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Paper 20
Entered: January 26, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL, L.L.C.,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2015-00636 (Patent 8,917,822 B2)
Case IPR2015-00637 (Patent 8,908,838 B2)

Before WILLIAM V. SAINDON, BARBARA A. BENOIT, and LYNNE E. PETTIGREW, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

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

On January 21, 2016, a conference call took place between Judges Saindon, Benoit, and Pettigrew and respective counsel for Petitioner, CaptionCall, L.L.C., and Patent Owner, Ultratec, Inc. The subject of the call was Patent Owner's request for authorization to file a motion requesting additional discovery. A court reporter was on the conference call, and the

transcript will be entered in the record of each proceeding in due course. Patent Owner represented that it had met and conferred with Petitioner concerning this matter, as requested by the Board.

Patent Owner seeks authorization to file a motion for additional discovery regarding the facts and materials on which Petitioner's declarant, Mr. Occhiogrosso, relied in forming his opinions of unpatentability in these cases and which purportedly have not been produced by Petitioner as routine discovery. *See* 37 C.F.R. § 42.51(b)(1) (Routine Discovery). Specifically, while indicating it does not seek documents subject to work-product immunity, Patent Owner seeks purported drafts of claim charts that are in the Petition filed in IPR2015-00636 (Paper 1) on January 29, 2015 and drafts of claim charts that are in the Petition filed in IPR2015-00637 (Paper 1) on the same day. Patent Owner represents that, during Mr. Occhiogrosso's depositions taken on November 12, 2015 for IPR2015-00637[1] and November 13, 2015 for IPR2015-00636[2], Mr. Occhiogrosso indicated he relied upon claim charts in the petitions in forming his opinions. Patent Owner indicates page 31, line 11 through page 37, line 9 is the relevant portion of the transcript of Mr. Occhiogrosso's deposition in IPR2015-00637 and the relevant portion of the transcript in IPR2015-00636 begins at page 19, line 19. Patent Owner now seeks production of these draft claim charts, which have not been produced by Petitioner. Patent Owner also indicates that the Board had ordered similar discovery in *Apple, Inc. v. Achates Reference Publishing, Inc.*, Case IPR2013-00080 (PTAB Jan. 31, 2014) (Paper 66).

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[1] Transcript filed as Ex. 2017.
[2] Transcript filed as Ex. 2018.

Petitioner opposes, indicating that: Patent Owner's request is untimely; the documents sought are not "routine discovery" under 37 C.F.R. § 42.51(b)(1); Patent Owner has not shown the documents would be useful; and Mr. Occhiogrosso signed his declaration close to the filing date of the petitions in each case. Petitioner also indicates that, in *Apple, Inc. v. Achates Reference Publishing, Inc.*, the Board authorized discovery of emails exchanged between two declarants, which is not the case here. *See Apple, Inc. v. Achates Reference Publishing, Inc.*, Case IPR2013-00080 (PTAB Jan. 31, 2014) (Paper 66).

Certain discovery is available in *inter partes* review proceedings. 35 U.S.C. § 316(a)(5); 37 C.F.R. §§ 42.51–53. A party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i). Illustrative factors to be considered in determining whether a discovery request meets the statutory and regulatory standards "necessary in the interests of justice" have been explained in *Garmin International, Inc. v. Cuozzo Speed Technologies, LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26 (informative). These factors are: (1) there must be more than a mere possibility of finding something useful; (2) a party may not seek another party's litigation positions or the underlying basis for those positions; (3) a party should not seek information that reasonably can be generated without a discovery request; (4) instructions and questions should be easily understandable; and (5) the discovery requests must not be overly burdensome to answer. *Id.*

As an initial matter, we note that Patent Owner first raised this issue with the Board on January 14, 2016, which is around two months after Mr. Occhiogrosso's depositions on November 12 and 13, 2015. Patent Owner contends that the issue is timely, however, because Patent Owner expects Petitioner to file a second declaration by Mr. Occhiogrosso in support of Petitioner's Reply due shortly, and so Patent Owner seeks the documents to prepare for an anticipated second deposition of Mr. Occhiogrosso. Patent Owner's argument is not persuasive because Petitioner's Reply is limited to responding to arguments raised in Patent Owner's Response. 37 C.F.R. §42.23(b) ("A reply may only respond to arguments raised in the . . . patent owner response.").

Moreover, even setting aside the procedural issue as to whether Patent Owner's request should be denied as untimely, Patent Owner's request is made nearly two months after it filed its Patent Owner's Response in each case on November 23, 2015. *See* IPR2015-00636, Paper 15; IPR2015-00637, Paper 15. Requesting these documents now, when Patent Owner lacks an opportunity to file a substantive paper addressing the documents, further weighs against the possibility that Patent Owner would find something useful in the documents.

Furthermore, Mr. Occhiogrosso signed each of his declarations on January 28, 2015, the day before the Petitions were filed. *See* IPR2015-00636, Ex. 1009, 65; IPR2015-00637, Ex. 1009, 60. This short time period weighs against the possibility that Patent Owner would find something useful in investigating prior claim chart drafts.

Accordingly, we determine that Patent Owner has not shown more than a mere possibility of finding something useful in the documents. We

also agree with Petitioner that the reasoning of the Board in *Apple, Inc. v. Achates Reference Publishing, Inc.* has limited probative value to the facts of this case. *See Apple, Inc. v. Achates Reference Publishing, Inc.*, Case IPR2013-00080 (PTAB Jan. 31, 2014) (Paper 66) (authorizing discovery of emails exchanged between declarants).

For these reasons, we determine that Patent Owner has not shown that its request is "necessary in the interests of justice." Therefore, we will not grant authorization for Patent Owner to file a motion for additional discovery seeking Petitioner's claim charts not filed with the petitions.

ORDER

Accordingly, it is:

ORDERED that Patent Owner is not authorized to file a motion to request additional discovery regarding additional claim charts in IPR2015-00636 or IPR2015-00637.

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