

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner,
v.
AT&T INTELLECTUAL PROPERTY I, L.P. and
AT&T INTELLECTUAL PROPERTY II, L.P.,
Patent Owners.¹

Case IPR2015-01227 (Patent 7,907,714 B2)²
Case IPR2015-01187 (Patent 6,993,353 B2)
Case IPR2015-01273 (Patent 6,487,200 B1)
Case IPR2015-01536 (Patent 8,855,147 B2)

Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

ORDER
Patent Owner's Request for Authorization to File Motion
for Additional Discovery
37 C.F.R. §§ 42.5, 42.51(b)(2)

¹ AT&T Intellectual Property I, L.P., is the Patent Owner in Case IPR2015-01227, whereas AT&T Intellectual Property II, L.P. is the Patent Owner in Cases IPR2015-01187, IPR2015-01273, and IPR2015-01536.

² This Order addresses similar issues in all the referenced cases, therefore, we issue a single Order to be filed in each case. The parties are not authorized to use this style of caption in any other filings, except as authorized below.

IPR2015-01187 (Patent 6,993,353 B2)
IPR2015-01227 (Patent 7,907,714 B2)
IPR2015-01273 (Patent 6,487,200 B1)
IPR2015-01536 (Patent 8,855,147 B2)

On January 5, 2016, a conference call was held with counsel for all parties and Judges Zecher, Murphy, and McShane to discuss AT&T's request for authorization to file a motion seeking additional discovery of evidence that is alleged to be related to the identification of the real parties in interest in these proceedings.

Patent Owners represented that the requests for additional discovery would be directed to evidence related to the potential involvement and interests of CoxCom, LLC, as well as three purported third-party indemnitors of Petitioner, each of which AT&T alleges are unnamed real parties in interest in these proceedings. In response, Petitioner contended that the discovery requests are not directed to the discovery of directly relevant information and they are overly broad.

Patent Owners arranged for a court reporter to be on the call and agreed to file the transcript as an exhibit in each proceeding. The parties, however, noted that, because some of the information discussed on the call was potentially confidential in nature, sealing and redaction of portions of the transcript may be sought.

We are persuaded that further briefing would assist us in deciding whether to provide Patent Owners with additional discovery in this case. We take this opportunity to remind Patent Owners that a party seeking additional discovery in an *inter partes* review proceeding must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i). We generally consider various factors in determining whether additional discovery in a proceeding is “necessary in the interest of justice.” These factors are discussed in more

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detail in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, slip op. at 6–7 (PTAB, Mar. 5, 2013) (Paper 26) (informative).

Accordingly, we authorize Patent Owners to file a motion for additional discovery. The motion may not exceed twelve pages and should include, as an exhibit, proposed discovery requests. Petitioner is authorized to file an opposition to the motion, also not to exceed twelve pages. If Petitioner objects to the scope of Patent Owners' proposed discovery requests, the opposition should also include, as an exhibit, Petitioner's alternative proposed discovery requests, preferably in red-line version. Patent Owners are not authorized to file a reply.

To the extent the transcript of the call, the motion, or the opposition includes information is believed to be confidential in nature, the parties should file both redacted and unredacted versions, along with a motion to seal and protective order. No prior authorization to file a motion to seal is required, however, it must be accompanied by a protective order.³ The motion to seal must explain the basis for every redaction made, with any opposition explaining why it believes the material should not be sealed.

Accordingly, it is:

ORDERED that Patent Owners' request for authorization to file a motion for additional discovery is *granted* and Patent Owners are authorized

³ Based on the parties' discussion during the conference call regarding a protective order, we understood the parties to agree to file a joint motion for entry of the default protective order set forth in the *Office Patent Trial Practice Guide*.

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to file a twelve page motion, with an exhibit including proposed discovery requests, by January 12, 2016;

FURTHER ORDERED that Petitioner is authorized to file a twelve page opposition, with an exhibit including any alternative proposed discovery requests, by January 20, 2016; and

FURTHER ORDERED that the parties are permitted to use the style of the caption of this Order if filing common motions and oppositions, limited to those permitted under this Order only, and to include a footnote attesting that identical papers are filed in the respective cases.

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