

Fife, Ashley

From: Vignone, Maria <Maria.Vignone@USPTO.GOV> on behalf of Trials <Trials@USPTO.GOV>
Sent: Wednesday, March 25, 2015 8:16 AM
To: Rosato, Michael; Trials
Cc: Argenti, Matthew; Eliot.Williams@bakerbotts.com; hop.guy@bakerbotts.com
Subject: RE: IPR2015-00059, 60, 61, 67, 68, and 81

Counsel: Patent Owner is hereby authorized to file a motion for additional discovery that is limited to the issue of whether the Dish entities are un-named real parties-in-interest. Patent Owner is advised that limited and targeted motions are more likely to be granted than broad and sweeping motions. In the event a motion for additional discovery is filed, Petitioner may oppose the motion in accordance with the timing and page limits set forth in Board rules.

Thank you,

Maria Vignone
Paralegal Operations Manager
Patent Trial and Appeal Board
571-272-4645

From: Rosato, Michael [<mailto:mrosato@wsgr.com>]
Sent: Tuesday, March 24, 2015 3:01 PM
To: Trials
Cc: Argenti, Matthew; Eliot.Williams@bakerbotts.com; hop.guy@bakerbotts.com
Subject: IPR2015-00059, 60, 61, 67, 68, and 81

Dear Trials:

Caltech (Patent Owner) would like a conference call to discuss 1) scheduling a time for routine discovery and to discuss authorization for additional discovery; and 2) authorization for additional briefing.

On March 18, 2015, in response to an invitation from the Board to do so, both Petitioner (Hughes) and Patent Owner concurrently filed briefs directed to the issue of whether the petitions in these proceedings properly identify all real parties-in-interest. With its brief Petitioner included newly executed declaration testimony (not previously authorized by the Board). Caltech requests that the Board set a time for routine discovery pursuant to 37 C.F.R. § 42.51(b)(ii).

Caltech also requests a conference call to discuss whether the Board will authorize some simple additional discovery related to the foundation for the declaration. The Board indicated its willingness to consider this request during the telephonic hearing held on February 25, 2015, as reflected in the hearing transcript (Ex. 2016) at 21:11-17.

Should the Board deem Hughes' unauthorized new testimony improper and expunges it from the record, then the above discovery may be unnecessary.

In addition, while Petitioner has had an opportunity to respond to Caltech's arguments regarding the real party-in-interest, the same cannot be said for Caltech. For this reason we also request authorization for a short Caltech reply brief – this request can be addressed during the call.

Caltech is available for a call during the following times:

- Wednesday, March 25th, 1:30 – 4pm EST
- Thursday, March 26th, Noon – 4pm EST

Sincerely,

Michael T Rosato (Counsel for Patent Owner Caltech)

Wilson Sonsini Goodrich & Rosati

[o] 206.883.2529 | [f] 206.883.2699

mrosato@wsgr.com

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