

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

TWITTER, INC.,  
Petitioner,

v.

PALO ALTO RESEARCH CENTER INC.,  
Patent Owner.

---

IPR2021-01398  
Patent 7,043,475 B2

---

Before KARL D. EASTHOM, SHEILA F. McSHANE, and  
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER  
Granting-in-Part Patent Owner's Request  
for Discovery  
*37 C.F.R. § 42.51*

## I. BACKGROUND

Pursuant to our authorization (Paper 25, “Order”), Patent Owner filed a Request for Discovery (Paper 27, “Request” or “Req.”), Petitioner filed an Opposition to Patent Owner’s Request for Discovery (Paper 30, “Opposition” or “Opp.”), and Patent Owner filed a Reply to Petitioner’s Opposition (Paper 31, “Rep. to Opp.”). This trial is near the final stages, with all briefing already filed according to the Scheduling Order (Paper 13) and an Oral Hearing set for December 14, 2022 (Paper 32).

For *inter partes* reviews, 37 C.F.R § 42.51(b) provides for limited discovery, which includes routine discovery under § 42.51(b)(1) and additional discovery under § 42.51(b)(2).

Patent Owner seeks discovery of an (unfiled) draft reply declaration referenced by Petitioner’s declarant, Dr. Turnbull, during his deposition (Ex. 2027), which involved cross-examination by Patent Owner of Dr. Turnbull concerning his testimony in his (filed) Reply Declaration (Ex. 1033). Req. 1. Patent Owner now seeks discovery of the draft reply declaration based on an alleged inconsistency therein (relative to the Reply Declaration) uncovered during the deposition. *Id.* According to Patent Owner, the alleged inconsistency undermines Petitioner’s, and supports Patent Owner’s, claim construction of “proximal information.” *Id.* at 1–2, 5.

As the Order explains, during a teleconference with the parties to discuss Patent Owner’s request to authorize the discovery Request,

the parties agreed that at the deposition, Dr. Turnbull initially referred to a draft of his expert [reply] declaration before shifting to the final filed version for the remainder of his deposition. Patent Owner alleged that Dr. Turnbull quoted a passage from paragraph 5 of the draft [reply] declaration that contradicts paragraph 5 of his [filed] Reply Declaration (Ex. 1033) in a

manner relating to the claim construction of the term “proximal information.” *Compare* Ex. 1033 ¶ 5 (testifying that “examples of proximal information in the ’475 [patent] include text extracted from a link and text near/surrounding/adjacent to a link (outlink)”), *with* Ex. 1033, 9:14–18 (testifying that “examples of proximal information in the ’475 [patent] include text associated with the link, and text near/surrounding/adjacent to a link, or outlink”).

Order 2.

Based on the alleged inconsistency, Patent Owner contends that the draft reply declaration is “routine discovery” under 37 C.F.R §§ (b)(1)(i) and (iii), and also that the “*Garmin* factors” weigh in favor of “additional discovery” under 37 C.F.R § 42.51(b)(2). *See* Req. 1–4 (citing *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 6–7 (PTAB Mar. 5, 2013) (precedential)). Petitioner replies that Dr. Turnbull inadvertently relied on a sentence in the wrong document (i.e., the unfiled draft reply declaration—instead of the filed Reply Declaration) after mistakenly downloading the draft declaration during the video deposition. *See* Opp. 1, 5; Order 3. Petitioner asserts that work product privilege applies to the whole draft reply declaration, but Petitioner does “not seek to claw back” paragraph five of the draft reply declaration. *See* Opp. 1, 5; Order 3.

*A. Routine Discovery*

Patent Owner seeks routine discovery under 37 C.F.R §§ 42.51 (b)(1)(i) and (iii), which follow:

(b) **Limited discovery.** A party is not entitled to discovery except as provided in paragraph (a) of this section, or as otherwise authorized in this subpart.

(1) **Routine discovery.** Except as the Board may otherwise order:

(i) Unless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.

