

From: [McCarthy, Sean M.](#)
To: [Stahnke, Sarah \(PAO\)](#); arussell@shawkeller.com; [McCullough, Christina J. \(SEA\)](#); [Campbell, Chad \(PHX\)](#); [Jennison, Judy \(SEA\)](#); jshaw@shawkeller.com; kkeller@shawkeller.com; *MSFT - Philips Team; [McKeever, Patrick J. \(SDO\)](#)
Cc: [#Philips Prosecution Bar](#); ["DSilver@McCarter.com"](mailto:DSilver@McCarter.com); ["bsmyth@McCarter.com"](mailto:bsmyth@McCarter.com)
Subject: RE: Koninklijke Philips N.V. matters Nos. 11-1125 through 15-1128, 15-1130, 15-1131, and 15-1170
Date: Thursday, October 26, 2017 2:58:02 PM

Sarah,

Addressing your points in turn:

- (1) IPR counsel agree to be bound by the district court's protective order (with the agreed exception concerning the prosecution bar not being triggered) for the documents identified in my earlier email.
- (2) We confirm that to the extent any document is filed, it will be filed under seal and we will take all necessary precautions to ensure the documents remain confidential.
- (3) Thank you for agreeing to the limited use of these documents in the IPRs, and thank you for confirming that reviewing these documents will **not** trigger the prosecution bar.

If this is acceptable to Microsoft, we do not believe a meet and confer is necessary.

Best regards,
Sean

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From: Stahnke, Sarah (Perkins Coie) [mailto:SStahnke@perkinscoie.com]
Sent: Thursday, October 26, 2017 4:56 PM
To: McCarthy, Sean M.; arussell@shawkeller.com; CMcCullough@perkinscoie.com; cscampbell@perkinscoie.com; JJennison@perkinscoie.com; jshaw@shawkeller.com; kkeller@shawkeller.com; MSFT-PhilipsTeam@perkinscoie.com; PMcKeever@perkinscoie.com
Cc: [#Philips Prosecution Bar](#); ["DSilver@McCarter.com"](mailto:DSilver@McCarter.com); ["bsmyth@McCarter.com"](mailto:bsmyth@McCarter.com)
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Sean,

We have some concerns about the use of these confidential Microsoft documents in the IPR proceedings. First, you have not indicated whether Philips' IPR counsel is bound by the Protective Order

entered in the district court case. Can you confirm that IPR counsel is, in fact, bound by the PO?

Second, we note that there is, as yet, no protective order in the IPR proceedings. We understand that you intend to file any documents under seal and take all necessary precautions to ensure the documents remain confidential. We expect that these documents will remain confidential and will not be available to the public. Please confirm.

Finally, we note that Paragraph 5 of the Protective Order prohibits the use of confidential material for any purpose other than use in the district court litigations. This use falls within that prohibition. In the interest of facilitating the PTAB's full review of Philips' request for discovery, however, we are willing to agree to a limited use of these documents in the IPRs, so long as they are not used for any other extra-litigation purpose. To this end, Philips may share these materials with outside IPR counsel who are bound by the district court's Protective Order and who maintain the confidentiality of the documents, and we agree that reviewing these documents and filing them under seal with the PTAB will not trigger the prosecution bar. This agreement applies only to the specific documents you have identified in your message.

Please let us know if you still believe that a meet and confer is necessary, and if so, we can check availability.

Regards,
Sarah

From: McCarthy, Sean M. [<mailto:SMcCarthy@FCHS.COM>]
Sent: Thursday, October 26, 2017 1:43 PM
To: arussell@shawkeller.com; McCullough, Christina J. (SEA); Campbell, Chad (PHX); Jennison, Judy (SEA); jshaw@shawkeller.com; kkeller@shawkeller.com; *MSFT - Philips Team; McKeever, Patrick J. (SDO); Stahnke, Sarah (PAO)
Cc: #Philips Prosecution Bar; 'DSilver@McCarter.com'; 'bsmyth@McCarter.com'
Subject: RE: Koninklijke Philips N.V. matters Nos. 11-1125 through 15-1128, 15-1130, 15-1131, and 15-1170

Microsoft Counsel,

We have not received a response to my below email. Please let us know when you and local counsel are available to meet and confer after **4:30pm ET today**.

Best regards,
Sean

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From: McCarthy, Sean M.
Sent: Wednesday, October 25, 2017 2:06 PM
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Cc: #Philips Prosecution Bar; DSilver@McCarter.com; bsmyth@McCarter.com

Subject: Koninklijke Philips N.V. matters Nos. 11-1125 through 15-1128, 15-1130, 15-1131, and 15-1170

Microsoft Counsel,

As you are probably aware, yesterday the PTAB authorized Philips to file a motion by **November 1, 2017** for additional discovery in IPR2017-00890, -01754, and -01766 relating to (1) whether and to what extent a relationship exists between Microsoft and HTC with respect to the current IPR proceedings, and (2) whether and to what extent a relationship exists between the instant Petitioners (HTC and Microsoft) and the petitioners in earlier *inter partes* review proceedings, namely Google, Acer, and ASUS. In particular, the PTAB stated that Patent Owner, in its motion, should “specifically identify[] the evidence **already in Patent Owner’s possession** tending to show beyond mere speculation that something useful will be uncovered by the request.” See IPR2017-00890, Paper 11, at 3 (emphasis added). However, paragraph 14 of the Protective Order (D.I. 132 in Case No. 15-1170) currently prohibits us from sharing certain documents with the attorneys involved in the IPRs because they are marked “HIGHLY CONFIDENTIAL – OUTSIDE COUNSEL ONLY,” and thus we may be hindered from complying with the PTAB’s order.

