

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIVERBED TECHNOLOGY, INC.,
Petitioner,

v.

SILVER PEAK SYSTEMS, INC.,
Patent Owner.

Case IPR2014-00245
Patent 8,392,684 B2

Before JUSTIN T. ARBES and HYUN J. JUNG, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on July 31, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Arbes and Jung. The call was requested by Patent Owner to (1) discuss issues regarding proposed amendments it may submit in a motion to amend, (2) seek authorization to file a motion for additional discovery, and (3) request that the trial schedule be extended.

Motion to Amend

Patent Owner stated that it intends to file a motion to amend, and will follow the presumption that “only one substitute claim would be needed to replace each challenged claim.” *See* 37 C.F.R. § 42.121(a)(3). Patent Owner requested general guidance regarding motions to amend, but did not have any specific questions at the time.

The parties are referred to *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, slip op. (PTAB June 11, 2013) (Paper 26) (“*Idle Free*”), and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00419, slip op. (PTAB Mar. 7, 2014) (Paper 32), for guidance regarding motions to amend. Entry of proposed amendments is not automatic, but only upon Patent Owner having demonstrated the patentability of the proposed substitute claims. Patent Owner in its motion should state, as to each proposed substitute claim, whether the claim is contingent on a corresponding claim in the challenged patent, U.S. Patent No. 8,392,684 B2 (“the ’684 patent”), being determined to be unpatentable.

We also reminded Patent Owner that it should explain in its motion why the proposed substitute claims are patentable over not just the prior art of record, but also prior art not of record but known to Patent Owner:

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner. Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims.

Idle Free at 7. This includes addressing the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular item of prior art. *Id.* at 7–8.

Finally, we reminded Patent Owner that its motion to amend must set forth clearly “(1) [t]he support in the original disclosure of the patent for each claim that is added or amended; and (2) [t]he support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” *See* 37 C.F.R. § 42.121(b).

Motion for Additional Discovery

Patent Owner sought authorization to file a motion for additional discovery of information about a product allegedly sold by Petitioner: the Riverbed Optimization System (“RiOS”) software used on Petitioner’s SteelHead appliance. According to Patent Owner, the product practices the disclosure of U.S. Patent Application Publication No. 2004/0088376 A1 (Ex. 1003) (“McCanne”), one of the prior art references asserted in this

proceeding. Patent Owner argued that information about the product, and the introduction of a particular feature into the product, is relevant to (1) what a person of ordinary skill in the art would have understood the McCanne reference to disclose, and (2) secondary considerations of nonobviousness (for both the existing claims of the '684 patent and Patent Owner's proposed substitute claims), such as copying, commercial success, and long felt need. Patent Owner stated that it had located some materials about the product from various sources, but needs additional information as well.

Petitioner opposed Patent Owner's request, arguing that the information sought is irrelevant to the anticipation ground in this proceeding because the issue for that ground is what the McCanne reference discloses, not what a later commercial product does. Petitioner further argued that Patent Owner cannot establish that Petitioner's product practices what is disclosed in the McCanne reference, and that Patent Owner's request is based only on speculation regarding Petitioner's product.

We took the matter under advisement, and requested that Patent Owner provide by email after the call the specific materials it would seek in a motion for additional discovery. Patent Owner provided the following:

The following requests for production of documents:

1. Copies of [Petitioner's] specifications and requirements documents for the Data Store encryption functionality in RiOS version 4.1 for [Petitioner's] Steelhead appliance.
2. Copies of [Petitioner's] documents attributing to a lack [of] disk encryption in [Petitioner's] Steelhead appliance (in whole or in part) potential lost sales or customer dissatisfaction.

3. Copies of [Petitioner's] documents lauding the Data Store encryption functionality in [Petitioner's] Steelhead products or criticizing the lack of similar functionality in competitors' [products].

A deposition of Petitioner covering these topics:

1. [Petitioner's] reasons for adding the Data Store encryption functionality to [Petitioner's] Steelhead appliance, its initial research, and development.

2. The significance of Data Store encryption functionality to the commercial or competitive success of [Petitioner's] Steelhead products.

