REDACTED

Paper No._____

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

Case IPR2015-01187 (Patent 6,993,353 B2) [1]
Case IPR2015-01227 (Patent 7,907,714 B2)
Case IPR2015-01273 (Patent 6,487,200 B1)
Case IPR2015-01536 (Patent 8,855,147 B2)

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

[1] The Board authorized the use of this caption style in its January 7, 2016 Order.

Identical papers are filed in each respective case.

Pursuant to 37 C.F.R. §§ 42.51(b)(2) and the Board's Order of January 7, 2016 (Paper 15), Patent Owners AT&T Intellectual Property I and II, L.P. ("AT&T") request that the Board authorize certain narrowly targeted discovery.

I. Factual Background

A. Indemnitors with Rights of Control

AT&T's action against CCI, CoxCom LLC and related Cox entities (the "Delaware Litigation") alleges infringement of the '353, '714, '200, and '147 Patents. In the Delaware Litigation, AT&T's allegations involve Arris and Cisco products purchased and distributed by Cox[2], as well as software believed to be sourced by Cox from Broadsoft.

Threshold information evidences existence of Arris, Cisco and Broadsoft indemnification obligations to Cox for claims of patent infringement and suggests that those indemnification obligations provide for vendor control of the defense and settlement of such claims. [redacted], strongly suggesting that those vendors have an oppor-

[2] The general term "Cox" is used where the specific entity is unknown. "Arris" products include products of Motorola Home Division, acquired by Arris in 2013.

tunity to control Cox's defense, which includes these proceedings.

Discovery of Arris, Cisco and Broadsoft indemnification agreement particulars and related communications is necessary, in the interest of justice, to confirm each vendor's opportunity to control these proceedings. Such control would call into question CCI's certification that it is the sole real party-in-interest.

B. CCI Related Entities

AT&T filed a complaint for patent infringement against CCI and other Cox entities (CoxCom, LLC and 31 Regional Cox Entities). AT&T briefed the issue of CoxCom, LLC's apparent control. POPR[3] at 14-23. While the Board found Cox's practice of taking inconsistent real party-in-interest positions "troubling," it did not, on the then-present record, find that CCI had failed to name all real parties-in-interest. Institution Decision at 12-13. AT&T seeks, in the interest of justice, additional discovery to supplement that record with evidence of CoxCom, LLC's control over the instant *inter partes* reviews.

II. Reasons for the Relief Requested

AT&T seeks very specific discovery. The discovery targets indemnification agreements and related communications between Cox and respective vendor-indemnitors, Arris, Cisco, and Broadsoft, each of which is believed to have the opportunity to control these *inter partes* reviews. The discovery also targets documents showing that CoxCom, LLC, a subsidiary of the named petitioner, controls

[3] Citations are to the record in IPR2015-01273.

the instant *inter partes* reviews. In each case, AT&T expects that the requested discovery will make a compelling showing that unnamed real-parties-in-interest "exercised or could have exercised control over" CCI's actions in the instant *inter partes* reviews and demonstrate that the Petitions should be dismissed for failing to name all real parties-in-interest. AT&T's discovery requests are therefore "necessary in the interest of justice." Further, the requests meet each of the *Garmin* factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013), as explained below.

A. More than a Mere Allegation or Possibility

There is far more than a possibility or mere allegation that useful information will be discovered; rather, AT&T herein shows "possession of evidence tending to show beyond speculation that in fact something useful will be uncovered." *Garmin*. All requested discovery meets the first *Garmin* factor.

Arris has publicly acknowledged, in financial disclosures filed with the Securities and Exchange Commission ("SEC") (*see* Ex. 2027 at 60), that Cox requested indemnification from Arris for claims arising from the Delaware Litigation. Indemnity provisions of Arris' standard Corporate Terms and Conditions of Sale reveal that Arris will defend patent infringement claims against its customers, if Arris is given sole control over the defense and settlement of such claims. Ex. 2028. It is well-understood that *inter partes* review is a standard tactic in defending

a claim of patent infringement. Ex. 2030 at 94; Ex. 2029 at 48. Most clearly indicative of control, however, is the fact that [redacted]. *See* Ex. 2026 at 24:2-7. [redacted]

AT&T also seeks indemnity-related communications between Arris and Cox. Arris' standard indemnity terms indicate that a customer must "promptly notif[y] ARRIS of the Claim." Ex. 2028. [redacted], and for Arris to acknowledge the indemnification request in SEC filings, Cox must have communicated with Arris regarding the claim, indemnity, and [redacted].

