

From: Ehmke, Andrew S.
Sent: Wednesday, October 17, 2018 5:08 PM
To: Ryan Loveless <ryan@etheridgelaw.com>; Brett Mangrum <brett@etheridgelaw.com>; Jim Etheridge <jim@etheridgelaw.com>; Jeff Huang <jeff@etheridgelaw.com>; Sean Burdick <sean.burdick@unilocusa.com>
Cc: Andy Ehmke IPR <Andy.Ehmke.ipr@haynesboone.com>; Scott Jarratt IPR <scott.jarratt.ipr@haynesboone.com>
Subject: RE: Apple Inc. v. Uniloc Luxembourg SA et al, IPR No. 2018-00361 - Discovery

Counsel:

Your request does not identify with particularity the relevant discovery materials, which makes it difficult to provide a full response. We have conferred with Apple's counsel in N.D. Ca. Case No. 3:18-cv-00365, and it is our understanding that there is nothing recently discovered via third-party discovery from the inventor or prior owner. We disagree with your unstated suggestion that Apple has failed to satisfy Rule 42.51(b)(1) or that any further action by Apple is needed.

Based on a quick discussion with Apple's litigation counsel, we presume that you may be referring to the materials Bates labelled ELUSHER-000000001-74 and the documents referenced in HPE's privilege log in N.D. Ca. Case No. 3:18-cv-00365 ("HPE Materials"). As you are aware, the Bates labelled documents and privilege log were provided to Uniloc's counsel on August 28 and September 4, respectively, and are already in the possession of Uniloc's litigation counsel.

To the extent your request is with respect to the HPE Materials:

- Apple does not oppose Uniloc producing the HPE Materials in this IPR proceeding.
- For the HPE Materials referenced in HPE's privilege log, Apple does not object to Uniloc requesting from HPE the referenced documents or using the existence of the privilege log in this proceeding.
- To the extent Uniloc's intended use of the HPE Materials requires permission of a third party, Apple does not oppose Uniloc seeking such permission. Because the HPE Materials are not Apple's documents, Apple takes no position on whether these third parties consent to making such discovery available in this IPR proceeding under the PTAB's default protective order and sealing procedures.
- Uniloc must reciprocally agree to each of the listed bullets to the extent Apple desires to use the HPE Materials in this IPR proceeding.

Notwithstanding any of the foregoing, Apple reserves the right to serve objections and file corresponding motions to exclude, as applicable, to the extent the HPE Materials are not appropriate or permissible in an IPR proceeding. Further, to the extent your request is for materials other than the HPE Materials, we would ask that you identify the materials so that we can more fully assess your request.

Finally, Apple does not oppose entering into the default protective order contained in the trial practice guide. Please provide a clean, executable version for us to sign.

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From: Ryan Loveless <ryan@etheridgelaw.com>

Sent: Wednesday, October 17, 2018 11:16 AM

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Subject: Apple Inc. v. Uniloc Luxembourg SA et al, IPR No. 2018-00361 - Discovery

Counsel:

We recently discovered that Apple obtained third-party discovery from not only an inventor of United States Patent No. 6,216,158 ('158 Patent), but also the prior owner of the '158 Patent. This discovery was obtained in the pending Northern District of California patent infringement litigation between Uniloc and Apple (Case No. 3:18-cv-365)(the "NDCA case"). Uniloc believes the information obtained from this discovery bears on the invention date and calls into question whether the references relied on in the petition qualify as prior art.

As you are aware, 37 CFR 42.5(b)(1) requires that Apple as part of routine discovery "serve relevant information that is inconsistent with a position advanced." To assist Apple in satisfying its duties, Uniloc is prepared to join Apple in requesting that these third parties make such discovery available for this IPR proceeding under the PTAB's default protective order and sealing procedures. See attached default protective order.

As to documents already produced (and presumably in possession of litigation counsel), we believe Apple and Uniloc simply need permission from these third parties to also make them available in this IPR proceedings, *Apple Inc. v. Uniloc Luxembourg SA et al*, IPR No. 2018-00361. As there is a joinder petition, we also propose making the same available to joinder petitioner, LG. See *LG Electronics Inc. et al v. Uniloc Luxembourg SA*, IPR No. 2018-01503 (a joinder to the Apple petition). Counsel accessing such documents (e.g., Uniloc, Apple, and LG) would need to sign the PTAB's protective order undertaking.

We ask that you let us know no later than COB on Friday, October 19, as to whether we can join together in seeking this discovery.

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