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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

IN RE PERSONAL WEB TECHNOLOGIES, LLC, ET AL., PATENT LITIGATION	Case No.: 5:18-md-02834-BLF-SVK
AMAZON.COM, INC. and AMAZON WEB SERVICES, INC., Plaintiffs, v. PERSONALWEB TECHNOLOGIES, LLC and LEVEL 3 COMMUNICATIONS, LLC, Defendants.	Case No.: 5:18-cv-00767-BLF-SVK **JOINT STATEMENT REGARDING MOTION TO COMPEL: PRODUCTION OF DOCUMENTS AND FURTHER INTERROGATORY RESPONSES FROM PERSONALWEB**
PERSONALWEB TECHNOLOGIES, LLC and LEVEL 3 COMMUNICATIONS, LLC, Counterclaimants, v. AMAZON.COM, INC., and AMAZON WEB SERVICES, INC., Counterdefendants.	

I. AMAZON'S STATEMENT

Amazon requests the Court's assistance with discovery issues that relate to requests (attached as **Exhibits 1 & 2)** served on April 25, 2019. Fact discovery closes on August 16, 2019; trial is set on March 16, 2020. The parties conducted a conference on July 17, 2019.

Interrogatory Nos. 11-14 ask PersonalWeb to disclose the facts that support its positions on patent validity. The PTAB invalidated a slew of claims in the patents during IPR proceedings. (Amazon can provide the PTAB decisions to the Court on request). No. 11 therefore asks PersonalWeb to explain the difference between each asserted claim and those held invalid, including how those differences are material to the Court's analysis of invalidity.[1] Nos. 12-14 request a comparison of the asserted claims to the invalid claim 70 of the '310 patent. PersonalWeb provided a non-response that its patents are "presumed" valid and the interrogatories are "premature." The Court should compel a full response. The requested information is plainly relevant: if the asserted claims are not patentably distinct from those held invalid, then they, too, are invalid. *See, e.g.*, *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1377 (Fed. Cir. 2018). PersonalWeb cannot dispute this: it did not assert any objection to the requests based on relevance, and therefore waived such objections.[2] And just because an expert may rely on the requested facts later does not make the requests "premature"; PersonalWeb must still turn over the facts in its possession now. *See Amgen Inc. v. Sandoz Inc.*, No. 14-CV-04741-RS (MEJ), 2017 WL 1352052, at *2 (N.D. Cal. Apr. 13, 2017) (rejecting objection that requests were premature); *see also Facedouble, Inc. v. Face.com, Inc.*, No. 12CV1584-DMS MDD, 2014 WL 585868, at *3 (S.D. Cal. Feb. 13, 2014) (same); *In re NCAA*

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[1] The Court should not credit PersonalWeb's claim of burden in having to address "253 different claim combinations." It did not object to the interrogatory based on burden, and has never proposed any compromise that would reduce its purported burden.

[2] PersonalWeb's contention that it need not provide discovery on this issue because Amazon did not plead a defense of collateral estoppel lacks merit. First, Amazon pled a defense of invalidity, and the similarity of the asserted claims to those previously held invalid bears on that issue. Second, the Court may consider collateral estoppel *sua sponte*. *See, e.g.*, *Hawkins v. Risley*, 984 F.2d 321, 324 (9th Cir. 1993) (holding courts have such authority so long as "the parties ha[ve] adequate opportunity to examine and contest the application of preclusion"); *Clements v. Airport Auth. of Washoe Cty.*, 69 F.3d 321, 329-30 (9th Cir. 1995) (applying issue preclusion and declining to find waiver based on defendants' failure to plead affirmative defense). In fact, Amazon requires PersonalWeb's response to decide whether to amend its pleadings.

Student-Athlete Name & Likeness Licensing Litig., No. 09-CV-01967 CW NC, 2012 WL 4111728, at *4 (N.D. Cal. Sept. 17, 2012) (compelling response). The scheduling order also requires Amazon to disclose its expert's invalidity opinion first: PersonalWeb should not be allowed to withhold evidence to ambush Amazon in rebuttal.

RFPs No. 94 & 95. PersonalWeb's right to assert the patents-in-suit is governed by license agreements between Kinetech, Inc. and Digital Island, Inc., the predecessors in interest of PersonalWeb and Level 3, respectively. Although the Kinetech License grants *Level 3* the exclusive right to enforce the patents against content delivery networks ("CDNs"), *PersonalWeb* asserted infringement by Amazon's CloudFront CDN. Amazon therefore contends that PersonalWeb lacks standing to assert this claim. The Kinetech License also contains terms that determine how the parties report and divide revenue from licenses to the patents in suit. Thus, Amazon requested documents related to the Kinetech License (No. 94) and communications between PersonalWeb and Level 3 (No. 95). These are highly relevant. They bear on whether PersonalWeb has standing, as they will show the parties' course of dealing under the Kinetech License, including how the parties interpreted the exclusive field terms and whether PersonalWeb gave the required written notice of its intent to sue in Level 3's field. The documents are also relevant to damages, since they reflect licensing communications and the amounts paid under those licenses.

