

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAVIUM, LLC¹
Petitioner

v.

ALACRITECH, INC.
Patent Owner

Case IPR2018-00401
Patent 7,945,699 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* FISHMAN.

Opinion Dissenting filed by *Administrative Patent Judge* SIU.

FISHMAN, *Administrative Patent Judge*.

DECISION
On Motion for Additional Discovery
37 C.F.R. §§ 42.20 and 42.51(b)(2)

¹ Cavium, Inc. filed the Petition in this matter and filed an Updated Mandatory Notice indicating its change of name to Cavium, LLC. Paper 17, 2.

I. INTRODUCTION

Pursuant to authorization granted in an Order entered October 3, 2018 (Paper 18), Alacritech, Inc. (“Patent Owner”) filed a Motion for Additional Discovery on October 11, 2018 (Paper 21, “Motion” or “Mot.”). Cavium, LLC (“Petitioner”) filed an Opposition to Patent Owner’s Motion on October 19, 2018. Paper 22 (“Opposition” or “Opp.”).

For the reasons discussed below, we grant Patent Owner’s Motion.

A. *Additional Discovery*

Under the Leahy-Smith America Invents Act (“AIA”), discovery is available for the deposition of witnesses submitting affidavits or declarations and for “what is otherwise necessary in the interest of justice.” 35 U.S.C. § 316(a)(5). Our corresponding rules allow for routine discovery providing: “[c]ross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.” 37 C.F.R. § 42.51(b)(1)(ii).

In addition to routine discovery, our rules allow for additional discovery, further providing: “[t]he moving party must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). As the movant, Patent Owner bears the burden of establishing that the request is in the interest of justice. We generally consider five factors (the “*Garmin* factors”) in determining whether the interests of justice would be served by granting additional discovery requests. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). In *Garmin*, we held that the following factors (the so-called “*Garmin* factors”) are important in determining whether additional discovery is necessary in the interest of justice:

1. More Than A Possibility And Mere Allegation — The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

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. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.

3. Ability To Generate Equivalent Information By Other Means — Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.

4. Easily Understandable Instructions — The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is *prima facie* unclear. Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.

5. Requests Not Overly Burdensome To Answer — The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests should be sensible and responsibly tailored according to a genuine need.

Id.

B. Real Parties-In-Interest, Privies, And Time Bar

The AIA requires that “[a] petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” 35 U.S.C. § 312(a). In addition, “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Our corresponding rules allow any “person who is not the owner of a patent” to file a petition unless “[t]he petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.” 37 C.F.R. § 42.101.

II. DISCUSSION

A. Summary Of Patent Owner’s Position

Patent Owner’s Motion requests additional discovery “regarding the real parties in interest (‘RPIs’) to this petition—namely, Dell, Inc., and . . . the Wistron entities and the CenturyLink entities that PO sued for infringement in the Eastern District of Texas (collectively ‘Defendant Customers’).” Mot. 1. Patent Owner broadly characterizes the documents sought as “documents memorializing the timing, nature and scope of the established indemnity and defense coordination relationships between the Petitioners and Defendant Customers.” Mot. 6.

Patent Owner argues the documents sought are critical because the filing date of the Petition in these cases is more than a year after the Defendant Customers were served with a complaint alleging infringement. Mot. 5. Therefore, if the Defendant Customers are in fact RPIs or privies of Petitioner, this

Petition may be barred under 35 U.S.C. § 315(b). Thus, Patent Owner contends additional discovery is needed because “[t]wo recent Federal Circuit cases² have changed the PTAB’s required RPI analysis.” Mot. 2. Patent Owner asserts that, in *AIT*, the Federal Circuit held that determining a real party in interest relationship “requires a ‘flexible approach’” and requires the Board to “consider . . . the entirety of the record” and “to ‘meaningfully examine’ the relationship between the entities.” Mot. 2–3.

Patent Owner argues all five *Garmin* factors weigh in favor of granting the motion. Mot. 5–10. We consider these arguments below.

B. Summary Of Petitioner’s Position

Petitioner opposes the Motion and argues: the Motion is untimely (Opp. 2–3); Dell, Inc. is not a real party-in-interest in these cases (Opp. 3–4); and the *Garmin* factors weigh against granting the Motion (Opp. 4–8). Petitioner further argues *AIT* and *Bungie* did not change the law to *require* the Board grant additional discovery and cites *Wi-Fi One*³ as supporting its position that additional discovery is not mandated. Opp. 8.

