

## Justin Nemunaitis

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**From:** Garrett, Mark <mark.garrett@nortonrosefulbright.com>  
**Sent:** Monday, October 03, 2016 3:35 PM  
**To:** Justin Nemunaitis; Robinson, Eagle  
**Cc:** Mike Ray; Lori Gordon; Kyle E. Conklin; Hamad Hamad  
**Subject:** RE: Rapid IPRs joinder issue

Justin,

The requested information is not relevant to the material fact that Petitioners were not aware of the Lane-Wells reference prior to June 20, 2016. Further, much if not all of the requested information is protected work product and/or attorney-client privileged. Finally, there was no information inconsistent with any positions advanced in the joinder motions.

Moreover, the requested information concerns estoppel, which is not at issue. In the joinder motions, the June 20, 2016 date gives the Board context about the filing dates of the July IPRs. And the point about skilled searchers not finding the Lane-Wells reference was included to (1) make clear that Petitioners would contest any assertion by Rapid Completions ("RC") that Petitioners' July IPRs should be subject to estoppel, in the event that (2) RC elects to argue that the schedule should not be extended because Petitioners' July IPRs might not survive estoppel.

There is no need to litigate (1) at this time and, for (2), the district court has now stayed the litigation through the completion of all the IPRs, including Weatherford's.

Regards,  
- Mark

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**From:** Justin Nemunaitis [mailto:jnemunaitis@caldwellcc.com]  
**Sent:** Thursday, September 29, 2016 12:24 AM  
**To:** Garrett, Mark; Robinson, Eagle  
**Cc:** Mike Ray; Lori Gordon; Kyle E. Conklin; Hamad Hamad  
**Subject:** RE: Rapid IPRs joinder issue

Mark,

Assuming your motion is even possible under the statute, it would inject delay and complexity based on a proceeding that has not been instituted. If your goal is logistical (e.g., minimizing depositions or something like that) I am happy to discuss those issues to try to find a compromise that does not involve formal joinder. However, it looks like your real goal is to circumvent statutory safeguards designed to protect patentees from harassment through excessive IPR filings. If that's the case, I doubt there is any room for compromise.

Regards,  
Justin

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**From:** Garrett, Mark [mailto:mark.garrett@nortonrosefulbright.com]  
**Sent:** Wednesday, September 28, 2016 11:17 AM  
**To:** Justin Nemunaitis <jnemunaitis@caldwellcc.com>; Robinson, Eagle <eagle.robinson@nortonrosefulbright.com>  
**Cc:** Mike Ray <MRAY@skgf.com>; Lori Gordon <LGORDON@skgf.com>; Kyle E. Conklin <KCONKLIN@skgf.com>; Hamad Hamad <hhamad@caldwellcc.com>  
**Subject:** RE: Rapid IPRs joinder issue

Justin, we'll consider your requests.

Setting these assertions aside, what is the basis for RC's opposition to joinder?

Thanks,  
- Mark

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**From:** Justin Nemunaitis [<mailto:jnemunaitis@caldwellcc.com>]  
**Sent:** Wednesday, September 28, 2016 10:56 AM  
**To:** Garrett, Mark; Robinson, Eagle  
**Cc:** Mike Ray; Lori Gordon; Kyle E. Conklin; Hamad Hamad  
**Subject:** Rapid IPRs joinder issue

Mark and Eagle,

Your motions for joinder make a number of factual assertions, for which no supporting evidence has been provided. We need to see that evidence to have a fair chance at responding. Specifically, your motion in the 774 IPR states:

"Petitioners became aware of Lane-Wells on or around June 20, 2016." Mot. at 2.

"For example, none of multiple, diligent searches conducted by skilled, professional searchers prior to filing the 598 Proceeding discovered Lane-Wells. . . ." Mot. at 5-6.

These assertions beg the question, if Petitioners conducted multiple diligent searches for prior art, and those searches did not locate Lane-Wells, how did Petitioners ultimately locate Lane Wells? Stated differently, if Petitioners were able to locate Lane Wells on June 20, 2016, why did it not locate it earlier? We need your answers to these questions in order to respond to your position that qualified searchers interested in the subject matter of the 774 patent could not be expected to locate Lane-Wells even if they had exercised reasonable diligence.

In answering these questions, please also explain:

Who are the "skilled, professional searchers" referred to in your motion? What types of searches did they perform? Who ultimately found Lane-Wells? How did he/she find it? Did he/she perform a different type of search? If so, what was that search and why was it not performed earlier?

Alternatively, did the person that located Lane-Wells obtain assistance from a person or other source that directed him/her to look for information about Lane-Wells tools? If so, please let us know what the source was, what information it provided in this regard, and when. Also, why did Petitioners not contact that source earlier or act on the information provided earlier?

In addition, pursuant to 37 CFR 42.51(b)(1)(iii), we request production of all relevant information that is inconsistent with your positions.

Please provide the requested information by 5pm next Tuesday. If do not intend to provide some portion of the requested information, or if you need more time, please let us know sooner so we have time to try to work something out. For example, I tried to keep this request at a high level, but if you believe it calls for privileged information, work-product, or joint defense materials, please just let me know so we can try to get the information we need for our response without getting into a more complicated dispute over those issues.

I am in trial this week, but please let me know if you'd like to schedule a call to discuss any of this.

Thanks,  
Justin

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