From: Noonen, Martin

**Sent:** Thursday, June 18, 2015 5:46 PM **To:** Jeff Eichmann; Christin Cho

Cc: Culpepper, Ross; Walters, Chad; Kubehl, Doug; Smith, Karina; Grissum, Morgan; Parrish,

Bryan; EXT Smith, Melissa (T-Mobile); Pennington, Ed; jpennington@sgrlaw.com; Pandit, Sid; Scruggs, Stephanie D.; EXT Jones, Mike; Gardner, Allen; Charley; EXT Rambin, Jeffrey; Julien Adams; Bunt, R.; DeRieux, Betty; MoFo-TracBeam; Simon Franzini; Rahebi, Bita;

Wiener, Christopher J.

Subject: RE: DCO proposal

Jeff: I am writing on behalf of Defendants regarding the DCO issues that the Court directed the parties to meet and confer about in the June 2 Order. Following our initial call last Thursday, you sent Defendants a "DCO Proposal" on Tuesday, which we discussed yesterday. As we informed you during our call yesterday, Defendants do not believe that 80 asserted claims is a reasonable number. Moreover, we need a much longer extension than 17 days to serve our respective Invalidity Contentions (IVCs) than the July 16 deadline set forth in Plaintiff's DCO Proposal. While we are resigned to asking the Court to resolve the "number of asserted claims" issue on Tuesday, we are hopeful that the parties can at least work out a reasonable compromise on the IVC deadline(s). Below is a summary of where we think we stand on various issues:

- 1. <u>Number of Asserted Claims</u>. As discussed below, we seem to be at an impasse on this issue, but please let us know if you have any other proposals you would like us to consider.
  - In the June 2 Order, the Court "ORDERED [Plaintiff] to elect a reasonable number of asserted claims within three weeks" (i.e., by June 23). Quite simply, we don't think that 80 claims is anywhere near reasonable given the sheer length of the claims of the patents in suit (some of which run for more than a column).
    - Under the circumstances, we would agree to 40 claims, although we don't agree that number is reasonable given that TracBeam initially asserted less than half that number in prior litigation and eventually dropped to 2 or 3 per remaining defendant by the time of expert reports.
  - Plaintiff's initial assertion of 140+ claims against T-Mobile and 120 claims against Apple appears to have been
    designed to run up our clients' expenses and impose maximum prejudice upon Defendants as they prepare their
    IVCs, and this tactic has certainly accomplished both apparent objectives.
    - Dropping to 80 claims doesn't ameliorate the great burden on Defendants; in fact, expecting Defendants to prepare and serve quality IVCs focused on a reduced universe of claims a little more than 3 weeks after finding out what those claims are is unrealistic.
  - Unless TracBeam is willing to agree to assert a reasonable (or, more accurately, less unreasonable) number of claims on June 23, Defendants will ask the Court to resolve that dispute.
- 2. IVC Deadline. A July 16 IVC deadline is unworkable from Defendants' perspective. As discussed, there would appear to be two alternatives: [a] phased IVCs which would treat July 16 (or thereabouts) as the deadline for provisional IVCs to be followed by supplementation around the time of Defendants' Preliminary Election of Prior Art in October, and [b] a more meaningful extension to mid-to-late September (albeit with no automatic supplementation) here are some comments on these two alternatives:
  - o [a] Please let us know if Plaintiff would be amenable to a phased IVC proposal whereby Defendants serve provisional IVCs approximately 4 weeks after Plaintiff asserts a reasonable number of asserted claims, with Defendants then being permitted to supplement their IVCs in mid-October to provide streamlined contentions regarding the up-to-32 asserted claims to be elected during Plaintiff's Preliminary Election in mid-September.
    - o If the parties reach agreement on what constitutes a reasonable number of asserted claims on June 23, the provisional IVCs would be directed to the claims then asserted by Plaintiff and would be served in mid-to-late July (i.e., close in time to Plaintiff's July 16 proposal).



