

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,  
Patent Owner.

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Case IPR2015-00059  
Patent 7,916,781 B2

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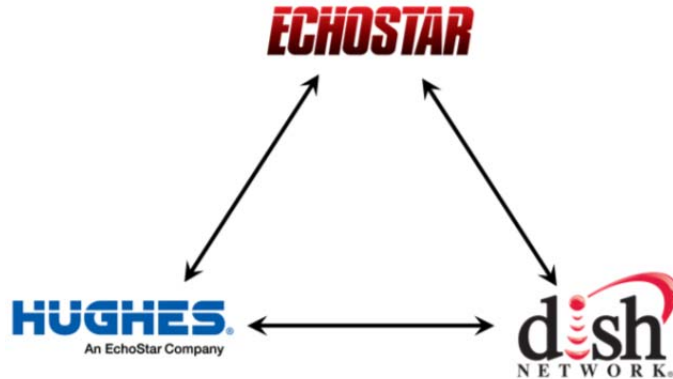
Before KALYAN K. DESHPANDE, GLENN J. PERRY, and  
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

PERRY, *Administrative Patent Judge*.

DECISION ON MOTION  
Granting in Part Patent Owner's Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

## INTRODUCTION

In its Preliminary Response (Paper 13) California Institute of Technology (“Patent Owner”) argued that Hughes (“Petitioner”) failed to name all real parties in interest. The following figure is reproduced from page 9 of Patent Owner’s Preliminary Response.



The figure portrays relationships among various entities, collective referred to as the “Echostar” entities, for convenience.

The panel authorized additional briefing on the issue of unnamed real parties in interest. In response, Petitioner (Paper 15) and Patent Owner (Paper 16) filed briefs. Petitioner also filed, without authorization and in support of Paper 15, a Declaration of T. Jezek, in house Intellectual Property Counsel of Hughes Network Systems, LLC. Ex. 1070.

Pursuant to panel authorization, Patent Owner filed a Motion for Discovery from Petitioner. Paper 17 (“Mot.”). Petitioner opposes. Paper 20. In its motion, Patent Owner seeks: 1) documents and things reviewed by Timothy Jezek in conjunction with preparation of declaration filed as Ex. 1070; 2) legal bills issued to Hughes, EchoStar, and/or DISH related to both the related District Court litigation and IPR proceedings; 3) indemnification agreements among the Echostar entities; 4) communications concerning drafts of IPR petitions, strategy and prior art cited in the IPR petitions; 5)

instructions and agreements relating to walling off work on the IPR proceedings from work on the District Court litigations; and 6) names of individuals at the EchoStar entities with decision making authority regarding the IPR proceedings and District Court litigation. Patent Owner also asks that we expunge the unauthorized declaration and, in the event we do not expunge the declaration, grant discovery related to it including cross-examination of Mr. Jezek.

Patent Owner explained in its preliminary response (Paper 13) reasons why it considered DISH Network Corporation, DISH Network L.L.C., and dishNET Satellite Broadband L.L.C. (collectively “DISH”), as well as EchoStar Corporation to be real parties-in-interest along with the petitioner, Hughes. The Board held a telephonic conference regarding the real party-in-interest issue on February 25, 2015, during which Hughes effectively conceded EchoStar is a real party-in-interest. Ex. 2016, 18:22-23. Footnote 1 of our Decision to Institute (Paper 18) indicates that we consider EchoStar Corporation, parent of Hughes Communications, Inc., to be a real party in interest.

Patent Owner notes that aside from Mr. Jezek’s declaration, Hughes has not provided evidentiary support for its contention that it properly named the real parties-in-interest beyond a single exhibit containing a portion of a motion for summary judgment filed by Hughes and DISH in one of the related district court cases.

Patent Owner argues that its requests are “in the interests of justice” as required by 37 C.F.R. 42.51(b)(2)(i); its discovery requests are narrowly tailored to the issue of whether the DISH entities should have been named as real parties-in-interest, and take into consideration the five factor test applied

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in *Garmin Int'l, Inc. et al v. Cuozzo Speed Techs. LLC*, IPR2012-00001 (Decision on Motion for Additional Discovery March 5, 2013) (identifying factors (i) more than a possibility and mere allegation; (ii) litigation positions and underlying basis, (iii) ability to generate equivalent information by other means, (iv) easily understandable instructions, and (v) requests not overly burdensome to answer). Paper 17.

Petitioner opposes the Motion, arguing that Patent Owner's requests are founded on mere speculation and that the requests are not necessary in the interests of justice. Paper 20.

#### DISCUSSION

On this record, Patent Owner's requests are more sweeping than appropriate in view of the Garmin factors. Nevertheless, in view of the importance of 35 U.S.C. § 312(a)(2), we deem some of Patent Owner's requests to be appropriate and in the interests of justice. Correctly naming real parties in interest is a threshold issue for granting a petition for *inter partes* review. The Board has vacated decisions to institute trial upon deciding that a real party in interest had not been identified in the petition.

The Jezek declaration was unauthorized. As such it will be expunged. Patent Owner's requests for discovery related to the Jezek declaration are moot and, therefore, denied.

We have already determined that EchoStar is a real party in interest. The only question remaining is whether DISH is a real party in interest. The most significant factor related to our determination is whether DISH exercised control over the IPR proceedings. We, therefore, authorize discovery that is more limited than requested. Discovery is limited to

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documents in the possession of EchoStar and Hughes to limit burden on Petitioner.

We authorize discovery of legal bills that demonstrate involvement of DISH in any of the IPR proceedings. We further authorize discovery of communications from DISH (not from other entities) related to drafts and approvals of IPR petitions. Limiting Patent Owner's requests in this manner strikes a balance between unduly burdening Petitioner while still allowing for the discovery of key documents that may resolve the issue of unnamed real parties in interest.

At this time, the remainder of Patent Owner's requests are denied without prejudice.

Should any of the documents Petitioner is required to produce be business confidential, Petitioner is authorized to seek an appropriate protective order.

#### ORDER

Accordingly, it is:

ORDERED that the Jezek declaration (Ex. 1070) be expunged;

FURTHER ORDERED that Petitioner shall produce documents in the possession of EchoStar and Hughes as follows:

1) legal bills demonstrating DISH involvement in the IPR proceedings, and 2) communications from DISH (not from other entities) related to drafts and approvals of IPR petitions;

FURTHER ORDERED that the remainder of Patent Owner's requests are denied without prejudice;

FURTHER ORDERED that Petitioner is authorized to file a motion for a protective order.

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