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Sent: Friday, November 30, 2018 5:36 PM
To: Trials; Steve Sereboff; Rich Giunta
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Subject: RPX Corp v Applications in Internet Time, IPR Nos. 2015-01750, 2015-01751, 2015-01752

Follow Up Flag: Follow up
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IPR2015-01750
IPR2015-01751
IPR2015-01752

Dear Board,

Pursuant to the Board's Order of November 20, 2018, the parties have conferred and submit the following proposals regarding discovery and briefing on remand, indicating the points on which the parties agree and those on which they disagree.

The main points on which the parties disagree relate to the procedure for discovery. Because there is greater agreement between the parties as to briefing schedule, this joint e-mail first reports the parties' joint proposal on briefing, followed by the different parties' proposals on discovery. Below are:

- 1) a table summarizing the parties' joint proposal for briefing schedule;
- 2) a textual summary of the points of agreement and disagreement between the parties regarding discovery; and
- 3) a table of proposed due dates under each party's proposed discovery procedure.

Joint Proposal for Briefing Schedule

| <u>Briefing item:</u> | <u>Deadline:</u> | <u>Length:</u> |
|-----------------------|---|---------------------------|
| Opening brief by RPX | 5 weeks from close of discovery | 14,000 words |
| Opposition by AIT | 3 weeks from RPX opening brief | Same as RPX opening brief |
| Reply by RPX | 2 weeks from AIT opposition | 7,000 words |
| Sur-reply by AIT | [Only if authorized by the Board after RPX's reply] | |
| Oral hearing | Both parties request oral hearing; date at the Board's discretion | |

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| Board's decision | Board's discretion | |
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Summary of points of agreement and disagreement between the parties regarding discovery

Points of agreement

- The parties agree that RPX will voluntarily produce documentary and/or testimonial evidence responsive to the list of discovery items RPX proposed in the parties' joint e-mail to the Board of November 15, 2018.
- The parties agree that the Board should order RPX to produce "[d]ocuments discussing any efforts by RPX to shield its clients from being named as real parties in interest in *inter parte* [sic] reviews and covered business method reviews" (as mentioned in Judge Reyna's Concurrence at 12).
- The parties agree that RPX will make available for cross-examination any declarant whose declaration is served with RPX's production, and that cross-examination will take place via deposition during a period following the production of documents and/or declarations.
- The parties agree that the evidentiary record will be closed at the close of discovery --that is, before briefing. Each party should serve, during the production period, any new evidence on which that party intends to rely in its briefing; and each party's briefing should rely on evidence already of record or served during the discovery period, unless the parties agree otherwise or other authorization is obtained from the Board.

Points of disagreement

- 1) The parties disagree as to the required timing for AIT to request additional discovery.
 - a. RPX proposes the following:
 - i. If AIT desires additional discovery beyond the list of items RPX has agreed to voluntarily provide, AIT should provide a list of its discovery requests before the Board orders the initiation of the discovery period.
 - ii. If the parties cannot reach agreement on any additional discovery requests AIT may have, the Board should order motion practice under which AIT files a motion for additional discovery and RPX has an opportunity to oppose.
 - iii. This process should be concluded before RPX is asked to search for responsive evidence and begin production, such that production would be undertaken and completed in a single round.
 - b. AIT believes that the CAFC remanded so that the Board could consider the evidence already of record, with additional discovery coming only if AIT requests it. AIT is especially concerned that these already extended proceedings will continue to drag out to AIT's considerable harm.
 - i. Regarding real party in interest, the CAFC stated on p. 30 that the evidence of record "at least suggests that RPX may have filed the three IPR petitions, in part, to benefit Salesforce." Regarding privity, Judge Reyna's stated at p. 8 of his concurrence, "The record suggests that the form of substantive legal relationship between RPX and Salesforce precisely is that which defines privity." AIT's interests therefore lie in the relationship between RPX (and its

subsidiaries) and Salesforce, especially how that relationship has impacted the IPRs. While AIT’s interest centers on how RPX and Salesforce each viewed these IPRs, the relationship between RPX and Salesforce leading up to the IPRs is material, in AIT’s view, because it sets the stage. For example, this goes to the question of “estoppel by conduct” raised by the CAFC at p. 39. There is also the issue generally of how RPX approaches the filing of IPRs, including how RPX accounts for them (e.g., RPX’s 2017 10-K states that RPX’s IPR costs are a cost of revenue from its patent risk management services). Accordingly, so long as the Board’s next order encompasses this, and RPX’s production is fulsome, AIT does not anticipate requesting additional discovery.

