

Filed: April 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUGHES NETWORK SYSTEMS, LLC
and HUGHES COMMUNICATIONS, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2015-00059
Patent 7,916,781

**PATENT OWNER'S REQUEST FOR ROUTINE DISCOVERY AND
MOTION FOR ADDITIONAL DISCOVERY**

TABLE OF CONTENTS

I. REQUEST FOR RELIEF 1

II. FACTUAL BACKGROUND..... 3

III. REASONS FOR GRANTING RELIEF..... 4

 A. Cross-Examination of Timothy Jezek..... 5

 B. Request for Production No. 1 and Interrogatory No. 3..... 6

 C. Request for Production No. 2..... 8

 D. Request for Production Nos. 3-5 and Interrogatory No. 2..... 9

 E. Interrogatory No. 1 and Deposition Notice..... 13

IV. CONCLUSION..... 15

V. EXHIBIT LIST..... 16

I. REQUEST FOR RELIEF

Pursuant to the Board's March 25, 2015 authorization (Ex. 2017) for "a motion for additional discovery that is limited to the issue of whether the DISH entities are un-named real parties-in-interest," the patent owner, Caltech, hereby requests that the Board set a time for routine discovery under 37 C.F.R. § 42.51(b)(1)(ii) and further moves for limited additional discovery pursuant to 37 C.F.R. § 42.51(b)(2)(1). In particular, Caltech requests that the Board authorize the following discovery, as set forth in Patent Owner's First [Proposed] Discovery Requests to Petitioner, submitted as Exhibit 2018¹

Request for Production No 1: Documents and things reviewed or considered by Timothy Jezek in conjunction with preparation of the Declaration of Timothy Jezek in Support of Petitioners' Reply Brief Regarding Identification of Real Parties-in-Interest, dated March 18, 2015 (Exhibit 1070).

Request for Production No. 2: Legal bills issued by Baker Botts L.L.P. and/or Wilmer Cutler Pickering Hale and Dorr LLP to Hughes, EchoStar, and/or DISH for services rendered in connection with the

¹ As explained below, Exhibit 2018 is a copy of the proposed discovery requests Caltech sent to Hughes in an attempt to resolve this issue without the need to bring this motion. While this representative set of requests lists U.S. Patent No. 7,961,781 and IPR 2015-0059, Caltech moves for identical discovery in all six IPRs brought by Hughes (IPR2015-00059, 060, 061, 067, 068, and 081).

preparation and filing of (1) the petitions in the Hughes IPRs and (2) Defendants' Invalidation Contentions in the Hughes/DISH District Court Litigation, dated May 15, 2014 (see Caltech IPR Ex. 2012), including documents sufficient to identify the entity that remitted payment for the legal services and the entity that paid the filing fees for the Hughes IPR petitions, whether directly or indirectly.

Request for Production No. 3: Indemnification agreements between DISH and Hughes, or between EchoStar and DISH, relating to the Hughes IPRs.

Request for Production No. 4: Communications between Hughes, or Hughes' IPR counsel, and DISH, or counsel for DISH, concerning the Hughes IPRs, including communications concerning drafts of the petitions for the Hughes IPRs, approval to file the petitions, IPR strategy, or the prior art cited in the petitions.

Request for Production No. 5: Instructions by, or agreements involving, Hughes or DISH, or counsel for either of those parties, to isolate or wall off work on the Hughes IPRs from work on the Hughes/DISH District Court Litigation.

Interrogatory No. 1: Please provide the names of individuals at Hughes, EchoStar, or DISH with decision-making authority with respect to the Hughes IPRs or the Hughes/DISH District Court Litigation.

Interrogatory No. 2: Please state whether Hughes or DISH, or counsel for either of those parties, ever communicated any instructions or agreement to isolate or wall off work on the Hughes IPRs from work on the Hughes/DISH District Court Litigation.

Interrogatory No. 3: Please identify any documents and things produced in response to Request for Production No. 1.

Cross-Examination Notice: To the extent the Board determines that the Declaration of Timothy Jezek (Ex. 1070) is not unauthorized

testimony that should be struck or expunged from the record, please produce for cross-examination Timothy Jezek. Any cross-examination conducted pursuant to this notice shall be at a time and place as may be agreed by the parties or as may be ordered by the Board.

Deposition Notice: Please produce for deposition individuals identified in response to Interrogatory No. 1. Any depositions conducted pursuant to this notice shall be at a time and place as may be agreed by the parties or as may be ordered by the Board.

II. FACTUAL BACKGROUND

Caltech explained in its preliminary response the numerous reasons why DISH Network Corporation, DISH Network L.L.C., and dishNET Satellite Broadband L.L.C. (collectively “DISH”), as well as EchoStar Corporation, should have been named as real parties-in-interest along with the petitioner, Hughes. The Board held a telephonic hearing regarding the real party-in-interest issue on February 25, 2015, during which Hughes effectively conceded EchoStar is a real party-in-interest. *See* Ex. 2016, 18:22-23. Following that hearing the Board authorized additional briefing directed to the issue of whether the three DISH entities should have been named real parties-in-interest in the petitions. Ex. 2015. Hughes and Caltech submitted their respective briefs on March 18, 2015. Paper Nos. 15, 16.

In support of its brief, and without prior authorization from the Board, Hughes filed a declaration provided by Timothy Jezek, identified as in-house counsel at Hughes. Ex. 1070. Among other assertions, the declaration states that the decision to file the petition was made entirely by Petitioners’ in-house counsel

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