

## Barrett, Ken

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**From:** Trials  
**Sent:** Monday, January 7, 2019 9:55 AM  
**To:** Barrett, Ken; Chung, Jason; Easthom, Karl  
**Cc:** Trials  
**Subject:** FW: IPR2015-01264, -01319, & -1319 | Bungie, Inc. v. Worlds Inc.| Documents filed with the Patent Trial and Appeal Board

**Follow Up Flag:** Follow up  
**Flag Status:** Flagged

**Categories:** Trial

Please see below

Thanks  
Andrew

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**From:** Rosato, Michael <mrosato@wsgr.com>  
**Sent:** Monday, January 7, 2019 9:40 AM  
**To:** Wayne M. Helge <whelge@davidsonberquist.com>; Trials <Trials@USPTO.GOV>  
**Cc:** Alan A. Wright <awright@davidsonberquist.com>; Aldo Noto <anoto@davidsonberquist.com>; Ethan Song <esong@davidsonberquist.com>; Argenti, Matthew <margenti@wsgr.com>  
**Subject:** RE: IPR2015-01264, -01319, & -1319 | Bungie, Inc. v. Worlds Inc. | Documents filed with the Patent Trial and Appeal Board

Dear Trials,

Bungie respectfully points out that Worlds (Patent Owner) is confusing 1) the "Stipulation of Uncontested Facts" (submitted as Exhibit 1064); with 2) argument in the brief on remand. The submitted Exhibit 1064, signed by both parties, contains only uncontested facts as mutually agreed upon by the parties.

Bungie had previously requested authorization to submit (by email) a draft version of the "Uncontested Facts" document for in camera review by the Board, in order to facilitate resolution of a dispute between the parties. The Board denied Bungie's request to make that submission (Paper 50), and no submission has ever been made. The Board's Order (Paper 50) did not prohibit Bungie from making argument in its Remand Brief, nor should Bungie be prohibited from making any argument. See also 37 C.F.R. 42.22(c)

Worlds will have opportunity to address any argument in Bungie's brief in their Opposition Brief, and the Board is fully capable of attributing the appropriate weight to argument advanced by either party. As such, Bungie believes no conference call is necessary to deny Worlds' request set forth below.

To the extent a call would be beneficial, Bungie is available during the following times:

- Tues (1/8) or Thursday (1/10) between 1pm and 4pm Eastern

Respectfully,

Michael T Rosato

*Wilson, Sonsini, Goodrich & Rosati*

IPR2015-01264

IPR2015-01319

IPR2015-01321

Exhibit 3001

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-----Original Message-----

From: Wayne M. Helge [<mailto:whelge@davidsonberquist.com>]

Sent: Friday, January 4, 2019 5:26 PM

To: [trials@uspto.gov](mailto:trials@uspto.gov)

Cc: Alan A. Wright; Aldo Noto; Ethan Song; Rosato, Michael; Argenti, Matthew

Subject: IPR2015-01264, -01319, & -1319 | Bungie, Inc. v. Worlds Inc. | Documents filed with the Patent Trial and Appeal Board

To the Board,

Patent Owner writes to alert the Board that Bungie's Brief on Remand filed today in IPR2015-01264, IPR2015-01319, and IPR2015-01321, and in particular pp. 18-19 of that Brief, improperly contains alleged "Statements of Material Fact" including insertions of emailed settlement discussions between the parties prior to the Board's Nov. 7, 2018 telephone conference with the parties. Most directly, such discussions were addressed in the Board's Order of last week (Paper 50, pp. 2-3), stating:

Petitioner represents that the stipulations include quotations from communications exchanged as settlement negotiations between the parties. ... Patent Owner submits that it would be inappropriate to enter into the record the substance of settlement discussions. ... We deny Petitioner's request to submit, and do not authorize the submission or filing of, the disputed draft stipulations.

Patent Owner also respectfully submits that Bungie's attempt to insert new evidence into the record, by embedding evidence into the brief rather than submitting exhibits, violates the Board's Order (Paper 48, p. 8), stating that "With the exception of the filing of the above-discussed 'noncontroversial evidence,' the evidentiary record remains closed." Bungie's SMFs 7-11 refer to dates prior to the Board's Nov. 7, 2018 telephone conference with the parties, and on that conference, Bungie did not seek to submit evidence of settlement discussions.

Patent Owner respectfully asks that a conference call be scheduled with the Board so Patent Owner can request permission to seek appropriate remedies for these violations, including striking Bungie's Brief on Remand.

Patent Owner also asks that Bungie's brief in all three subject cases be placed under seal temporarily, while an appropriate remedy can be fashioned by the Board.

Respectfully,

Wayne Helge  
Lead Counsel for Patent Owner

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