

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 IPR2014-00746
Patent 5,563,883

Before KRISTEN L. DROESCH, KALYAN K DESHPANDE, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

On June 26, 2014, a conference call was held, at the request of Patent Owner, C-Cation Technologies, between counsel for Petitioner, Arris Group, counsel for Patent Owner, and Judges Quinn, Droesch, and Deshpande. During the call, counsel for Patent Owner explained that it seeks discovery of certain alleged agreements between Petitioner and Comcast in related litigation *C-Cation Techs., LLC v. Comcast Corporation*, No. 2:11-cv-00030 (E.D. Tex.) (“2011 Texas litigation”) to prove that Arris Group was in privity with Comcast. Patent Owner asserts that additional discovery would be proper based on the following arguments:

- 1) Patent Owner filed a lawsuit in January 2011 against Comcast (“the 2011 litigation”), but Petitioner, Arris Group, was not a party to the 2011 litigation.
- 2) Patent Owner had the opportunity and obligation to control the 2011 Texas litigation based on the following asserted facts:
 - a) Standard terms and conditions for sale of Patent Owner’s products obtained from Petitioner’s website apparently specify that Petitioner is under a contractual obligation to indemnify its customers, and exercise “sole control” over any litigation brought against Petitioner’s customers.
 - b) Petitioner’s SEC disclosures apparently specify that Petitioner agreed to pay indemnification claims related to Comcast’s use of Petitioner’s products identified in the 2011 Texas litigation.

Patent Owner served a document request on Petitioner seeking the alleged agreement between Petitioner and Comcast that would indicate the terms of the indemnification alluded to in the SEC filings. Petitioner

objected to Patent Owner's document request. Patent Owner and Petitioner met and conferred, but an agreement could not be reached. During the conference call, Petitioner provided the following arguments to support its objections:

- 1) The indemnification information in the SEC filing does not rise to the inference of control over the 2011 Texas litigation;
- 2) The act of control is speculative based on the standard terms and conditions of the agreement;
- 3) Patent Owner's discovery request is not in "the interest of justice" (citing *Broadcom Corp. v. Tefonaktiebolaget LM Ericsson (PUBL)*, Case IPR 2013-00601, Paper 9 (PTAB, December 11, 2013) on the basis that the requested document(s) will not yield useful information; and
- 4) The alleged document, if it exists, is confidential and will include contractual terms that are irrelevant to the sought-after indemnification provisions.

After hearing from both parties, the Board granted Patent Owner's request for authorization to file a motion for the discovery of the indemnification agreement. First, however, the panel requested the parties to meet and confer again to discuss whether the parties could agree to the production of the indemnification agreement. The parties were again unable to reach an agreement.

Having determined that Patent Owner's motion for additional discovery of the document under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances, we alert Patent Owner that its motion should explain why

it believes discovery of the document is “necessary in the interest of justice.” See 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The parties are directed to the order (Paper 26) in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013), for guidance regarding motions for additional discovery.

Further, to the extent Patent Owner’s motion or Petitioner’s opposition include 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.

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In consideration of the foregoing, it is

ORDERED that Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2), due by July 7, 2014 limited to eight (8) pages;

FURTHER ORDERED that Petitioner is authorized to file an opposition due by July 11, 2014, limited to eight (8) pages; and

FURTHER ORDERED that Patent Owner is authorized to file a reply, *if necessary*, due by July 16, 2014, limited to five (5) pages.

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PETITIONER:

Andrew R. Sommer
asommer@winston.com

Jonathan E. Retsky
jretsky@winston.com

PATENT OWNER:

Lewis V. Popovski
lpopovski@kenyon.com

Jeffrey S. Ginsberg
jginsberg@kenyon.com

David J. Kaplan
djkaplan@kenyon.com

David J. Cooperberg
dcooperberg@kenyon.com