C. Analysis

1. *AIT Clarifies The Required Analysis Regarding RPI And Privity*

We agree with Petitioner that neither *AIT* nor *Bungie* changed the law to mandate that the Board unconditionally grant additional discovery. Our rules stand

² *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. July 9, 2018), *reh’g en banc denied*, Nos. 2017-1698, 2017-01699, 2017-1701 (Fed. Cir. Oct. 23, 2018) (“*AIT*”) and *Worlds, Inc. v. Bungie, Inc.*, 903 F.3d 1237 (Fed. Cir. Sept. 7, 2018) (“*Bungie*”).

³ *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1338-41 (Fed. Cir. 2018).

unchanged requiring that a moving party must demonstrate that the requested additional discovery would be in the interests of justice and further provide that the Board may specify other conditions for such discovery. *See* 37 C.F.R.

§ 42.51(b)(2). We agree that the Board has the discretion to grant or deny a motion for additional discovery in an *inter partes* review based on whether the moving party has shown that the requested discovery is necessary in the interest of justice.

However, *AIT* does substantively address the Board's evaluation of RPI and privity issues. Prior to *AIT*, our analysis of RPI and privity issues had frequently focused principally on an entity's control, or opportunity to control, a proceeding before the Board. In earlier related cases decided by this panel, this panel analyzed arguments relating to the alleged RPI status of Dell (one of the Defendant Customers), based principally on whether Dell controlled or had the opportunity to control that *inter partes* review proceeding. *See, e.g.*, Case IPR2017-01392, Paper 11, 21–25; *see also* Case IPR2017-01393, Paper 8, 16–20.

The Federal Circuit in *AIT* specifically ruled that a similar focus by the Board in *AIT* was unduly narrow. *AIT*, 897 F.3d at 1345. Specifically, the Court held,

[T]he Board's determination that Salesforce was not a real party in interest under § 315(b) relied on an impermissibly narrow understanding of the common-law meaning of the term, was not based on consideration of the entirety of the administrative record, and seemingly misallocated the burden of proof. Any one of these errors might warrant vacatur—together, they compel it. . . . The Board did not consider critical evidence proffered by AIT. Nor did it adequately explain why it rejected certain of AIT's common law theories, particularly where RPX bore the burden of proving its petitions were not time-barred under § 315(b).

AIT, 897 F.3d at 1356. In a concurring opinion, Judge Reyna noted that the majority addressed real party-in-interest issues but wrote separately to emphasize that a similar broad analysis should apply to issues of privity. *Id.* at 1358 (Reyna, J., concurring). Judge Reyna specifically pointed out that, “[w]hile ‘control’ over a proceeding may be germane to a form of privity,” “[p]rivacy between parties does not hinge on any single proceeding.” *Id.* at 1361–62 (Reyna, J., concurring). Instead, Judge Reyna suggests, “[t]he substantive legal relationship inquiry focuses on the legal obligations between the parties, not between a party and a proceeding.” *Id.* at 1361 (Reyna, J., concurring). Judge Reyna further suggests that determining the existence of a privity relationship requires a broader inquiry and finds “[a] common character of these relationships is that the two parties share a high degree of commonality of proprietary or financial interest.” *Id.* at 1362 (Reyna, J., concurring). Judge Reyna identifies an indemnification relationship as an exemplary relationship that could form a privity relationship. *Id.* (Reyna, J., concurring).

It is clear that *AIT* changed prior practices of the Board such that our review of real party-in-interest and privity issues must extend beyond a narrow view focused solely on control or the opportunity to control a proceeding before the Board.

2. *The Motion Is Timely*

We are not persuaded by Petitioner that the Motion is untimely. Petitioner argues Patent Owner was in possession of the agreement that governs Petitioner’s indemnification obligations to Dell since April 21, 2017. *Opp.* 2. Petitioner further argues that, in August 2018, Patent Owner requested and was denied the same additional discovery in related earlier cases. *Id.* Petitioner further contends

Patent Owner did not raise the issue with Petitioner until September 18, 2018. *Id.* Thus, Petitioner asserts the Motion is untimely. Still further, Petitioner argues that, if the additional discovery were granted, “there is no provision in the scheduling order for any additional briefing by Patent Owner. *Id.* at 3.

