UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

IN RE: PERSONALWEB TECHNOLOGIES, LLC, ET AL. PATENT LITIGATION

Case No. 18-md-02834-BLF (SVK)

ORDER REGARDING THE PARTIES' JULY 24, 2019 DISCOVERY DISPUTE

Re: Dkt. No. 466

Before the Court is the Parties' joint statement on a motion by Amazon.com, Inc. and Amazon Web Services, Inc. (collectively "Amazon") to compel PersonalWeb Technologies, LLC and Level 3 Communications, LLC (collectively "PersonalWeb") to supplement their response to Amazon's Interrogatory No. 4. ECF 466. The Court reviewed the Parties' submission and held a telephonic hearing on August 7, 2019. For the reasons stated on the record and set forth herein, the Court **GRANTS** Amazon's motion.

I. BACKGROUND

Amazon's Interrogatory No. 4 requests:

> If you contend that there exist any secondary considerations or objective evidence of nonobviousness with respect to each of the claimed inventions of the patents-in-suit, state in detail the full factual and legal basis for your contention, including identifying all persons and documents supporting this contention. Your answer should also identify and explain any nexus you contend exists between the claimed invention(s) and any evidence of secondary considerations or objective evidence of non-obviousness, including without limitation a claim-by-claim description of the connection between each of the asserted claims and any evidence of commercial success.

Amazon's First Set of Interrogatories, Ex. 1, ECF 466-1 at 7–8.

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In response, PersonalWeb asserted various objections. Its substantive response is as follows:

> The non-obviousness of the Patents-in-Suit's claimed inventions is reflected by the tremendous commercial success achieved by AWS' S3 and CloudFront products and services. Upon information and belief, Amazon's accused products have produced millions of dollars in revenues due in part to its use of the inventions of the Patents-in-Suit.
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> The non-obviousness of the Patents-in-Suit is also reflected by the commercial success achieved by the other defendants that PersonalWeb has sued and/or parties licensed under the True Names patents, including, but not limited to products referenced in PersonalWeb's Response to Interrogatory No. 3, herein.

PersonalWeb's Response to Amazon's First Set of Interrogatories, Ex. 1, ECF 466-1 at 13.

Amazon argues that PersonalWeb's response refers to the success of the accused technology of Amazon and others but "does not disclose any facts that connect that commercial success to the purported non-obviousness *of the patent-in-suit*." ECF 466 at 2 (emphasis in original). Amazon further complains that PersonalWeb is unwilling to confirm that its response is complete. *Id.*

PersonalWeb argues that its response is as complete as it realistically can be, in light of Amazon's invalidity contentions. *Id.* at 3–4. In particular, PersonalWeb complains that Amazon's contentions of obviousness combinations are not sufficiently specific, and therefore PersonalWeb cannot tether its secondary considerations to specific claims as requested by Interrogatory No. 4. *Id.* PersonalWeb further argues that in light of the state of Amazon's invalidity contentions, obviousness "is no longer an issue in this case and Interrogatory No. 4 does not relate to any relevant issue in the case . . . ." *Id.* at 4. PersonalWeb closes its argument by suggesting that it is not challenging Amazon's invalidity contentions per se, but rather that the contentions "do not provide enough information to allow PersonalWeb to answer Interrogatory No. 4." *Id.* at 5.

II. DISCUSSION

As an initial matter, the Court takes PersonalWeb at its word that it points to Amazon's invalidity contentions solely as an explanation as to why it cannot provide a more complete response to Interrogatory No. 4. Accordingly, the Court looks to Amazon's obviousness

contentions solely for the purpose of evaluating PersonalWeb's argument here.

PersonalWeb argues that it cannot provide more precise secondary considerations or the nexus between the claimed inventions and evidence of secondary considerations because Amazon has not linked its obviousness combinations to specific claim elements. ECF 466 at 4. PersonalWeb further complains that "[a]sking PersonalWeb to form contentions as to secondary considerations of non-obviousness and the nexus between such indicia and each of the thousands of possible combinations of prior art Amazon relies on . . . is completely unreasonable, overbroad, and unduly burdensome." *Id*. In support of its argument, PersonalWeb generally relies upon *Novartis v. Torrent Pharma. Ltd.*, 853 F. 3d 1316, 1330 (Fed. Cir. 2017).

The Court disagrees with PersonalWeb's position. First, the guidance *Novartis* actually provides is that for evidence of secondary considerations to be "accorded substantial weight," there must be a nexus "between the evidence (of secondary consideration) and the merits of the claimed invention." 853 F. 3d at 1330. Interrogatory No. 4 is directed at the nexus between claimed inventions and secondary considerations. There is no requirement, as PersonalWeb seems to be suggesting, that PersonalWeb link its evidence of secondary considerations to each and every combination of obviousness.

Second, PersonalWeb's suggestion that it cannot discern which claims Amazon contends are obvious because of how Amazon organized its contentions is unavailing. After first noting that its contentions are not properly at issue in this motion, Amazon states that, "[i]t mapped each limitation in the claims to a primary prior art reference and included pin citations to the other references that disclose the same limitation." ECF 466 at 3. The Court reviewed Amazon's invalidity contention claim charts and verified Amazon's statement. Further, at the hearing, Amazon confirmed that to the extent it relies upon prior art combinations in support of obviousness, those combinations are as set forth in the claim charts attached to its invalidity contentions. Amazon further confirmed that there are obviousness allegations, supported by cites to prior art, for each claim in suit.

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Accordingly, in consideration of the law and facts discussed above, the Court finds that PersonalWeb has an obligation to respond to Amazon's Interrogatory No. 4 with facts in support of secondary considerations properly linked to each claimed invention. *Novartis*, 853 F. 3d at 1330.

III. CONCLUSION

The Court **GRANTS** Amazon's motion to compel and **ORDERS** PersonalWeb to supplement its response to Interrogatory No. 4 in compliance with this Order by **Friday, August 16, 2019**.

SO ORDERED.

Dated: August 7, 2019

SUSAN VAN KEULEN
United States Magistrate Judge