

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,  
Petitioner,

v.

PARALLEL NETWORKS LICENSING, LLC,  
Patent Owner.

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Case IPR2015-00483 (Patent No. 5,894,554)  
Case IPR2015-00485 (Patent No. 6,415,335)

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Before KEVIN F. TURNER, JEREMY M. PLENZLER and  
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

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Pursuant to a request from Patent Owner Parallel Networks Licensing (“Parallel”), the Board convened a conference call on September 24, 2015. Parallel seeks authorization to file a motion to compel routine discovery under 37 C.F.R. §§ 42.51(b)(1)(iii) and 42.52, or in the alternative authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). A court reporter was present on the call, and Petitioner Microsoft Corporation agreed to file a copy of the transcript in the record of each case. The matters discussed during the call will be reflected in the transcript, and need not be repeated at length herein. For the following reasons, we *deny* Parallel’s requests for authorization.

*Motion to Compel Routine Discovery*

We deny authorization for Parallel to file a motion to compel routine discovery, because we consider the type of discovery sought by Parallel to not be “routine,” as defined by our Rules. Under 37 C.F.R. § 42.51(b)(1)(iii), a party is required to:

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. This requirement does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product. This requirement extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.

Parallel seeks the testimony of Dr. Daniel Andressen, in the form of live testimony during a deposition. Such information, however, cannot be “served,” as set forth in our Rule pertaining to routine discovery. Nor can live testimony be “inconsistent” with a position of a party until that

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testimony is provided during a deposition. Thus, the language and context of the Rule strongly supports the conclusion that “inconsistent information” routine discovery is directed toward documents and things, as opposed to live deposition testimony. Furthermore, the examples provided in our Trial Practice Guide support this conclusion. 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012) (“[W]here a petitioner relies upon an expert affidavit alleging that a method described in a patent cannot be carried out, the petitioner would be required to *provide any non-privileged work undertaken by, or on behalf of, the petitioner* that is inconsistent . . . .” (emphasis added)).

Because the type of information sought is outside that authorized by Rule, we conclude that Parallel would not be able to prevail on a motion to compel routine discovery of Dr. Andressen’s live cross-examination via deposition and, therefore, deny authorization of the motion.

#### *Motion for Additional Discovery*

Parallel also requests authorization to seek the deposition of Dr. Andressen as additional discovery, if we deny routine discovery. The panel discussed with the parties the requirements for additional discovery, which Parallel has the burden to show is “in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). Specifically, Parallel argued that, in its proposed motion for additional discovery, it would establish that the following *Garmin* factors have been met:

1. More Than A Possibility And Mere Allegation: The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

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2. Litigation Positions And Underlying Basis: Asking for the other party's litigation positions and the underlying basis for those positions is not necessary in the interest of justice.

3. Ability To Generate Equivalent Information By Other Means

4. Easily Understandable Instructions

5. Requests Not Overly Burdensome To Answer: Requests should be sensible and responsibly tailored according to a genuine need.

*See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26).

Parallel focused its discussion primarily on the first *Garmin* factor, explaining that it was in possession of evidence that Dr. Andressen had characterized the SWEB reference differently in the past than Microsoft is currently characterizing it to the Board in this *inter partes* review. According to Parallel, this evidence would be useful to the Board in interpreting the disclosure of the SWEB reference from the perspective of a person of ordinary skill in the art.

Upon questioning by the panel, Parallel conceded that the testimony of the author of a reference does not have particular significance, but rather is indicative of the understanding a person of ordinary skill in the art would have had of the disclosure of the reference. In other words, Parallel allegedly seeks Dr. Andressen's testimony, not as the author of the SWEB reference, but rather as a person of ordinary skill in the art at the time the invention was made.

Based on these statements, we conclude that Parallel would not be able to establish in a motion that the additional discovery sought would be in the interests of justice, and therefore we deny authorization of such a

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motion. Parallel's argument fails factor 3 of the *Garmin* test, because the information sought may be generated by other means. Parallel stated to the Board that it is retaining its own expert, who will provide testimony regarding how a person of ordinary skill in the art would have understood the SWEB reference. Furthermore, by its own admission, the testimony of Dr. Andressen would carry no extra weight merely because he is the author of SWEB. Parallel's expert will provide equivalent testimony to that sought by Dr. Andressen, without the need to grant additional discovery.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion to compel routine discovery is *denied*;

FURTHER ORDERED that Patent Owner's request for authorization to file a motion for additional discovery is *denied*.

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