- If the parties don't reach agreement on the "number of asserted claims" issue, the provisional IVCs would be due four weeks after Plaintiff serves a reduced number of asserted claims following the Court's ruling re what constitutes a "reasonable" number.
- o In the mid-October time frame, Defendants would then serve Supplemental IVCs that would focus on the up-to-32 claims that Plaintiff elects pursuant to the Model Order on September 17.
- o [b] Please also let us know if Plaintiff will reconsider Defendants' proposal of a mid-to-late September IVC deadline (whereby the IVCs would not be subject to automatic supplementation).
  - o After some consideration, the earliest that Defendants could pledge to serve IVCs after learning Plaintiff's reduced set of asserted claims on June 23 would be September 16 (due to work and vacation schedules of the attorneys involved), but Plaintiff has already rejected each of the following three ways that a September 16 deadline could be incorporated into the previously agreed case schedule:
    - (1) The entire case schedule (including the December 16 Markman hearing and the trial date) could be "time-shifted" around three months with the Court's permission;
    - (2) The rest of the case schedule would not change with Plaintiff absorbing any strategic disadvantage with not having Defendants' IVCs until the Patent Rule 4 claim construction process is underway (reiterating that this is a problem of Plaintiff's own making from Defendants' perspective); or
    - (3) The Patent Rule 4 claim construction schedule could be compressed between September 16 (i.e., the extended IVC deadline) and December 16 (the current Markman hearing date) attached is a rough "compressed" schedule that shows this appears feasible.
- Defendants remain willing to work with Plaintiff on a reasonable compromise on the IVC deadline issue.
- 3. Implementation of the Model Order. We didn't delve into this on our calls, but notwithstanding that we deem the Model Order numbers too high for this case, we are in general agreement regarding the implementation of the Model Order set forth in Plaintiff's DCO Proposal with two exceptions, both tied to Defendants' Preliminary Election of Prior Art:
  - Defendants need more than two weeks to make their Preliminary Election after Plaintiff makes its Preliminary Election of up to 32 claims on September 17.
    - o A minimum of four weeks is needed (and would be especially imperative if Defendants are going to submit Supplemental IVCs on that date as part of the phased IVC option discussed above in 2[a]) - we propose October 15 for this deadline.
  - o While Defendants will agree to count each obviousness combination as a reference in their Final Election of Prior Art on March 31, 2016, they will not agree to this constraint for their Preliminary Election on October 15.

Please let us know your thoughts on the above. If you feel it would be productive to discuss any of the above issues further, we can do so toward the end of tomorrow's scheduled meet and confer on the Protective Order.

Thanks. Martin

From: Jeff Eichmann [mailto:jeff@dovellaw.com]

Sent: Wednesday, June 17, 2015 12:01 PM

To: Ross.Culpepper@bakerbotts.com; Noonen, Martin; Christin Cho

Cc: chad.walters@bakerbotts.com; doug.kubehl@bakerbotts.com; karina.smith@bakerbotts.com; Morgan, Grissum@bakerbotts.com; bryan.parrish@bakerbotts.com; melissa@gillamsmithlaw.com;

epennington@sgrlaw.com; jpennington@sgrlaw.com; spandit@sgrlaw.com; sscruggs@sgrlaw.com;

mikejones@potterminton.com; allengardner@potterminton.com; charley@pbatyler.com; jrambin@capshawlaw.com;

Julien Adams; rcbunt@pbatyler.com; ederieux@capshawlaw.com; MoFo-TracBeam; Simon Franzini; Rahebi, Bita

Subject: RE: DCO proposal

Ross:

(310) 482-2959



Conference ID: 6909 Password: 703

Jeff

From: Ross.Culpepper@bakerbotts.com [mailto:Ross.Culpepper@bakerbotts.com]

Sent: Wednesday, June 17, 2015 11:35 AM

**To:** Jeff Eichmann; <a href="mailto:mnoonen@mofo.com">mnoonen@mofo.com</a>; Christin Cho

Cc: chad.walters@bakerbotts.com; doug.kubehl@bakerbotts.com; karina.smith@bakerbotts.com; Morgan.Grissum@bakerbotts.com; bryan.parrish@bakerbotts.com; melissa@gillamsmithlaw.com; epennington@sgrlaw.com; jpennington@sgrlaw.com; spandit@sgrlaw.com; sscruggs@sgrlaw.com; mikejones@potterminton.com; allengardner@potterminton.com; charley@pbatyler.com; jrambin@capshawlaw.com; Julien Adams; rcbunt@pbatyler.com; ederieux@capshawlaw.com; Mofo TracBeam@mofo.com; Simon Franzini;

BRahebi@mofo.com

Subject: RE: DCO proposal

Jeff,

That works for T-Mobile and Apple. Let us know what dial-in to use.

