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**Sent:** Tuesday, May 10, 2016 10:49 AM

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

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**Subject:** Request for Conference Call in CBM2015-00161 (CBM2016-00035), CBM2015-00172 (CBM2016-00040), CBM2015-00179, CBM2015-00181, CBM2015-00182, CBM2016-00009

Dear PTAB,

As pointed out in Patent Owner's mandatory notices, these proceedings involve patents that have been heavily litigated. They have survived numerous invalidation attempts both in district court and in the patent office, sometimes by consent judgement and sometimes by court/jury/examiner findings. During the course of the many proceedings involving these patents, millions of documents have been produced and scores of individuals have provided testimony. Although Patent Owner should not be prejudiced as a result of the inability of these CBMs to accommodate the large volume of material from these earlier proceedings supporting its positions, Patent Owner has spent the past few months identifying a very small subset of the documents and individuals, which it would be willing to move forward with in these CBMs if an agreement on their admissibility could be reached with Petitioners and if it was clear Patent Owner would not be prejudiced by such a compromise. To that end, Patent Owner has spent the last month trying to reach a compromise with Petitioners on how to get this small subset of material into these proceedings without unnecessarily increasing the cost of these proceedings. Although not required to do so, Patent Owner has even identified to Petitioners the specific documents and testimony (with pincites) from the prior proceedings that it seeks to rely on in its patent owner responses. Despite Patent Owner's attempts, the parties have been unable to reach a compromise. Accordingly, Patent Owner requests:

- Waiver of FRE 901 (authentication) in these proceedings such that either party in these proceedings can directly rely on (as opposed to only via an expert) documentary evidence without authenticating such evidence if the evidence was (i) produced by a party to a previous litigation (as

opposed to a third party) from its own records in the previous litigation, (ii) admitted as a trial exhibit in the previous litigation, and (iii) not subject to any dispute concerning authenticity in the prior litigation.

- Waiver of FRE 802 (hearsay) in these proceedings such that either party can directly rely on (as opposed to only via an expert) sworn testimony from other proceedings without preparing a new declaration for these proceedings so long as the opposing party has the opportunity to depose the testifying individual if it desires such a deposition;
- Additional discovery in the form of subpoenas to facilitate depositions of individuals listed on the attached spreadsheet, which was provided to Petitioners on May 2, 2016;
- The Board's guidance on Petitioners' duty to produce evidence related to how the GUI tools in their products were developed, which contradicts their positions that the claims are obvious because such evidence, for example, will show the state of mind of a POSITA, failure of others, copying, and other secondary considerations;
- An extension of the deadline for the Board to issue its final written decisions to facilitate further extensions of time for TT's patent owner responses; and
- To the extent these proceedings cannot be timely completed without depriving Patent Owner of a full and fair opportunity to defend its patents due to the limitations of these proceedings, which are not set up to deal with the volume of evidence Patent Owner has supporting the validity of its patents, and due to positions being taken by Petitioners, that the institution decisions be vacated.

The parties are available for a conference call to discuss these issues on May 11, 2016, after 1:30pm Eastern.

Best regards,

Joshua L. Goldberg

Backup Counsel for Patent Owner

**Joshua L. Goldberg**

**Attorney at Law**

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