
From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Thursday, September 6, 2018 5:44 PM
To: Kelton, Thomas; McDole, Jamie; Andy Ehmke IPR; Calmann Clements IPR
Cc: Jim Etheridge; Ryan Loveless; Danny Butts; Jeff Huang
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

Thank you for the courtesy of providing your proposed email for review. The statement "and all references or citations to the declaration in any filing, as the declarant is unavailable for cross-examination" may be confusing to the Board given that there are no such references or citations made in the Patent Owner Response. We request either taking out that statement or adding the parenthetical (no such references or citations to the declaration are made in the Patent Owner Response).

Thanks,
Brett

From: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Sent: Thursday, September 6, 2018 5:36 PM
To: Brett Mangrum <brett@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <andy.ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>
Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett, please tell me if you are okay with this message to the Board:

In IPR2018-00289, Petitioner Apple respectfully requests permission to file an Unopposed Motion to Strike under 37 CFR 42.5(a) and 42.7(a). Specifically, the Petitioner seeks to strike the Easttom Declaration (Exhibit 2001) and all references or citations to the declaration in any filing, as the declarant is unavailable for cross-examination. Petitioner and Patent Owner have conferred, and Patent Owner indicates that they do not oppose the motion. If needed, Petitioner and Patent Owner are available for a Board call any time on Monday or Wednesday between 10:00am and 12:30pm EDT or at another time convenient for the Board.

Thomas Kelton

Partner
(t) 972.739.6923

From: Kelton, Thomas
Sent: Wednesday, September 5, 2018 6:19 PM
To: 'Brett Mangrum' <brett@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>
Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett,

Thank you for your response. We will reach out to the Board to set up a call on either Monday (anytime) or Wednesday between 9am and 11:30am CDT to discuss the motion to strike.

Thomas Kelton

Partner
(t) 972.739.6923

From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Wednesday, September 5, 2018 5:38 PM
To: Kelton, Thomas <Thomas.Kelton@haynesboone.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>
Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

While we still feel the most appropriate option under the circumstances is for petitioner to file an unopposed motion to exclude, and we note that Petitioner had originally recommended this option (albeit via a motion filed, instead, by patent owner), given your present preference for a motion to strike, upon consideration, we recommend you pursue that option.

Thanks,
Brett

From: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Sent: Wednesday, September 5, 2018 1:14 PM
To: Brett Mangrum <brett@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <andy.ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>
Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett, thank you for the meet and confer today. I should be in the rest of the afternoon (except from 2pm-3pm). Please reach out regarding the motion to strike and stipulation language when you get a chance.

I got your voicemail—I don't think a motion to exclude would get us where we need to be, and it wouldn't be decided until the Final Written Decision. Here is a good reference:
https://www.uspto.gov/sites/default/files/documents/Boardside_Chat_Motions_to_Exclude_and_Motions_to_Strike_2_0180607.pdf

Best regards,

Thomas Kelton

Partner
(t) 972.739.6923

From: Kelton, Thomas
Sent: Thursday, August 30, 2018 6:32 PM
To: 'Brett Mangrum' <brett@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>
Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett, I invited you, and feel free to forward the invite to any of your colleagues. Andy Ehmke and I will attend from Haynes Boone.

Thomas Kelton

Partner
(t) 972.739.6923

From: Brett Mangrum <brett@etheridgelaw.com>

Sent: Thursday, August 30, 2018 6:15 PM

To: Kelton, Thomas <Thomas.Kelton@haynesboone.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>

Cc: Jim Etheridge <jim@etheridgelaw.com>; Ryan Loveless <ryan@etheridgelaw.com>; Danny Butts <danny@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>

Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

We are available starting at 10am CST for a conference call between the parties Wednesday morning of next week, as proposed. Please circulate dial in information with your calendar invite.

Enjoy the holiday weekend.

