

Broughan III, Thomas A.

From: Zeilberger, Daniel [danielzeilberger@paulhastings.com]
Sent: Monday, April 11, 2016 1:08 PM
To: Border, Scott; James Bailey; Wesley C. Meinering
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggin.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Scott, we have added our position to your draft email to the Board below:

Your Honors-

Petitioner's Position

The joined Petitioners request a call with the Board to request authorization for additional discovery for the cross-examination of a declarant (Dr. Short) whose testimony Patent Owner has cited and relies upon in this proceeding.

Patent Owner submitted with its Patent Owner response a declaration from a Dr. Short, a named inventor on the patent at issue in this proceeding. The declaration was originally prepared for an inter partes reexamination proceeding. Patent Owner relies on Dr. Short's declaration for its assertions that secondary considerations exist that support a finding of non-obviousness. See Resp. at 29-36.

The joined Petitioners requested that Patent Owner either provide Dr. Short for cross-examination or withdraw the declaration. Patent Owner has not agreed to provide Dr. Short for cross-examination and has represented that such cross-examination is unnecessary given that Dr. Short was questioned in related litigation on topics discussed in the declaration. Patent Owner provided the district court trial transcript containing Dr. Short's direct and cross-examination. The joined Petitioners have reviewed the transcript of the trial testimony, and believe that Dr. Short was not tested on each of the topics discussed in the declaration that Patent Owner now relies on in this proceeding.

Thus, the joined petitioners request authorization for additional discovery for the cross-examination of Dr. Short.

Patent Owner's Position

Petitioners are not entitled to cross-examine Dr. Short. Dr. Short's declaration-at-issue here was submitted in an inter partes reexamination proceeding nearly four years ago. Moreover, Dr. Short has already been questioned in related litigation on the topics discussed in the declaration. So, there already has been a fair opportunity to cross-examine Dr. Short. Patent Owner even provided the transcript from the district court to Petitioners in an attempt to resolve this issue. Patent owner disagrees with Petitioners' analysis of the transcript and believes there is a one-to-one correspondence between the topics covered in the declaration and the topics covered in the transcript. So, to the extent the Board considers Petitioners' request for additional discovery, Patent Owner requests briefing on the issue.

Should the Board desire to have a conference call, the parties are available at the following times this week:

Tuesday: 9:30 am-11 am

Wednesday: 9:30 am-11 am

From: Border, Scott [mailto:sborder@sidley.com]
Sent: Monday, April 11, 2016 12:37 PM
To: Zeilberger, Daniel; James Bailey; Wesley C. Meinerding
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggins.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Dan-

Thank you for providing the trial transcripts that include Dr. Short's cross-examination. Apple does not agree that these transcripts are a proper substitute for the cross-examination of Dr. Short in this proceeding. For example, the cross-examination does not test Dr. Short's opinions related to long-felt need, failure of others, skepticism, or nexus.

Consequently, we believe a call with the Board is necessary. Apple has consulted with the other joined petitioners, and together the petitioners propose the following email to the Board, which we intend to send in the next hour:

Your Honors-

The joined Petitioners request a call with the Board to request authorization for additional discovery for the cross-examination of a declarant (Dr. Short) whose testimony Patent Owner has cited and relies upon in this proceeding.

Patent Owner submitted with its Patent Owner response a declaration from a Dr. Short, a named inventor on the patent at issue in this proceeding. The declaration was originally prepared for an inter partes reexamination proceeding. Patent Owner relies on Dr. Short's declaration for its assertions that secondary considerations exist that support a finding of non-obviousness. See Resp. at 29-36.

The joined Petitioners requested that Patent Owner either provide Dr. Short for cross-examination or withdraw the declaration. Patent Owner has not agreed to provide Dr. Short for cross-examination and has represented that such cross-examination is unnecessary given that Dr. Short was questioned in related litigation on topics discussed in the declaration. Patent Owner provided the district court trial transcript containing Dr. Short's direct and cross-examination. The joined Petitioners have reviewed the transcript of the trial testimony, and believe that Dr. Short was not tested on each of the topics discussed in the declaration that Patent Owner now relies on in this proceeding.

Thus, the joined petitioners request authorization for additional discovery for the cross-examination of Dr. Short.

Should the Board desire to have a conference call, the parties are available at the following times this week:

Tuesday: 9:30 am-11 am

Wednesday: 9:30 am-11 am

Thursday: 9 am to 11 am

SCOTT BORDER
Associate

Sidley Austin LLP
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From: Zeilberger, Daniel [<mailto:danielzeilberger@paulhastings.com>]
Sent: Monday, April 11, 2016 9:45 AM
To: Border, Scott; James Bailey; Wesley C. Meinerding
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggin.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Scott,

Attached is one of the transcripts from Dr. Short's examination that deals with the topics in the declaration. We hope this resolves the issue. Please let us know if it does not. If you intend to still email the Board, please provide us with the email you intend to send so that we can make sure our position is adequately reflected.