Thanks,

Ross

Ross Culpopper | Baker Botts L.L.P. | | ross.culpepper@bakerbotts.com | 214,953.6543 office | 214,934.8604 cell | 214,661.4543 fux | www.bakerbotts.com

From: Jeff Eichmann [mailto:jeff@dovellaw.com]
Sent: Wednesday, June 17, 2015 1:04 PM

To: Culpepper, Ross; Noonen, Martin; Christin Cho

**Cc:** Walters, Chad; Kubehl, Doug; Smith, Karina; Grissum, Morgan; Parrish, Bryan; EXT Smith, Melissa (T-Mobile); Pennington, Ed; <u>jpennington@sgrlaw.com</u>; Pandit, Sid; Scruggs, Stephanie D.; EXT Jones, Mike; Gardner, Allen; Charley; EXT Rambin, Jeffrey; Julien Adams; Bunt, R.; DeRieux, Betty; <u>Mofo TracBeam@mofo.com</u>; Simon Franzini;

BRahebi@mofo.com

Subject: RE: DCO proposal

Ross,

How about 2pm PT?

Jeff

**From:** Ross.Culpepper@bakerbotts.com [mailto:Ross.Culpepper@bakerbotts.com]

**Sent:** Wednesday, June 17, 2015 9:09 AM

To: Jeff Eichmann; mnoonen@mofo.com; Christin Cho

Cc: <a href="mailto:com;">chad.walters@bakerbotts.com;</a>; <a href="mailto:doug.kubehl@bakerbotts.com">doug.kubehl@bakerbotts.com</a>; <a href="mailto:karina.smith@bakerbotts.com">karina.smith@bakerbotts.com</a>; <a href="mailto:moissa@gillamsmithlaw.com">Morgan.Grissum@bakerbotts.com</a>; <a href="mailto:bryan.parrish@bakerbotts.com">bryan.parrish@bakerbotts.com</a>; <a href="mailto:melissa@gillamsmithlaw.com">melissa@gillamsmithlaw.com</a>; <a href="mailto:epennington@sgrlaw.com">epennington@sgrlaw.com</a>; <a href="mailto:jpennington@sgrlaw.com">jpennington@sgrlaw.com</a>; <a href="mailto:jpennington@sgrlaw

Julien Adams; <a href="mailto:rcbunt@pbatyler.com">rcbunt@pbatyler.com</a>; <a href="mailto:edericux@capshawlaw.com">edericux@capshawlaw.com</a>; <a href="mailto:Mofo\_TracBeam@mofo.com">Mofo\_TracBeam@mofo.com</a>; <a href="mailto:Simon Franzini">Simon Franzini</a>;

BRahebi@mofo.com

Subject: RE: DCO proposal

Jeff,



## Thanks,

Ross

Ross Culpepper | Baker Botts L.L.P. | | ross.culpepper@bakerbotts.com | 214.953.6543 office | 214.934.8604 cell | 214.661.4543 fax | www.bakerbotts.com

**From:** Jeff Eichmann [mailto:jeff@dovellaw.com] **Sent:** Wednesday, June 17, 2015 10:35 AM **To:** Culpepper, Ross; Noonen, Martin; Christin Cho

**Cc:** Walters, Chad; Kubehl, Doug; Smith, Karina; Grissum, Morgan; Parrish, Bryan; EXT Smith, Melissa (T-Mobile); Pennington, Ed; <u>jpennington@sgrlaw.com</u>; Pandit, Sid; Scruggs, Stephanie D.; EXT Jones, Mike; Gardner, Allen; Charley; EXT Rambin, Jeffrey; Julien Adams; Bunt, R.; DeRieux, Betty; <u>Mofo TracBeam@mofo.com</u>; Simon Franzini;

BRahebi@mofo.com

Subject: RE: DCO proposal

Ross,

Tomorrow will be tough. I have a deposition in the morning in CA followed immediately by a flight to NY the rest of the day. Can we touch base this afternoon?

Jeff

From: Ross.Culpepper@bakerbotts.com [mailto:Ross.Culpepper@bakerbotts.com]

Sent: Wednesday, June 17, 2015 8:33 AM

**To:** Jeff Eichmann; <a href="mailto:mnoonen@mofo.com">mnoonen@mofo.com</a>; Christin Cho

Cc: chad.walters@bakerbotts.com; doug.kubehl@bakerbotts.com; karina.smith@bakerbotts.com; Morgan.Grissum@bakerbotts.com; bryan.parrish@bakerbotts.com; melissa@gillamsmithlaw.com; epennington@sgrlaw.com; jpennington@sgrlaw.com; spandit@sgrlaw.com; sscruggs@sgrlaw.com; mikejones@potterminton.com; allengardner@potterminton.com; charley@pbatyler.com; jrambin@capshawlaw.com; Julien Adams; rcbunt@pbatyler.com; ederieux@capshawlaw.com; Mofo TracBeam@mofo.com; Simon Franzini; BRahebi@mofo.com

Subject: RE: DCO proposal

Jeff.

Can you let us know your availability tomorrow for a meet and confer to discuss your DCO proposal?

