

From: Fahrenbach, Brian
Sent: Friday, April 01, 2016 4:45 PM
To: Jennifer Seraphine; Abramic, John
Cc: Matthew Smith; Filarski, Thomas; 678IPR; Zhuanjia Gu; Hails, Robert L. (rhails@bakerlaw.com)
Subject: RE: Sony v. Raytheon, IPR2015-01201 and IPR2016-00209

Jennifer,

This responds to your and Matt Smith's e-mails of March 29, March 23 and March 18, 2016.

Regarding your March 29 email, we are confused by your second paragraph as to why you believe these issues are not entirely resolved. Are you suggesting that Raytheon did not serve Exhibits 2010-2013? We believe those exhibits were served through the external download site we provided to you on March 11, 2016. Please let us know if you did not receive copies or your reasons why these exhibits were not properly served.

If, however, you are suggesting that service was somehow defective because the additional documents you seek were not served, we disagree with your argument. First, these documents do not qualify as routine discovery under 37 C.F.R. § 42.51(b)(1)(i). Instead, you requested these documents as additional discovery pursuant to 37 C.F.R. § 42.51(b)(2)(i), even though your co-counsel, Mr. Hails, has had them since July 2015. Raytheon has said that it would not object to Petitioner's outside counsel using the additional documents in connection with the IPR, provided that you comply with the IPR protective order. As we advised earlier, you can find these documents at RAY00004572-5424 and RAY00007358-7941. Given that they are already in Sony's possession, we figured it would be more practical for you to use those documents as opposed to us re-producing them in response to your discovery request. Paragraph 22 of the litigation protective order allows the parties to alter the designation and use of documents produced in the underlying litigation. If Sony's litigation counsel will not share these documents with you or you need something more regarding them, please let us know.

We do not believe that the objections stated in Matt Smith's March 18 email were properly lodged with the Board. Nonetheless, and as a courtesy to Sony, we provide the following responses. Each objection would be overruled for the following reasons:

Objection 1: Raytheon has already provided our best copy of the original of Exhibit 2008. If you continue to object, Raytheon can make the original Exhibit 2008 available for inspection in accordance with 37 CFR § 42.51(c) so that you may confirm that Exhibit 2008 is a true and accurate duplicate of the original. Raytheon also notes that the declarations of Mr. Arthur Medrano and Mr. William McInnis lay the proper foundation for this exhibit under FRE 901 and 1003.

Objection 2: Petitioner objects to Exhibits 2010, 2011, 2012, 2013, 2014, 2022, 2025, 2026 and 2027 under FRE 106, FRE 1002, FRE 901 and 37 C.F.R. § 42.51(b)(1)(i). These objections would be overruled for the following reasons:

- As stated above, the objections regarding Exhibits 2010-2013 are misplaced. First, Raytheon only relies upon the relevant excerpts from the annual IRAD reports, which are already in Sony's possession. The excerpts are complete documents as they report on the particular relevant projects; the other projects in the annual IRAD reports are not relevant. Second, the declarations of Mr. Medrano and Mr. McInnis establish the authenticity and admissibility of these exhibits under FRE 902 and 1003. Additionally, these documents are 1) regularly-kept business records and 2) over twenty years old. (See FRE 803(6) and (16); 901(b)(1) and (8).)
- As for Exhibit 2014, though all relevant pages were already provided, Raytheon was able to locate additional pages of that lab notebook. All pages of the notebook that are within Raytheon's possession,

custody, or control, including the originally-served pages, are combined into one document, which is being sent via a secure site. The declarations of Mr. Medrano and Mr. McInnis lay the proper foundation for this exhibit under FRE 902 and 1003. (FRE 803(6) and (16); 901(b)(1) and (8).)