We are unpersuaded that the delay in requesting additional discovery was substantial or prejudiced Petitioner. *AIT*, changing the Board’s practice in review of RPI and privity issues, was decided in July 2018. Patent Owner’s earlier (August 2018) request for the same additional discovery in related cases was denied because, in those earlier cases (filed in May of 2017), Dell had already been joined as a party and there was no 315(b) bar issue either at the time of filing of those earlier petitions or later when Dell was joined as a party. *See* IPR2017-01391, Paper 67, 2–3. Although it is true that Patent Owner could have requested this additional discovery for this case at that time (August 2018), we perceive no prejudice to Petitioner in the added month delay (from the August 2018 conference call to the later September 2018 conference call). Petitioner’s Reply to Patent Owner’s Response in this case is not due until December 5, 2018.

Regarding Petitioner’s concern that there is no provision in the scheduling order for any additional briefing by Patent Owner, we can order changes to the schedule as needed by the parties to address issues relating to RPI, privity, and § 315(b) time-bar.

Lastly, Petitioner argues that, contrary to Patent Owner’s contention that its motion is not untimely because RPI is a “jurisdictional issue,” “[p]ermitting additional discovery is not jurisdictional.” *Opp.* 3 (citing *Mot.* 9). Petitioner’s argument is a non-sequitur. We do not understand Patent Owner to argue that *additional discovery* is a jurisdictional issue but, instead, that a time bar arising

from a *real party-in-interest* relationship may present a jurisdictional issue that cannot be waived. *See* Mot. 9.

For the above reasons, we are persuaded Patent Owner's Motion is timely filed. Should either party require additional time for any further briefing that might be ordered, such additional time may be requested and, for good cause, may be granted.

3. *Even If Dell Is Not An RPI, Dell May Be A Privy Of Petitioner*

We are not persuaded by Petitioner's argument that Dell is not a real party-in-interest in this proceeding. Even granting Petitioner's assertion, Patent Owner's Motion seeks documents that relate, *inter alia*, to indemnification and joint defense agreements between Petitioner and the Defendant Customers, which includes Dell. Such documents may aid the Board in evaluating whether there is privity between Petitioner and any of the Defendant Customers (entities arguably time-barred under 315(b)). Petitioner admits to at least partially indemnifying Dell in its motion to intervene in Patent Owner's litigations against Dell. Ex. 2055, 5.

4. *Weighing the Garmin Factors*

a. *Garmin Factor 1*

Garmin factor 1 requires that Patent Owner show more than mere allegations/speculations that the requested documents exist and would be useful.

Patent Owner argues the discovery sought is clearly useful in that it would aid the Board in performing the broader analysis of RPI and privity required by *AIT* to determine the nature of the relationship between Petitioners and the Defendant Customers. Mot. 5–6. Patent Owner suggests that the Board already found the existence of such an indemnification is readily admitted on the record.

Mot. 6–7 (citing Case IPR2017-01405, Paper 71, 3). However, we note the cited paper refers to an admission in a conference call including Intel (Petitioner in IPR2017-01405)—Cavium did not participate in the conference call discussed in the cited paper. Regardless, Petitioner here (Cavium) filed a Motion To Intervene in litigation against Dell, which Patent Owner has filed on the record in this case as Exhibit 2055. Therein, Cavium admits that it intervened, in part, based on its indemnification obligation to Dell (through its subsidiary QLogic). *See, e.g.*, Ex. 2055, 5. Thus, the existence of documents relating to indemnification between Dell and Cavium (at least indirectly through QLogic) is admitted by Petitioner (Cavium). Patent Owner further argues Petitioners have refused to produce documents relating to indemnification or defense coordination in this proceeding or in the District Court litigations. Mot. 7.

Petitioner argues Patent Owner has not met its burden of showing, beyond mere speculation, that anything useful would be produced by the requested additional discovery. Opp. 4–5. Petitioner cites *Ricoh*⁴ in support of its position that “[i]ndemnification and joint defense alone does not mandate additional discovery.” Opp. 5.

We are persuaded *Garmin* factor 1 weighs in favor of granting Patent Owner’s Motion. Cavium’s admission of the existence of an indemnification relationship presents more than mere speculation/allegations that written agreements exist defining the metes and bounds of the indemnification relationship. Further, in view of the Federal Circuit’s holding in *AIT*, the Board

⁴ *Ricoh Ams. Corp. v. MPHJ Tech. Inv., LLC*, Case IPR2015-01178, Paper 8, 2 (PTAB Aug. 6, 2015). (“[A]ll litigation where a . . . retailer is a party and the manufacturer is not raises issues of indemnification If we allowed discovery on the real party in interest in every such situation, our timely and efficient review procedure would be lost.”).

needs to perform a broader review of such relationships to determine RPI and privity issues. Production of the requested documents would be useful to the Board in understanding the nature and timing of those business and legal relationships and, thus, will aid the Board in determining whether there may be a time-bar under § 315(b) because of the relationships between Petitioners and Defendant Customers (including at least Dell).

