Trials@uspto.gov
Tel: 571-272-7822

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
COMMSCOPE HOLDING COMPANY, INC.,
Petitioner,

v.

BARKAN WIRELESS IP HOLDINGS, L.P.,
Patent Owner.

IPR2020-00827 and -00831 (Patent 8,014,284 B2)
IPR2020-00829, -00833, and -00835 (Patent 8,559,312 B2)
IPR2020-00838 (Patent No. 9,392,638)

Before THU A. DANG, MEREDITH C. PETRAVICK, WILLIAM V. SAINDON, NATHAN A. ENGELS, and JOHN A. HUDALLA, *Administrative Patent Judges*.[1]

SAINDON, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Request for Authorization to File a Motion for Additional Discovery
37 C.F.R. § 42.5

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[1] This is not an expanded panel decision. Judges Petravick, Saindon, and Engels are the panel in IPR2020-00827 and -00831. Judge Engels was not present on the call but joins this decision upon consultation. Judges Dang, Saindon, and Hudalla are the panel in IPR2020-00829, -00833, -00835, and -00838.

On July 27, 2020, we held a conference call with counsel for Petitioner and Patent Owner. Patent Owner requested the call via an email dated July 22, 2020, and sought authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). Specifically, Patent Owner sought additional discovery to ascertain the nature of the relationship between Petitioner and its district court co-defendant, Sprint Corporation.

Patent Owner requests that Petitioner "produce any and all agreements between CommScope and Sprint, including any supply agreements, indemnity agreements, litigation support agreements, and/or IPR support agreements." Patent Owner then requests the following three interrogatories:

1) Identify all agreements between CommScope and Sprint relating to indemnification, common defenses, litigation support, and IPR support.
2) Identify all communications between CommScope and Sprint relating to the agreements identified in response to Interrogatory Number 1 as well as any communications relating to IPR2020-00827, IPR2020-00829, IPR2020-00831, IPR2020-00833, IPR2020-00835, and IPR2020-00838.
3) Identify the three persons most knowledgeable about the agreements identified in response to Interrogatory Number 1 and the communications identified in response to Interrogatory Number 2.

Lastly, Patent Owner requests "the option to depose at least one person identified in response to Interrogatory Number 3."

We heard relevant background information and arguments from both sides. At a high level, a 2006 press release indicated that Petitioner was to supply products to Sprint, and that Sprint was to sell those products. Both Petitioner and Sprint were sued for patent infringement in district court by

Patent Owner on or around October 16, 2019, and are presently co-defendants. No time bar is presently at issue. No other proceedings before the PTAB involve the patents challenged in these proceedings.

During the call, we asked Patent Owner how the requested additional discovery would provide something useful to this proceeding under *Garmin* factor 1. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs., LLC*, IPR2012-00001, Paper 23 (PTAB Mar. 5, 2013) (precedential).[2] Patent Owner asserted that it would be useful to ascertain whether Sprint is a real party in interest. Patent Owner asserted that documents and communications regarding Petitioner's and Sprint's relationship would be useful because Petitioner and Sprint have publicly announced that Petitioner supplies products to Sprint.

Petitioner responded by acknowledging that it is a product vendor to Sprint, and that Petitioner and Sprint were sued in district court at or around the same time and are now co-defendants. Petitioner asserted that there is no time bar issue. Petitioner further asserted that the information sought would be overly burdensome because Petitioner and Sprint have multiple product agreements and because their involvement in the parallel district court proceeding means that they have been required, as co-defendants, to communicate.

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[2] *Garmin* factor 1 requires: "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."

We asked Patent Owner if there was any other reason that the additional discovery may provide something useful to these proceedings, aside from double-checking Petitioner's identification of the real parties in interest in the Petition. Patent Owner asserted that discovery regarding Petitioner's relationship with Sprint would be useful for the estoppel effects that attach to the parties upon a final written decision from the Board. Petitioner responded that estoppel does not attach until the Board issues a final written decision and even then, the scope and applicability of any resulting estoppel would be decided by the district court and not the PTAB.

Based on the information presented to us at this time, we determine that Patent Owner's requested motion for additional discovery would not pass muster under the *Garmin* factors. Accordingly, to save the costs and time associated with briefing the motion, we do not authorize Patent Owner to file a motion for additional discovery at this time. *See* 37 C.F.R. §§ 42.20(b) ("A motion will not be entered without Board authorization."), 42.1(b) ("This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding."). Our reasoning follows.

First, Patent Owner alleges that the utility of the information it seeks to discover is to double-check whether Petitioner complied with its statutory requirement to identify all real parties in interest. *See* 35 U.S.C. § 312(a)(2) (requiring "the petition identifies all real parties in interest"). However, a petitioner's identification of the real parties in interest is accepted until a patent owner presents sufficient reason to put the petitioner's identification into dispute. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1241 (Fed. Cir. 2018) ("[A]n IPR petitioner's initial identification of the real parties in

interest should be accepted unless and until disputed by a patent owner."). A patent owner must produce some evidence that tends to show that a particular third party should be named as a real party in interest, and "[a] mere assertion that a third party is an unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute." *Id.* at 1244.

At this time, Patent Owner has not put forth any evidence or reason to suggest that Petitioner's identification should not be accepted. The mere facts that Petitioner and Sprint are co-defendants in the related district court action, and that Petitioner supplies products to Sprint, are insufficient to suggest that Petitioner should have identified Sprint as a real party in interest. Patent Owner has not offered any reason to believe that Petitioner filed these petitions for the benefit of Sprint or that Sprint is funding or controlling these proceedings, for example. Thus, at this time, Patent Owner's allegation is merely speculative and insufficient to put the issue into dispute, and Patent Owner's desire to double-check Petitioner's identification of real parties in interest does not warrant additional discovery. *See id.*

Further, to the extent Patent Owner is concerned about potential estoppel issues in parallel or later proceedings, those concerns are not properly raised in these proceedings. Concerns regarding estoppel would be ripe at the time and in the forum in which estoppel might be asserted, based on the facts and circumstances as they may exist at such a time, but those concerns do not warrant discovery in these proceedings.

Second, the scope of discovery sought is unduly burdensome, and is not sufficiently tailored to the purported purpose—to ascertain whether Sprint should have been named a real party in interest. Patent Owner's document request and interrogatory #1 seek documents and information related to agreements between Petitioner and Sprint in nearly unlimited timeframes and contexts. Interrogatory #2 asks Petitioner to identify all communications related to the agreements referenced in interrogatory #1, and Patent Owner further requests identification of three persons (interrogatory #3), and then deposition of at least one person, knowledgeable about the agreements. Much, if not most, of the requested information would have little value to any real party in interest inquiry, and the cost and burden in obtaining the information would far outstrip the limited value of double-checking Petitioner's real party in interest identification. *See* 37 C.F.R. § 41.1(b). Accordingly, Patent Owner's discovery request would also fail under *Garmin* factor 5.[3]

In view of the above, we do not authorize Patent Owner to file a motion for additional discovery at this time.

It is so ORDERED.

[3] *Garmin* factor 5 requires: "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."

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PETITIONER:

Kevin Anderson
KPAnderson@duanemorris.com

John Baird
jmbaird@duanemorris.com

Carol Ansley
carol.ansley@commscope.com

PATENT OWNER:

Michael F. Heim
mheim@hpcllp.com

R. Allan Bullwinkel
abullwinkel@hpcllp.com

Blaine A. Larson
blarson@hpcllp.com