
From: Abramic, John
Sent: Friday, February 12, 2016 2:35 PM
To: Matthew Smith
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

Thanks Matt. We will review. For your first comment (Non-ITAR related), are you contemplating specific individuals? If not, can you propose language to cover the people you intend to cover? If you are suggesting that it include "members of Sony's Intellectual Property Department", can you give us an idea of the people that would include?

John

From: Matthew Smith [<mailto:smith@turnerboyd.com>]
Sent: Friday, February 12, 2016 2:01 PM
To: Abramic, John
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

John,

A few thoughts on the draft protective order:

Non-ITAR-related comments:

- (1) In paragraph 3, we would like to expressly include members of Sony's Intellectual Property Department under the definition of "in house counsel". These people are usually Japanese patent attorneys, but not U.S.-licensed attorneys.

ITAR-related comments:

- (1) The exclusion of classes of people eligible to view ITAR materials in paragraph 4 should not include those in-house counsel who are U.S. persons. The ITAR information may need to be briefed, and we would like U.S. persons at least at Sony Corporation of America to be able to see the briefing.
- (2) The requirement in paragraph 7 that "*Any party aware of actual or suspected ITAR infractions will immediately inform Raytheon Company and await further instructions from Raytheon Company or its Counsel*" needs to be removed. As remote as the possibility of an infraction is, it is inappropriate to have parties in an adversarial proceeding reporting to one another's counsel and "awaiting instructions". The requirement also seems inconsistent with the requirement in paragraph 6 that "*Any disclosure of Raytheon-produced export-controlled technical data, or furnishing of technical assistance where an authorization is needed but not secured, constitutes an export violation, which should be disclosed to the Department of State.*"
- (3) There is a portion of paragraph 5 that reads "*These restrictions also apply to United States citizens and permanent residents employed by a company or organization that falls within the definition of "foreign person." See ITAR § 120.16.*" This requirement does not follow from the cited rule. Where does it come from? We should make clear that it will not exclude law firms hired by foreign clients. We have non-U.S. clients, and I would guess Steptoe does as well.
- (4) Paragraph 10 is incomplete.
- (5) Have you given any thought to how we can limit or eliminate the impact of ITAR / EAR materials on the proceeding?

Matt

From: Matthew Smith
Sent: Wednesday, February 10, 2016 10:13 PM
To: 'Abramic, John'
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

John,

I am available Tuesday afternoon Eastern time. Depending on when the call is scheduled, I may be able to send you a list of specific concerns with the draft order before the call.

Matt

From: Abramic, John [<mailto:jabramic@Steptoe.com>]
Sent: Wednesday, February 10, 2016 6:26 PM
To: Matthew Smith
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: Re: IPR2015-01201 - Protective Order

Matt,

At 11:00am central tomorrow, we intend to request a Board call for Friday or Tuesday (Monday is a holiday).

Regards,

John

Sent from my iPhone

On Feb 9, 2016, at 7:11 PM, Abramic, John <jabramic@Steptoe.com> wrote:

Matt,

We will put it off a day in response to your request. Since we would likely not get a Thursday call with the Board on short notice, can you give me times when you are available for a Board call next Monday and Tuesday?

John

Sent from my iPhone

On Feb 9, 2016, at 6:22 PM, Matthew Smith <smith@turnerboyd.com> wrote:

John,

Thanks for letting me know that the documents you intend to submit were produced in the litigation and their relevance. You might want to give me a day to talk to Sony's litigation counsel about the nature of the protective order there. I think there are a number of issues created by your proposal for the IPR, but perhaps we clear some of them up before you request a call.

Matt

On Feb 9, 2016, at 12:58 PM, Abramic, John <jabramic@Steptoe.com> wrote:

Matt,

Thanks. We will request a call with the Board in an email first thing tomorrow morning.