....

(iii) Unless previously served, a party must 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.

Patent Owner generally argues that Dr. Turnbull waived any privilege for the draft reply declaration by using it to prepare for the deposition, citing it during the deposition, and refreshing his recollection with it during the deposition. Req. 3–4 (citing Ex. 2027, 9:8–10:12; Fed. R. Evid. 612(a)(1); *Thomas v. Euro RSCG Life*, 264 F.R.D. 120, 122 (S.D.N.Y. 2010) (finding privileged waived and ordering production of notes reviewed prior to deposition); *Heron Interact, Inc. v. Guidelines, Inc.*, 244 F.R.D. 75, 78 (D. Mass. 2007) (ordering production of documents reviewed by deponent prior to deposition)). Patent Owner also argues that “because the document contains inconsistent information, the document is routine under § 42.51(b)(1)(iii).” *Id.* Patent Owner contends that Dr. Turnbull “testified that he used the *entire* document, not just one paragraph, in anticipation of and to prepare for his deposition.” *Id.* (citing Ex. 2027, 9:8–18).

Petitioner replies that Dr. Turnbull inadvertently relied on a single sentence in paragraph five of the wrong document (i.e., the privileged draft reply declaration) after downloading it during the video deposition. Opp. 1. Petitioner submits it does not waive privilege as to the draft reply

declaration, but states it does not seek to “claw back” paragraph five of the draft reply declaration. *See* Opp. 1, 5; Order 3.

Under routine discovery, “a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding,” but “[t]his requirement does not make discoverable anything otherwise protected by legally recognized privileges such as attorney-client or attorney work product.” 37 C.F.R § 42.51(b)(1)(iii) (emphasis added). We find, for the reasons that follow, that the work product privilege applies to the draft declaration except for paragraph 5 (which Petitioner does not seek to “claw back” as indicated above).

In context to this *inter partes* proceeding, “[f]or cross-examination testimony,” under 37 C.F.R § 42.53(d)(5)(ii), “the scope of the [cross-] examination is limited to the scope of the direct testimony.” Here, the scope of the direct testimony is Dr. Turnbull’s Reply Declaration (Ex. 1033) with the caveat that Dr. Turnbull opened the door to further cross-examination at least with respect to paragraph five of the draft reply declaration during his deposition. As further context, under 37 C.F.R § 42.65(a), “[e]xpert testimony [in the form of a declaration] that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”

Under this context, Patent Owner cites *Albritton v. Acclarent, Inc.*, No. 3:16-cv-03340-M, 2020 WL 11627275, at \*10 (N.D. Tex. Feb. 28, 2020), in support of its position for discovery of the entire draft reply declaration. Req. 6. As Patent Owner notes, *Albritton* states that “to the extent initial draft reports prepared by attorneys communicate facts, data, or assumptions to [the experts] for them to consider in forming their opinions, those draft reports do not fall within Defendant’s counsel’s reservation of its

privilege under Rule 26(b)(4)(B) and shall be produced.” *Id.* (quoting *Albritton*, 2020 WL 11627275, at \*10, referring to Fed. R. Civ. P. 26(b)(4)(B)).

Patent Owner’s reliance on *Albritton* relates to Fed. R. Civ. P. 26. *See* Req. 6 (quoting *Albritton*, 2020 WL 11627275, at \*10).<sup>1</sup> This rule was amended in 2010, and as the court explained in *Republic of Ecuador v. Hinchee*, 741 F.3d 1185, 1195 (11th Cir. 2013), these amendments “did two things” relevant to the privilege at issue here:

First, as outlined above, the drafters added Rules 26(b)(4)(B) and (C) to protect draft expert reports and attorney-expert communications as work product. Second, the drafters changed the language of Rule 26(a)(2)(B) from “data or other information” to “facts or data.” This change rejects the outcome reached by cases that relied on the old “other

---

<sup>1</sup> Applicable portions of Rules 26(b)(4) (B) and (C) follow:

(B) *Trial-Preparation Protection for Draft Reports or Disclosures.* Rules 26(b)(3)(A) and (B) protect drafts of any report or disclosure required under Rule 26(a)(2), regardless of the form in which the draft is recorded.