While we believe the below-identified materials do not trigger the prosecution bar of paragraph 14 because they would fall into documents not classified as Prosecution Bar Materials, namely “(i) documents and information related only to damages or reasonable royalty rates,” out of an abundance of caution we would like your written consent to allow the attorneys working on the IPR to view, without triggering the prosecution bar of the protective order, the agreements between Microsoft and Acer, and between Microsoft and ASUS. **To be clear, the attorneys working on the IPR are all outside counsel.** In particular, we wish to disclose the following documents to our IPR team:

- (1) Microsoft OEM Master Licensing Agreement (Version 2015) (MSFT_PHILIPS00004741-806)
- (2) Microsoft OEM Business Terms Document (Version 10.0) (MSFT_PHILIPS00004807-831)
- (3) Co-Licensee Amendment to Microsoft OEM Business Terms Document (Version 10.0) (MSFT_PHILIPS00004832-835)
- (4) Co-Licensee Amendment to Microsoft OEM Business Terms Document (Version 10.0) (MSFT_PHILIPS00004836-839)
- (5) Co-Licensee Amendment to Microsoft OEM Business Terms Document (Version 10.0) (MSFT_PHILIPS00004840-842)
- (6) Co-Licensee Amendment to Microsoft OEM Business Terms Document (Version 10.0) (MSFT_PHILIPS00004843-845)
- (7) Co-Licensee Amendment to Microsoft OEM Business Terms Document (MSFT_PHILIPS00004846-848)
- (8) Co-Licensee Amendment to Microsoft OEM Business Terms Document (MSFT_PHILIPS00004849-851)
- (9) Co-Licensee Amendment to Microsoft OEM Business Terms Document (MSFT_PHILIPS00004852-854)
- (10) Co-Licensee Amendment to Microsoft OEM Business Terms Document (MSFT_PHILIPS00004855-857)

- (11)Amendment to Microsoft OEM Business Terms Document (Version 11.0)
(MSFT_PHILIPS00004858-867)
- (12)Microsoft OEM Business Terms Document (Version 11.0) (MSFT_PHILIPS00004868-889)
- (13)Microsoft Business Terms Document for OEM Customers (Version 9.0)
(MSFT_PHILIPS00004890-905)
- (14)Microsoft Business Terms Document for OEM Customers (Version 7.0)
(MSFT_PHILIPS00004906-921)
- (15)Microsoft Business Terms Document for OEM Customers (Version 8.0)
(MSFT_PHILIPS00004922-938)
- (16)Microsoft OEM Business Terms Document for Embedded Systems (Version 3.0)
(MSFT_PHILIPS00004939-957)
- (17)Microsoft OEM Business Terms Document for Embedded Systems (Version 4.0)
(MSFT_PHILIPS00004958-992)
- (18)Microsoft Desktop Operating System License Agreement (Version 10.0)
(MSFT_PHILIPS00004993-5030)
- (19)Microsoft Desktop Operating System License Agreement (Version 11.0)
(MSFT_PHILIPS00005031-5044)
- (20)Microsoft Desktop Operating System License Agreement (Version 12.0)
(MSFT_PHILIPS00005045-5061)
- (21)Microsoft Desktop Operating System License Agreement (Version 2011)
(MSFT_PHILIPS00005062-5081)
- (22)Microsoft Desktop Operating System License Agreement for OEM Customers (Version 8.01)
(MSFT_PHILIPS00005082-106)
- (23)Microsoft Desktop Operating System License Agreement for OEM Customers (Version 9.0)
(MSFT_PHILIPS00005107-196)
- (24)Microsoft OEM Master Licensing Agreement (Version 2012) (MSFT_PHILIPS00005197-259)
- (25)Amendment to the Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005260-262)
- (26)Amendment to the Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005263-266)
- (27)Microsoft OEM Mobility License Agreement (Version 3.0) (MSFT_PHILIPS00005267-276)
- (28)Amendment to the Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005277-283)
- (29)Amendment to the Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005284-298)
- (30)Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005299)
- (31)Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005300)
- (32)Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005301)
- (33)Microsoft OEM Mobility License Agreement (MSFT_PHILIPS00005302)
- (34)Microsoft OEM Mobility License Agreement (Step Plus, Version 3.0)
(MSFT_PHILIPS00005303)
- (35)Microsoft OEM Mobility License Agreement (Version 4.0) (MSFT_PHILIPS00005320-346)
- (36)Microsoft OEM Embedded Operating Systems License Agreement for Reference Platform Devices (Version 2.0) (MSFT_PHILIPS00005347-393)
- (37)Microsoft Toolkit License Agreement for OEM Customers (Version 9.0)

(MSFT_PHILIPS00005394-405)
(38)Microsoft Toolkit License Agreement for OEM Customers (Version 9.0)
(MSFT_PHILIPS00005406-417)

Please let us know by tomorrow, **October 26, 2017 by 3:00pm ET** whether you will consent to disclosing the aforementioned agreements to the IPR team without triggering the prosecution bar of paragraph 14 of the Protective Order. To the extent we rely on any of these document in our filing due November 1st, we will of course file such documents under seal to maintain their confidentiality.

If you do not consent to such authorization, please know that we intend to file an expedited motion with the Court for such authorization by **Friday, October 27, 2017** in order to comply with the PTAB's order. In that regard, please let us know when you are available to meet and confer **after 3:00 pm ET tomorrow**.

Best regards,
Sean

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