EXHIBIT D

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June 25, 2014

VIA E-MAIL

Ms. Andrea Pallios Roberts, Esq.
Quinn Emanuel Urquhart & Sullivan, LLP
555 Twin Dolphin Drive
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Redwood Shores, CA 94065

Re: *Rockstar Consortium US LP, et al. v. Google, Inc.*,
Case No. 2:13-cv-893 (E.D. Tex.)

Dear Andrea:

I write in response to your letter of June 23, 2014 regarding our June 19, 2014 meet and confer.

First, this confirms that Plaintiffs Rockstar Consortium US LP and Netstar Technologies LLC would be amenable to jointly moving the Court to issue an Order limiting claim terms and prior art references along the lines disclosed in the Model Order referenced by General Order 13-20:

> By the date set for completion of claim construction discovery pursuant to P.R. 4-4, the patent claimant shall serve a Preliminary Election of Asserted Claims, which shall assert no more than ten claims from each patent and not more than a total of 32 claims. Not later than 14 days after service of the Preliminary Election of Asserted Claims, the patent defendant shall serve a Preliminary Election of Asserted Prior Art, which shall assert no more than twelve prior art references against each patent and not more than a total of 40 references.

> No later than 28 days before the service of expert reports by the party with the burden of proof on an issue, the patent claimant shall serve a Final Election of Asserted Claims, which shall identify no more than five asserted claims per patent from among the ten previously identified claims and no more than a total of 16 claims. By the date set for the service of expert reports by the party with the burden of proof on an issue, the patent defendant shall serve a Final Election of Asserted Prior Art, which shall identify no more than six asserted prior art references per patent from among the twelve prior art references previously identified for that particular patent and no more than a total of 20 references. For purposes of this Final Election of Asserted Prior Art, each obviousness combination counts as a separate prior art reference.

According to the Court's May 13, 2014 Scheduling Order, the relevant dates would be (1) September 2, 2014 for Plaintiffs' identification of 32 claims, (2) September 16, 2014 for Google's selection of 40 references, (3) December 22, 2014 for Plaintiffs' identification of 16 claims, and (4) January 19, 2015 for Google's selection of 20 references total. Please confirm.

We disagree, however, that entry of the Order reducing claims and prior art references "provides a solution to at least one of Rockstar's complaints regarding Google's invalidity contentions," as you suggest in your letter. Regardless of the number of claims asserted, Google improperly wishes to rely on an impermissibly high number of obviousness combinations. Contrary to your statement, the number of possible obviousness combinations is <u>not</u> a function of the number of the claims asserted. The numbers prove this.

Each table in Google's Exhibit B includes an introductory statement that "one of ordinary skill in the art would be motivated to combine the references addressed in claim charts A-1 to A-39 with any one *or more* of the Table [] references listed below…" Table B1 contains over two dozen references. If Plaintiffs asserted only the claims from the '969 Patent and Google likewise asserted only the various combinations of references in Table B1, Plaintiffs would still be forced to prosecute their case in the face of millions of prior art combinations. Google cannot simply establish a massive pool of prior art references and then extract any number of combinations at any time. This is insufficient notice of Google's invalidity theories, and entry of the Model Order does nothing to resolve this.

In *Realtime Data, LLC v. Packeteer, Inc*., 2009 WL 4782062, at *3 (E.D. Tex. Dec. 8, 2009), the court precluded reliance on two prior art references because they were not charted on a claim-by-claim and element-by-element basis. The

defendant argued that disclosing the references in an appendix sufficed. *Id*. The court disagreed and found that "this type of disclosure cannot serve as sufficient notice because [the defendant] disclosed over 500 prior art references in Appendix J, resulting in an impermissibly high number of combinations to reasonably serve the notice function contemplated by the Patent Rules." Here, as in *Realtime*, Google seeks to rely on an impermissibly high number of combinations, and winnowing the number of asserted claims does not resolve that.