(C) *Trial-Preparation Protection for Communications Between a Party's Attorney and Expert Witnesses.* Rules 26(b)(3)(A) and (B) protect communications between the party’s attorney and any witness required to provide a report under Rule 26(a)(2)(B), regardless of the form of the communications, except to the extent that the communications:

(i) relate to compensation for the expert's study or testimony;

(ii) identify facts or data that the party's attorney provided and that the expert considered in forming the opinions to be expressed; or

(iii) identify assumptions that the party's attorney provided and that the expert relied on in forming the opinions to be expressed.

information” language in Rule 26(a)(2)(B) to compel the production of draft expert reports and communications between attorneys and experts. Rule 26(a)(2)(B) was changed so that it would not conflict with new Rules 26(b)(4)(B) and (C), which now *expressly exempt draft reports and attorney-expert communications from discovery*.

....

None of this suggests the drafters’ intent to confer work-product status on *the notes of a testifying expert or on a testifying expert’s communications with other experts*. Rather, the 2010 Amendment to Rule 26(a)(2)(B) *was intended to protect the opinion work-product* of attorneys in the context of expert discovery. As the 2010 Advisory Committee put it, “[t]he refocus of disclosure on ‘facts or data’ is meant to limit disclosure to material of a factual nature by excluding *theories or mental impressions of counsel*.” *Id.* (emphasis added). . . . In other words, the term “facts or data” includes all materials considered by a testifying expert, *except the core opinion work-product of attorneys*.

*Id.* at 1194–95 (emphasis added except for second to last). Therefore, *Hinchee* indicates that Fed. R. Civ. P. 26 generally allows for discovery of “facts and data,” but not mental impressions of attorneys. This suggests discovery of “facts and data” that an expert opinion relies upon in a declaration. However, the Request encompasses production of expert “opinion” evidence “based” on “underlying facts or data” in the draft reply declaration, instead of just “facts or data.” *See* 37 C.F.R § 42.65(a) (“Expert testimony [in the form of a declaration] that does not disclose the underlying *facts or data on which the opinion is based* is entitled to little or no weight.” (emphasis added)).

Patent Owner Owner’s reliance on *Albritton* (and other cited cases discussed below) is not persuasive, because Patent Owner does not explain how a claim construction theory, which is a legal inquiry that Patent Owner

agrees is at “the heart” of its dispute and therefore central to its Request, represents “facts or data.” *See* Req. 5

The court in *Albritton* did not interpret Rule 26(b)(4)(B) contrary to *Hinchee*.<sup>2</sup> In *Albritton*, counsel had previously waived privilege as to work-product communications under Rule 26(b)(4)(C) while preserving the privilege for draft expert reports under Rule 26(b)(4)(B). *See* 2020 WL 11627275, at \*9. In the passage Patent Owner relies on, the court simply held that, to the extent that an attorney prepared an initial draft of an expert report and communicated “facts, data, or assumptions” to the expert to consider in forming the expert’s opinions, those communications were not excluded from the party’s previous waiver of Rule 26(b)(4)(C) protection at least as to facts, data, or assumptions therein. *See id.* at \*10.

