

# EXHIBIT H

## Manning, Susan Baker

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**From:** Lu, Sam [SLu@irell.com]  
**Sent:** Tuesday, April 12, 2011 9:36 PM  
**To:** Manning, Susan Baker  
**Cc:** Somait, Lina  
**Subject:** RE: Skyhook v. Google (federal) -- protective order

Dear Susan,

Thank you for your response. Skyhook responds as follows:

1. I do not believe that we will be able to reach agreement on the patent prosecution bar.
2. We're amenable to the idea of filing simultaneous opening briefs and simultaneous opposition briefs. However, I would propose filing opening briefs early next week. Please let me know a convenient day for you to do so.
3. Because we are unable to reach agreement on the patent prosecution bar, Skyhook does not agree to the following language in the current draft of the protective order:

"Protected Material disclosed or produced in the State Action is deemed disclosed or produced in this action and is subject to this Stipulated Protective Order to the extent it differs from the Stipulated Protective Order in the State Action."

While that language was proposed by Skyhook, it was proposed before Google's addition of the patent prosecution bar. Google is now seeking a patent prosecution bar in the federal case to which Skyhook is unwilling to agree. In view of this fact, Skyhook is not amenable to undoing the parties agreement in the state case regarding the ability of its counsel to represent Skyhook in any and all proceedings based upon which documents its counsel may have viewed.

Regards,

Sam

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**From:** Manning, Susan Baker [mailto:susan.manning@bingham.com]  
**Sent:** Monday, April 11, 2011 6:10 PM  
**To:** Lu, Sam  
**Cc:** Somait, Lina; Goldberg, Robin S.; zzm google/skyhook (ext)  
**Subject:** RE: Skyhook v. Google (federal) -- protective order

Hi Sam --

Thanks for your further suggested edits. The language about sending non-confidential documents is fine, as are the provisions for disaster backup systems.

As to counsel's participation in reissue/reexam proceedings, Skyhook's latest proposal does not address Google's concerns about the possible misuse of confidential information to reshape the claims. The concern is very real, widely recognized, and we think that Google's compromise proposal appropriately balances Google's interest in guarding against the misuse (even inadvertently) of its confidential information, and Skyhook's desire to coordinate its response in any reissue or reexam proceedings. We do not think the court will be particularly moved by the choice of counsel point; all bars do, to a certain extent, deprive a party of their choice of counsel. The only

issue is whether the protective order strikes an appropriate balance between all of the competing interests. We think Google's proposal does that.

Because we did not propose specific language for Google's operationalizing proposal that counsel with access to confidential information may be involved in addressing prior art, but not in drafting new or amended claims, I attach a modified draft of the protective order, as well as a document showing our proposed language and Skyhook's. Please let me know whether Skyhook will reconsider its position after reviewing the specific proposed language.

I hope we can reach compromise. If not, I propose that the parties file simultaneous opening motions this week for entry of a protective order, to be followed by simultaneous oppositions. I suggest that we agree to forgo replies; since the issues are relatively narrow and already on the table, I don't think the court will need to hear from each side three times (or appreciate the additional paper). Please let us know.

best,  
Susan

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**From:** Lu, Sam [mailto:[SLu@irell.com](mailto:SLu@irell.com)]  
**Sent:** Friday, April 01, 2011 4:55 PM  
**To:** Manning, Susan Baker  
**Cc:** Somait, Lina; Lo, Audrey; Suggs, Christopher B.; Goldberg, Robin S.  
**Subject:** RE: Skyhook v. Google (federal) -- protective order

Dear Susan,

Attached are clean and redlined versions of Skyhook's edits to the protective order.

Skyhook has considered Google's proposal to limit counsel's participation in reexamination and reissue proceedings to addressing the scope of the prior art and its relevance to the claims as originally issued. However, this proposal still does not address the primary issue raised in our discussions: Skyhook's right to the counsel of its choosing to represent it in reexamination proceedings initiated by Google and related to the litigation. In an effort to reach compromise, and consistent with the case law cited to you, Skyhook proposes adding an exemption that would allow counsel to participate in reexamination proceedings initiated by or at the behest of a Party (as defined in the protective order) challenging a patent. This provision would ensure that, if Google were to expand the dispute between the parties to include a reexamination of a Skyhook patent, Skyhook would not be deprived of the counsel of its choosing.

In addition, please note that we have also included language relating to post-grant opposition proceedings, in the event that legislation is adopted in the future that would permit such proceedings.

We have also added language to the prosecution bar that would allow counsel to send non-confidential discovery or Court filings to an attorney involved in patent prosecution to ensure compliance with the duty of candor to the PTO.

Finally, we have added an exclusion for Protected Material that exists on any disaster recovery backup

system from the requirement of being returned or destroyed within 60 days of final disposition. The negligible risk of disclosure of Protected Material on disaster recovery backup systems (which I am confident both law firms hope will never be utilized) does not justify the high cost of searching all disaster recovery backup systems for Protected Material.

We hope these additions are agreeable to Google. Please let us know Google's position at your earliest convenience.

Regards,

Sam

**From:** Manning, Susan Baker [mailto:susan.manning@bingham.com]  
**Sent:** Monday, March 28, 2011 10:10 AM  
**To:** Lu, Sam  
**Cc:** Somait, Lina; Lo, Audrey; Suggs, Christopher B.; Goldberg, Robin S.  
**Subject:** Skyhook v. Google (federal) -- protective order

Dear Sam --

I write to follow up on the only outstanding issue on the PO: whether the prosecution bar will prohibit those attorneys with access to the other side's confidential information from being substantively involved in reissue or reexamination proceedings. Google believes that the case law (and common sense) on balance supports extending the bar to reexamination and reissue proceedings. When you and I last spoke, neither party had a compromise position to propose. In thinking about the issue since then, Google's chief concern is that counsel with access to its confidential information not be able to use that information (even inadvertently) to reshape the claims of the patents. Were the patents to be part of reexamination or reissue proceedings, we think the risk of misuse of Google's confidential information is less grave if counsel's activities are limited to addressing the scope of the prior art and its relevance to the claims as originally issued.

If Skyhook is open to such an approach, please give me a call to discuss. Either way, please advise as to Skyhook's position in the next few days. We'd like to get this wrapped up. I hope we're able to come to agreement, but if we're not, let's discuss an approach for presenting the issue to the court for resolution.

thanks,  
Susan

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