcement can be a basis for a common legal interest. *See Intellectual Ventures*, 2013 WL 12322005, at *5. It is clear from the common interest agreements already produced and the documents produced with the Amended Privilege Log that ARE, Dr. Cox, Intangible Edge/Mr. Lucier, and Network-1/Mssrs. Horowitz and Greene all shared a common interest in regard to enforcement of the portfolio, which includes licensing and litigation. In addition, the Common Interest doctrine also applies patent prosecution activities where the parties, like the parties here, all shared an interest in obtaining strong and enforceable patents. *In re Regents of Univ. of California*, 101 F.3d 1386, 1390 (Fed. Cir. 1996); *Crane Sec. Techs., Inc. v. Rolling Optics, AB*, 230 F. Supp. 3d 10, 20 (D. Mass. 2017)(the "[common] interest that potential licensees and patent owners have in successfully prosecuting patent applications" is "widely recognized in the law.") That said, ARE is producing a number of documents previously withheld, including a few documents related to potential pursuits aside from litigation and licensing.

2. Work product generally: You assert "we are aware of no basis for the assertion of the work-product doctrine at any point prior to sale of the Cox patent portfolio in February 2013." Described above, ARE and its client considered infringement and enforcement of the Cox portfolio as early as 2006 and continuously until this case was filed. For 2013, and beyond, Mr. Halpern confirmed, for example, that in 2013, when ownership of the patents changed to Network-1, a conflict waiver contemplated "enforcement" of the portfolio, which includes litigation and licensing. *See* Halpern Tr. at 141:18-142:21. Your letter misunderstands Mr. Halpern's testimony that at the time of the waiver, "the parties weren't specifically contemplating litigation … with respect to the Cox patent portfolio." *Id.* at 142:22-143:4. The conflicts waiver was an agreement amongst ARE's clients, and Mr. Halpern confirmed that the parties to the waiver were not contemplating litigation with each other (hence the conflicts waiver). In any event, the Amended Log shows ARE was anticipating litigation regarding specific products and patents as early as 2006. Work going forward, as designated on the Amended Log, was with an eye towards litigation and constituted protected work product. *See Application of Minebea Co., Ltd.*, 143 F.R.D. 494, 499 (S.D.N.Y. 1992)("This rule does not, however, preclude application of the work-product protection to work performed to prosecute a patent application if it was also performed in anticipation of or concerning litigation.")(patent prosecution work performed while litigation was anticipated protected by work product doctrine); *Stix Prod., Inc. v. United Merchants & Mfrs., Inc.*, 47 F.R.D. 334, 337 (S.D.N.Y. 1969) (documents prepared with "litigation in mind" or "with an eye toward" or where "the prospect of litigation is identifiable" are protected work product.)

3. Documents reviewed by ARE's rule 30(b)(6) witness: Your request for privileged documents consulted by Mr. Halpern in preparation for ARE's Rule 30(b)(6) deposition is baseless. Even the case you cite, *In re Rivastigmine Patent Litig.*, 486 F. Supp. 2d 241, 243 (S.D.N.Y. 2007) confirms this. For example, the case explains Google's argument that simply reviewing a document in preparation for deposition somehow waives privilege is "inconsistent with the advisory committee note indicating that Rule 612 does not bar the assertion of privilege with respect to documents used to refresh a witness' recollection." *Id.* Accordingly, courts have required a separate waiver of privilege to warrant production of otherwise privileged documents reviewed by a

deponent. *Suss v. MSX Int'l Eng'g Servs., Inc.*, 212 F.R.D. 159, 163–64 (S.D.N.Y. 2002). Google has failed to argue there was any waiver by Network-1 or any holder of privilege, and for good reason, there was none. Therefore the privileged documents reviewed by Mr. Halpern need not be produced.

4. "Vendor" entries 2422-2436: The Amended Log clarifies the descriptions for these documents to provide additional information for Google to assess the privileges.

5. Other matters: The Amended Log provides additional detail for many, if not all, of the entries previously described as concerning "background materials for case" and "email regarding attorney work product." In addition, ARE is producing entry 357.

You will see that the additional documents produced by ARE have little to no relevance to the underlying case. What little relevance they may have is not proportional to the burden that has already been undertaken by ARE to locate nonprivileged documents in the law firm's files. We trust there are no remaining disputes. We are happy to meet and confer, but it is not worthwhile to have general discussions about privilege issues without specific entries in mind. So please, in advance of any meeting, identify specific log entries Google still contends should be produced. Please also be prepared to explain any purported relevance of the identified entries.

Best regards,

Russ, August & Kabat

/s/ Jacob Buczko

Jacob Buczko