Cisco's standard Terms of Sale indicate that Cisco will defend patent infringement claims against its customers, provided that Cisco is granted full and exclusive control of the defense and settlement of such a claim. Ex. 2032. *Inter partes* review is often an integral part of such a defense. *See* Ex. 2030 at 94. Cox is a customer of Cisco, and Cox has previously requested indemnification from Cisco

based on claims involving similar technologies, prompting Cisco to file a declaratory judgment action. *See* Ex. 2033. The fact that [redacted] is highly probative: (i) that a request was made or notice given relative to the AT&T claims; and (ii) of a vendor-indemnitor opportunity to control the defense. *See* Ex. 2026 at 24:2-7. [redacted]

AT&T also seeks indemnity-related communications between Cisco and Cox. Like Arris, Cisco requires that its customers "notify Cisco in writing of the Claim." Ex. 2032. [redacted], Cox must have communicated with Cisco regarding the AT&T claim, indemnity, and [redacted].

Cox publicly acknowledges that Broadsoft supplies it with software and components of its telephony service. Ex. 2034. Cox's Phone Tools software was alleged to infringe the '714 Patent in AT&T's infringement contentions. Ex. 2035. Publicly-referenced terms of Broadsoft license agreements obligate Broadsoft to "defend at its expense any and all claims…brought against [a] Customer based on an allegation that [its] Software or its usage, infringes a patent." Ex. 2036. [redacted] Ex. 2026 at 24:2-7. [redacted]

[redacted] AT&T also seeks indemnity-related communications; [redacted], Cox must have communicated with Broadsoft regarding the claim, indemnity, and [redacted].

Thus, AT&T is in possession of threshold evidence tending to show beyond speculation that indemnification agreements and related communications exist between Cox and each of Arris, Cisco, and Broadsoft. Counsel for Petitioner tacitly acknowledged the existence of the agreements sought. Ex. 2026 at 12:6-9. This evidence also provides specific factual reasons for expecting that discovery of such agreements will be useful to confirm vendor-indemnitor opportunity to control a defense that includes the instant *inter partes* reviews and, ultimately, that the vendors are real parties-in-interest.

For the above-described indemnification agreements and indemnity-related communications, AT&T seeks production whether the indemnitee is styled as Petitioner CCI, as CoxCom, LLC or as an entity that CCI or CoxCom, LLC purports to control. CoxCom, LLC and the Regional Cox Entities are the likely purchasers of goods from the vendor-indemnitors, so those entities are likely parties to an indemnification agreement that benefits CCI. CCI admits that it only provides "general corporate, accounting, and management services," and "does not engage in, directly or indirectly, the provision of telephony services or technology." Ex. 2012

at 3. Rather, CoxCom, LLC "supplies certain of the Cox Entities with the technology used by those entities in providing telephony products and services" and thus may be the relevant party to any indemnification agreements. *See Id.* Further, a CCI VP testified that "local markets must purchase and pay for their own equipment, relying on a consultative role provided by CCI." Ex. 2037 at 8. Thus, relevant indemnification agreements and communications likely name and, indeed, may be in the possession of the regional entities or CoxCom, LLC, rather than CCI. The requested discovery is not a "fishing expedition," but rather a necessary consequence of Cox's operating structure.

The Board invited Petitioner to, in its Opposition, suggest tailoring of discovery requests such that it could agree to production. If CCI can stipulate that the requested indemnification agreements and communications are between the vendors-indemnitors and CCI only, then Petitioner may wish to suggest tailoring.

Finally, as briefed in the POPR, AT&T established facts that CoxCom, LLC appears to have a measure of control over the instant proceedings. POPR at 14-23. As one example, CoxCom, LLC is named as petitioner or real party-in-interest in ***every*** other pending *inter partes* review in which a Cox entity is involved, yet not named or acknowledged in any way in the instant *inter partes* reviews. Ex. 2020. The Board found Cox's practice "troubling." Indeed, as one pertinent example, IPR2015-01796 concerns a cable modem patent (U.S. Patent No. 5,563,883), as do

the '353 and '147 Patents. In the corresponding litigation, only CCI was alleged to infringe the '883 patent, but in that *inter partes* review, **both** CCI and CoxCom, LLC entities were listed as real parties-in-interest. Ex. 2018 at 2, Ex. 2019 at 1, 4.

