

Richard G. A. Bone

From: Richard G. A. Bone
Sent: Wednesday, February 12, 2014 9:27 AM
To: jmicallef@sidley.com
Cc: Kushan, Jeffrey P.; 'Suh, Wonjoo'; 292_IPR_DLAteam@dlapiper.com; Heintz, James M.
Subject: RE: Microsoft Corporation v. SurfCast, Inc., IPR2013-00292, and IPR2014-00271
Attachments: Lagermann 20130820 (redacted).pdf; Lagermann 20130627 (redacted).pdf; LTOC-DiscoveryFeb12-2014-IPR2013-00292.pdf

Dear Mr. Micallef:

Please see attached letter and enclosures.

Richard Bone

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From: Suh, Wonjoo [<mailto:wsuh@sidley.com>]
Sent: Wednesday, February 05, 2014 10:50 AM
To: Richard G. A. Bone; Heintz, James M.; Patents; 292_IPR_DLAteam@dlapiper.com
Cc: Kushan, Jeffrey P.; MS_Surfcast
Subject: Microsoft Corporation v. SurfCast, Inc., IPR2013-00292, IPR2013-00293, IPR2013-00294, IPR2013-00295, and IPR2014-00271

Counsel:

Please see the attached correspondence from Joe Micallef.

Regards,
Wonjoo

WONJOO SUH
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BY E-MAIL ONLY (To: jmicallef@sidley.com)

February 12, 2014

Joseph A. Micallef, Esq.
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Re: *Microsoft Corporation v. SurfCast, Inc.*, IPR2013-00292; and
Microsoft Corporation v. SurfCast, Inc., IPR2014-00271;
Patent No.: 6,724,403
Your Ref.: *Please provide*
Our Refs.: 0792-00-012Y01; and 0792-00-012Y05

Dear Mr. Micallef:

I write in response to your letters of January 29 and February 5, 2014 regarding the above-captioned *inter partes* reviews ("the IPRs"). Taking your points in turn:

1. Thank you for explaining your position on the use of material from the Maine litigation, in the IPRs, on the phone on Monday. Nothing in the Maine protective order precludes Microsoft from using material that is not designated confidential. For items that your client may want to rely on that have been designated confidential in the Maine litigation, we will not object to Microsoft filing them under seal in the IPRs provided that such items are relevant to an issue that is properly the subject of the IPRs. Please identify any such item you wish to use along with the issue in the IPRs to which the item relates and we will respond promptly with either permission to use the item or our reasons for not granting permission so that you may take up the issue with the Board if you disagree.
2. Regarding Mr. Lagermann's deposition transcript from the Maine deposition, we will have to disagree. It is SurfCast's belief that nothing in the transcript contradicts the positions that have been advanced in the Patent Owner's Response. Accordingly, if you wish to raise this issue with the Board, you are free to do so. Accompanying this letter, we are serving you with a copy of the Lagermann deposition transcripts with the confidential portions redacted as would be required by 37 C.F.R. § 42.51(b)(1)(iii) if, in fact, Mr. Lagermann's testimony were contradictory to our position. These redacted portions do not include any of the pages that you have brought to our attention. Service of this document in no way indicates that we believe any of this information is inconsistent with positions taken in the IPR.



3. SurfCast agrees with the revised groupings of claims, as listed in item 3, points a – d, of your February 5, 2014 letter.
4. As you will appreciate we are working on finalizing dates for deposition. Regarding Mr. Weadock's deposition, in accordance with the Board's direction to reach a compromise on our disagreement over the length of the deposition, we propose making him available for 10.5 hours of cross-examination. Please let us know if you agree to this compromise. Regarding all the deponents' availability, this is what we have so far:
 - a. Richard Bone: February 19 – 20, 2014, Palo Alto, California (Offices of either my counsel, or DLA Piper LLP).
 - b. Ovid Santoro: February 26 – 27, 2014, Offices of DLA Piper LLP, Washington, D.C.
 - c. Klaus Lagermann: March 6 – 7, 2014, Offices of DLA Piper LLP, Washington, D.C. (*Confirmed*)
 - d. Tom Dechaene: March 11 – 12, 2014, Offices of DLA Piper LLP, Washington, D.C. (*Confirmed*)
 - e. Glenn Weadock: March 12 – 14, 2014, Denver or San Diego preferred.
5. Per 37 C.F.R. § 42.64(b)(2), Patent Owner has ten (10) business days to respond to your objections to SurfCast's Exhibits (Appendix to your letter of January 29, 2014). Our response to your objections is as follows:
 - a. At least the following objections to at least the following exhibits are not identified with sufficient particularity to allow correction in the form of supplemental evidence, as required by 37 C.F.R. § 42.64(b)(1):
 - i. the "lacking foundation" objections to exhibits 2004 – 2030, 2034 – 2038, 2044, 2048 – 2052, 2063, 2065, 2067, and 2068;
 - ii. the "mischaracterizing evidence" objections to exhibits 2004 – 2008, 2051, 2052, 2063 and 2065;
 - iii. the "misleading" objection to exhibit 2041;
 - iv. the "assuming facts not in evidence" objection to exhibits 2004, 2063, and 2065;
 - v. the "hearsay" objections to exhibits 2017, 2018, 2043, 2045 – 2047, 2051, and 2052;



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- vi. the “calling for a legal conclusion” objections to exhibits 2004 – 2008, 2063, and 2065; and
 - vii. the “lacking relevance” objections to exhibits 2004 – 2006, 2009 – 2052, 2054 – 2063, 2065, and 2067 – 2071.
- b. Your objections regarding “lack of authenticity and incompleteness, due to redaction” and/or failure to file an unredacted copy for the following exhibits has been cured by the unredacted (other than redactions for privilege) copies of the following exhibits served with Patent Owner’s Motion to Seal in IPR2013-00292 on February 10, 2014: exhibits: 2009 – 2012, 2015, 2016, 2018 – 2029; 2034 – 2038; 2049, 2050, 2067, and 2068.

Finally, as you are aware from the Maine litigation, a number of the individuals whose declarations appear in IPR2013-00292 have an ownership stake in SurfCast, Inc. We propose to file a notice of this fact, under seal and as supplemental information, in the IPR2013-00292. Please let us know if you will oppose.

Very truly yours,

/Richard G. A. Bone/

Richard G. A. Bone
Partner

Enclosures (redacted transcript of Lagermann deposition from the Maine case)

cc: James M. Heintz, Esq., (DLA Piper LLP)
Jeffrey Kushan, (Sidley Austin LLP)