Just to be clear, Sony's counsel is in possession of ITAR regulated documents that Raytheon intends to submit, including documents evidencing conception and reduction to practice (see, e.g., section 3-2(b) of Raytheon's Disclosures under P.R. 3-1 and 3.2 in the underlying litigation) and documents related to commercial success. Also, there is a protective order entered in the underlying litigation that contains ITAR restrictions. It was our understanding that Sony was aware of this information, but in the event this causes Sony to reconsider its intent to oppose entry of a protective order with ITAR restrictions, please let us know before tomorrow morning.

Regards,

John

From: Matthew Smith [<mailto:smith@turnerboyd.com>]
Sent: Tuesday, February 09, 2016 1:39 PM
To: Abramic, John
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

John,

Thank you for your email. A call on Thursday or Friday would be fine with me. I am available after noon Eastern on Thursday and after 3 PM Eastern on Friday.

Raytheon has not presented any reason to submit ITAR / EAR documents, and the handling of ITAR / EAR information would be a burden on both parties and the Board. So Sony is opposed to the motion.

Sony would not oppose entry of the Board's default protective order in this case.

Thanks and regards,

Matt

From: Abramic, John [<mailto:jabramic@Steptoe.com>]
Sent: Monday, February 8, 2016 2:23 PM
To: Matthew Smith
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

Matt,

Thank you for your email. Some of the documents that we intend to submit in connection with the Patent Owner response were previously confirmed by Raytheon's compliance team to be ITAR protected. As such, Raytheon is obligated to follow ITAR law and regulations with respect to those documents.

Raytheon must follow the ITAR regulations and intends to seek leave from the Board to have a protective order entered. We trust that you will join this proposal.

By the close of business tomorrow, we intend to request a conference call with the Board for Thursday or Friday of this week. Please let us know your availability for such a call and whether you agree to the protective order.

As to the question in your follow-up email, some of the documents would only be "confidential" and not ITAR/EAR, such that there would be two categories of restricted documents.

Regards,

John

From: Matthew Smith [<mailto:smith@turnerboyd.com>]
Sent: Monday, February 08, 2016 1:44 PM
To: Abramic, John
Cc: Filarski, Thomas; Jennifer Seraphine; Hails, Robert L.; Zhuanjia Gu
Subject: RE: IPR2015-01201 - Protective Order

John,

Thanks for your letter. Would you explain why there is a need to submit ITAR and/or EAR documents in the proceeding at all? The application leading to the patent-at-issue was filed more than 20 years ago, and the technological subject matter would seem to have been made public through publication of the patent.

Regards,

Matt

From: Abramic, John [<mailto:jabramic@steptoe.com>]
Sent: Friday, February 5, 2016 1:20 PM
To: Matthew Smith
Cc: Filarski, Thomas
Subject: IPR2015-01201 - Protective Order

Matt,

In connection with Patent Owner's response in IPR2015-01201, Patent Owner anticipates submitting confidential documents to the PTAB. Accordingly, Patent Owner intends to approach the Board to request entry of a Protective Order in the proceeding.

Also, as your client may be aware based on the protective order in the underlying litigation, certain documents and information relevant to the proceeding are subject to The International Traffic in Arms Regulations ("ITAR") found in Title 22 of the Code of Federal Regulations, parts 120 to 130. Please see the attached letter regarding ITAR. Patent Owner will need to ensure that the protective order contains appropriate ITAR provisions.

Attached is a draft proposed protective order based on the standing protective order found in Appendix B to the PTAB Trial Practice Guide. Proposed modifications are made in redline. Please let us know whether Petitioner would oppose entry of the attached protective order. If you have any proposed modifications to the draft, please let us know and we can consider them. Also, please let us know your availability for a call with the Board next week as we would like to request authorization to move to have a protective order entered.

Regards,

John L. Abramic | **Steptoe**

Partner

312 577 1264 | direct
630 341 9128 | mobile
312 577 1370 | fax
jabramic@steptoe.com

Steptoe & Johnson LLP
115 South LaSalle Street Suite 3100
Chicago, IL 60603
www.steptoe.com