Either the identification of CCI alone in the instant *inter partes* reviews is incorrect, or the identification of both CCI and CoxCom, LLC in other proceedings is incorrect, but both cannot be correct: Cox's positions are "irreconcilably inconsistent." *See* Ex. 2010 at 3.

Further, a draft stipulation (Ex. 2007) circulated by counsel indicated that CoxCom, LLC ***directs*** the action of other defendants in the Delaware Litigation, including Petitioner CCI. Given that the same counsel represents CoxCom, LLC and CCI, and given that CoxCom, LLC's role is acknowledged, specific factual reasons beyond speculation exist to grant additional discovery into the represented parties and the entities invoiced and responsible for payment of costs for the instant *inter partes* reviews. *See Corning Optical Commn'cs v. PPC Broadband*, Case IPR2014-00440, Paper 68 at 17, 20-21 (Aug. 18, 2015) (engagement letter and documents showing funding of IPR useful for RPI determination). Moreover, specific factual reasons beyond speculation exist to grant additional discovery into the management structure and employment agreements of relevant CoxCom, LLC personnel, to determine whether there is any overlap between Petitioner and CoxCom, LLC, such that CCI has "blurred sufficiently the lines of corporate separation with"

CoxCom, LLC. *Zoll Lifecor Corp. v. Philips Elec. N. Am. Corp.*, Case IPR2013-00606, slip op. at 10 (PTAB Mar. 20, 2014) (Paper 13).

B. No Overlap with Litigation Positions or their Underlying Basis.

AT&T does not seek to prematurely learn the litigation positions or strategies of CCI in this proceeding. The requested discovery does not relate to any invalidity allegations, and is therefore proper under the second *Garmin* factor.

C. No Ability to Generate Equivalent Discovery by Other Means.

AT&T's proposed discovery requests narrowly target indemnification agreements and related communications indicating that Arris, Cisco, and Broadsoft have the ability to control the instant *inter partes* reviews and are unnamed real parties-in-interest. While at least one of these parties has publicly conceded that Cox has requested indemnification, the terms of indemnity agreements are typically confidential and not publicly available. In addition, the information sought is not available for AT&T to discover in the Delaware Litigation because it is stayed, including 30(b)(6) depositions of vendor-indemnitors. Thus, information as to Arris', Cisco's, or Broadsoft's rights or opportunities to control the instant *inter partes* reviews cannot be generated by alternate means. AT&T's proposed discovery requests also narrowly target retention agreements, invoicing and payment details for the instant *inter partes* reviews. This information is solely in Cox's possession, and cannot be generated by alternate means.

D. Requested Discovery Is Easily Understandable.

AT&T's instructions are easily understandable and are based on instructions similar to those approved by the Board in *Garmin*.

E. Requested Discovery Is Not Overly Burdensome.

AT&T's proposed discovery is tailored narrowly to a small number of documents that are relevant to the determination of whether Petitioner CCI properly named all real parties-in-interest in compliance with 35 U.S.C. § 312(a)(2). The production of the documents responsive to AT&T's proposed discovery requests should not impose a large financial burden, burden on human resources, or burden on meeting the time schedule of this review.

Specifically, the retention and indemnification agreements (Req. 1, 3, 5, and 7) should be singular documents easily retrievable by CCI, as the terms of the agreement(s) were likely relevant [redacted]. Similarly, communications concerning indemnification (Req. 2, 4, and 6) should easily be retrievable by a simple electronic mail search by recipient or sender. Invoices and payment information (Req. 8 and 10), and an identification of the individuals who directed the filing of the Petitions or related papers (Req. 9), are recent and should also be easily retrievable. Agreements as to allocation of payment for invoices in the instant proceeding (Req. 11) are likely relied upon monthly (or as invoices are generated), and are therefore not burdensome to produce. Additionally, the requested employment agreements for Cox in-house counsel are likely to be

easily accessible (Req. 12) and are therefore not burdensome to produce.

