## Mead, Lowell

**From:** Rachuba, L Roman <lrachuba@sughrue.com>
**Sent:** Tuesday, August 8, 2023 9:33 AM
**To:** Whitt, Samuel K; Mead, Lowell; Keefe, Heidi; Chen, Reuben
**Cc:** z/Box-Topia; _Topia
**Subject:** RE: Box/Dropbox v. Topia - IPR2023-00427, IPR2023-00429, IPR2023-00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433 - Use of Confidential Documents

**[External]**

Hi Sam,

Topia intends to rely on the documents to show that Ms. Keefe has waived Egnyte's joint defense privilege by describing conversations she had with Egnyte's other outside counsel regarding the scope of her representation and Egnyte's invalidity strategies.

In view of the above, please let us know Petitioners' position by the end of the week.

Thank you,

Roman

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**From:** Whitt, Samuel K <swhitt@cooley.com>
**Sent:** Wednesday, August 2, 2023 1:14 PM
**To:** Rachuba, L Roman <lrachuba@sughrue.com>; Mead, Lowell <lmead@cooley.com>; Keefe, Heidi <hkeefe@cooley.com>; Chen, Reuben <rchen@cooley.com>
**Cc:** z/Box-Topia <zBoxTopia@cooley.com>; _Topia <Topia@sughrue.com>
**Subject:** RE: Box/Dropbox v. Topia - IPR2023-00427, IPR2023-00429, IPR2023-00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433 - Use of Confidential Documents

Roman,

Thank you for your message. So that we can better understand Topia's request, can you please explain specifically for what purpose or purposes Topia would be seeking to use these protected materials in the Egnyte district court litigation?

Best,

Sam Whitt
Cooley LLP
(202) 776-2316 (office)
(858) 204-4817 (cell)

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**From:** Rachuba, L Roman <lrachuba@sughrue.com>
**Sent:** Thursday, July 27, 2023 6:20 PM
**To:** Whitt, Samuel K <swhitt@cooley.com>; Mead, Lowell <lmead@cooley.com>; Keefe, Heidi <hkeefe@cooley.com>;

Chen, Reuben <rchen@cooley.com>
**Cc:** z/Box-Topia <zBoxTopia@cooley.com>; _Topia <Topia@sughrue.com>
**Subject:** Box/Dropbox v. Topia - IPR2023-00427, IPR2023-00429, IPR2023-00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433 - Use of Confidential Documents

**[External]**

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Counsel,

Patent Owner seeks permission to use Ex.1029 (Declaration of Heidi Keefe) and Ex. 2018 (Transcript of Heidi Keefe Deposition) in the related Egnyte district court case (*Topia Technology, Inc. v. Egnyte, Inc*., C.A. No. 21-1821-CJB). Since the information is confidential with respect to Petitioners, please let us know if Petitioners authorize Patent Owner to use the documents in the Delaware Court.

Alternatively, Patent Owners seek to modify the proposed protective order in these proceedings to allow use of Ex. 1029 and Ex. 2018 in the Delaware Court.

Good cause exists for the modification because Patent Owner was unaware that Petitioners would seek to use testimony from Ms. Keefe in these IPRs at the time of agreeing to the current proposed protective order. Additionally, modifying the proposed protective order will avoid unnecessary expense and duplicative discovery efforts in the related district court action, by, *e.g.*, avoiding the necessity of subpoenaing Ms. Keefe.

Petitioners would not be prejudiced from the proposed modification because the documents would be subject to a corresponding protective order in the related district court case, and the documents would be protected from public disclosure.

Courts routinely permit the modification of protective orders to allow documents and information to be used in related actions to avoid unnecessary expense and duplication of resources, especially where here, neither party would be prejudiced. *TradeWinds Airlines, Inc. v. Soros*, 2016 U.S. Dist. LEXIS 94735, *6 (S.D.N.Y. 2016) ("There is a compelling need for modification here to avoid considerable unnecessary effort and expense. Plaintiffs' claims in the North Carolina action are closely related to the claims brought before this Court. Without modification of the Protective Order, the same discovery materials will likely have to be reviewed and re-produced, needlessly causing duplication of effort and extra expense. And importantly, because the proposed modifications maintain the same protections regarding public disclosure, there is no significant prejudice to any party."); *Ocean Semiconductor LLC v. NXP USA, Inc*., 2023 U.S. Dist. LEXIS 74080, *13 (W.D.TX. 2023) ("[t]he balance of the efficiency related to duplicative discovery and the lack of prejudice to Analog weigh in favor of modification of the protective order."); *Stack v. Gamill*, 796 F.2d 65, 68 (5th Cir. 1986) ("protective orders should generally be modified to allow discovery in other actions"); *United Nuclear Corp. v. Cranford Ins. Co*., 905 F.2d 1424, 1428 (10th Cir. 1990); *Wilk v. American Medical Ass'n*, 635 F.2d 1295, 1299 (7th Cir. 1980); *Oracle Corp. v. SAP AG*, 2010 U.S. Dist. LEXIS 20811, *9 (N.D. CA. 2010); *Foltz v. State Farm Mut. Automobile Ins. Co.,* 331 F.3d 1122, 1131 (9th Cir. 2003); *Charter Oak Fire Ins. Co. v. Electrolux Home Prods*., 287 F.R.D. 130, 134 (E.D.N.Y. 2012); *Jochims v. Isuzu Motors*, 148 F.R.D. 624, 632 (S.D.Iowa 1993).

Please let us know if Petitioners agree to either: (1) allow Patent Owner to use the documents in the Delaware Court or (2) modify the proposed protective order as discussed above.

Sincerely,

*L. Roman Rachuba II*

Sughrue Mion, PLLC
Washington, DC | Tokyo

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*L Roman Rachuba*

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