Patent Owner also cites to *Thomas*, 264 F.R.D. at 122, as persuasive authority as “finding [the] privileged waived and ordering *production of notes reviewed* prior to [a] deposition.” Req. 3 (emphasis added); *Thomas v. Euro RSCG Life*, 264 F.R.D. 120 (S.D.N.Y. 2010). Petitioner distinguishes *Thomas* (and other cases cited by Patent Owner) as involving an “entirely different” discovery standard and also “hav[ing] nothing to do with when a testifying witness inadvertently opened and read from the wrong document.” Opp. 6. In *Thomas*, the court held that “it is in the interests of justice for defendants to be able to adequately cross-examine plaintiff by having access to notes that plaintiff admitted to reviewing so that she could answer questions ‘accurately.’” *Thomas*, 264 F.R.D. at 122. The court found that

---

<sup>2</sup> In *Albritton*, the court ordered that to the extent the plaintiff there asserted a privilege with respect to any draft reports, it was to provide a privilege log. *Albritton*, 2020 WL 11627275, at \*10.



“[t]he *notes are simply a factual recitation*, arranged chronologically, and evince no work-product concerns.” *Id.* (emphasis added). The notes related to, or were a summary of, “many conversations” the witness had with another person, and the witness testified that “it’s going to be very difficult for me to recount all of the conversations.” *Id.*

As Petitioner argues, *Thomas* is not on point. *See* Opp. 6. Dr. Turnbull does not testify that he relied on anything in his draft reply declaration (other than paragraph five thereof) or had difficulty recalling large portions of testimony such that any alleged reliance would transform the draft reply declaration into “notes” under the rubric of *Thomas*. *See* Ex. 2027, 6:21–23 (testifying that “I just copied several [documents] to my desktop that I thought would be relevant. If we have another one, I can go dig it up. It won’t take but a second.”), 12:2–9 (testifying based on “a sentence” from paragraph 5 of the draft reply declaration and based on paragraph 132 from his filed original Declaration (Ex. 1003)). Patent Owner’s arguments and citations to the deposition do not show that Dr. Turnbull relied on other portions of the draft reply declaration during his deposition or that he reviewed it prior to the deposition to refresh his recollection. *See* Rep. to Opp. 1 (citing Ex. 2027, Ex. 2027, 5:16–18, 6:13–14, 9:8–10:10).<sup>3</sup>

---

<sup>3</sup> Patent Owner cites to other cases that precede the 2010 Amendments to Fed. R. Civ. P. 26. *See* Req. 3 (citing *Heron Interact, Inc. v. Guidelines, Inc.*, 244 F.R.D. 75, 78 (D. Mass. 2007)); 6 (citing *W.R. Grace & Co.-Conn. v. Zotos Intern., Inc.*, No. 98–CV–838S(F), 2000 WL 1843258, \*2–\*5 (W.D.N.Y. 2000)). But as quoted above, the 2010 Amendments “reject[] the outcome reached by cases that relied on the old ‘other information’ language in Rule 26(a)(2)(B) to compel the production of draft expert reports and communications between attorneys and experts.” *Hinchee*, 741 F.3d at

Patent Owner also argues that the “Board . . . ha[s] ordered production of entire draft and non-filed declarations.” Req. 6 (citing *GEA Process Eng’g, Inc. v. Steuben Foods, Inc.*, IPR2014-00041, Paper 52, 6–7 (PTAB July 21, 2014)). Petitioner argues that the “facts are inapt” in *Stueben Foods*, because it relates to discovery of a signed, but unfiled, omnibus declaration, which the patent owner in that case broke into five separate declarations and filed, but the declarant testified he did not review all of them prior to the filing thereof (i.e., he reviewed them thereafter). *Compare* Opp. 6 (arguing that “[h]ere, there is no dispute that Dr. Turnbull reviewed the final filed version”) *with*, *Stueben Foods*, Paper 52 at 4–5 (quoting declarant’s testimony that shows he investigated the five declarations only *after* patent owner filed them and finding that at least minor differences existed between the signed unfiled omnibus declaration and four of the five filed declarations he did not authorize).

