

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 OPPOSITION
TO PETITIONER'S MOTION FOR DISCOVERY**

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I. PRECISE STATEMENT OF RELIEF REQUESTED

On September 10, 2015, Petitioner filed its motion for additional discovery, seeking to compel document discovery and testimony from Dr. Dariush Divsalar and Dr. Robert McEliece. For at least the reasons set forth below in Patent Owner's ("Caltech") opposition, Petitioner fails to demonstrate the requested discovery is in the interests of justice. The motion should be *denied*.

II. INTRODUCTION

In view of the materials presented in the petition, the Board instituted trial based on the understanding that 1) the "Divsalar Reference" (Ex. 1011) was published *at* the 36th Annual Allerton Conference (Paper 18 pp. 11-12); and 2) that Petitioner's lone witness regarding the reference's alleged publication, the librarian Ms. Fradenburgh, was an available witness in this proceeding (*id.* at 11). As set forth in Caltech's Patent Owner Response, both of those bases have been demonstrated as false. Paper 24 ("PO Response") pp. 20-29.

With its case now in doubt, Petitioner seeks authorization to embark on a late-stage discovery campaign it speculates might reconstruct the unpatentability case it was required to set forth in the original petition. Not only does Petitioner fail to demonstrate the requested discovery is in the interest of justice, but Petitioner's representations actually illustrate fundamental misapprehensions regarding the scope of an *inter partes* review and of the underlying legal issue. *Inter partes* review is strictly limited to prior art patents and publications; it does not contemplate some version of notice pleading in a petition followed by a

discovery campaign attempting to substantiate the pleaded case. *See* 35 U.S.C. § 312(a)(3). Moreover, it is impossible to reconcile Petitioner's claims that 1) the Divsalar Reference was sufficiently available to the public and, therefore, a printed publication as asserted; but 2) information about the alleged public availability of the Divsalar Reference is uniquely in the hands of only one or two individuals. In other words, if only Dr. Divsalar and Dr. McEliece were aware of the reference's availability, then the reference could not have been broadly available such that members of the public exercising reasonable diligence could locate it. Petitioner represents that despite its extraordinary diligence, it has been unable to locate any member of the public to substantiate its assertion of public availability.

The record demonstrates, and Petitioner's arguments in its motion underscore, that the Divsalar Reference was not publicly available 102(b) prior art as set forth in the petition. Petitioner's request is simply a belated and untimely attempt to cure defects in its case-in-chief as set forth in the petition. Moreover, Petitioner's stated need for discovery is due to its strategic choice in refusing to make its witness, Ms. Fradenburgh, available for cross-examination. Petitioner's motion for discovery seeks a "do-over" to search for information it speculates might exist so as to belatedly fix the deficiencies in its petition, as well as excuse its failure to produce its own witness. In view of these reasons and as further set forth below, including the undue burden the requests would place on the Board, Caltech, and the proposed witnesses, the requests should be denied.

III. LEGAL STANDARDS

A petitioner bears the burden of “mak[ing] a sufficient showing that [a purported prior art reference] is a printed publication, i.e., that it was publicly accessible.” *Square, Inc. v. Unwired Planet, LLC*, CBM2014-00156, Paper 11 at 19-20 (Dec. 24, 2014) (citing *In re Lister*, 583 F.3d 1307, 1317) (Fed. Cir. 2009); *see also Nestle Oil Oyj v. Reg Synthetic Fuels, LLC*, IPR2013-00578, Paper 54 at 15 (March 12, 2015). This burden must be satisfied in the petition. *See, e.g., Symantec Corp. v. Trustees of Columbia University*, IPR2015-00370, Paper 13 at 9 (June 17, 2015) (denying institution for failure of proof on publication date in the petition); *see also Medtronic, Inc. v. Endotach LLC*, IPR2014-00695, Paper 18 at 9 (Sept. 25, 2014) (noting that petitioner’s “burden to make its case” requires that the petitioner anticipate reasonable positions a patent owner may take in response and “adequately address such positions in its Petition as needed”).

A party seeking additional discovery has the burden of demonstrating that the additional discovery is “necessary in the interest of justice.” 37 C.F.R. § 42.51(b)(2); *Garmin Int’l Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (Mar. 5, 2013). “That is significantly different from the scope of discovery generally available under the Federal Rules of Civil Procedure.” *Garmin*, IPR2012-00001, Paper 26 at 5.

IV. THE REQUESTED DISCOVERY IS AN UNTIMELY ATTEMPT TO CURE A DEFECT IN THE PETITION

Petitioner bears the burden of establishing in its petition the asserted case for unpatentability, but its motion for discovery makes clear that it failed to do so.

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