Regards,
Brett

From: "Kelton, Thomas" <Thomas.Kelton@haynesboone.com>

Date: August 29, 2018 at 6:30:32 PM CDT

To: Brett Mangrum <brett@etheridgelaw.com>

Cc: Ryan Loveless <ryan@etheridgelaw.com>, "McDole, Jamie" <Jamie.McDole@haynesboone.com>, Jim Etheridge <jim@etheridgelaw.com>, "Jeff Huang" <jeff@etheridgelaw.com>, Andy Ehmke IPR <andy.ehmke.ipr@haynesboone.com>, Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>, Danny Butts <danny@etheridgelaw.com>

Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett,

We are available to meet and confer Wednesday morning anytime between 9am and 10:30am CDT next week. Please tell us if that works, and I will circulate a calendar invite. As we discussed, here is the authority for taking your expert's deposition:

- Trial Practice Guide ("Routine discovery includes: ... (2) the cross-examination of the other sides declarants.")
- Rule 42.51(b)(1)(ii)
- *Mexichem Amanco Holdings S.A. de C.V. v. Honeywell Int'l, Inc.*, IPR2013-00576 (Paper 36) (Sept. 5, 2014).
- *HTC CORPORATION and HTC AMERICA, INC. v. NFC TECHNOLOGY, LLC*, IPR2014-01198 (paper 41) (November 6, 2015).

Alternatively, if you are of the position that Easttom's testimony is not relevant to this proceeding, we would agree to not take his deposition, so long as you stipulate that (i) Uniloc will not cite or refer to the Easttom testimony in any paper, filing, demonstrative, or oral argument and (ii) the Easttom testimony should be given no weight because he was not made available for cross-examination.

Best regards,

Thomas Kelton

Partner
(t) 972.739.6923

From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Tuesday, August 28, 2018 5:30 PM
To: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>; Danny Butts <danny@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

Counsel for Patent Owner does not have availability this week and it is doubtful that the Board will be able to host a meet and confer on such short notice or that it would appreciate being asked to do so. We do have some limited availability in the morning early next week for the parties to meet and confer. We feel it would be premature to burden the Board absent such a conference between the parties. In advance of such a conference, please provide your response to the authority we cited to you so that we have sufficient time to consider it. Please also respond to our request that petitioner clarify its position regarding the mechanism and authority (to the extent petitioner is aware of any) for Patent Owner to withdraw a declaration cited only in a preliminary response, as you previously proposed.

Regards,
Brett _

From: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Sent: Tuesday, August 28, 2018 3:36 PM
To: Brett Mangrum <brett@etheridgelaw.com>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Andy Ehmke IPR <andy.ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>; Danny Butts <danny@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett,

Since you are not giving us a date for deposition, please give us some dates and times later this week for a Board call. I am available Thursday afternoon or any time on Friday. Best regards,

Thomas Kelton

Partner
(t) 972.739.6923

From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Tuesday, August 28, 2018 11:59 AM
To: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>; Danny Butts <danny@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

Patent Owner is not aware of a need or even a basis for Patent Owner withdraw the declaration from the record. Please be more specific as to what you are requesting the mechanism and supportive authority you are recommending.

Regards,
Brett

From: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Sent: Friday, August 24, 2018 9:11 PM
To: Brett Mangrum <brett@etheridgelaw.com>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Andy Ehmke IPR <andy.ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>; Danny Butts <danny@etheridgelaw.com>
Subject: RE: IPR2018-00289. Patent Owner's Response to Petition

Brett, if you are not going to make your expert available, will you withdraw the declaration from the record?

Thomas Kelton

Partner
(t) 972.739.6923

From: Brett Mangrum <brett@etheridgelaw.com>
Sent: Friday, August 24, 2018 8:11 PM
To: Kelton, Thomas <Thomas.Kelton@haynesboone.com>
Cc: Ryan Loveless <ryan@etheridgelaw.com>; McDole, Jamie <Jamie.McDole@haynesboone.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Calmann Clements IPR <Calmann.Clements.ipr@haynesboone.com>; Danny Butts <danny@etheridgelaw.com>
Subject: Re: IPR2018-00289. Patent Owner's Response to Petition

Thomas,

Please see the Office Patent Trial Practice Guide's statement that "discovery before the Board is focused on what the parties reasonable need to respond to the grounds raised by an opponent," 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012). Further, the rules proscribe Petitioner from presenting arguments in a reply that are not responsive to arguments raised in a response.

Have a great weekend.

Brett

On Aug 24, 2018, at 5:49 PM, Kelton, Thomas <Thomas.Kelton@haynesboone.com> wrote:

Brett, the authority is 37 CFR 42.51(b)(1)(ii). If you have authority that makes an exception for a declaration filed pre-institution, please let us know. Otherwise, please provide us dates that your expert is available. Thanks,

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