

Kristyn Waldhauser

From: Joseph Colaianne
Sent: Thursday, June 29, 2023 4:30 PM
To: Rabena, John F.; Mandir, William H.
Cc: Linhong Zhang; Jonathan Bright
Subject: RE: Element Capital v. BOE et al.

Hi John,

Defendants are OK with Element's clarification to condition 2. With that, I believe we are in agreement so Element may file its motion on these terms.

Regards,
Joe

From: Joseph Colaianne
Sent: Monday, June 26, 2023 3:48 PM
To: 'Rabena, John F.' <jrabena@sughrue.com>; Mandir, William H. <wmandir@sughrue.com>
Cc: Linhong Zhang <LWZhang@fr.com>; Jonathan Bright <jbright@fr.com>
Subject: RE: Element Capital v. BOE et al.

Thanks John. I think this should work, but let us confirm with our clients and we will revert shortly.

Regards,
Joe

From: Rabena, John F. <jrabena@sughrue.com>
Sent: Monday, June 26, 2023 11:47 AM
To: Joseph Colaianne <colaianne@fr.com>; Mandir, William H. <wmandir@sughrue.com>
Cc: Linhong Zhang <LWZhang@fr.com>; Jonathan Bright <jbright@fr.com>
Subject: RE: Element Capital v. BOE et al.

Hi Joe,

Element is ok with your conditions below with one clarification to condition 2. Element will not add any additional claims or patents in this litigation, but is not giving the defendants a covenant not to sue in other litigations. If you are ok with this clarification, let me know.

Thanks
John

From: Joseph Colaianne <colaianne@fr.com>
Sent: Monday, June 26, 2023 9:01 AM
To: Rabena, John F. <jrabena@sughrue.com>; Mandir, William H. <wmandir@sughrue.com>

Cc: Linhong Zhang <LWZhang@fr.com>; Jonathan Bright <jbright@fr.com>

Subject: RE: Element Capital v. BOE et al.

Hi John and Bill – just wanted to check back on this; any word? Thanks.

From: Joseph Colaianni

Sent: Wednesday, June 21, 2023 4:51 PM

To: 'Rabena, John F.' <jrabena@sughrue.com>; 'Mandir, William H.' <wmandir@sughrue.com>

Cc: Linhong Zhang <LWZhang@fr.com>; Jonathan Bright <jbright@fr.com>

Subject: RE: Element Capital v. BOE et al.

Hi John and Bill,

Thanks for agreeing to our proposed conditions. After speaking with our client, we wanted to raise a few additional points that I believe should not be controversial. To memorialize the parties' understanding, can you confirm your agreement to the following:

In exchange for Defendants not opposing Element's motion for leave to amend its infringement contentions, Element agrees:

1. Not to argue discretionary denial of a subsequent IPR petition filed against the newly asserted claims.
2. Not to assert any additional claims or patents in the litigation. In the spirit of cooperation, BOE notes that it expects to produce additional technical documents describing the accused products in the near future. These documents are not GDS files in nature and, in our view, less informative.
3. To update the proposed contentions to clarify that, of the newly charted claims, only dependent claims 23 and 35 are asserted, consistent with Element's June 12 representation. The infringement contentions previously provided assert that defendants also allege that defendants infringe independent claims 18 and 33.
4. That Defendants may serve supplemental invalidity contentions responding to the newly asserted claims by eight weeks after the court grants the motion.
5. That Element's motion for leave to amend states the foregoing conditions as part of the statement of non-opposition.

Please let us know if this is acceptable, or if you would like to discuss.

Regards,
Joe

From: Joseph Colaianni

Sent: Tuesday, June 20, 2023 5:29 PM

To: 'Rabena, John F.' <jrabena@sughrue.com>; Mandir, William H. <wmandir@sughrue.com>

Subject: RE: Element Capital v. BOE et al.

Thanks John and Bill. Let me confirm with the client and I'll revert shortly (hopefully tomorrow).

From: Rabena, John F. <jrabena@sughrue.com>

Sent: Tuesday, June 20, 2023 1:17 PM

To: Mandir, William H. <wmandir@sughrue.com>; Joseph Colaianne <colaianne@fr.com>

Subject: RE: Element Capital v. BOE et al.

[This email originated outside of F&R.]

Hi Joe, Bill is right. Element agrees to your conditions if you do not oppose the motion.

From: Mandir, William H. <wmandir@sughrue.com>

Sent: Tuesday, June 20, 2023 4:39 PM

To: 'Joseph Colaianne' <colaianne@fr.com>

Cc: Rabena, John F. <[jraben@sughrue.com](mailto:jrabena@sughrue.com)>

Subject: RE: Element Capital v. BOE et al.

Hi Joe,

I am looping-in John Rabena as he contacted the client about this matter, and I understand we are all set, but I will let John respond.

Thanks, Bill

From: Joseph Colaianne <colaianne@fr.com>

Sent: Tuesday, June 20, 2023 10:47 AM

To: Mandir, William H. <wmandir@sughrue.com>

Subject: Element Capital v. BOE et al.

Hi Bill – I just wanted to follow up on our conversation of Friday and see if you were able to confirm whether (1) Element would agree not to argue discretionary denial of a subsequent IPR petition filed against the newly asserted claims in exchange for BOE not opposing the motion for leave, and (2) whether Element intends to assert any additional claims in the litigation.

Thanks,

Joe

Joseph Colaianne :: Principal :: Fish & Richardson P.C.

+1-202-626-6434 direct :: colaianne@fr.com

fr.com :: [Bio](#) :: [LinkedIn](#)

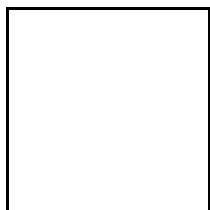
This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

John F. Rabena

Managing Partner

Sughrue Mion, PLLC | 2000 Pennsylvania Ave., N. W. Washington, DC 20006 | Office: 202-663-7472 | Fax: 202-293-7860

jrabena@sughrue.com - www.sughrue.com



Warning: In rare cases, our e-mail filtering software may eliminate legitimate email from clients unnoticed. Therefore, if your mail contains important instructions, please make sure that we acknowledge receipt of those instructions.

This message is intended only for the designated recipient(s). It may contain confidential or proprietary information and may be subject to the attorney-client privilege or other confidentiality protections. If you are not a designated recipient, you may not review, copy or distribute this message. If you receive this in error, please notify the sender by reply e-mail to coordinate retrieval or deletion of this message. Thank you.

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