*Stueben Foods* supports Petitioner’s position for other reasons. First, the Board found that the patent owner there waived any work product privilege. *Stueben Foods*, Paper 52 at 5 (“Patent Owner cannot on the one hand argue that the omnibus declaration is privileged, and on the other hand

---

1195. As *Hinchee* discusses, the 2010 Amendments to Fed. R. Civ. P. 26 operate to protect attorney-client and work product privilege in draft reports by only allowing discovery of “facts and data,” as opposed to the predecessor rule that allows for discovery of “information.” *See id.* Therefore, if anything, *W.R. Grace*, based on the predecessor rule, supports Petitioner’s position, or at the least, is not instructive. *See W.R. Grace* 2000 WL 1843258, at \* 4 (“The court finds that the 1993 revisions enacted in Fed. R. Civ. P. 26(a)(2)(B)’s requiring disclosure of all “*information* considered by the expert in forming the [expert’s] opinion” does not exempt so-called ‘core’ work-product, i.e., mental impressions, opinions, and litigation strategies.” (emphasis added)).

allow Patent Owner's declarant to review the declaration again and now testify as to the differences between the omnibus declaration and the five declarations that were actually filed."'). Here, if there was waiver, it appears to be due to an inadvertent and limited disclosure that pertains only to paragraph five of the draft reply declaration.

Second, in ordering discovery of the entire unfiled and unsigned omnibus declaration, the Board in *Stueben Foods* distinguished the following two cases: 1) *Clemmons v. Acad. for Educ. Dev.*, No. 10-cv-911, 2013 WL 5994487, at \*2 (D.D.C. Nov. 13, 2013) (quoting *Judicial Watch v. Dep't of Commerce*, 201 F.R.D. 265, 269 (D.D.C. 2001)), cited by the patent owner in *Stueben Foods* "for the principle that '[a] draft of a declaration to be executed by a party or witness denotes what a lawyer thinks that party or witness should say and thereby exposes that lawyer's mental processes'; 2) *Intel Corp. v. VIA Techs, Inc.*, 204 F.R.D. 450, 452 (N.D. Cal. 2001), cited by the patent owner in *Stueben Foods* "for the principle that work product protection attached to the declarant's declaration 'right up until the moment it was filed.'" *Stueben Foods*, Paper 52 at 6–7.

In general, the Board summarized the two cases above as "legal authority from other tribunals *for the proposition that a draft declaration is protected from disclosure unless, and until, it has been filed and/or served,*" but found "[t]hat authority[] is inapplicable to the facts of this case." *Stueben Foods*, Paper 52 as 6 (emphasis added). In particular, the Board distinguished *Clemmons* and *Intel Corp.* by finding that in the *Stueben Foods* case, "[p]atent [o]wner's declarant testified that he reviewed the omnibus declaration and authorized his signature to be applied to that single document," and "the omnibus declaration is the only document that he, in

fact, reviewed and executed.” *Stueben Foods*, Paper 52 at 6–7. There is no similar testimony here about executing the unfiled draft reply declaration. *See* Ex. 2027. As another distinction, there is no testimony that Dr. Turnball did not review the Reply Declaration, and he attested to the truth of it. *See Stueben Foods*, Paper 52 at 5 (“Our analysis *turns on the specific fact in this case* that Patent Owner’s declarant *did not review the actual declarations that were filed* in each of the five cases” (emphasis added)); Ex. 1033, 24. Therefore, under *Clemmons*, *Intel. Corp.*, and the Board’s underlying rationale in *Stueben Foods*, a draft declaration “exposes [the] lawyer’s mental processes,” *Clemmons*, 2013 WL 5994487, at \*2 (quoting *Judicial Watch*, 201 F.R.D. at 269), and is protected work product “right up until the moment it was filed,” *Intel Corp.*, 204 F.R.D. at 452. This applies to the draft reply declaration here, it is protected as not filed because it presumptively or potentially exposes Petitioner’s lawyer’s mental processes.

Patent Owner also refers to 37 C.F.R § 42.51(b)(1)(i) as support for its request for routine discovery, but acknowledges that it only applies if the draft reply declaration is “[s]tripped of any privilege.” Req. 3–4. For the reasons noted above, Petitioner did not waive the privilege as to the draft reply declaration except to the extent that Dr. Turnball discussed paragraph five and Petitioner does not seek to claw it back.

