
From: Sooter, Mindy <Mindy.Sooter@wilmerhale.com>
Sent: Wednesday, April 29, 2020 6:42 PM
To: Steven J. Pollinger; Selwyn, Mark; WH Apple Optis Service
Cc: ~Smith, Melissa; PanOptis_Apple2; PPM Apple (ppm_apple@grayreed.com); #Hilco/PanOptis v Apple [Int]; Sewall, Michaela P.
Subject: RE: PoA2 | 4/8/2020 M&C Items (proposals on reducing asserted claims and prior art)

Steve,

Regarding case narrowing, below are Apple's 20 references according to our agreement below.

'774: 5 total

1. Anticipation by Hottinen
2. Obviousness in view of Hottinen
3. Obviousness in view of Hottinen + Murakami
4. Obviousness in view of Murakami
5. Obviousness in view of IEEE 802.16-2004, IEEE C802.16e-04/552r7 (CL-MIMO Contribution), + IEEE 802.16e-04/103r2 (Uplink Channel Reuse Contribution)

'154: 2 total

1. Obviousness in view of C30-20060731-040R4 (3GPP2 Joint Proposal) + C30-20061204-060 (3GPP2 Nortel MIMO Operations Proposal)
2. Obviousness in view of IEEE 802.16-2004 and IEEE 802.16e-2005

557: 4 total

1. Obviousness in view of US 8,009,637 ("Harris")
2. Obviousness in view of Harris + US 2007/0165567 ("Tan")
3. Obviousness in view of US 2006/0018336 ("Sutivong") + Tan
4. Obviousness in view of Sutivong + Tan + R1-060046

332: 2 total

1. Obviousness in view of Ericsson + Knuth
2. Anticipation by Chung

284: 4 total

1. Obviousness in view of 3GPP TS 36.212 + 3GPP TS 36.321 + R1-02-0051
2. Obviousness in view of 3GPP TS 36.212 + 3GPP TS 36.321 + R1-02-0051 + 3GPP TS 25.214
3. Obviousness in view of 3GPP TS 36.212 + 3GPP TS 36.321 + R1-02-0051 + R1-074873
4. Obviousness in view of 3GPP TS 36.212 + 3GPP TS 36.321 + Kim + 3GPP TS 25.214

833: 3 total

1. Obviousness in view of R1-075037 + US2006/0262871 + R1-073269 + R1-073094
2. Obviousness in view of R1-075037 + R1-073926 + US2006/0262871 + R1-073094
3. Obviousness in view of R1-075037 + US8,467,367 + US8,374,161 + R1-073094

Also, regarding contentions, we accept your proposal that both sides' supplemental contentions are the operative contentions in this case.

For avoidance of doubt, this represents a global resolution regarding the contentions the parties have served, and plaintiffs will not dispute the manner in which we have counted our 20 references or their disclosure within the invalidity contentions.

From: Steven J. Pollinger <spollinger@McKoolSmith.com>

Sent: Wednesday, April 29, 2020 3:54 PM

To: Selwyn, Mark <Mark.Selwyn@wilmerhale.com>; WH Apple Optis Service <WHAppleOptisService@wilmerhale.com>

Cc: melissa@gillamsmithlaw.com; PanOptis_Apple2 <PanOptis_Apple2@McKoolSmith.com>; PPM Apple (ppm_apple@grayreed.com) <ppm_apple@grayreed.com>; #Hilco/PanOptis v Apple [Int]

<#Hilco/PanOptisvApple@irell.com>; Sewall, Michaela P. <Michaela.Sewall@wilmerhale.com>

Subject: RE: PoA2 | 4/8/2020 M&C Items (proposals on reducing asserted claims and prior art)

EXTERNAL SENDER

We await Apple's 20 "references" today as specified per the agreement below.

From: Steven J. Pollinger

Sent: Saturday, April 25, 2020 2:49 PM

To: Selwyn, Mark

Cc: WH Apple Optis Service; melissa@gillamsmithlaw.com; PanOptis_Apple2; PPM Apple (ppm_apple@grayreed.com); #Hilco/PanOptis v Apple [Int]; Sewall, Michaela P.

Subject: RE: PoA2 | 4/8/2020 M&C Items (proposals on reducing asserted claims and prior art)

Mark, yes, agreed. Here are Plaintiffs' 16 claims (no more than five per patent).

U.S. Patent No. 8,005,154 – Claims 33, 37 = 2
U.S. Patent No. 8,019,332 – Claims 1, 6, 7, 10 = 4
U.S. Patent No. 8,385,284 – Claims 1, 14, 27 = 3
U.S. Patent No. 8,411,557 – Claims 1, 5, 10 = 3
U.S. Patent No. 9,001,774 – Claims 6, 10 = 2
U.S. Patent No. 8,102,833 – Claims 1, 8 = 2

-Steve

From: Selwyn, Mark [<mailto:Mark.Selwyn@wilmerhale.com>]

Sent: Saturday, April 25, 2020 11:29 AM

To: Steven J. Pollinger

Cc: WH Apple Optis Service; melissa@gillamsmithlaw.com; PanOptis_Apple2; PPM Apple (ppm_apple@grayreed.com); #Hilco/PanOptis v Apple [Int]; Sewall, Michaela P.

Subject: RE: PoA2 | 4/8/2020 M&C Items (proposals on reducing asserted claims and prior art)

Steve:

I understand from our call last evening that plaintiffs agree with the Apple's interpretation of how a reference is counted under the Model Order as set forth in Michaela's 9:42am e-mail of Thursday.

If plaintiffs will agree to identify today their 16 claims (no more than five per patent), then Apple will identify by next Wednesday its 20 references (no more than six per patent).