

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 IPR2015-01187 (Patent 6,993,353 B2)²
Case IPR2015-01227 (Patent 7,907,714 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*.

DECISION

Granting-in-Part Patent Owner's Motion for Additional Discovery
37 C.F.R. § 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.

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I. INTRODUCTION

Petitioner, Cox Communications, Inc. (hereafter “Cox” or “Petitioner”), filed Petitions (“Pet.”) requesting an *inter partes* review in each of the four above-identified proceedings. Paper 9.³ The Petitions identify Cox Communications, Inc. as the sole real party in interest.

Patent Owners, AT&T Intellectual Property I, L.P. or AT&T Intellectual Property II, L.P. (hereafter “AT&T” or “Patent Owner”), filed a Preliminary Response (Prelim. Resp.) in IPR2015-1227, IPR2015-1273, and IPR2015-1536, respectively, asserting that a subsidiary to Cox, CoxCom, LLC, as well as other Cox entities, should have been identified as real parties in interest in these proceedings.⁴ Paper 12. In the Decisions to Institute in these cases, we determined, *inter alia*, that the evidence of record before us at the time established that Cox had complied sufficiently with 35 U.S.C. § 312(a)(2) by identifying all real parties in interest. Paper 13.

On January 5, 2016, a conference call was convened to discuss AT&T’s request for authorization to file a motion seeking additional discovery of evidence alleged to be related to the identification of the real parties in interest in these proceedings. At that time, in addition to CoxCom, LLC and other Cox entities, AT&T also identified three Cox vendors it alleged to be

³ Citations are to Case IPR2015-01227 as representative, unless otherwise noted or ordered.

⁴ In the instant Motion, AT&T requests discovery related to CoxCom, LLC, and other Cox entities for all four of the captioned proceedings. Paper 20, 7–8; Ex. 2038.

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potential real parties in interest, and requested leave to file a related motion for additional discovery. Ex. 2026, 4:21–25.⁵

On January 12, 2016, pursuant to our authorization, AT&T filed a redacted version of a Motion for Additional Discovery from Cox regarding the real party in interest issues. Paper 20 (“Mot.”). On January 20, 2016, Cox filed a redacted version of an Opposition to this Motion. Paper 26 (“Opp.”).

AT&T provided its Proposed Discovery Requests with the Motion for Additional Discovery, which can be divided into those that generally relate to the three Cox vendors (Requests 1–6), and those that generally relate to CoxCom, LLC and other Cox entities (Requests 7–12). Ex. 2038. Cox, in turn, provides its positions in the Opposition, with specific reference to a red-line version of the Proposed Discovery Requests. Ex. 1024.

For the reasons discussed below, we grant-in-part AT&T’s Motion for Additional Discovery.

II. MOTION FOR ADDITIONAL DISCOVERY

Additional discovery may be ordered if the party moving for the discovery shows “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2). There are five factors (“the Garmin factors”) important in determining whether additional discovery is in the interests of justice. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26)

⁵ We refer to the parties’ redacted version of Exhibit 2026. The parties have filed Motions to Seal limited portions of confidential information, and we address those Motions in Section IV below.

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(informative). These factors are listed as follows: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek other party's litigation positions and the underlying basis for those positions; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

A. Cox Vendors

AT&T requests the production of: (i) agreements between the Cox vendors, Arris, Cisco, and Broadsoft, and Cox, CoxCom, LLC, and other Cox entities under which indemnification was requested in the Delaware litigation (Requests 1, 3, 5); and (ii) communications between the Cox vendors and Cox, CoxCom, LLC, and other Cox entities for the Delaware litigation directed to the indemnification notices, requests and approvals (Requests 2, 4, and 6). Ex. 2038, 5–7. AT&T alleges that discovery of the particulars of the agreements and related communications between the Cox vendors, Arris, Cisco, and Broadsoft, and Cox, CoxCom, LLC, as well other Cox entities, is necessary to determine their opportunity to control the proceedings. Mot. 2. AT&T also contends, *inter alia*, that it is beyond speculation that useful information will be discovered, and the discovery is not burdensome. *Id.* at 3–6, 10–11.

Cox objects to producing the agreements because it alleges that the potential usefulness of the discovery is speculative, and the production is burdensome, especially as to the communications sought under Requests 2, 4, and 6. Opp. 1–6, 11. Cox states, however, that the agreements that AT&T requests were already produced in the related Delaware litigation,

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and Cox grants AT&T's counsel access to the requested documents in this proceeding. *Id.* at 10, n.2.

We, therefore, grant the Motion for Additional Discovery as to Requests 1, 3, and 5, in light of Cox's willingness to grant access to these documents to AT&T's counsel. This production will be subject to the terms of the Default Protective Order, as agreed to by the parties, and as entered by this Order. *See infra* Section III.