Patent Owner also refers to Fed. R. Evid. 612(b), asserting that “[w]hen a witness uses a writing to refresh their memory, ‘an adverse party is entitled to have the writing produced at the hearing, to inspect it, to cross-examine the witness about it, and to introduce in evidence any portion that relates to the witness’s testimony.’” Opp. 2 (quoting Fed. R. Evid. 612(b)). However, based on the findings above, Patent Owner fails to show that this

applies to the whole draft reply declaration where Dr. Turnbull did not refresh his memory with anything other than paragraph five of the draft reply declaration. Moreover, Patent Owner had the opportunity to cross-examine Dr. Turnbull about the draft reply declaration during the deposition and did not ask him to produce it there, waiving its asserted application of Fed. R. Evid. 612(b).<sup>4</sup> At most, Patent Owner is entitled to produce paragraph five as evidence in this trial, as that is the “portion that relates to the witness’s testimony.” *See* Fed. R. Evid. 612(b)

Accordingly, we grant the Motion in-part and order discovery of paragraph five of the draft reply declaration. However, we determine that, with the exception of paragraph five, the draft reply declaration is protected from disclosure. Thus, we determine that any part of the draft reply declaration, other than paragraph five, is not permissible routine discovery.

*B. Additional Discovery*

Alternatively, Patent Owner argues that Dr. Turnbull’s draft reply declaration is discoverable under 37 C.F.R § 42.51(b)(2) as “additional discovery” in light of the *Garmin* factors. For the reasons below, Patent Owner has not shown that this additional discovery is in the interests of justice.

---

<sup>4</sup> Patent Owner asserts that “[a]s with any deposition, Dr. Turnbull was asked to disclose any materials he had with him.” Req. 1 (citing Ex. 2027 5:1–15). This characterization is accurate only if “disclose” means “identify.” That is, Patent Owner merely asked Dr. Turnbull “do you have any documents with you today,” and he answered “[n]o, nothing on my desk. I have some just completely blank eCopies of things that *we might need that I can pull up*, and that’s it.” Ex. 2027, 5:14–18 (emphasis added). Patent Owner did not ask Dr. Turnbull to “pull up” any documents or transfer them to Patent Owner. *See* Ex. 2027.

Patent Owner persuasively shows that *Garmin* factors 4 (easily understandable instructions) and 5 (requests not overly burdensome to answer) favor discovery of the draft reply declaration. *See Garmin*, Paper 27 at 6–7.

*Garmin* factor 2 relates to litigation positions. Because, as determined above, the draft declaration (except paragraph five) falls under a privilege as attorney work product, *Garmin* factor 2 weighs strongly against Patent Owner.

*Garmin* factor 3 relates to the ability to generate equivalent information by other means. This factor refers to “[i]nformation a party can reasonably figure out or assemble without a discovery request,” which “would not be in the interest of justice to have produced by the other party.” *Garmin*, Paper 27 at 6. Patent Owner states it “cannot obtain this [draft declaration] from any other source.” Req. 5–6.

Patent Owner here is arguing that the only thing equivalent to the draft reply declaration is the draft reply declaration. Contrary to this argument, as explained above, Patent Owner ultimately seeks information to support its claim construction position with respect to “proximal information,” arguing that “a key dispute between the parties” is “whether an association is required for ‘proximal information.’” Req. 5. But “[i]n determining the meaning of [a] disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005)). Therefore, the information Patent Owner seeks to support its claim

construction position should be “principally . . . [in] the intrinsic evidence of record,” which is readily available. *See DePuy Spine*, 469 F.3d at 1014. Patent Owner does not need Petitioner’s unfiled draft reply declaration to set forth a claim construction of “proximal information” supported by the record. Patent Owner is in the best position to establish the claim construction of its claim term based on its patent specification. *See Garmin*, Paper 27 at 17 (“Cuozzo has not adequately explained why it needs Garmin’s views to establish what Cuozzo believes had been a long-felt but unresolved need with regard to speed limit indicators. Cuozzo can rely on its own analysis of the state of the art or on the opinions of independent analysts.”).

