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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TWILIO, INC.,
Plaintiff,
v.
TELESIGN CORPORATION,
Defendant.

Case No.16-cv-06925-LHK (SVK)

**ORDER REGARDING DISCOVERY
DISPUTES OF NOVEMBER 3, 2017
AND NOVEMBER 16, 2017**

Re: Dkt. Nos. 145, 149

United States District Court
Northern District of California

Before the Court are two discovery disputes relating to interrogatories and requests for production (“RFP”). ECF 145, 149. The Court is familiar with the parties and posture of this case, having ruled on several issues. *See* ECF 89, 109, 113, 135, 152. By way of relevant background for the matters at hand, the parties submitted their interrogatory dispute on November 3, 2017, wherein TeleSign seeks to compel further responses from Twilio. ECF 145. On November 14, 2017, the Court held a hearing on a previously filed dispute regarding Twilio’s damages contentions. At that hearing, the parties asked the Court to defer ruling on the interrogatory dispute until they could submit yet another dispute arising out of Twilio’s document responses and production. On November 16, 2017, the parties submitted their RFP dispute, wherein TeleSign complains of inadequate responses and productions by Twilio. ECF 149. On November 17, 2017, the Court issued an order on TeleSign’s motion to compel amended damages contentions from Twilio. ECF 152. Having reviewed the joint letters submitted by the parties, the Court orders as follows.

I. November 3, 2017 Interrogatory Dispute

Some of the issues raised in the interrogatory dispute were addressed by this Court’s order on damages contentions. To the extent there are still outstanding issues, the Court addresses them

1 **Interrogatory No. 1:** In large part, the need to compel Twilio to respond to this
2 interrogatory is mooted by the Court’s November 17, 2017 order on damages contentions. ECF
3 152. However, the issue as to “irreparable harm” remains. Twilio’s verb-tense objection is not
4 well taken, and Twilio must respond and identify, with all the particularity that is currently
5 available to it, the irreparable harm that it has suffered or anticipates it will suffer. Twilio’s
6 response is subject to Rule 26(e)(1)(A) and may be amended as necessary.

7 **Interrogatory No. 9:** While Twilio’s definition of a “third party affiliate” seems evident
8 from its position in the submission to the Court, Twilio is ordered to respond to the following
9 question: In response to Interrogatory No. 9, is Twilio excluding from its response only
10 companies related to Twilio? If yes, then no further action is required. If no, such that Twilio is
11 excluding from its definition of “third party” parties not related to Twilio, then Twilio needs to
12 respond to the interrogatory as to those parties.

13 **Interrogatory No. 10:** The Court addressed this dispute in its November 17, 2017 order
14 on damages contentions. ECF 152 at 8.

15 **Interrogatory No. 11:** This interrogatory asks Twilio to provide “on a limitation-by-
16 limitation basis, where and how each alleged claim is valid in view of the Prior Art identified in
17 TeleSign’s Invalidity Contentions” and the reasons therefore. TeleSign cites to other jurisdictions
18 that require such a disclosure under their local rules. However, there is no such requirement in
19 this District. This information is better provided in an expert report, and as such Twilio is not
20 required to respond at this time.

21 **Interrogatory No. 12:** This interrogatory asks Twilio to identify Prior Art relating to the
22 Asserted Patents, excluding the Prior Art cited on the face of the Asserted Patents. Twilio has
23 qualified its response as to “relevant or non-cumulative Prior Art.” The term “prior art” as used in
24 35 U.S.C. § 102(a) requires that the prior publication, public use, etc., relate to the claimed
25 invention. Therefore Twilio’s response, which is narrowed to “relevant” prior art, is not the
26 unilateral limitation on production that TeleSign suggests. Twilio’s response is sufficient.