After prolonged negotiation, PersonalWeb finally offered to produce draft licenses, communications of Kinetech and Digital Island, and communications with Level 3 regarding license administration only, but reiterated that it is withholding its other communications with Level 3 based on "common-interest privilege." At 9:18 p.m. on July 23, 2019, Amazon emailed that it "would accept supplemental responses" that reflect this compromise. But the very next day, July 24, Level 3 disclosed that PersonalWeb had initiated an arbitration against it "related to issues before this Court" including Amazon's standing defense. (Dkt. 465.) The arbitration demand states that PersonalWeb had *already provided* Level 3 with "numerous written notices" about their dispute over the exclusive field terms in the Kinetech License and Level 3's alleged failure to "cooperate" in the litigation against Amazon. Indeed, on July 25, PersonalWeb's counsel represented to Judge Freeman that PersonalWeb and Level3 have engaged in "months" of communications about their dispute directly related to the

issues in this case. (*See* July 25, 2019 CMC Tr. at 6:15-17.)

Yet, in negotiating its discovery dispute with Amazon, PersonalWeb concealed the fact that it had for months communicated with Level 3 about issues in the case for which those parties are *adverse* and therefore share *no common interest. See Mondis Tech., Ltd. v. LG Elecs., Inc*., No. 2:07-CV-565-TJW-CE, 2011 WL 1714304, at *4 (E.D. Tex. May 4, 2011) ("any communications in which the parties are negotiating their rights and relationships to each other are not to be protected") (citation omitted).[3] Amazon has also learned that PersonalWeb also intervened to prevent Level3 from producing documents that Level3 itself did not intend to withhold. All of these must be produced. The court should also require PersonalWeb furnish a privilege log of withheld documents: (1) PersonalWeb bears the burden to establish application of the privilege (*see Leader Techs., Inc. v. Facebook, Inc.,* 719 F. Supp. 2d 373, 375-76 (D. Del. 2010); and (2) PersonalWeb's prior concealment of its dispute with Level 3 and its related communications means its privilege claims should be scrutinized carefully.

II. PERSONALWEB'S STATEMENT

Interrogatories 11-14 seek PersonalWeb's contentions regarding differences between the claims asserted in the present case with 23 invalidated claims spread among the 10 "TrueName" patents. These interrogatories seek no facts—only contentions that would ordinarily be contained in a patent owner's rebuttal expert report. Indeed, *Amgen v. Sandoz*, cited by Amazon for "rejecting objection that requests were premature" explicitly found that while obviousness related interrogatories "are not improper *to the extent they seek only facts*", they "are improper where they ask the respondent to provide *an expert opinion*" as Amazon does here. 2017 WL 1352052 at *2 (emphasis added).

Interrogatory 11 asks PersonalWeb to identify differences that "materially alter the question of invalidity"—language that appears to be taken from *Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013). *Ohio Willow Wood* used this language in the context of collateral

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[3] *United States v. Gonzalez*, 669 F.3d 974 (9th Cir. 2012), cited by PersonalWeb, is not at all to the contrary. It affirms that the privilege exists so that persons who share "a common interest in litigation" can communicate with their attorneys "to more effectively prosecute or defend their claims" and that the attorneys "at a minimum" need to be engaged in that process for the communications to be protected. *Id.* at 978, 980.

estoppel due to the previous invalidation of a claim related to a later asserted claim. Neither Amazon nor Twitch raised collateral estoppel as an affirmative defense generally, or specifically regarding the invalidation of claim 70 of the '310 patent. *See* Fed. R. Civ. Proc. 8(c)(1)[4]. Accordingly, the differences that "materially alter the question of invalidity" vis-à-vis claim 70 of the '310 patent are not relevant to any claim or defense in this case and thus PersonalWeb should not be forced to provide contentions for such a non-issue in violation of Rule 26's proportionality standard.

Further, Interrogatory 11 is particularly burdensome and disproportionate to the needs of the case as it asks PersonalWeb to identify differences between *each* of 23 claims in the definition of "invalidated claims" and *each* of the 11 asserted claims. This would require PersonalWeb to identify differences between 253 different claim combinations (23 x 11 = 253).

Interrogatories 12-14 asked for "elements or limitations" that "make the claim narrower or otherwise materially different from the scope of claim 70 of the '310 patent." In these interrogatories, what "materially" relates to is not stated. While Interrogatory 11 specifies "materiality" as to the "question of invalidity," Interrogatories 12-14 do not indicate whether "material" relates to invalidity, infringement, or some other issue. It is not up to PWeb to guess to which issue materiality is intended.

As to **Interrogatories 11-14**, absent collateral estoppel or res judicata, the difference between the claims is not material to the issue of the invalidity of the asserted claims. The invalidity of each claim is determined independently. The prior art and reasoning used to previously invalidate a claim would have to be applied anew to each asserted claim regardless of the similarities or differences to the invalidated claims. Amazon's motion should be rejected as to Interrogatories 11-14.

RFP Nos. 94-95. In supplemental responses served 8/4/19, PersonalWeb committed to produce non-privileged, non-protected, responsive documents "prepared in the ordinary course of business

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[4] Amazon also did not raise this issue in its invalidity contentions. Amazon argues that pleading a defense of invalidity somehow obviates the Rule 8(c)(1) requirement to plead the affirmative defense of collateral estoppel but cites no authority for this proposition. Ironically, Amazon now defends its failure to include a defense based on a prior proceeding after it argued that PersonalWeb should not be allowed to amend its infringement contentions because of matter from prior proceedings. The case Amazon cites for the proposition that a court may consider issue preclusion *sua sponte, Hawkins v. Riley*, involved issue preclusion based on a judgment that was issued *after* the pleadings were filed—the invalidations Amazon now wants to rely on happened before the present cases were even filed.

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