With respect to the alleged inconsistency in the construction of the term “proximal information,” Patent Owner argues that it centers on Dr. Turnbull’s use of the term “associated with” in paragraph five of the draft reply declaration, instead of the term “extracted from,” which appears in paragraph five of the Reply Declaration. Req. 2. Patent Owner also points to portions of Dr. Turnbull’s deposition in support of its theory of an inconsistency in Petitioner’s position. *Id.* at 4–5. Accordingly, if there is a material inconsistency, Patent Owner already possesses the information it seeks in the cited portions of the deposition and paragraph five of the draft reply declaration.

Moreover, as Petitioner argues, Patent Owner could have questioned Dr. Turnbull more about the draft reply declaration during the deposition, but did not. Opp. 1–2 (citing Ex. 2027). By failing not to further cross-examine Dr. Turnbull about the draft reply declaration during the deposition, Patent Owner forfeited a timely opportunity to question Dr. Turnbull about

why or how the draft reply declaration materially differs from Petitioner's current position. If Patent Owner had taken the opportunity to seek additional testimony from Dr. Turnbull at deposition on information it now seeks to uncover, the Request could have been obviated. Granting the Request for the full draft reply declaration could at this juncture open the door to reopening discovery, which would impose additional burden on the parties and Board at this late stage in the proceedings.<sup>5</sup>

Based on the foregoing, this factor does not weigh in favor of discovery.

*Garmin* factor 1 relates to whether there is more than a mere possibility and mere allegation that something useful will be found. *Garmin*, Paper 27 at 6. "The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered." *Id.* With the possible exception of paragraph five, Patent Owner points to nothing to show that the draft reply declaration will be useful in supporting its claim construction of "proximal information." *See* Req. 4 (citing Ex. 2027, 9:14–18, testimony relating to paragraph five of the draft reply declaration). In other words, as noted above, Patent Owner argues that an alleged inconsistency centers on Dr. Turnbull's use of the term "associated with" in paragraph five of the draft reply declaration, instead of the term "extracted from" in paragraph five of the Reply Declaration. Req. 2. Patent Owner also points to portions of Dr. Turnbull's deposition to support its theory of an inconsistency in Petitioner's position. *Id.* at 4–5.

---

<sup>5</sup> Patent Owner may address paragraph five of the draft reply declaration in the upcoming oral hearing.



Even if Patent Owner is correct that there is an inconsistency already shown in the record, it relates only to paragraph five of the draft reply declaration. Patent Owner's allegations based on this alleged inconsistency essentially reduce to the following theory: 1) the draft reply declaration contradicts the Petition (Paper 1), Dr. Turnbull's Declaration (Ex. 1003), Dr. Turnbull's Reply Declaration, and the Reply (Paper 17) with respect to one claim term, "proximal information"; 2) Petitioner changed its position from what it originally asserted in the Petition and Declarations to what it asserts in the draft reply declaration as to that term; and then, 3) Petitioner changed its position back again to its original "party-line position" by asserting it again in the Reply and Reply Declaration. *See* Paper 17 (Sur-reply), 6 ("Yet, after realizing he relied on and was reading from a draft declaration he prepared for deposition . . . [Dr. Turnbull] *reverted to [Petitioner's]* party-line position that extracted text, without any association with a link, is 'proximal information' . . . . Twitter's expert had it right initially." (emphasis added)).

