[redacted] Case No. IPR2014-00172

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By: Oliver R. Ashe, Jr., Esq.
**ASHE, P.C.**
11440 Isaac Newton Sq. North
Suite 210
Reston, VA 20190
Tel.: (703) 467-9001
Fax: (703) 467-9002
E-mail: oashe@ashepc.com

Gregory M. Howison
**HOWISON & ARNOTT, LLP**
Lincoln Centre II
5420 LBJ Freeway, Suite 660
Dallas, Texas 75240
Tel.: (972) 680-6050
Fax: (972) 479-0464
E-mail: ghowison@dalpat.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION,
Petitioner,

v.

VIRNETX, INC. AND SCIENCE APPLICATION INTERNATIONAL CORPORATION,
Patent Owner

Case IPR2014-00172
Patent 6,502,135

# PETITIONER'S PROPOSAL REGARDING DISCOVERY

## I. INTRODUCTION

In accordance with the Order dated February 10, 2014 (Paper No. 23), the parties conferred regarding the Patent Owner's discovery requests. The ending point of these discussions was substantially the same as the starting point - VirnetX's Exhibits 2002-2005, which the Board has already ruled are overly broad. RPX and Apple presented proposed modifications to the VirnetX discovery requests with the objective of providing responsive information to VirnetX while balancing a variety of other factors. VirnetX rejected the RPX and Apple proposals.

## II. RPX'S PROPOSAL REGARDING DISCOVERY

The following reflects the proposal RPX presented to VirnetX:

REQUEST FOR PRODUCTION NO. 1: [redacted]

REQUEST FOR PRODUCTION NO. 2: Documents or things containing communications occurring on or prior to November 22, 2013, between RPX and Apple regarding the preparation or filing of the RPX IPRs.

REQUEST FOR PRODUCTION NO. 3: [redacted]

REQUEST FOR PRODUCTION NO. 4: Engagement agreements or retainer agreements and corresponding termination agreements between RPX and Sidley Austin, RPX and Howison & Arnott, and RPX and ASHE relating to the RPX IPRs.

WITNESS STATEMENTS/FOLLOW-UP INTERROGATORIES: RPX will provide written statement(s) by one or more witnesses to testify to communications in request for production Nos. 2, 3 and/or 4 (above) that were not reduced to writing. VirnetX may submit a reasonable number of follow-up interrogatories within the scope of such written statement(s).

MODIFICATION TO INSTRUCTIONS: Delete Instruction Nos. 3 and 4; add the term "responsive" before each instance of the term "document."

MODIFICATION TO DEFINITIONS: Limit "communications" to tangible means and limit the terms "RPX", "Apple", "Sidley Austin", "Howison & Arnott" and "ASHE" to employees (and/or partners) of each entity.

ADDITIONAL REQUIREMENTS: With respect to RFP Nos. 1-4, RPX proposes that all materials be produced in accordance with the provisions of the Default Protective Order currently in effect in these proceedings. Also, RPX proposes that the parties agree that the production of the documents in response to

RFP No. 4 would not be construed as a waiver of any privilege in these or any other proceedings.

## III. DISCUSSION

RPX believes its proposal strikes the appropriate balance between a number of potentially competing factors (producing information that is properly focused on the issues raised in the VirnetX motion for discovery; maintaining the current schedule for the patent owner's preliminary responses; avoiding unnecessarily delving into privileged information; achieving an efficient and cost-effective discovery process, *etc.*). VirnetX only accepted RPX's proposed RFP Nos. 1 and 4, but these RFP's were of the *same scope as or broader than* the original VirnetX RFPs.

Production in response to proposed RFP Nos. 1-4 would provide VirnetX with the information it sought regarding [redacted] any documents or things containing communications between Apple and RPX regarding the preparation and filing of the RPX IPR petitions (including the filing of corrected petitions); [redacted]; and the terms under which Sidley Austin, Howison & Arnott, and ASHE were each retained by RPX.

The Witness Statement/Follow-Up Interrogatories proposal (including an

opportunity for follow-up interrogatories) is intended to efficiently provide an organized and first-hand accounting of any communications encompassed by proposed RFP Nos. 2, 3 and 4 that were not reduced to writing. VirnetX flatly rejected this proposal and, in discussions, appeared to want to parlay the RPX proposal into a deposition under FRCP 30(b)(6), thereby *broadening* its original requests for discovery from RPX. VirnetX also flatly rejected an alternative RPX proposal to allow cross-examination of any Witness Statements, again advocating for an open-ended 30(b)(6)-style deposition. Frankly, in addition to timing and expense, RPX's largest concern with presenting any witnesses for live testimony is that it will be perceived by VirnetX as an unfettered opportunity to expand the scope of any discovery granted by the PTAB which, in turn, will provoke voluminous disputes regarding scope and privilege that will likely require significant PTAB involvement for resolution.

The reasonableness of VirnetX's current position should be viewed in light of the fact that, after RPX filed its petitions, VirnetX waited 36 days before seeking access to Exhibits 1072 and 1073 and 47 days before raising the issue of discovery with the PTAB.

Respectfully submitted,

/Oliver R. Ashe, Jr./
Oliver R. Ashe, Jr.
Registration No. 40,491
Counsel for Petitioner

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