- Raytheon is also sending, via a secured site, a supplemental declaration from Dr. Fitzgerald that describes and appends updated versions of Exhibits 2022 and 2025-2027. We are filing a motion with the Board to submit the supplemental declaration and replacement exhibits into the record. Sony will be in possession of the relevant portions of the documents that Dr. Fitzgerald cited to in Exhibits 2022 and 2025-2027 as part of his original declaration. You have the public citation and if you are unable to locate the citations, Raytheon will make them available for your inspection. Dr. Fitzgerald's declaration lays the proper foundation for these Exhibits under FRE 901 and 1003 as they are true and accurate duplicates of documents relied-upon by Dr. Fitzgerald to form his opinion.

Objection 3: Petitioner's objections to Exhibits 2020 and 2022 through 2036 under FRE 402 and 403 are misplaced for the following reasons:

- Exhibits 2020, 2022-2024, 2027-2028, and 2032 are admissible under FRE 402 and 403 because they are publicly available documents that were available around the relevant timeframe, as evidenced by their publication dates. These documents are relevant and simplify the issues under FRE 402/403 because they help the Board determine the understanding of a PHOSITA during the relevant timeframe.
- Exhibits 2025-2026 and 2029-2031, and 2033-2035 support Dr. Fitzgerald's conclusions about a PHOSITA's understanding. These documents, moreover, describe the art's background and scientific principles. Thus, Sony's objections to these exhibits is in error.
- Sony's objections to Exhibit 2036 is in error. Exhibit 2036 is relevant to conception and reduction to practice.
- Your objection under FRE 802 has not been stated with particularity as required by 37 C.F.R. § 42.64(b)(1). Your objection is improper because you have failed to identify any out of court statement, or the purpose for which you believe such statement is being offered.

Objection 4: Sony's objections to any of Raytheon's testimony that may rely upon evidence subject to Objections 1-3 is misplaced because, as shown above, Objections 1-3 should be overruled.

Objection 5: Sony's objections to testimony referencing chips, including the CRC-559 chip and mask sets, are in error. Mr. Bendik lays the proper foundation under FRE 901 for the original CRC-559 and its photograph. That photograph was served to Sony as part of Mr. Bendik's declaration and your co-counsel Mr. Hails has been invited to inspect the chip since July 2015. (See Ex. 2016, paragraph 14.) Your objections to Ex. 2015 and 2038 are thus misplaced. Raytheon's Patent Owner Response, Exhibit 2015-2016 and 2038 all rely on evidence that Raytheon served upon Sony. For clarity, Raytheon will provide an updated exhibit list that includes the photograph of the CRC-559 in Mr. Bendik's declaration. We plan to submit this to the Board as well. Again, as with the other information and documents previously produced to Sony and petitioner's counsel, you are invited to inspect things relied upon and within Raytheon's possession, custody or control at a reasonably and mutually agreeable time and location.

Specifically, and in answer to the questions in your e-mail of March 28, Raytheon will make any referenced physical things in our possession, including the CRC-559, available for inspection, pursuant to 37 C.F.R. § 42.51(c). We propose an inspection next week at a mutually agreeable time at a mutually agreeable location near Chicago, Illinois. However, Raytheon will not allow Sony to take custody of the chips or perform destructive testing. Instead, we propose that Sony arrange for the use of, a microscope, or any other non-destructive testing, investigation or analysis implements, at the mutually agreeable location. Any observation or non-destructive testing of the chips must also be pre-approved by Raytheon and witnessed by Raytheon's counsel.

Objection 6: Petitioner's objections to the additional notebooks of Mr. Bendik are misplaced. Paragraph 34 includes Mr. Bendik's testimony which is subject to cross-examination. In addition, Raytheon has diligently searched for the notebooks referenced in paragraph 34, but has been unable to locate them.

This should resolve all of Sony's remaining questions.

Brian G. Fahrenbach
Associate

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From: Jennifer Seraphine [<mailto:seraphine@turnerboyd.com>]
Sent: Tuesday, March 29, 2016 11:48 AM
To: Abramic, John
Cc: Matthew Smith; Filarski, Thomas; 678IPR; Zhuanjia Gu; Hails, Robert L. (rhails@bakerlaw.com)
Subject: Re: Sony v. Raytheon, IPR2015-01201 and IPR2016-00209

John,

Thank you for your below email. We will obtain Exhibits 2010-2013 from the litigation production as you indicated. Thank you for your cooperation.

