

Rosato, Michael

From: Rosato, Michael
Sent: Friday, February 02, 2018 11:45 AM
To: Trials
Cc: Torczon, Richard; Argenti, Matthew; Goldenberg, Richard; Smith, Michael H.(DC); Dowd, James; Selwyn, Mark
Subject: IPR2017-210, 219, 297, 700, 701 and 728
Attachments: RE: IPR2017-210, 219, 700, 701, 728: Request for emergency call

Dear Trials,

Per the attached email correspondence, the Board has previously instructed that discovery disputes and corresponding relief, including sanctions, should be brought to the panel's attention after deposition transcripts become available. Caltech (Patent Owner) now seeks Board authorization to pursue relief for discovery misconduct by the Petitioner related to the cross-examination of two Caltech witnesses: Dr. Michael Mitzenmacher and Dr. Divsalar.

Briefly, the discovery misconduct includes extensive and repeated violations of Bd.Rule 42.53(d)(5)(ii), which expressly limits cross-examination to the scope of the witness' direct testimony. See also, 37 CFR 42.12(a)(1), (5), (7). Upon review of the deposition transcripts, Caltech estimates that ~30% of Dr. Mitzenmacher's cross-examination and ~70% of Dr. Divsalar's cross-examination was directed to subject matter outside the scope of direct testimony.

The requested relief includes, but is not limited to, the following:

- Cross-examination testimony of the witnesses should be struck from the record. See, e.g., 37 CFR 42.12(b)(2).
- At a minimum, testimony elicited in violation of §42.53(d)(5)(ii) should be struck from the record
- An order holding the direct testimony of both Dr. Mitzenmacher and Dr. Divsalar are deemed facts established in the IPR proceedings. See, e.g., 37 CFR 42.12(b)(1).
- Revocation of *pro hac* admission of Petitioner's representative, Mr. Dowd (who conducted cross-examination of Dr. Divsalar)
- An order providing for reasonable compensatory expenses. See, e.g., 37 CFR 42.12(b)(6).

Caltech recognizes that a decision on the requested relief is likely to occur after Petitioner has filed their reply brief to the PO Response. As such, Caltech proposes any cross-examination transcripts of Dr. Mitzenmacher or Dr. Divsalar be filed under the protective order that parties have agreed upon for these cases at least until the Board renders its decision on the relief requested. Caltech believes such designation is necessary to avoid prejudice to Caltech, including misuse of the transcripts in related parallel litigation. Petitioner has indicated that such a preliminary designation is acceptable, but intends to argue that the transcripts should be publicly available.

Caltech has conferred with counsel for Petitioner, who opposes the requested relief. Parties are available for a conference call with the Board during the following times:

- Feb 5: Before 4:00 pm ET
- Feb 6: Between 3:00-4:00 ET
- Feb 7: Before noon ET

Respectfully submitted,

Michael T Rosato (Counsel for Patent Owner/Caltech)
Wilson Sonsini Goodrich & Rosati

CALTECH - EXHIBIT 2036

[o] 206.883.2529 | [f] 206.883.2699

mrosato@wsgr.com

Rosato, Michael

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, January 10, 2018 12:19 PM
To: Rosato, Michael; Goldenberg, Richard; Trials
Cc: Smith, Michael H.(DC); Dowd, James; Selwyn, Mark; Argenti, Matthew
Subject: RE: IPR2017-210, 219, 700, 701, 728: Request for emergency call

Counsel,

We do not think a call is necessary at this stage. After obtaining the transcript, counsel may seek remedy through a subsequent conference with the Board requesting appropriate relief or sanctions related to the deposition.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
Direct: 571-272-5366

From: Rosato, Michael [<mailto:mrosato@wsgr.com>]
Sent: Wednesday, January 10, 2018 2:44 PM
To: Goldenberg, Richard <Richard.Goldenberg@wilmerhale.com>; Trials <Trials@USPTO.GOV>
Cc: Smith, Michael H.(DC) <MichaelH.Smith@wilmerhale.com>; Dowd, James <James.Dowd@wilmerhale.com>; Selwyn, Mark <Mark.Selwyn@wilmerhale.com>; Argenti, Matthew <margenti@wsgr.com>
Subject: RE: IPR2017-210, 219, 700, 701, 728: Request for emergency call

Dear Trials,

Caltech's position is not stated below, but briefly includes the following:

Petitioner's representations are inaccurate. The witness is neither obstructing or refusing to answer questions. The attached rough transcript excerpt, which the Petitioner has identified as being representative of their complaint, illustrates that Petitioner's complaint is without merit (please note that the deposition transcript as a whole has a preliminary confidential designation).

For context, Caltech's Patent Owner Responses in these cases each detail instances where Petitioner's expert, Dr. Davis, refused to answer simple questions such as whether a cited prior art reference depicts a Tanner graph. See e.g., IPR2017-00297, Paper 31, pp. 14-15. The parties have also previously discussed inappropriate conduct by Petitioner during cross examination of Caltech's expert witness, Dr. Mitzenmacher. Petitioner's complaints today are believed to not only be without merit, but an effort to distract from legitimate concerns Caltech has raised with regard to Petitioner's discovery misconduct.

While Caltech does not believe an emergency call is warranted, we are willing to participate in such a call in order to give a full accounting of the facts and circumstances.

Respectfully submitted,

Michael T Rosato

Wilson Sonsini Goodrich & Rosati

[o] 206.883.2529 | [f] 206.883.2699

mrosato@wsgr.com

From: Goldenberg, Richard [<mailto:Richard.Goldenberg@wilmerhale.com>]

Sent: Wednesday, January 10, 2018 10:18 AM

To: Trials

Cc: Smith, Michael H.(DC); Dowd, James; Selwyn, Mark; Argenti, Matthew; Rosato, Michael

Subject: IPR2017-210, 219, 700, 701, 728: Request for emergency call

Dear Honorable Board,

Petitioner requests an emergency call with the Board regarding the deposition of Dr. Hui Jin, which is occurring today. The witness is obstructing the deposition by refusing to answer simple questions and Petitioner seeks the Board's guidance regarding how to proceed.

For reference, the parties to these IPRs are: Apple Inc. Petitioner v. California Institute of Technology Patent Owner.

Richard Goldenberg | WilmerHale

60 State Street

Boston, MA 02109 USA

+1 617 526 6548 (t)

+1 617 526 5000 (f)

richard.goldenberg@wilmerhale.com

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