

IPR2014-00171 to 00177

From: [Apple]
To: [RPX]
Cc: [RPX]
Subject: RPX agreement modifications
Date: Tuesday, October 22, 2013 2:21:08 AM
Attachments: [2013 10 21 Form Amendment to Membership and License Agreement for Innovation Promotion.docx](#)
[ATT00001.htm](#)
[2013 10 21 Form Amendment to Membership and License Agreement for Innovation Promotion.Redline.docx](#)
[ATT00002.htm](#)

[RPX]

Here are some minor edits to the agreement, in clean and redline form. I have a fair bit of time free tomorrow if you want to get on a call to discuss.

[Apple]

Apple Inc.
1 Infinite Loop, MS 169-2NYJ, Cupertino, California 95014
[REDACTED]

ATTORNEY-CLIENT PRIVILEGED & WORK PRODUCT

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized review, use, disclosure or distribution is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

[REDACTED] RPX00091

FIRST ADDENDUM TO THE
MEMBERSHIP AND LICENSE AGREEMENT

This First Addendum to the Membership and License Agreement (this "Addendum"), dated October 22, 2013 (the "Addendum Effective Date"), is made by Apple Inc. ("Member", "you", or "your") and RPX Corporation ("RPX", "Member", "we", or "us") as an addendum to the Membership and License Agreement entered into by Member and RPX with an Effective Date of [_____] (the "Agreement"). Except as expressly set forth herein, all capitalized terms shall have the meaning given in the Agreement.

WHEREAS, the Parties desire to supplement the Agreement to further support RPX's efforts to promote innovation and patent quality, as more fully set forth herein.

NOW, THEREFORE, in accordance with Section 9.3 of the Agreement and in consideration of the premises and mutual covenants herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

I. Promotion of Innovation and Patent Quality.

- (a) RPX agrees that, beginning on the Addendum Effective Date, RPX will collect contributions to the Innovation Promotion Fund (the "Fund") from Member and other RPX members to promote innovation and patent quality, which efforts might include (at RPX's sole discretion) any of the following activities, whether performed directly by RPX or indirectly through third parties at the direction or request of RPX:
- (i) Gathering and analyzing data relating to costs imposed on operating companies through patent assertions by non-practicing entities;
 - (ii) Filing with the United States Patent and Trademark Office ("USPTO") requests for reexamination, or petitions for post grant, covered business method, or inter partes review with respect to patents of questionable quality;
 - (iii) Educating the general public and industry groups about inefficiencies in the current patent system and the impact of proposals for reforms;
 - (iv) Conducting prior art searches to assist with challenges against potentially invalid patents, and developing databases or technologies to improve the efficiency of such searches; and
 - (v) Creating mechanisms to increase transparency in the patent market.

As between Member and RPX, RPX will have complete control over any and all activities undertaken pursuant to this Section 1(a), including complete control over the selection, initiation, termination, and funding of the activities and the manner and method in which the activities are undertaken, the hiring of outside counsel or consultants, and all strategic decisions in connection with any petitions or proceedings before the USPTO or otherwise. Other than the report described in Section 1(b) below, RPX will have no obligation to communicate with Member regarding the activities or to otherwise involve Member in any



way. In no event will RPX disclose to Member any nonpublic information regarding any planned or filed petitions or proceedings before the USPTO pursuant to Section 1.

(b) The activities undertaken in Section 1 shall continue so long as there are sufficient monies in the Fund. On or before each anniversary of the Addendum Effective Date, RPX will deliver to Licensee a report providing an overview of the monies raised for Fund and RPX's activities and use of the monies pursuant to Section 1 above.

2. Contributions. Member will make a one-time lump sum contribution of US\$500,000 ("Initial Contribution") for the Fund, and Member will pay such amount to RPX within thirty (30) days following the Addendum Effective Date. This payment shall not have any effect on the Member's Annual Membership and License Fee for any year of the Term, and Member has no obligation to make any additional contributions other than the Initial Contribution. In no event will Member be entitled to receive a refund of any amounts paid to RPX pursuant to this Addendum. Notwithstanding anything to the contrary in the Agreement, Member acknowledges and agrees that the foregoing amount will not be included in calculating Member's AAML Fee under Section ____ of the Agreement.

3. No Other Amendment. Except as expressly amended herein, all rights, terms, conditions and agreements in the Agreement shall remain in full force and effect.

IN WITNESS WHEREOF, the Parties have caused this Addendum to be executed and delivered by their duly authorized officers as of the applicable date set forth below.