Unfortunately, this does not entirely resolve the issues. First, we believe you were required to produce the exhibits with your response, and late service is not excused by an offer of production in another case. As you know, the litigation protective order contains a provision that materials produced in the litigation are to be used only for the purpose of the litigation. For this reason (among others), service in the litigation is not equivalent to service in the inter partes review.

In addition, we have the following questions regarding your offer of inspection:

- (1) Where, when and under what conditions would you allow inspection of the "multiple chips"?
- (2) Will you allow us to take custody of the chips to perform microscopic inspection and testing? If we need to destroy a portion of the chips to determine whether the claimed method was used, would Raytheon allow this?
- (3) Can you confirm that the chips available for inspection are the ones claimed by Mr. Finnila to have been produced in late 1990?
- (4) Have you located a complete copy of Exhibit 2014?

Thanks and regards,

Jennifer Seraphine

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On Mar 24, 2016, at 3:25 PM, Abramic, John <jabramic@Steptoe.com> wrote:

Matt,

Complete copies of Exhibits 2010-2013 are already in Sony's possession. Exhibits 2010-2013 are excerpts from documents that were produced in the underlying litigation on about July 16, 2015 and are identified by bates nos. RAY00004572-5424 and RAY00007358-7941. Bob Hails has had access to those documents since that time. We would not be opposed to Petitioner's counsel using those documents in the IPR provided that they are treated according to the protective order entered in the IPR, including the provisions related to confidentiality and ITAR. Also, on that same date, multiple chips, including the CRC559 chip referred to in paragraph 16 of Finnilla's declaration and in paragraph 14 of Bendik's declaration, were made available for inspection by Sony's counsel, including Mr. Hails. We are willing to extend that offer to you in connection with the IPR, subject to the confidentiality and ITAR protections in the protective order. We are also checking to see if we have a complete copy of Exhibit 2014. If we do, we will produce a complete copy.

I assume that resolves the discovery issues.

As to your request to submit a reply to the preliminary response, we do not believe that would be appropriate or necessary. Please let us know what you intend to say in your email requesting a conference call and we will provide a response for the email. We are unavailable for a call on Friday or Monday. We could be available for a call on Tuesday or Wednesday next week after 1pm eastern.

Regards,

John

From: Matthew Smith [<mailto:smith@turnerboyd.com>]
Sent: Wednesday, March 23, 2016 2:19 PM
To: Abramic, John
Cc: Filarski, Thomas; 678IPR; Zhuanjia Gu; Jennifer Seraphine; Hails, Robert L. (rhails@bakerlaw.com)
Subject: Sony v. Raytheon, IPR2015-01201 and IPR2016-00209

John,

We write concerning two matters in the above-referenced inter partes reviews.

First, Sony intends to seek certain initial discovery in IPR2015-01201 (Sony may seek further discovery later). We request that you produce:

- (1) complete copies of Exhibits 2010-2014; and
- (2) chips and wafer masks referred to in paragraph 16 of Finnilla's declaration (Ex. 2015), and in paragraph 14 of Bendik's declaration (Ex. 2016).

We believe Raytheon was required to produce these items under 37 C.F.R. 42.51(b)(1)(i), and that their production would be justified as "additional discovery". If Raytheon will voluntarily produce these items, there is no need to go through the Board.

Second, Sony believes that Raytheon's argument in its preliminary response in IPR2016-00209, that "the petition shows it raises the same arguments that are being reviewed in the instituted IPR" is inconsistent with Raytheon's position in its patent owner response in IPR2015-01201 that Bertin is not prior art. We would like to file a one-page paper in reply to Raytheon's preliminary response in IPR2016-00209.

Please let us know week by close of business tomorrow whether you plan to oppose either motion, and when you are available for a conference call with the PTAB on Friday of this week or Monday of next week.

Thanks and regards,

Matt

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