Cox states that AT&T will have to additionally agree to abide by the terms of the Delaware protective order for production of the documents under Requests 1, 3, and 5. *Opp.* 10, n.2. Issues related to the application of a protective order from the Delaware litigation do not fall within our jurisdiction.

Additionally, in light of Cox's willingness to produce the agreements related to indemnification, we also grant the Motion for Additional Discovery as to Requests 2, 4, and 6, subject to certain conditions. As discussed further, *infra* Section II.B, argument and evidence relating to other Cox entities, besides CoxCom, LLC, has not been presented and developed sufficiently in the Motion for Additional Discovery for our consideration. We, therefore, limit the scope of the production of non-privileged portions of the specified communications for Requests 2, 4, and 6 to communications between the Cox vendors and Cox or CoxCom, LLC only.

B. Other Cox Entities

AT&T also requests: (i) engagement letters and retention agreements between Cox's counsel and Cox, as well as those with CoxCom, LLC and other Cox entities, and invoices for services related to the preparation of the

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Petitions and services rendered for these four proceedings (Requests 7 and 8); (ii) documents identifying individuals and their titles at Cox, CoxCom, LLC, other Cox entities, and Cox vendors, who provided direction to Cox's counsel in these proceedings, including "review and approval of any of the Petitions or any of the papers filed" (Request 9); (iii) documents identifying payors and payment dates, and agreements or communications among Cox, CoxCom, LLC, other Cox entities, and the Cox vendors concerning the allocation of payment for these proceedings (Requests 10 and 11); and (iv) employment agreements, including those establishing authority, between Ms. Stephanie Allen-Wang and any of the Cox entities (Request 12). Ex. 2038, 5–8.

AT&T contends that it has established facts that CoxCom, LLC appears to have a measure of control over these proceedings. Mot. 7. AT&T points to evidence related to Cox's identification of other related parties as real parties in interest in other *inter partes* reviews pending before the Board, and a draft stipulation with CoxCom, LLC identified as evidence of corporate blurring. *Id.* at 7–8. AT&T also contends that, because the same counsel represents Cox and CoxCom, LLC, it is beyond speculation that discovery should be granted for invoicing and payments. *Id.* at 8. AT&T also asserts that the grant of discovery into the management structure and employment agreements is supported by the specific facts. *Id.* AT&T additionally contends that this production should not be burdensome, and even if materials may be confidential, they are not shielded from discovery. *Id.* at 10–12.

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Cox replies that AT&T is broadly seeking discovery into the interoperability and corporate structure of all of the Cox regional subsidiaries, and AT&T provides no evidence or argument beyond what has already been briefed, and which is flawed. Opp. 6–7. Cox questions the basis for AT&T’s request for the employment agreement of Cox counsel, Ms. Allen-Wang, because it contends that it has already been established that she serves as counsel for different Cox entities. *Id.* at 9. Cox argues that it already has been established that Cox and Cox, LLC are represented by the same counsel, so no additional discovery is warranted. *Id.* Cox also contends that Requests 7–12 seek extensive identifications, agreements, and communications between or involving all Cox entities and suppliers that would be burdensome to produce, and represents an effort by AT&T to breach internal work-product and common interest privileges. *Id.* at 12. Even with AT&T’s alleged failures to support the requested discovery, Cox provides a redacted engagement letter (Ex. 1022) and one representative redacted invoice (Ex. 1023).⁶ *Id.* at 9.

For Requests 7–11, AT&T provides evidence that would support discovery of potentially useful information regarding CoxCom, LLC. We find, however, that AT&T has not provided evidence that would support the discovery of useful information regarding the other Cox entities. We also view the discovery requests as overly broad to the extent they require

⁶ We note that Cox has provided Exhibits 1022 and 1023 as proposed production, however, the scope of redactions of these documents may be potentially excessive. Therefore, as ordered herein, Cox will be required to produce these documents to AT&T, with the modifications as noted.

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extraneous production from other entities that would not be useful, such as the production of all invoices between Petitioner's counsel and Cox itself. That said, AT&T has sufficiently met the factors supporting additional discovery under Requests 7–11. Therefore, we grant-in-part the Motion for Additional Discovery as to Requests 7–11, subject to the following conditions.

For Requests 7 and 8, production is ordered for the non-privileged information in any engagement letters, retention agreements, and invoices, between Petitioner's counsel and CoxCom, LLC that are associated with these four proceedings. Any dollar amounts or fee rates may be redacted. The non-privileged portions of Cox's engagement letter and representative invoice (Exs. 1022 and 1023), shall be re-produced to AT&T in a modified form, with no redactions of any text that identifies any other entities besides Cox and Cox's counsel, or identifies any persons employed by the other entities, or of the associated text relating in any way to those other entities or persons. Any dollar amounts or fee rates may be redacted. For Request No. 9, the identification and title of any individual at CoxCom, LLC, Arris, Cisco, and Broadsoft, respectively, who approved the Petition or any of the papers filed in these four proceedings shall be produced. For Requests 10 and 11, production is ordered of the non-privileged information in any documents that identify payors and payment dates for any entity besides Cox, including any agreements for payment allocation or reimbursement of payments to Petitioner's counsel for the preparation the Petitions or for services rendered in these four proceedings. Any dollar amounts or fee rates may be redacted.

