

## Bittman, Scott

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**From:** Lindsay, Jonathan  
**Sent:** Thursday, September 19, 2013 5:24 PM  
**To:** Sean Luner; Wieland III, Charles (charles.wieland@bipc.com)  
**Cc:** Rick Lyon; Scheer, Michael J.; Dunham, Thomas M.; AV1-PRPS  
**Subject:** RE: IPR2013-00071 - Network-1's Discovery Obligations

Sean, Chad

As we previously stated, we reject Network-1's attempt to impose the burden upon Avaya to identify potentially inconsistent documents, especially when Avaya cannot access documents in Network-1's (and its expert's) possession, custody, or control. Consistent with Network-1's duty of candor to the PTO, and its discovery obligations to the Board, it is Network-1's responsibility to produce any documents that contain inconsistent information, whether or not Avaya can or does identify them.

With respect to your characterization of our July conversation, you had represented to us that Network-1 had fulfilled its "routine discovery" obligations at that time. Since making that representation, however, Network-1 has now taken many more positions including in its Response, Motion to Amend, and Expert declaration. Accordingly, documents that may not have contained "inconsistent information" before, may do so now. This is why we begin our email below with the introduction of "In view of Network-1's Response and Motion to Amend . . . ."

That said, if your position is that that Network-1, its attorneys, Dr. Knox, Mr. Horowitz, and the inventors, have produced all documents in their possession, custody, or control that include any information "that is inconsistent with a position advanced by [Network-1]" in this Proceeding, even in view of Network-1's Response and Motion to Amend, then you should confirm that position in writing.

Concerning your suggestion to obtain a protective order in this IPR to protect any confidential documents, Network-1 has been free to approach the Board for a protective order at any point before the filing of Network-1's Response and Motion to Amend, or even during the last six weeks following their filing. In any event, such documents would have been due "concurrent[ly] with the filing of the documents or things that contains the inconsistency," which in this Proceeding includes at least the Preliminary Response, Response, and Motion to Amend. 37 CFR § 42.51(b)(1)(iii). Consistent with the position that we have taken throughout this proceeding, Avaya would not oppose Network-1 approaching the Board for a protective order, even at this late date, in order to comply with its discovery obligations. We are generally available tomorrow or next week (other than during Dr. Knox's deposition) for such a call with the Board.

With respect to your offer to produce non-confidential documents, we expect that Network-1 will promptly produce any non-confidential documents produced, generated, filed, submitted, or otherwise disseminated by any party (including Network-1, the defendants, and third parties) that contain any information "that is inconsistent with a position advanced by [Network-1]" in this Proceeding. Again, however, if Network-1's position is that there are no such documents, even in view of Network-1's Response and Motion to Amend, then you should confirm that position in writing.

Regards,

Jonathan

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**From:** Sean Luner [mailto:sean@dovellaw.com]  
**Sent:** Wednesday, September 18, 2013 8:50 AM  
**To:** Lindsay, Jonathan

**Cc:** Wieland III, Charles (charles.wieland@bipc.com); Rick Lyon  
**Subject:** FW: IPR2013-00071 - Network-1's Discovery Obligations

Jonathan,

I am following up on my voicemail from yesterday and your e-mail to Chad (below).

After your June 26, 2013 e-mail (referenced below), on July 1, 2013, we discussed your concerns relating to Network-1's production. Based on our discussion, Avaya was going to identify specific documents that you wanted Network-1 to produce in this IPR proceeding and we were going to develop an approach to get you access to such documents (including confidential documents). We have been waiting for you to identify these documents. As a result, we were surprised by your recent e-mail.

We are willing to work with you to develop a strategy that will allow us to provide you with any non-privileged documents, including confidential documents, that you would like, whether or not they are required discovery. While the approach that you outlined below (*i.e.*, simply moving to modify the Protective Orders issued in all of the prior litigations) will not work for various reasons, we can evaluate other alternatives including requesting the Board to issue a Protective Order in this IPR proceeding and jointly requesting third-parties to allow you to access such documents. Because IPR proceedings are a new procedure and there has not been any guidance on the issue of producing confidential documents from prior litigations, we may need to be creative in developing the right approach.

Please coordinate with Rick Lyon from our office (copied). Together you should be able to develop an approach that will provide you with any documents that you would like without violating Protective Orders and the rights of third-parties. In the meantime, if you are interested in receiving all non-confidential documents produced by Network-1 in the prior litigations, let us know and we can provide them to you.

As always, thank you for your cooperation in this matter.