This theory alleging numerous shifts in position by Petitioner amounts to mere speculation. A draft declaration is a preliminary nonfinal version of an expert's opinion, which is generally protected from discovery until filed. *See Stueben Foods*, Paper 52 as 6 (citing cases). There is no more than a mere possibility that the draft reply declaration, with the exception of paragraph five, discusses anything about "proximal information," let alone an alleged inconsistency about that term. It follows that there is no more than a mere possibility based on speculation that other than paragraph five, the draft reply declaration will shed light on the claim construction of

“proximal information,” which Patent Owner stresses is “the heart of a key dispute between the parties.” Req. 5.

Moreover, Petitioner disagrees that there is any inconsistency in its claim construction position in paragraph five of the draft reply declaration or otherwise. *See* Opp. 2 (arguing that “Dr. Turnbull and Petitioner have always taken the position that proximal information includes text associated with the link—and that it includes text extracted from the link” (citations omitted)). Petitioner explains further that “Petitioner and Dr. Turnbull have never asserted that any association must be stored/maintained/tracked.” *Id.* at 3. On the other hand, Petitioner asserts that Patent Owner’s claim construction position is “that the association between the text and the link itself is stored or tracked.” *Id.* (citing PO Resp. § IV.A; Sur-Reply 10–17).

Patent Owner does not dispute Petitioner’s characterization of its claim construction position. *See* Rep. to Opp. 1. Rather, Patent Owner contends that Dr. Turnbull’s “draft based testimony . . . confirms that his draft requires an enduring association” between a link and proximal information. *Id.* (citing Ex. 2027, 9:14–18, 9:22–10:12). However, Petitioner persuasively argues that Dr. Turnbull’s testimony in that cited portion does not support Patent Owner. *See* Opp. 3 (arguing that “Dr. Turnbull’s testimony that ‘proximal information’ ‘would have to be associated with something, whether it’s the link or perhaps even part of a link,’ is consistent,” and “Dr. Turnbull ha[s] never asserted that any association must be stored/maintained/tracked” (citing Ex. 2027, 9:22–10:10)). At this part of the deposition, there is no discussion related to storing, maintaining, or tracking an association, or an enduring association. *See* Ex. 2027, 9:22–10:10. At subsequent parts of the deposition, Patent

Owner cross-examined Dr. Turnbull about the requirements for proximal information, including any associations. *See, e.g.*, Ex. 2027, 16:10–20. However, Patent Owner had the opportunity to directly ask Dr. Turnbull if his draft reply declaration discusses anything related to an enduring association of proximal information, and Patent Owner did not pursue that line of questioning. *See* Ex. 2027.

Accordingly, the Request amounts to seeking to search through the draft reply declaration to attempt to find something useful that Patent Owner could have sought during the cross-examination of Dr. Turnbull. However, nothing Patent Owner points to here indicates that the draft reply declaration has more than a mere possibility of including any information pertaining to tracking or storing an association between the proximal information and link, which is what Patent Owner seeks and is at “the heart of a key dispute between the parties.” *See* Req. 3–5.

After weighing all the *Garmin* factors, we determine that ordering the production of the draft reply declaration is not in the interests of justice, at least with respect to the portions of the declaration other than paragraph five. Accordingly, we deny the Motion as it relates to additional discovery, with the discovery of paragraph five of the draft reply declaration ordered as routine discovery, rendering that aspect moot for purposes of additional discovery.

## II. ORDER

Accordingly, it is

ORDERED that Patent Owner’s Request for Discovery is *granted-in-part* and Petitioner shall produce paragraph 5 of the draft reply declaration

IPR2021-01398  
Patent 7,043,475 B2

within three business days of this Order in a manner mutually agreed-upon  
by the parties.

For PETITIONER:

J. Steven Baughman  
Megan Raymond  
PAUL, WEISS, RIFKIND, WHARTON & GARRISON LLP  
sbaughman@paulweiss.com  
mraymond@paulweiss.com

For PATENT OWNER:

Ashley Moore  
James Quigley  
MCKOOL SMITH, P.C.  
amoore@mckoolsmith.com  
jqigley@mckoolsmith.com