

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

Patent Owner.

IPR2015-00059 (Patent 7,916,781)

PETITIONERS' MOTION FOR DISCOVERY

On September 4, 2015 the Board authorized Petitioners to file this motion for discovery pursuant to 37 C.F.R. §§ 42.51 and 42.52.

INTRODUCTION

Petitioners seek to obtain limited discovery from the authors of the prior art publication that forms the basis for the ground upon which this Trial was instituted. In particular, Petitioners seek limited document discovery and testimony from Dr. Dariush Divsalar and Dr. Robert McEliece regarding the fact of publication of their paper: “Coding Theorems for ‘Turbo-Like’ Codes,” (the “Divsalar Reference”), which was published in the Proceedings of the Thirty-Sixth Annual Allerton Conference of Communication, Control and Computing. *See* Ex. 1011. Both Dr. Divsalar and Dr. McEliece are affiliated with the Patent Owner (California Institute of Technology).¹ Dr. McEliece is a named inventor on the ‘781 Patent, which is at issue in this Trial.

This request is in the interest of justice because the discovery will allow Petitioners to develop a fair record, and will aid the Board in deciding the merits of this Trial. *See* Trial Practice Guide (77 Fed. Register 48756, 48761) § I(F) (“Discovery is a tool to develop a fair record and to aid the Board in assessing the credibility of the witnesses”).

¹ *See* <http://coding.jpl.nasa.gov/index.php/ddivsalar> & <http://www.ee.caltech.edu/EE/Faculty/rjm/>. JPL is a division of the California Institute of Technology. <http://www.caltech.edu/content/jet-propulsion-laboratory>. Patent Owner has also indicated an intent to rely on Dr. Divsalar as a testifying expert witness in the District Court litigation

As an initial matter, the discovery sought by Petitioners is “Routine Discovery” that should have already been provided by Patent Owner pursuant to 37 C.F.R. § 42.51(b)(1)(iii). The information sought (information regarding publication of the Divsalar Reference) is inconsistent with a position advanced by Patent Owner in its response. *See* PO Response (Paper 24) at 25 (Patent Owner arguing that Petitioners’ evidence “fail[s] to establish the public availability of Divsalar as 102(b) prior art.”). While Patent Owner has carefully avoided making an affirmative statement that the Divsalar Reference is *not* a prior art publication, its argument asks the Board to avoid reaching the merits of the validity of the challenged claims based on the date of public availability of the Divsalar Reference. Accordingly, Petitioners are entitled to limited discovery from the Patent Owner’s witnesses regarding publication of the Divsalar Reference under the Routine Discovery standard.

Moreover, the discovery sought by Petitioners is appropriate under the Additional Discovery standard of 37 C.F.R. § 42.51(b)(2), because the discovery is in the interests of justice. As explained below, Petitioners’ proposed discovery satisfies all of the *Garmin* factors, and the discovery will assist the Board in determining whether the Divsalar Reference is a prior art publication, which is an important issue in this Trial -- indeed, Patent Owner devotes over eight pages of its Response to the issue. *See* PO Resp. (Paper 24) at 20-29. While Patent Owner might prefer to avoid the merits of this Trial by suggesting that the Divsalar

Reference is not prior art, while shielding from discovery the authors of that very document, such a result would not be in the interests of justice. Instead, this discovery should be permitted, so that the Board can have before it this highly relevant evidence when rendering its Final Written Decision.

I. PROPOSED DISCOVERY

Petitioners seek to take the following discovery from each of Dr. Dariush Divsalar and Dr. Robert McEliece (the “Witnesses”):

A. DEFINITIONS:

“Documents” shall mean all forms of recording information, including emails.

“Divsalar Reference” shall mean: “Coding Theorems for ‘Turbo-Like’ Codes” by Dariush Divsalar, Hui Jin, and Robert J. McEliece.

B. DOCUMENT REQUESTS

1. All Documents reflecting or referring to your submission of the Divsalar Reference for publication.
2. All Documents reflecting or referring to availability of the Divsalar Reference to members of the public.
3. All Documents reflecting or referring to publication of the Divsalar Reference.

C. DEPOSITION

Petitioners seek no more than 2 hours of deposition testimony with each Witness regarding the documents produced in response to this discovery request, and regarding the submission, presentation, and publication of the Divsalar Reference.

II. ARGUMENT

A. PETITIONERS ARE ENTITLED TO THE PROPOSED DISCOVERY BECAUSE IT IS “ROUTINE DISCOVERY”

A party to a Trial is required to serve on the opposing party as “Routine Discovery” any “relevant information that is inconsistent with a position advanced by the party during the proceeding.” 37 C.F.R. § 42.51(b)(1)(iii). This requirement extends to “inventors.” *Id.* Here, the discovery sought from at least Dr. McEliece qualifies as Routine Discovery, because Dr. McEliece is an inventor of the challenged patent, and the information sought is inconsistent with the position taken by Patent Owner in its Response.

As discussed above, Patent Owner devoted over eight pages of its Response to arguing that there was insufficient evidence to conclude that the Divsalar Reference qualifies as a prior art publication under 102(b). *See* PO Resp. (Paper 24) at 20-29. However, Dr. McEliece is likely to have in his possession documents that would be inconsistent with Patent Owner’s argument. For instance, Dr.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.