

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ACTIFIO, INC.,  
Petitioner,

v.

DELPHIX CORP.,  
Patent Owner.

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IPR2015-00014 (Patent 8,150,808 B2)  
IPR2015-00016 (Patent 8,150,808 B2)  
IPR2015-00019 (Patent 8,150,808 B2)  
IPR2015-00025 (Patent 8,161,077 B2)  
IPR2015-00026 (Patent 8,161,077 B2)  
IPR2015-00034 (Patent 8,150,808 B2)  
IPR2015-00100 (Patent 8,566,361 B2)  
IPR2015-00108 (Patent 8,566,361 B2)  
IPR2015-00128 (Patent 8,468,174 B1)

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Before HOWARD B. BLANKENSHIP, JENNIFER S. BISK,  
PATRICK R. SCANLON, and MINN CHUNG, *Administrative Patent  
Judges.*

BISK, *Administrative Patent Judge.*

DECISION  
Motion to Compel Routine Discovery  
*37 C.F.R. § 42.51(b)*

Petitioner filed a Motion to Compel Patent Owner to Provide Routine Discovery under 37 C.F.R. § 42.51(b)(1)(iii) in each of the proceedings listed above.<sup>1</sup> Paper 20 (“Mot.”).<sup>2</sup> Patent Owner filed an opposition. Paper 22 (“Opp”).

Petitioner’s Motion seeks production of:

1. A PowerPoint presentation delivered by Mr. Jedidiah Yueh, CEO of Patent Owner and co-inventor of its patents, dated March 2010, that discusses the creation of a “virtual database” using pointers to already existing blocks of a source database (produced in the co-pending district court case with production numbers DPHX00009175-87 and designated highly confidential);
2. A document authored by key Delphix engineers that discusses disk blocks and use of those blocks by VDBs (produced in the co-pending district court case with production numbers DPHX00477138-141 and designated highly confidential).

Mot. 2. Petitioner contends that these documents are plainly inconsistent with several statements Patent Owner makes in support of its Patent Owner Response. *Id.* at 1. Specifically, Petitioner argues that both documents discuss Patent Owner’s commercial product, which allegedly practices all of the challenged independent claims. According to Petitioner, the first document shows that Patent Owner’s product creates virtual databases in a manner that is “irreconcilable” with Patent Owner’s claim construction position of this term. *Id.* at 1–2. In addition, Petitioner asserts that the

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<sup>1</sup> We authorized the Motion in an Order on September 23, 2015. Paper 19.

<sup>2</sup> Unless otherwise indicated, all references are to papers in IPR2014-00128.

second document describes databases accessing disk blocks, in contradiction to Patent Owner's arguments that "data block on disk . . . are never accessed, or used, by any database." *Id.* at 4.

Patent Owner responds that there is no inconsistency between the two documents and Patent Owner's statements in its Response. *Opp.* Patent Owner argues that the first document is extrinsic evidence, irrelevant to any claim construction issue as a matter of law—and, moreover, it is not inconsistent. *Id.* at 1–3. Patent Owner also argues that the second document describes internal features of the described products' *file system not database* and thus is irrelevant to the issue identified by Petitioner. *Id.* at 3–4. Finally, Patent Owner asserts that the two documents are highly confidential and that Petitioner's request for the documents, coming so close in time to the deposition of Patent Owner's declarant, will unnecessarily increase the complexity of these proceedings. *Id.* at 4–5.

On this record, we are persuaded that these two documents are within the routine discovery that is contemplated by our rules. *See* 37 C.F.R. § 42.51(b)(1)(iii)(b) ("Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency."). Moreover, we are not persuaded that producing these documents presents a significant burden on Patent Owner.

We are sensitive to Patent Owner's concerns about confidentiality, and note that neither document need be filed with the Board until such time that a party seeks to rely on its contents as evidence. If that situation should arise, the parties are authorized to file a motion to seal along with a joint proposed protective order. The proposed protective order may be the

Board's default protective order or it may deviate from that order, in which case the motion must also identify specifically how the proposed order departs from the default order, explain why every change is warranted, and include with the motion a separate redlined version of the proposed protective order showing the differences. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48760–61, 48771 (Aug. 14, 2012).

It is

ORDERED that Petitioner's motion is *granted*;

FURTHER ORDERED that Patent Owner shall produce to Petitioner the two documents listed above at a mutually agreed upon time prior to the deposition of Dr. Shenoy.

PETITIONER:

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