3. The documents [Petitioner] produced in response to Patent Owner's requests and their authenticity.

After further consideration, we are persuaded that a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances, but should be limited in two respects. First, we are not persuaded that information about Petitioner's product would be relevant to the asserted ground of anticipation of claims 1, 2, 7–9, 14–16, and 21–24 of the '684 patent. As Petitioner correctly pointed out, whether the McCanne reference anticipates the claims depends only on the disclosure of the McCanne reference. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255-56 (Fed. Cir. 1989) (“Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference.”). Patent Owner has not explained sufficiently how the information about Petitioner's later commercial product would be relevant to that analysis. Accordingly, any request by Patent Owner shall be limited to materials that would show secondary considerations of nonobviousness (e.g., for the remaining obviousness grounds applicable to claims 3–6, 10–13, and 17–20). Second,

Patent Owner has not shown a particular need for a deposition, or explained why the documents it seeks would be insufficient without a deposition of one of Petitioner's employees. Accordingly, any request by Patent Owner also shall be limited to documents only.

Patent Owner in its motion should identify specifically what documents are being requested and explain why it believes the requested discovery 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 *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. (PTAB Mar. 5, 2013) (Paper 26), for guidance regarding motions for additional discovery. In particular, the mere possibility of finding something useful and a mere allegation that something useful will be found are insufficient. Further, requests for discovery will not be granted if they are unduly broad and burdensome, or if the information sought is otherwise available to the requesting party. As explained during the call, discovery requests may be narrowed by time period, document type, or other factors to ensure that they are limited to an appropriate scope.

Schedule

Patent Owner requested that all of the due dates in the Scheduling Order (Paper 13) in this proceeding be extended so that Patent Owner may conduct its requested discovery. Specifically, Patent Owner requested that the time periods for DUE DATES 1 and 2 each be extended from two months to three months to match the "default" time periods in Appendix A-1 of the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768–69

(Aug. 14, 2012). Petitioner opposed Patent Owner's request. We took the matter under advisement.

We are not persuaded that there is sufficient reason to extend the due dates in this proceeding. Contrary to Patent Owner's argument, the time periods listed in Appendix A-1 are not automatic, as the Board "set[s] due dates for the trial taking into account the complexity of the proceeding but ensuring that the trial is completed within one year of institution." *Id.* at 48,757. We do not view the issues in this proceeding as so complex as to require three months each for DUE DATES 1 and 2. Patent Owner's delay in seeking authorization to file a motion for additional discovery and an extension of the trial schedule also weighs against granting its request. A trial was instituted on June 11, 2014, but Patent Owner waited until July 29, 2014 (nine days before DUE DATE 1, August 7, 2014) to request a conference call. Accordingly, the due dates in the Scheduling Order will not be changed at this time.

The parties are reminded, however, that they may stipulate to different dates for DUE DATES 1 through 5 in the Scheduling Order (provided the dates are no later than DUE DATE 6) and, if they do so, the parties shall file promptly a notice of the stipulation. Also, if Patent Owner's motion for additional discovery is granted and Patent Owner believes additional action is necessary to bring the materials to the Board's attention, Patent Owner may request another conference call.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied the conference requirement of 37 C.F.R. § 42.121(a);

IPR2014-00245
Patent 8,392,684 B2

FURTHER ORDERED that Patent Owner is authorized to file a motion for additional discovery, under the terms set forth herein, by August 8, 2014, limited to five pages; Petitioner is authorized to file an opposition by August 15, 2014, also limited to five pages; and no reply is authorized; and

FURTHER ORDERED that the schedule for this proceeding set forth in the Scheduling Order (Paper 13) is unchanged.

IPR2014-00245
Patent 8,392,684 B2

PETITIONER:

David M. O'Dell
Kyle Howard
HAYNES AND BOONE, LLP
david.odell.ipr@haynesboone.com
kyle.howard.ipr@haynesboone.com

PATENT OWNER:

Darren E. Donnelly
Jason E. Amsel
FENWICK & WEST LLP
ddonnelly-ptab@fenwick.com
jamsel-ptab@fenwick.com