Sean

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**From:** Lindsay, Jonathan [<mailto:JLindsay@crowell.com>]  
**Sent:** Thursday, September 12, 2013 4:45 PM  
**To:** Wieland III, Charles; Mukai, Robert  
**Cc:** AV1-PRPS  
**Subject:** IPR2013-00071 - Network-1's Discovery Obligations

Chad,

In view of Network-1's Response and Motion to Amend, we are writing to follow up on our June 26, 2013 email regarding Network-1's discovery obligations in this Proceeding. As you know, Network-1 is required to produce all "relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency." 37 CFR § 42.51(b)(1)(iii).

- I. Network-1 Undoubtedly Has Relevant Information that is Inconsistent with Positions it has Advanced, and it Has Refused to Produce Such Information

The only documents that Network-1 has produced to date consist of (i) public pleadings from prior litigations and (ii) one email that was an exhibit in the *Cisco* litigation (which we specifically requested after identifying it as being relevant from the trial transcript). Yet, Network-1, its attorneys, Mr. Horowitz, and Dr. Knox, have all been involved in a series of litigations involving the '930 patent, and it is inconceivable that there are no other documents that are "inconsistent with a position" advanced by Network-1 in this Proceeding. Indeed, based on the public record, it appears that Dr. Knox served as both a non-infringement and invalidity expert in the *Cisco* litigation. As you know, we do not have access to

any of Dr. Knox's expert reports from the *Cisco* litigation, and you have not produced any. Nor have you produced any expert reports of the other defendants, which presumably would rebut and/or be inconsistent with Dr. Knox's opinions. We note that the IPR Rules do not limit the production of inconsistent positions to those taken by or authored by Network-1.

Similarly, Network-1 asserts that Secondary Considerations support the non-obviousness of the challenged claims. (See Response, at 53-58). Yet, Network-1 has only identified pieces of evidence that it alleges supports its position. Avaya believes that, especially since invalidity under 35 U.S.C. § 103 was an issue in the prior litigations, there should be documents and information that are inconsistent with Network-1's position. For example, in addition to the expert reports noted above, the prior litigations likely have involved evidence cited in those reports, discovery, and briefing on the issue.

## II. It Would Not be Unduly Burdensome for Network-1 to Identify and Produce Documents that Avaya Seeks

We also disagree with Network-1's previously-stated position that it has no obligation to search documents from the prior cases because of the large volume of documents that exist and that it is incumbent upon Avaya to specifically identify potentially inconsistent documents. That burden shifting is inconsistent with the Rules and, frankly, an impossibility given that Avaya has no way of knowing what documents that Network-1 has in its possession, custody, or control. Moreover, these documents were all generated during the course of litigation and the Dovel & Luner firm – the same firm that is counsel of record in this Proceeding – was counsel of record in the prior litigations. Thus, we find that Network-1's position lacks credibility.

## III. Network-1 Cannot Refuse to Produce Based on Confidentiality Grounds

Furthermore, Mr. Luner has previously taken the position that a protective order from the prior case would likely prohibit the production of relevant documents in this Proceeding. Again, however, consistent with Network-1's "duty of disclosure" to the PTO, and the rules of this Proceedings, it is Network-1's responsibility to obtain relief from any such prior protective order. Paragraph 21 of the Protective Order from the *Cisco* litigation specifically authorizes Network-1 to seek such relief:

21. This Protective Order shall not prevent the parties from applying to the Court for relief therefrom or modification thereto, or from applying to the Court for further or additional relief by way of protective orders or otherwise, or from agreeing between themselves to modifications of this Protective Order.

(Doc. 107, p. 18). Simply put, it is improper for Network-1 to refuse to produce based on confidentiality grounds. Network-1 withholding material information during this Proceeding could constitute inequitable conduct that renders the '930 patent unenforceable in the underlying district court litigation. If Network-1 has confidentiality concerns in this Proceeding, the IPR rules allow Network-1 to seek an appropriate Protective Order to protect any such information.

Please provide a written response to this email by no later than September 17, 2013 that: (1) indicates when Network-1 will produce additional documents, along with an explanation as to why the documents have not previously been produced, (2) confirms that Network-1, its attorneys, Dr. Knox, Mr. Horowitz, and the inventors, have produced all documents in their possession, custody, or control that include any information "that is inconsistent with a position advanced by [Network-1]" in this Proceeding, (3) confirms that Network-1 is searching documents produced, generated, and advocated by other parties (including the defendants in the prior litigations) and (4) explains the steps taken to locate inconsistent documents.

Regards,

Jonathan

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