Although we may agree that the Court's holding in *AIT* may impose a significant burden on the Board to review such relationships in numerous cases, this does not present a reason to limit the required review into RPI and privity issues.

b. Garmin Factor 2

Garmin factor 2 provides that requesting an opposing party's "litigation positions and the underlying basis for those positions is not necessary in the interest of justice."

Patent Owner argues the request does not target Petitioners' litigation positions but, instead, seeks "documents that will establish the timing, nature and scope of these 'readily admitted' and established relationships, including the rights, interests and obligations between the Petitioners and Defendant Customers as required by recent precedent." Mot. 8.

Petitioner argues the requested discovery is seeking "joint defense privileged communications, including defendants' respective rights, interests and obligations . . . in the underlying [litigations] and IPR proceedings." Opp. 6. Petitioner contends this is particularly true where Cavium has not intervened and is not indemnifying some of the Defendant Customers. *Id.*

For the reasons asserted by Patent Owner, we are not persuaded that this factor weighs against granting the Motion.

c. Garmin Factor 3

Garmin factor 3 relates to whether the requested documents are obtainable by Patent Owner through other means. Patent Owner asserts the information cannot otherwise be obtained and that the documents are exclusively within the control of Petitioners and Defendant Customers. Mot. 8. Patent Owner contends multiple attempts to obtain these documents in related litigations and other IPRs have been unavailing. *Id.*

Petitioner does not address this factor, and we determine that this factor weighs in favor of granting the Motion.

d. Garmin Factors 4 And 5 - Easily Understood And Not Burdensome

Patent Owner argues the requests are narrowly tailored and simple. Mot. 10.

Petitioner argues the requests are “overbroad, vague, unduly burdensome and in some cases call for information that is highly confidential or privileged.” Opp. 6.

We find the request (Ex. 2400) to be sufficiently clear. We note that the request specifically states: “If Petitioners find the meaning of any term in any Request for Production unclear, Petitioners should assume a reasonable meaning, state what the assumed meaning is, and produce documents on the basis of that assumed meaning.” Ex. 2400, 1. Furthermore, the request explicitly contemplates that Petitioner shall provide a privilege log for any document that Petitioner withholds on the basis of privilege, and we, accordingly, do not understand the request to require production of privileged documents or attorney work-product.

See id. at 1–2. Moreover, confidential information may be filed under seal in accordance with our rules. *See* 37 C.F.R. §§ 42.14, 42.54, 42.55, 42.56.

Petitioner further argues that the requests “seek documents and communications on various topics between Cavium and CenturyLink and/or Wistron, when Cavium did not intervene in those litigations and there is no evidence that there exists any indemnification or customer relationship.” *Id.*

Initially we note Cavium’s motion to intervene in Alacritech’s litigation against Dell observes that the litigations against CenturyLink and Wistron were consolidated with the litigation against Dell. Ex. 2055, 4 (“Alacritech also filed two complaints against other defendants on the same day, CenturyLink, Inc. and Wistron Corporation. All three cases have been consolidated for pretrial matters except for venue.”). To the extent Cavium is involved in a joint defense relationship or an indemnification relationship with any of the Defendant Customers in the consolidated litigations, we grant Patent Owner’s Motion. Where no such relationships exist, there will be nothing to produce.

Petitioner contends the requests define “Challenged Patents” as including three patents when this Petition involves only one of the three included patents. *Id.*

We note, however, that Cavium has been joined as a party in other IPRs proceedings (IPR2018-00400 and IPR2018-00403) involving the other two patents listed in Patent Owner’s request for production. Patent Owner has filed essentially the same motion for discovery in the corresponding IPRs filed by Intel. *See* Case IPR2018-00226, Paper 31; Case IPR2018-00234, Paper 26. We issue essentially the same order granting Patent Owner’s motions in those other cases. Thus, Petitioner is to produce responsive documents relating to all three identified patents.

Petitioner further contends the requests define “Communications” to include forms of electronic communications not ordinarily searched such as instant messaging. Opp. 6–7.