Regards,
Dan

From: Border, Scott [<mailto:sborder@sidley.com>]
Sent: Friday, April 08, 2016 5:40 PM
To: Zeilberger, Daniel; James Bailey; Wesley C. Meinerding
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggin.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Dan-

Petitioners are willing to wait until 10 AM EST on Monday for service of the Dr. Short deposition transcripts. Given the extremely compressed schedule, Petitioners believe that the parties will be at an impasse if service is not effected before then, as any further delay will to continue to prejudice Petitioners. Petitioners are willing to quickly review the transcripts and will consider withdrawing the request for a deposition of Dr. Short if all of the points raised in the declaration filed in this proceeding were appropriately tested during the previous depositions. If service is not effected by 10 AM EST, Petitioners will send the request for a teleconference soon thereafter and specifically indicate that the parties are at an impasse.

SCOTT M. BORDER
Associate

SIDLEY AUSTIN LLP
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From: Zeilberger, Daniel [<mailto:danielzeilberger@paulhastings.com>]
Sent: Friday, April 08, 2016 3:38 PM
To: Border, Scott; James Bailey; Wesley C. Meinerding
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggin.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Scott,

Given that we are checking into the deposition transcript issue and still meeting and conferring on this issue, we believe it is premature to send this email to the Board. But we have provided our position and availability below if Petitioners would still like to send an email to the Board. Please note that we moved one of your proposed sentences into the Petitioner's position section of the email.

Your Honors –

Petitioner's position: Patent Owner has submitted with its Patent Owner response a declaration from a Dr. Short, a named inventor on the patent at issue in this proceeding. Patent Owner relies on Dr. Short's declaration for its assertions that secondary considerations exist that support a finding of non-obviousness. See Resp. at 29-36. The joined petitioners have requested that Patent Owner provide Dr. Short for cross-examination or withdraw the declaration. The joined petitioners request a call with the Board to request authorization for additional discovery for the cross-examination of Dr. Short.

Patent Owner's position: Petitioners are not entitled to cross-examine Dr. Short. Dr. Short's declaration-at-issue here was submitted in an *inter partes* reexamination proceeding nearly four years ago. Moreover, Dr. Short has already been questioned in related litigation on the topics discussed in the declaration. So, there already has been a fair opportunity to cross-examine Dr. Short. Petitioners' request for a conference call is also premature as the parties are still meeting and conferring on this issue. Patent Owner is looking into Petitioners' latest request for production of the transcripts from the related litigation.

Should the Board desire to have a conference call, the parties are available at the following times next week:

Tuesday: 10 am-11 am
Wednesday: 10 am-11 am

Regards,

Jeff Kushan
Lead Counsel for Petitioner Apple

From: Border, Scott [<mailto:sborder@sidley.com>]
Sent: Friday, April 08, 2016 2:31 PM
To: Border, Scott; Zeilberger, Daniel; James Bailey; Wesley C. Meinerding
Cc: Palys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggin.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Dan-

Draft email is below – we would like to send to the Board NLT than 3:00 EST.

Your Honors –

Patent Owner has submitted with its Patent Owner response a declaration from a Dr. Short, a named inventor on the patent at issue in this proceeding. Patent Owner relies on Dr. Short's declaration for its assertions that secondary considerations exist that support a finding of non-obviousness. See Resp. at 29-36. The joined petitioners have requested that Patent Owner provide Dr. Short for cross-examination or withdraw the declaration.

Patent Owner position: [Patent Owner has indicated that it will not provide Dr. Short for cross-examination]

The joined petitioners request a call with the Board to request authorization for additional discovery for the cross-examination of Dr. Short. The parties are available at the following times next week:

Monday 10 am –2 pm,
Tuesday 10 am-12 pm
Wednesday 10 am-12 pm
Thursday 10 am-1pm, 2 pm – 4:30 pm

Regards,

Jeff Kushan
Lead Counsel for Petitioner Apple

SCOTT M. BORDER

Associate

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From: Border, Scott
Sent: Friday, April 08, 2016 2:05 PM
To: 'Zeilberger, Daniel'; James Bailey; Wesley C. Meinering
Cc: Pallys, Joseph E.; Modi, Naveen; Thomas Martin; docketing; Kushan, Jeffrey P.; Broughan III, Thomas A.; Dillon, Samuel; Kasdan, Abraham; IP@wiggins.com
Subject: RE: IPR2015-01046 and IPR2015-01047

Dan-

You've indicated that cross-examination is not necessary in this proceeding because Dr. Short has already been deposed by Apple in another proceeding. If that is your justification as to why you do not need to make Dr. Short available, then you should serve the relevant deposition transcripts on each of the Petitioners.

We will send a draft email to the Board shortly.

SCOTT M. BORDER

Associate

SIDLEY AUSTIN LLP

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