RPX CORPORATION

MEMBER

By: _____

By: _____

Name: _____

Name: _____

Title: _____

Title: _____

Date: _____

Date: _____



RPX CONFIDENTIAL

[REDACTED] AMENDMENT FIRST ADDENDUM TO THE
MEMBERSHIP AND LICENSE AGREEMENT

This [REDACTED] Amendment First Addendum to the Membership and License Agreement (this "Amendment Addendum"), dated [REDACTED], 20 October 22, 2013 (the "Amendment Addendum Effective Date"), is made by [REDACTED] (Licensee Apple, Inc. ("Member", "you", or "your") and RPX Corporation ("RPX", "Licensor/Member", "we", or "us") as an addendum to amend the Membership and License Agreement entered into by Licensee/Member and RPX with an Effective Date of [REDACTED] (the "Agreement"). Except as expressly set forth herein, all capitalized terms shall have the meaning given in the Agreement.

WHEREAS, the Parties desire to amend/supplement the Agreement to further support RPX's efforts to promote innovation and patent quality, as more fully set forth herein.

NOW, THEREFORE, in accordance with Section 9.3 of the Agreement and in consideration of the premises and mutual covenants herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

I. Promotion of Innovation and Patent Quality.

(a) RPX agrees that, for the period beginning on the Amendment Addendum Effective Date and ending on the next anniversary of the Effective Date of the Agreement, RPX will use reasonable efforts to collect contributions to the Innovation Promotion Fund (the "Fund") from Member and other RPX members to promote innovation and patent quality, which efforts might include (at RPX's sole discretion) any of the following activities, whether performed directly by RPX or indirectly through third parties at the direction or request of RPX:

- (i) Gathering and analyzing data relating to costs imposed on operating companies through patent assertions by non-practicing entities;
- (ii) Filing with the United States Patent and Trademark Office ("USPTO") requests for reexamination, or petitions for reexaminations, post grant reviews, covered business method, or inter partes reviews/review with respect to patents of questionable quality;
- (iii) Educating the general public and industry groups about inefficiencies in the current patent system and the impact of proposals for reforms;
- (iv) Conducting prior art searches to assist with challenges against potentially invalid patents, and developing databases or technologies to improve the efficiency of such searches; and
- (v) Creating mechanisms to increase transparency in the patent market.

As between Licensee/Member and RPX, RPX will have complete control over any and all activities undertaken pursuant to this Section I(a), including complete control over the selection, initiation, termination, and funding of the activities and the manner and method in which the activities are undertaken, the hiring of outside counsel or consultants, and all strategic decisions in connection with any petitions or proceedings before the USPTO or

RPX CONFIDENTIAL

otherwise. Other than the report described in Section 1(b) below, RPX will have no obligation to communicate with LicenseeMember regarding the activities or to otherwise involve LicenseeMember in any way. In no event will RPX disclose to LicenseeMember any nonpublic information regarding any planned or filed petitions or proceedings before the USPTO pursuant to Section 1.

(b) The activities undertaken in Section 1 shall continue so long as there are sufficient monies in the Fund. On or before the next anniversary of the Addendum Effective Date, RPX will deliver to Licensee a report providing an overview of the monies raised for Fund and RPX's activities and use of the monies pursuant to Section 1 above.

2. ~~Annual Membership and License Fee~~ Licensee's Annual Membership and License Fee for the current year of the Term Contributions. Member will be increased by an additional ~~make a one-time lump sum contribution of US\$500,000 ("Initial Contribution")~~ for the Fund, and LicenseeMember will pay such amount to RPX within thirty (30) days following the AmendmentAddendum Effective Date. This payment shall not have any effect on the Member's Annual Membership and License Fee for any year of the Term, and Member has no obligation to make any additional contributions other than the Initial Contribution. In no event will LicenseeMember be entitled to receive a refund of any amounts paid to RPX pursuant to this AmendmentAddendum. Notwithstanding anything to the contrary in the Agreement, LicenseeMember acknowledges and agrees that the foregoing amount will not be included in calculating Licensee'sMember's AAML Fee under Section 1.1 of the Agreement.

Formatted: Highlight

3. No Other Amendment. Except as expressly amended herein, all rights, terms, conditions and agreements in the Agreement shall remain in full force and effect.

IN WITNESS WHEREOF, the Parties have caused this AmendmentAddendum to be executed and delivered by their duly authorized officers as of the applicable date set forth below.

RPX CORPORATION
By: _____
Name: _____
Title: _____
Date: _____

LICENSEE
MEMBER
By: _____
Name: _____
Title: _____
Date: _____