Finally, this request is timely, as AT&T requested authorization to file this motion for discovery after duly meeting and conferring with CCI, and soon after trial institution. AT&T expects that, once additional discovery is authorized and produced, AT&T will be able to use the discovery in its Patent Owner Response.

F. Additional Discovery is Necessary in the Interest of Justice.

As shown above, each of the five *Garmin* factors applies to Patent Owner's request for additional discovery, demonstrating that the requests meet the interest of justice standard. Proper naming of the real parties-in-interest in the instant reviews is necessary to ensure compliance with the statutory requirements of 35 U.S.C. § 312, to facilitate conflict of interest inquiries at the Office, and for proper application of estoppels under 35 U.S.C. § 317.

[redacted] The Trial Practice Guide is clear; the ***opportunity*** to control a proceeding can be sufficient to qualify a party as a real party-in-interest. 77 Fed. Reg. 48759. Additionally, AT&T does not believe that any issues of confidentiality prevent the consideration of all of the relevant facts in the Board's decision on this motion or preclude the requested discovery. FRE 408 only bars evidence of "conduct or a statement made during compromise negotiations about [a] claim" and then only when offered to

prove/disprove validity or amount of the claim or to impeach. Additionally, FRE 408(b) allows the Board to "admit this evidence for another purpose." *See Hyundai Mobis Co., LTD v. Autoliv ASP, Inc.*, Case IPR2014-01005, slip op. at 6 (Paper 33) (PTAB Mar. 25, 2015). [redacted] is therefore not inadmissible under FRE 408. Moreover, [redacted] Further, any argument that the requested documents are confidential is of no moment; the "fact that the information may be confidential…does not shield it from discovery." IPR2015-00595, Paper 31. Finally, out of an abundance of caution, the parties stipulated to a protective order in these proceedings that will limit public disclosure of confidential information.

III. Conclusion

Because AT&T's discovery request satisfies all five *Garmin* factors as detailed above, AT&T respectfully requests that the Board allow the proposed discovery set forth in Exhibit 2038.

Respectfully submitted,

Dated: January 12, 2016 /*David W. OBrien*/ Reg. No. 40,107

IPR2015-01227

Cox Communications, Inc.

v.

AT&T Intellectual Property I, L.P.

Patent Owner's Exhibit List

January 12, 2015

ATT-2001	Docket Report – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2002	Complaint – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2003	Plaintiffs' Answering Brief in Opposition to Defendants' Motion to Transfer – Document 90, AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2004	Defendants' Answer, Affirmative Defenses, and Counterclaims – Document 38, AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2005	Aggregated Rule 7.1 Statements of Defendants – AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del.)
ATT-2006	Summary of Cox Entities
ATT-2007	E-mail dated July 21, 2015 from Gourdin W. Sirles to Jared Hoggan and attached draft Joint Stipulation to Dismiss Certain Cox Defendants
ATT-2008	Declaration of Robin Sangston in Support of Cox Communications, Inc.'s Motion to Dismiss – Document 35-3, Sprint Communications Company L.P. v. Cox Communications, Inc. *et al*.,

	Case No. 11-cv-2683 JAR (D. Kansas)
ATT-2009	Federal Communications Commission, Evolution of Cable Television, available at https://www.fcc.gov/print/node/37265.
ATT-2010	Order Denying Motion to Transfer – Document 132, AT&T Intellectual Property I, L.P. *et al.* v. Cox Communications, Inc., *et al.*, Case No. 14-1106-GMS (D. Del. July 9, 2015)
ATT-2011	CCI's Supplemental Brief Concerning Personal Jurisdiction – Document 56, Sprint Communications Company L.P. v. Cox Communications, Inc. *et al*., Case No. 11-cv-2683 JAR (D. Kansas)
ATT-2012	Complaint – Cox Communications, Inc., *et al*. v. Sprint Communications Company *et al*. (D. Del.)
ATT-2013	Stipulation and Order of Dismissal of Cox Communications Inc. and Substitution of CoxCom, LLC – Document 11, Joao Control & Monitoring Systems, LLC v. Cox Communications Inc., Case No. 1:14-CV-520-GMS (D. Del. Oct. 7, 2014)
ATT-2014	Stipulation and Order to Substitute – Document 9, Futurevision.com, LLC v. Cox Communications, Inc. et al., Case No. 14-870-GMS (D. Del. Sept. 3, 2014)
ATT-2015	IPR2015-01477 – Petition for *Inter Partes* Review of U.S. Patent No. 6,587,046
ATT-2016	IPR2015-01477 – Petitioners' Power of Attorney
ATT-2017	IPR2015-01760 – Petition for *Inter Partes* Review of U.S. Patent No. 6,549,130
ATT-2018	IPR2015-01796 – Petition for *Inter Partes* Review of U.S. Patent No. 5,563,883
ATT-2019	Complaint – C-Cation Technologies, LLC v. Atlantic Broadband