- ii. While AIT is amenable to RPX producing more evidence, AIT wishes to balance disclosure of new evidence against the considerable harm AIT suffers from each passing day that the cloud of these IPRs hang over its patents. AIT is uncertain what RPX will produce, and hopes that no additional discovery will be necessary. AIT proposes, therefore, that after RPX makes its initial production, AIT will have an opportunity to seek Board approval for additional discovery. This forces AIT to decide whether the additional discovery it may request is worth the additional delay, and could relieve the Board of the burden of refereeing another dispute between the parties.
- iii. AIT sincerely hopes that additional discovery is unnecessary, but if necessary, might propound limited, targeted document requests, interrogatories and/or requests for admission, as well as seek depositions of important witnesses. AIT would want all of this done on an expedited basis.

Proposed due dates (exemplary) under each party’s proposed discovery procedure

All examples assume the Board’s Order on procedure issues December 7.

Example schedule under RPX’s proposed discovery procedure

| Item due: | Deadline: | Example dates | |
|--|--|--|---|
| | | If no motion practice: | If motion practice: |
| AIT motion for additional discovery | 3 weeks from Board’s Order on procedure (add an additional week if the period includes the December holidays) | [No motion, if AIT has no additional discovery requests that are not agreed upon.] | January 4 |
| RPX opposition to AIT’s discovery motion | 2 weeks from AIT’s discovery motion | [No opposition if no discovery motion] | January 18 |
| Production of documents/declarations responsive to voluntary/ordered discovery, and any evidence on which either party intends to rely in briefing | (If no motion for additional discovery): 6 weeks from Board’s Order on procedure (If motion for additional discovery): | January 18 | March 1 (example assuming Board’s decision on AIT’s discovery motion issues February 1) |

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| | 1 month from Board's decision on AIT's discovery motion | | |
| Depositions of declarants | 1 month from production of documents/declarations | February 18 | April 1 |
| RPX opening brief on the merits | 5 weeks from end of deposition period | March 25 | May 6 |
| AIT opposition brief | 3 weeks from RPX opening brief | April 15 | May 28 |
| RPX reply brief | 2 weeks from AIT opposition brief | April 29 | June 11 |
| Oral hearing | Board's discretion | | |

Example schedule under AIT's proposed discovery procedure

| Item due: | Deadline: | Example due or end dates | |
|--|---|--------------------------|---|
| | | If no motion practice: | If motion practice: |
| Production of documents/declarations responsive to voluntary/ordered discovery, and any evidence on which either party intends to rely in briefing | 2 weeks from Board's Order on procedure | December 21 | December 21 |
| Depositions of declarants | 1 month from production of documents/declarations | January 21 | January 21 |
| AIT motion for additional discovery | 2 weeks from last deposition | [not applicable] | February 4 |
| RPX opposition to AIT's discovery motion | 1 week from AIT's discovery motion | [not applicable] | February 11 |
| Board order on additional discovery | Board's discretion | [not applicable] | assume Board's Order on additional discovery issues February 25 (2 weeks) |
| Production of additional discovery | 2 weeks from Board order | [not applicable] | March 11 |

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| RPX opening brief on the merits | 5 weeks from end of deposition period | February 25 | April 15 |
| AIT opposition brief | 3 weeks from RPX opening brief | March 18 | May 6 |
| RPX reply brief | 2 weeks from AIT opposition brief | April 1 | May 20 |
| Oral hearing | Board's discretion | | |

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