

Hawthorne, Eric W.

From: Elisabeth H. Hunt <Elisabeth.Hunt@WolfGreenfield.com>
Sent: Thursday, November 15, 2018 4:46 PM
To: Trials; Steve Sereboff; Rich Giunta
Cc: Anneliese Lomonaco; RGiunta-PTAB@WolfGreenfield.com; RPritzker-PTAB@WolfGreenfield.com; EHunt-PTAB@WolfGreenfield.com; Bryan S. Conley; Jonathan Pearce
Subject: RE: RPX Corp v Applications in Internet Time, IPR Nos. 2015-01750, 2015-01751, 2015-01752 [SoCal IP file A213.L18F23]

Follow Up Flag: Follow up
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Dear Board,

Pursuant to the Board's e-mail below of November 9, the parties have conferred and submit the following proposals regarding procedure on remand. Below are:

- (1) a table summarizing the points of agreement and disagreement between the parties for each item of the proposed remand procedure;
- (2) a table of proposed due dates under each party's proposed procedure; and
- (3) a textual list of points of agreement and disagreement.

Table 1 – Points of Agreement/Disagreement regarding Remand Procedure

Item of procedure:	Points of agreement:	Points of disagreement:	
		RPX proposals:	AIT proposals:
Opening brief by RPX (consolidated for all three proceedings)	<u>Length</u> 14,000 words.	<u>Scope</u> Whether Salesforce is an RPI or privy of RPX under 35 U.S.C. §315(b), which will also resolve whether Salesforce is an unnamed RPI under §312(a)(2).	<u>Scope</u> The identity of any real party or privy of the petitioner under 35 U.S.C. § 315.

		<p><u>New Evidence</u></p> <ul style="list-style-type: none"> documentary and testimonial evidence responsive to factual questions raised in Fed. Cir. remand opinion (examples in the list of items below Table 2). documentary and testimonial evidence RPX will voluntarily provide responsive to AIT discovery requests RPX agrees are relevant to the remand proceeding (listed below Table 2). Any other discovery the Board may grant. <p><u>Deadline</u> 1 month from Board's Order.</p>	<p><u>New Evidence</u> None from RPX.</p> <p><u>Deadline</u> 3 weeks from Board's Order.</p>
<p>Responsive Brief by AIT (consolidated)</p>	<p><u>Length</u> Same as RPX opening brief.</p>	<p><u>New Evidence</u></p> <ul style="list-style-type: none"> Any evidence cited in RPX's opening brief. Any discovery provided to AIT with RPX's opening brief but not cited therein. Cross examination of any new testimonial evidence submitted with RPX's opening brief. <p><u>Deadline</u> 1 month from RPX's brief.</p>	<p><u>New Evidence</u> AIT can submit publicly available documentary evidence.</p> <p><u>Deadline</u> 2 weeks from RPX's brief.</p>
<p>Reply by RPX (consolidated)</p>	<p><u>Length</u> 7,000 words.</p>	<p><u>Deadline</u> 2 weeks from AIT's responsive brief.</p>	<p><u>Deadline</u> 1 week from AIT's responsive brief.</p>
<p>Sur-reply by AIT</p>	<p>Only if authorized</p>		

	in 1 week from authorization.		
Oral hearing (consolidated)	<u>Deadline</u> 2 weeks after RPX's reply or AIT's sur-reply (if any).		
Board Decision	<u>No agreement</u>	<u>Deadline</u> 6 months from Mandate (April 30, 2019)	<u>Deadlines</u> The Board should decide <i>promptly</i> whether to terminate the proceedings. AIT defers to the Board to choose its own deadline for this. AIT believes that if the Board does not terminate the proceedings, there should be another conference call to discuss further matters. AIT believes that there will be good cause to extend these proceedings for more than 6 months from the remand.