	Group, LLC et al. (D. Del.)
ATT-2020	Summary of Cox Entity *Inter Partes* Review Petitions
ATT-2021	Collection of Dun and Bradstreet Reports of Cox Entities
ATT-2022	Declaration of Stephanie Allen-Wang in Support of Cox's Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a) – Document 78, AT&T Intellectual Property I, L.P. *et al*. v. Cox Communications, Inc., *et al*., Case No. 14-1106-GMS (D. Del.)
ATT-2023	Summary of Cox Entity Leadership
ATT-2024	[RESERVED]
ATT-2025	[RESERVED]
ATT-2026	Transcript of Conference Call Hearing held January 5, 2016.
ATT-2027	Form 10-Q for the quarter ended September 30, 2015 of Arris Group, Inc. dated November 6, 2015, as filed with the U.S. Securities and Exchange Commission, *available at* https://www.sec.gov/Archives/edgar/data/1141107/000119312515370106/d70478d10q.htm (last retrieved January 12, 2016)
ATT-2028	ARRIS Corporate Terms and Conditions of Sale, *available at* https://www.arris.com/globalassets/resources/company-overview/tc.pdf (last retrieved January 12, 2016)
ATT-2029	America Invents Act, HR Rep No 112-98, 112th Cong, 1st Sess (2011)
ATT-2030	Brian J. Love & Shawn Ambwani, Inter Partes *Review: An Early Look at the Numbers*, 81 U. CHI. L. REV. DIALOGUE 93, 93–95 (2014), https://lawreview.uchicago.edu/page/inter-partes-review-early-look-numbers.
ATT-2031	[CONFIDENTIAL – FILED UNDER SEAL]

ATT-2032	Terms of Sale and Software License Agreement, Cisco Systems Inc., *available at* http://www.cisco.com/web/about/doing_business/legal/docs/tc-us.pdf (last retrieved January 12, 2016).
ATT-2033	Cisco Systems, Inc. v. Sprint Communications Company L.P., Complaint for Declaratory Judgment, May 28, 2015 (D. Del.).
ATT-2034	Cox Selects Broadosft's Platform For VoIP, TMCNews, *available at* http://technews.tmcnet.com/hosted-voip/feature/articles/7784-cox-selects-broadsofts-platform-voip.htm (last retrieved January 12, 2016).
ATT-2035	AT&T Preliminary Infringement Contentions, Exhibit G38, Case No. 14-1106-GMS (D. Del.).
ATT-2036	Broadsoft, Inc. v. CallWave Communications, LLC, Complaint for Declaratory Judgment, April 23, 2013 (D. Del.).
ATT-2037	Sprint Communications, L.P., v. Cox Communications, Inc., Memorandum and Order, Sept. 14, 2012 (D. Kansas).
ATT-2038	AT&T's Proposed Discovery Requests

UNITED STATES PATENT AND TRADEMARK OFFICE

COX COMMUNICATIONS, INC.
Petitioner
v.
AT&T INTELLECTUAL PROPERTY I, L.P.
Patent Owner

Case IPR2015-01227 (Patent 7,907,714 B2)

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that service was made on the Petitioner as detailed below.

Date of service	January 12, 2016
Manner of service	Federal Express delivery
Documents served	Patent Owner's Motion for Additional Discovery Patent Owner's Exhibit List Exhibits 2026-2038
Persons served	Steven M. Bauer Proskauer Rose LLP One International Place Boston, MA 02110 PTABMattersBoston@proskauer.com

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