Thanks,

Ross

Ross Culpepper | Baker Botts L.L.P. | | ross.culpepper@bakerbotts.com | 214.953.6543 office | 214.934.8604 cell | 214.661.4543 fax | www.bakerbotts.com

**From:** Jeff Eichmann [mailto:jeff@dovellaw.com]

Sent: Tuesday, June 16, 2015 10:03 AM

To: Noonen, Martin; Christin Cho

**Cc:** Culpepper, Ross; Walters, Chad; Kubehl, Doug; Smith, Karina; Grissum, Morgan; Parrish, Bryan; EXT Smith, Melissa (T-Mobile); Pennington, Ed; 'jpennington@sgrlaw.com'; Pandit, Sid; Scruggs, Stephanie D.; EXT Jones, Mike; Gardner, Allen; Charley; EXT Rambin, Jeffrey; Julien Adams; Bunt, R.; DeRieux, Betty; MoFo-TracBeam; Simon Franzini; Rahebi,

DILA

Subject: DCO proposal

Martin,



See attached re the DCO.

Thanks leff

From: Noonen, Martin [mailto:MNoonen@mofo.com]

**Sent:** Monday, June 15, 2015 9:40 PM **To:** Jeff Eichmann; Christin Cho

Cc: 'Ross.Culpepper@bakerbotts.com'; 'chad.walters@bakerbotts.com'; 'doug.kubehl@bakerbotts.com'; 'karina.smith@bakerbotts.com'; 'Morgan.Grissum@bakerbotts.com'; 'bryan.parrish@bakerbotts.com'; 'melissa@gillamsmithlaw.com'; 'epennington@sgrlaw.com'; 'jpennington@sgrlaw.com'; 'spandit@sgrlaw.com'; 'sscruggs@sgrlaw.com'; 'mikejones@potterminton.com'; 'allengardner@potterminton.com'; 'charley@pbatyler.com'; 'jrambin@capshawlaw.com'; Julien Adams; 'rcbunt@pbatyler.com'; 'ederieux@capshawlaw.com'; MoFo-TracBeam; Simon Franzini; Rahebi, Bita

Subject: RE: TracBeam lawsuit: meet and confer re Court's order

Jeff: Following up on our Thursday call, just confirming that Plaintiff is putting together the revised Discovery Order that is due tomorrow. Please circulate that for Defendants' review along with any proposal you may have on the outstanding DCO issues. We can then set up a follow-up call to discuss remaining issues. Thanks. Martin

From: Noonen, Martin

Sent: Thursday, June 11, 2015 10:07 AM

To: Jeff Eichmann; Christin Cho

Cc: Ross.Culpepper@bakerbotts.com; chad.walters@bakerbotts.com; doug.kubehl@bakerbotts.com; karina.smith@bakerbotts.com; Morgan.Grissum@bakerbotts.com; bryan.parrish@bakerbotts.com; melissa@gillamsmithlaw.com; epennington@sgrlaw.com; jpennington@sgrlaw.com; spandit@sgrlaw.com; sscruggs@sgrlaw.com; mikejones@potterminton.com; allengardner@potterminton.com; charley@pbatyler.com; jrambin@capshawlaw.com; Julien Adams; rcbunt@pbatyler.com; ederieux@capshawlaw.com; MoFo-TracBeam; Simon Franzini; Rahebi, Bita

Subject: RE: TracBeam lawsuit: meet and confer re Court's order

Jeff: That timing (1PM Pacific / 3PM Central / 4PM Eastern) works for Defendants. Please circulate a dial-in and we'll talk to you then. Thanks. Martin

From: Jeff Eichmann [mailto:jeff@dovellaw.com]

**Sent:** Thursday, June 11, 2015 9:35 AM

To: Noonen, Martin; Christin Cho

Cc: Ross.Culpepper@bakerbotts.com; chad.walters@bakerbotts.com; doug.kubehl@bakerbotts.com; karina.smith@bakerbotts.com; Morgan.Grissum@bakerbotts.com; bryan.parrish@bakerbotts.com; melissa@gillamsmithlaw.com; epennington@sgrlaw.com; jpennington@sgrlaw.com; spandit@sgrlaw.com; sscruggs@sgrlaw.com; mikejones@potterminton.com; allengardner@potterminton.com; charley@pbatyler.com; jrambin@capshawlaw.com; Julien Adams; rcbunt@pbatyler.com; ederieux@capshawlaw.com; MoFo-TracBeam; Simon Franzini: Rahebi, Bita

Subject: RE: TracBeam lawsuit: meet and confer re Court's order

Martin, Ross:

Would 1pm PT / 4pm ET work for you all today?

Jeff



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