

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 IPR2015-00635
Patent 5,563,883

Before MIRIAM L. QUINN, *Vice Chief Administrative Judge*, and
LYNNE E. PETTIGREW, *Administrative Patent Judge*.

PETTIGREW, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On April 2, 2015, a conference call was held, at the request of Patent Owner, C-Cation Technologies, LLC, between counsel for Petitioner, ARRIS Group, counsel for Patent Owner, and Judges Quinn and Pettigrew. During the call, counsel for Patent Owner explained that it seeks discovery of agreements between Petitioner and Comcast Corporation relating to a

IPR2015-00635
Patent 5,563,883

lawsuit filed in January 2011 by Patent Owner against Comcast, titled *C-Cation Technologies, LLC v. Comcast Corp.*, Case No. 2:11-cv-00030 (E.D. Tex.). Patent Owner seeks to prove that the Petition is time-barred under 35 U.S.C. § 315(b) based on privity between Petitioner and Comcast. Patent Owner indicated it seeks the same discovery that was requested and ordered by the Board in *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00746 (PTAB July 24, 2014) (Paper 15), involving the same parties and the same patent as this case. In IPR2014-00746, in a decision instituting *inter partes* review, the Board determined that, based on the evidence presented at that stage of the proceeding, § 315(b) did not bar institution of *inter partes* review. *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00746, slip op. at 8–10 (PTAB Nov. 24, 2014) (Paper 22). Ultimately, Patent Owner disclaimed the one claim for which review was instituted, and the Board granted Patent Owner’s request for adverse judgment. *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00746 (PTAB Feb. 18, 2015) (Paper 28).

On the call, Petitioner stated that it opposes Patent Owner’s requested discovery on two grounds: (i) administrative res judicata, and (ii) estoppel under 42 C.F.R. § 42.73(a). Essentially, Petitioner contends that Patent Owner’s requested discovery is not appropriate because Patent Owner is estopped from litigating the privity issue in this proceeding.

After hearing from both parties, we determine that Patent Owner’s motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances. In its motion, Patent Owner should explain explicitly what discovery is requested and why it believes such discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5)(B); 37 C.F.R.

IPR2015-00635
Patent 5,563,883

§ 42.51(b)(2)(i). The parties are directed to *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26), for guidance regarding motions for additional discovery.

To the extent Patent Owner's motion or Petitioner's opposition includes information believed to be confidential, the parties may file redacted and unredacted versions, along with a motion to seal. Prior authorization to file a motion to seal is not required. The motion to seal must explain the basis for every redaction made. A party opposition to the motion to seal should explain why it believes the material should not be sealed.

The parties are encouraged to agree on the terms of a proposed protective order that, if entered, would provide appropriate protections to ensure confidentiality. To the extent the parties believe additional protections are necessary beyond those provided for in the Board's default protective order, the parties may include such protections in the proposed protective order. If the proposed protective order differs from the Board's default protective order in any way, the motion should identify specifically how the two protective orders differ and explain why such changes are warranted. A separate redlined version of the proposed protective order showing the differences between the default protective order and the proposed protective order also should be filed with the motion.

IPR2015-00635
Patent 5,563,883

ORDER

Accordingly, it is:

ORDERED that Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2), no later than April 8, 2015, limited to eight (8) pages;

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner's motion, no later than April 14, limited to eight (8) pages; and

FURTHER ORDERED that Patent Owner is authorized to file a reply, if necessary, no later than April 17, limited to five (5) pages.

FOR PETITIONER:

Andrew R. Sommer
Jonathan E. Retsky
WINSTON & STRAWN LLP
asommer@winston.com
jretsky@winston.com

FOR PATENT OWNER:

Lewis V. Popovski
Jeffrey S. Ginsberg
David J. Kaplan
David J. Cooperberg
KENYON & KENYON LLP
lpopovski@kenyon.com
jginsberg@kenyon.com
djkaplan@kenyon.com
dcooperberg@kenyon.com