

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS GROUP, INC.
Petitioner,

v.

C-CATION TECHNOLOGIES, LLC
Patent Owner.

Case IPR2014-00746
Patent 5,563,883

Before KRISTEN L. DROESCH, KALYAN K. DESHPANDE,
MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

ORDER
Granting Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

INTRODUCTION

Pursuant to authorization from the panel, Patent Owner filed a Motion for Discovery from Petitioner. Paper 10 (“Motion”). In its Motion, Patent Owner seeks production of the indemnification agreement between Petitioner and Comcast. *Id.* at 4. Petitioner opposes the Motion arguing that the agreement will not uncover something useful because Patent Owner failed to explain how the agreement can establish that Petitioner was in privity with Comcast. Paper 11 (“Opp.”) at 1-2. Patent Owner seeks to prove that the petition is time-barred under 35 U.S.C. § 315(b) by showing privity between Petitioner and Comcast during the relevant time period. *See* Paper 14 at 3 (“Reply”). Because Patent Owner has shown factual support for its very limited discovery request, we hereby *grant* the Motion.

WHETHER SOMETHING USEFUL WILL BE FOUND

The first and oft-disputed factor in determining whether additional discovery is necessary in the interests of justice is whether there exists more than a “mere possibility” or “mere allegation that something useful [to the proceeding] will be found.” *Garmin Int’l, Inc. et al. v. Cuozzo Speed Techs LLC*, Case IPR2012-00001, Paper 20, slip op. at 2-3 (PTAB Feb. 14, 2014), “Order—Authorizing Motion for Additional Discovery” (listing factors to determine whether a discovery request is necessary in the interests of justice) (“the Garmin factors”). Under this first factor, a party should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered. *Id.* The discovery-seeking party only needs to set forth a threshold amount of evidence tending to show that the discovery it seeks factually supports its contention. *See*

Garmin, IPR2012-00001, Paper 26, slip op. at 8-9, “Decision—On Motion for Additional Discovery” (finding that, with respect to Cuozzo’s contention of commercial success, Cuozzo failed to present a threshold amount of evidence tending to show that the requested discovery of sales and pricing information involved units with a nexus to the claimed features). Something “useful” is something favorable in substantive value to a contention of the party moving for discovery. *Id.* at 7-8. We have not required that a party seeking additional discovery prove its contention as a prerequisite for obtaining the additional discovery. Furthermore, we weigh other considerations in addition to the *Garmin* factors, such as whether the requested additional discovery is very limited and sought early in the proceeding.

At issue is the dispute regarding whether production of an indemnification agreement in this proceeding is in the interests of justice. Patent Owner has made a very limited request concerning the agreement between Petitioner and Comcast, a non-party to this proceeding. The existence of this agreement is not disputed. Opp. n.1. The question for us to answer is whether Patent Owner has brought forth a threshold amount of evidence tending to show that the indemnification agreement supports the contention that Petitioner controlled or could have exercised control in the prior litigation where Comcast was a defendant.¹ Although Petitioner does not dispute that the agreement exists or that indemnification was requested, Petitioner

¹ Patent Owner addressed all the remaining *Garmin* factors in its Motion. Motion 6-8. We do not address those factors in this decision as Patent Owner has made a sufficient showing and Petitioner has not contested them.

urges that we answer the question in the negative because the agreement alone cannot give rise to privity. Motion 2-7.

We are not persuaded that in order for Patent Owner to show it is entitled to the indemnification agreement, it must first prove, at this time, that Petitioner exercised control over Comcast sufficient for it to be deemed in privity with Comcast. Patent Owner has provided evidence showing: (1) the agreement exists;² (2) Comcast made indemnification claims against Petitioner;³ (3) Petitioner had contractual rights with Comcast regarding exercising “sole control” of the litigation;⁴ and (4) Petitioner resolved the indemnification claims with Comcast.⁵ This evidence constitutes threshold evidence sufficient to deem the very limited request of the indemnification agreement to be necessary in the interests of justice. Also of importance is the consideration that the request was made a mere one month after the Petition received a notice of filing accorded. Based on the foregoing, we determine that, based on the specific facts presented in this case, Patent Owner’s request for the indemnification agreement is in the interests of justice.

This decision does not address the ultimate issue of whether Petitioner and Comcast were privies or that the evidence sought by Patent Owner will eventually show privity. We have considered Petitioner’s argument that it is improper to infer privity in a situation where Petitioner settled a contractual dispute with Comcast.

² Ex. 2011 at p. 15 l. 14 - 16, l. 3.

³ Ex. 2006 at 125.

⁴ Ex. 2010 at 6.

⁵ *Supra* n.3.

Opp. 7-8. The parties are free to argue the various inferences from the facts presented in the light most favorable to their position. At this juncture, we do not weigh the facts to determine the likelihood that Petitioner and Comcast were privies in the relevant time period. Doing otherwise puts Patent Owner in a precarious situation of having the burden to prove its contention in order to seek the evidence that supports that contention.

ORDER

Accordingly, it is hereby:

ORDERED that Petitioner shall produce:

Agreement(s) between Arris and Comcast under which Comcast requested indemnification for the claims brought against Comcast in the Texas Litigation that reference (or are contingent on) Arris's ability to control the litigation

FURTHER ORDERED that the Petitioner is authorized to file a motion for protective order pursuant to the guidance provided in our Order dated July 2, 2014, Paper 9, in this proceeding.

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