		<p>Scope Whether Salesforce is an RPI or privy of RPX under 35 U.S.C. §315(b), which will also resolve whether Salesforce is an unnamed RPI under §312(a)(2). If the Board finds Salesforce is not an RPI or privy, RPX believes the Board should reinstate the decisions on the merits of unpatentability from the vacated FWDs (Paper 80 in IPR2015-01750 and IPR2015-01752, and Paper 82 in IPR2015-01751).</p>	<p>Scope If the Board does not terminate the proceedings on the evidence of record, the proceedings should proceed toward revised FWDs because the prior FWDs were vacated. AIT would like additional discovery as suggested by the CAFC related to RPX's § 315 and § 312 obligations. AIT expects that there will be discovery disputes because RPX believes that discovery should be limited to its relationship with Salesforce but AIT believes that RPX's § 315 and § 312 obligations under are not limited to Salesforce. After discovery, AIT believes that the parties should each have an opportunity for additional briefing on all issues.</p>
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Table 2 – Proposed Due Dates (assuming the Board's Order on the remand procedure issues November 21):

Due:	Date under RPX proposal:	Date under AIT proposal:
RPX Opening brief	One month: December 21 (with evidence)	Three weeks: December 12 (no evidence)
AIT Response	One month: January 21 (with cross-examination)	Two weeks: December 26 (no evidence)
RPX Reply	Two weeks: February 4	One week: January 2
AIT Sur-Reply		One week, if authorized
Oral hearing	Week of February 18, if no sur-reply by AIT	Week of January 14, if no sur-reply by AIT
Board Decision	April 30 (6 months from mandate)	At Board discretion, but promptly
Additional discovery	[none]	To be determined
Supplemental briefing	[none]	To be determined
Board decision on supplemental briefing	[none]	To be determined

Textual List of points of agreement and disagreement between the parties on the remand procedure.

Points of agreement

- The parties agree briefing should commence with issues related to 35 U.S.C. § 312 and 35 U.S.C. § 315 (RPI and privity).
- On the issues related to RPI and privity, the parties agree that consolidation of the three IPRs is appropriate.
- The parties agree that RPX should file the opening brief, AIT should file a response, and RPX should file a reply to AIT's response. The parties agree that AIT would only file a sur-reply if authorized by the Board after RPX files its reply.
- The parties agree on the following proposed word count limits: 14,000 words for RPX's opening brief; the same limit for AIT's response as for RPX's opening brief; 7,000 words for RPX's reply.
- The parties request an oral hearing.

Points of disagreement

- 1) The parties disagree as to scope of the remand.
 - a) RPX believes the Federal Circuit's majority opinion remanded only the issue of whether Salesforce is a real party in interest ("RPI") under § 315(b), and invited the Board to also consider whether Salesforce is a privy of RPX.
 - b) AIT believes the Federal Circuit vacated the FWDs in their entirety. Therefore, §§ 312 and 315 are fully at issue without limitation to Salesforce, and the merits issues are also open. AIT proposes that if the Board does not terminate the cases after the briefing at the current stage, then the record on §§ 312 and 315 should be reopened so that AIT can pursue the full range of discovery urged by the Federal Circuit. AIT believes that after discovery, the parties should have an opportunity for supplemental briefing to address any new evidence that arose in discovery and other issues preserved through the appeals, including the merits of unpatentability.
 - c) AIT further believes that the three proceedings should be consolidated for all purposes, not merely as to RPI and privity. Though the '111 patent will expire soon, AIT is agreeable to continuing to use BRI as the claim construction standard to further facilitate speedy resolution.
- 2) The parties disagree as to submission of evidence.
 - a) RPX proposes to submit with its opening brief documentary and/or testimonial evidence responsive to factual issues the Federal Circuit's opinion suggests may warrant further analysis by the Board (examples listed below), where such evidence is available. RPX will make available for cross-examination any declarant whose declaration is submitted with the opening brief.
 - i) "[W]hether RPX files IPR petitions to benefit *specific* clients that previously have been accused of patent infringement." Federal Circuit Opinion ("Op.") at 27.
 - ii) "RPX, unlike a traditional trade association, is a for-profit company whose clients pay for its portfolio of 'patent risk solutions.' ... These solutions help paying members 'extricate themselves from NPE lawsuits.' ... The company's SEC filings reveal that one of its 'strategies' for transforming the patent market is 'the facilitation of challenges to patent validity,' one intent of which is to 'reduce expenses for [RPX's] clients.' ... Yet the Board did not consider these facts, which, taken together, imply that RPX can and does file IPRs to serve its clients' financial interests, and that a key reason clients pay RPX is to benefit from this practice in the event they are sued by an NPE." Op. at 27.
 - iii) Whether "the circumstances surrounding RPX's creation of its Best Practices Guide—none of which the

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