Materials that can be found by a reasonably diligent search must be produced.

Still further, Petitioner contends its relationship with Dell spans many years and, thus, the request “could encompass a large number of documents entirely unrelated to this IPR.” Opp. 7.

Upon consideration of Petitioner’s contention, we limit the scope of Patent Owner’s Request for Production No. 4 to documents that relate to Alacritech’s patents, to these proceedings, or to indemnification or defense agreements having relevance to Alacritech’s patents or to these proceedings. We find that Patent Owner’s Requests for Production Nos. 1–3 are sufficiently focused such that we are not persuaded that any further narrowing is required.

Lastly, Petitioner argues the protective order in this case “does not provide sufficient confidentiality for the requested documents.” *Id.*

To the extent necessary, the parties may meet and confer and propose a different protective order to afford the requisite protection for confidential information in this proceeding.

We determine this factor weighs in favor of granting the Motion.

e. Conclusion Weighing Garmin Factors

For the above reasons, we determine the *Garmin* factors weigh in favor of granting Patent Owner’s Motion.

III. ORDERS

It is

ORDERED that the Patent Owner's motion for additional discovery is granted subject to the limitations set forth above.

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CHARLES J. BOUDREAU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*, dissenting

I respectfully disagree with the Majority's position that Patent Owner has demonstrated that additional discovery in this matter should be granted in the interests of justice.

Patent Owner requests "discovery . . . regarding the real parties in interest ('RPIs') to this petition" in the form of production of "documents memorializing

⁵ Cavium, Inc. filed the Petition in this matter and filed an Updated Mandatory Notice indicating its change of name to Cavium, LLC. Paper 17, 2.

the timing, nature and scope of the established indemnity and defense coordination relationships between the Petitioners and Defendant Customers, including their respective rights, interests and obligations in the underlying [Eastern District of Texas] Cases and IPR proceedings.” Paper 21, 1. Patent Owner further argues that such discovery is based on “more than a ‘mere possibility’ or a ‘mere allegation that something useful [to the proceeding] will be found.” Paper 21, 5 (citing “Garmin Factor 1”). However, Patent Owner does not indicate specific information beyond that of a “mere possibility” or “mere allegation” that such additional discovery would result in something useful. For example, Patent Owner states that the “discovery sought is clearly useful” because in the event that something useful is, in fact, produced, “the instant IPR [will be] jurisdictionally time-barred under Section 315(b) as it was filed more than one year after service of complaints on the Defendant Customers.” Paper 21. In other words, Patent Owner alleges that *if* something useful is obtained through additional discovery (e.g., a document stating unequivocally that alleged parties are real parties in interest), *then* the instant IPR may be dismissed. This begs the question, however, whether at this stage of the proceeding, there exists more than a “mere allegation” or “mere possibility” that something useful will be produced in the first place. I do not identify any specific information in the record that would lead one to suspect beyond a “mere possibility” that something useful would be produced.

Patent Owner argues that documents that “show that the Defendant Customers have an established relationship” “exist” and that “Petitioners have ‘readily admitted’ and made ‘of record’ their indemnity relationships with the Defendant Customers.” Paper 21, 6-7. In other words, Patent Owner argues that there is more than a “mere possibility” that something useful will be produced by obtaining a document already known to exist. While I would agree that there is

more than a “mere possibility” of obtaining a document that is known to exist upon further discovery of that document, I cannot agree that there is more than a “mere possibility” of producing something *useful* in the production of a document that is already known to exist. At best, such production would be redundant to the information already available in the record and would accomplish no more than producing documents that are not necessary to our determination of RPI in this matter.

In support of the contention that there is more than a “mere possibility” or “mere allegation” that additional discovery of documents “memorializing the timing, nature and scope of the established indemnity and defense coordination relationships between the Petitioners and Defendant Customers” would supposedly be useful, Patent Owner states that “[t]wo recent Federal Circuit cases⁶ have changed the PTAB’s required RPI analysis.” Paper 21, 1.