Google's reliance on *KSR* is misplaced. *KSR* did not reduce a defendant's obligation under the patent rules to provide sufficient notice of its invalidity theories. Further, *KSR* does not relieve a party from sufficiently describing motivations to combine. *See, e.g., Alexsam, Inc. v. IDT Corp*., 715 F.3d 1336, 1347 (Fed. Cir. 2013) (requiring evidence of motivation to combine even if prior art references disclose claimed elements). Here, Google's introduction to each table in Exhibit B simply states that a person of ordinary skill would have been motivated to combine the reference in Exhibit A with any one or more of the Exhibit B references. This boilerplate language likewise fails to provide sufficient notice of Google's invalidity theories.

Rockstar echoes the proposal made during our conference. That is, Rockstar proposes that Google identify 50 references by September 16, 2014, wherein each obviousness combination counts as a separate prior art reference, and describe with additional clarity the relevant motivations to combine.

With respect to Google's deficient NetGravity and DoubleClick charts, we explained that Google should have provided significantly more detail in its charts for those two references because Google acquired and presumably possesses, controls, or has custody of the relevant underlying technical documentation. Google did not deny it had the underlying documents. To the contrary, Google confirmed it would be producing additional documents this week, but stopped short of saying it would produce all the documents related to NetGravity and DoubleClick.

Your letter states that "Rockstar took the position that Google was required to have already produced every single document on which it will rely at trial in relation to a particular reference." That is not Rockstar's position. Rockstar's position is that Google should not be allowed to trickle out discovery and documents for systems it owns and intends to assert as prior art, especially when there is no dispute that it has possession, custody, and control of the relevant underlying technical documents.

The defendant in *IXYS Corp. v. Advanced Power Technology, Inc*., 2004 WL 1368860, at *3 (N.D. Cal. June 16, 2004), approached its obligations in a fashion

similar to Google's present approach, *i.e.*, by not producing relevant underlying technical materials that described its own system asserted as prior art. The court rejected that approach:

> APT's reading of the Patent Local Rules is untenable at best and insultingly tendentious at worst. The Local Rules exist to further the goal of full, timely discovery and provide all parties with adequate notice and information with which to litigate their cases, not to create supposed loopholes through which parties may practice litigation by ambush. Rule 3-4(b) quite obviously requires APT to produce more than the "identity" of the prior art upon which it seeks to rely-if APT believes that a mask layer photograph or drawing is relevant to this action, then Rule 3-4(b) requires APT to serve upon IXYS a copy of that same document.

Id.

In addition to producing the underlying documents, Google should have provided further detail in its DoubleClick and NetGravity charts. You state that "Rockstar has not cited a single example of something that it does not understand based on the purported lack of specificity in Google's charts." The burden is not on Rockstar to cite examples of something it does not understand. Rather, Google must sufficiently describe how the prior art systems purportedly meet every limitation of every claim. Part and parcel of this is describing how the alleged prior art systems work. Google's charts do not do that sufficiently, and there is no excuse for this when every relevant document is in Google's possession, custody, and control.

You reference the two Merriman patents cited in the DoubleClick chart. Is Google limiting the functionality of DoubleClick to that disclosed in the two patents (and the handful of magazine and newspaper articles) cited in the chart? Does Google intend to supplement its DoubleClick chart with the documents it possesses and will produce? If so, when?

You also provided bates numbers for the two NetGravity "user guides" you produced. Thank you. Is Google limiting the functionality of NetGravity to that disclosed in the "user guides" and the other superficial references cited in NetGravity chart? Does Google intend to supplement its NetGravity chart with the documents it possesses and will produce? If so, when?

Rockstar proposes that Google provide supplemental DoubleClick and NetGravity charts with citations to the relevant underlying technical documents by July 2, 2014.

Finally, Rockstar's infringement contentions specifically identify each accused instrumentality and provide a chart identifying specifically where each element of each asserted claim is found within each accused instrumentality. You requested supplementation and say that Google has produced over 180,000 pages of technical documentation. Is this the extent of Google's production? How many more pages of technical documentation can Rockstar expect? You also pose several questions related to meaning and interpretation of the claim terms, but those questions are more appropriately resolved during the claim construction process, which is just starting.

Please confirm whether Google will (1) accept Rockstar's proposal regarding references and combinations and (2) provide supplemental invalidity charts for DoubleClick and NetGravity by July 2, 2014.

We remain happy to discuss these issues.

Sincerely,

John P. Lahad