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For Request 12, we do not find that AT&T has established more than a mere possibility that anything useful would be discovered by the production of the employment agreements of Ms. Allen-Wang. AT&T already knows that Ms. Allen-Wang serves as counsel for Cox and CoxCom, LLC, and AT&T fails to specify what additional useful information would be obtained by the production of any employment agreement. We, therefore, deny AT&T's Request 12.

III. PROTECTIVE ORDER

The parties have jointly moved for entry of the Board's default Protective Order (Paper 19). For good cause, we grant the entry of the Board's default Protective Order, attached as Exhibit B to our Trial Practice Guide. The parties shall file a copy of the Board's Standing Protective Order, signed by counsel for both parties, separately as an exhibit.

We remind the parties of the public's interest in maintaining a complete and understandable file history and, thus, that there is an expectation that confidential information relied upon in a subsequent decision will be made public. *See Office Trial Practice Guide*, 77 Fed. Reg. at 48760–61. In addition, confidential information subject to a protective order ordinarily becomes public 45 days after denial of a petition to institute or 45 days after final judgment in a trial. A party seeking to maintain the confidentiality of the information may file motions in Cases IPR2015-01187 (U.S. Patent No. 6,993,353 B2), IPR2015-01227 (U.S. Patent No. 7,907,714 B2), IPR2015-01273 (U.S. Patent No. 6,487,200 B1), and IPR2015-01536 (U.S. Patent No. 8,855,147 B2).

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IV. MOTIONS TO SEAL

We granted leave to file motions to seal in light of the representations made by Cox concerning the confidentiality of some of the statements made at the January 5, 2016, conference call. AT&T and Cox both submitted Motions to Seal information in the record. Paper 22, 25.

AT&T moves to seal: (i) the confidential (un-redacted) version of the Motion for Additional Discovery⁷ and Exhibit 2026 (noted as “sealed” on the docket), and (ii) Exhibit 2031 in its entirety. Paper 22 (“AT&T Mot. to Seal”). Cox moves to seal the confidential (unredacted) version of Petitioner’s Opposition to Patent Owner’s Motion for Additional Discovery⁸. Paper 25 (“Cox Mot. to Seal”).

AT&T states in its Motion to Seal that it moves to seal all the materials at issue based upon Cox’s allegations of confidentiality. AT&T Mot. to Seal, 1–2. Cox states in its Motion to Seal that the contents of its Opposition discuss confidential information, and references exhibits already filed under seal. Cox Mot. to Seal, 2.

At this time, without addressing the ultimate confidentiality status of the information for which sealing is sought, in order to be prudent, we grant AT&T’s Motion To Seal and the Cox’s Motion to Seal.

⁷ AT&T’s unredacted Motion for Additional Discovery is docketed as Paper 21 in Case IPR2015-01227, Paper 18 in Case IPR2015-01187, Paper 22 in Case IPR2015-01273, and Paper 26 in Case IPR2015-01536.

⁸ Cox’s unredacted Opposition is docketed as Paper 27 in Case IPR2015-01227, Paper 25 in Case IPR2015-01187, Paper 26 in IPR2015-01273, and Paper 20 in Case IPR2015-01536.

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IV. ORDER

Accordingly, it is:

ORDERED that AT&T's Motion for Additional Discovery is *granted* as to discovery of materials requested under Requests 1–11, subject to the conditions stated herein;

FURTHER ORDERED that AT&T's Motion for Additional Discovery is *denied* as to discovery of materials requested under Request 12;

FURTHER ORDERED that the Board's Default Standing Protective Order shall be entered in this proceeding;

FURTHER ORDERED that the parties shall file a copy of the Board's Standing Protective Order, signed by counsel for both parties, as a uniquely numbered exhibit, within five business days; and

FURTHER ORDERED that AT&T's Motion to Seal and Cox's Motion to Seal is granted. As a result, the following papers and exhibits shall remain under seal:

Case IPR2015-01187, Papers 18 and 25, Exhibit 2026 (noted as "sealed" on the docket), Exhibit 2031;

Case IPR2015-01227, Papers 21 and 27, Exhibit 2026 (noted as "sealed" on the docket), Exhibit 2031;

Case IPR2015-01273, Papers 22 and 26, Exhibit 2026 (noted as "sealed" on the docket), Exhibit 2031; and

Case IPR2015-01536, Papers 16 and 20, Exhibit 2026 (noted as "sealed" on the docket), Exhibit 2031.

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