In particular, Patent Owner argues that, in RPX, the Federal Circuit held that determining a real party in interest relationship “requires a ‘flexible approach’” and requires the Board to “consider . . . the entirety of the record” and “to ‘meaningfully examine’ the relationship between the entities.” Paper 21, 2–3. Even assuming that Patent Owner is correct that the Federal Circuit held that the Board must consider the entire record to “meaningfully examine” the issue of real parties in interest, Patent Owner does not adequately explain how additional discovery is necessary in the interests of justice in order for the Board to meaningfully examine the entire record. Nor does it logically follow that instructions for “meaningfully” examining the issue of real parties in interest

⁶ *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. July 9, 2018) (“RPX”) and *Worlds, Inc. v. Bungie, Inc.*, 2018 WL 4262564, at *7 (Fed. Cir. Sept. 7, 2018) (“Bungie”)

would indicate more than a “mere possibility” that something useful will be produced with additional discovery in this case.

The Majority takes the position that, in RPX, the Federal Circuit supposedly held that the PTAB must not take “an impermissibly narrow understanding” of the meaning of the terms “real party in interest” and “privity” and that the PTAB must “consider critical evidence proffered” by Patent Owner (i.e., AIT). Maj. Dec. 6–7. Presumably, the Majority relies on this statement in RPX to support the allegation that additional discovery of documents pertaining to the RPI issue in this case is based on more than a “mere possibility” or “mere allegation” that something useful will be produced. I cannot agree with the Majority on this point because, in my view, the panel not taking “an impermissibly narrow understanding” of the meaning of the term “real party in interest” or “privity” does not require additional discovery. Nor does the panel taking a broader “understanding” of the meaning of the term “real party in interest” or “privity” provide more than a “mere possibility” that something useful will be produced with additional discovery. In fact, the probability/possibility that something useful will be produced with additional discovery is wholly unrelated at all to whether the panel takes “an impermissibly narrow understanding” of terms or not.

The Majority also states that “Cavium’s admission of the existence of an indemnification relationship present more than mere speculation/allegations that written agreements exist.” Maj. Dec. 10. However, in my view, the question is whether there is more than a “mere possibility” that something useful will be produced with additional discovery of an indemnification agreement. Again, this document is already known to exist. While the Majority states that the document may “defin[e] the metes and bounds of the indemnification relationship” (*id.*), the Majority does not clearly explain a rational basis for why there is more than a

“mere possibility” that any of these alleged definitions of “metes and bounds,” if any, would be something useful to the present matter. In my view, there may be, at best, a “mere possibility” of such utility but no more (and, most likely, far less). I would not consider this Garmin factor met under these circumstances.

Patent Owner argues that in *Bungie*, the PTAB allegedly determined that a real party in interest relationship had not been shown between “Bungie” and “Activision” but that the Federal Circuit held that “Worlds ‘presented evidence sufficient to put Bungie’s identification of itself as the sole [RPI] into dispute’” and “remand[ed to the Board] for further factual investigation and analysis.” Paper 21, 4. In other words, in *Bungie*, the PTAB held that a real party in interest relationship had not been demonstrated sufficiently between Bungie and Activision based on the evidence of record but the Federal Circuit disagreed and instead determined that, in fact, the evidence of record may have indicated the presence of a real party in interest relationship between Bungie and Activision. Patent Owner does not explain sufficiently how additional discovery is necessary in this matter in the interests of justice or that there is more than a “mere possibility” that something useful will be produced based on Bungie. Indeed, the fact that the Federal Circuit allegedly held that a real party in interest relationship *may have* existed between parties based on evidence of record of that case (i.e., *Bungie* case) does not appear to have any bearing on whether additional discovery is needed in this case. In addition, Patent Owner does not indicate that the Federal Circuit held that additional discovery was deemed to be necessary in *Bungie* at all or that there existed more than a “mere possibility” or “mere allegation” that something useful would have been produced.

Patent Owner also argues that the request for additional discovery complies with each of the other Garmin factors – namely, the request does not target

Petitioner's litigation positions, cannot be acquired through other means, is understandable, and is not unduly burdensome. Paper 21, 7, 8 (citing Garmin Factors 2–5). The Majority states that each of these factors “weigh in favor of granting Patent Owner’s Motion.” Maj. Dec. 14. Firstly, the requested documents pertaining to “defense coordination relationships between the Petitioners and Defendant Customers, including their respective rights, interests and obligations in the underlying [Eastern District of Texas] Cases,” on their face, clearly targets “litigation positions.” Regardless, in my view, Patent Owner has not demonstrated that there is more than a “mere possibility” that anything useful will be produced with additional discovery. It would make no logical sense to expend resources to pursue documents of little to no utility just because the documents in question allegedly do not target litigation positions, cannot be acquired through other means, are understandable, or “not unduly burdensome” to produce.