27 **Interrogatory No. 13:** Pursuant to Patent L.R. 3–1(f), if a plaintiff wishes to assert that its
28 own product practices the claimed invention, it must identify the products which practice each

1 claim. However, a detailed claim chart is not required. *See Nazomi Commc'ns, Inc. v. Arm*
 2 *Holdings PLC*, No. C 02-02521-JF(RS), 2003 WL 24054504, at *2–3 (N.D. Cal. Sept. 3, 2003).
 3 Therefore, the Court orders Twilio to identify its products that it contends embody the asserted
 4 claims and to identify which claims are embodied in which products.

5 **II. November 16, 2016 RFP Dispute**

6 **a. “Relevant” Documents**

7 There is an expectation in discovery that requests and responses are both made in good
 8 faith. In operation, this expectation prevents disputes from drifting into an argument over
 9 semantics. Here, the parties appear to be adrift.

10 The first overarching complaint raised by TeleSign as to 50 RFPs is that Twilio responds
 11 that it is producing “relevant” documents, without having asserted relevance objections. In the
 12 submission to the Court, Twilio states unequivocally that it is not withholding responsive
 13 documents. To the extent Twilio’s written responses do not provide such a clear statement, Twilio
 14 is to supplement its written responses to state, as unequivocally as it does in the submission to the
 15 Court, that it is not withholding responsive documents, and if it is, to identify those documents.
 16 *See Fed. R. Civ. P. 34(b)(2)(C).*

17 Beyond this clarification to be provided by Twilio, the Court finds that Twilio’s response
 18 that it is producing “relevant” documents, particularly in response to the RFPs cited by TeleSign,
 19 to be appropriate because the RFPs cited by TeleSign require some type of limitation in responses
 20 and production, as seen in the examples below.

- 21 • Several of Telsign’s requests seek documents “relating to” a specific topic. Here,
 22 “relating to” and “relevant” are substantially the same. Twilio has limited its
 23 responses to documents that are “relevant” and stated that it is not withholding any
 24 documents. As such, Twilio has produced documents relating to each topic.
 25 Although technically “relevant” could be a subset of “relating to,” it is not
 26 necessarily so. Further, a statement that a party is producing “relevant” documents
 27 and not withholding any documents, particularly in response to a request seeking

1 drifted into an unnecessary dispute over semantics. *See, e.g.*, RFP Nos. 2, 5-7, 9-
2 13.

- 3 • Some requests are limited to documents “sufficient to show” a specific event. For
4 example, RFP No. 44 seeks production of “[d]ocuments sufficient to show the
5 technical operation of any Twilio Products that Practice the Claimed Inventions.”
6 ECF 149-1 at 33. The request does not seek “all documents” that show the
7 technical operation of products but rather, properly, is limited to documents
8 “sufficient to show” the technical operation. As a result of the structure of the
9 request, a response and production limited to relevant documents is not only
10 appropriate but appears to be what TeleSign has asked for.
- 11 • Other requests suffer from a failure to set forth adequate parameters on the
12 documents TeleSign seeks. For example, RFP No. 3 requests “[c]ommunications
13 with licensees, potential licensees or potential infringers of the Asserted Patents,
14 including agreements and settlement negotiations.” ECF 149-1 at 6. Certainly
15 TeleSign does not seek all communications with potential licensees, down to
16 minute emails exchanged regarding logistics of meetings, for example. By limiting
17 its response to only those documents that are relevant, Twilio is placing a good
18 faith limitation on the documents to be produced. As such, the Court finds Twilio’s
19 responses sufficient.

20 **b. Individual RFP disputes**

21 In addition to the general complaint discussed above, TeleSign attempts to identify discrete
22 disputes as to specific RFPs. However, with regards to RFPs 4, 24, 32 and 36, the parties are
23 again adrift, suggesting requests are duplicative, setting forth compromises, then abandoning those
24 comprises in favor of further disagreement. The Court will not revisit the parties’ paths to impasse
25 herein, and instructs the parties to proceed as follows:

26 **RFP No. 4:** This RFP is not duplicative to the extent that it requests internal documents
27 relating to negotiations regarding the Asserted Patents. Twilio is to produce internal documents

28 relating to negotiations regarding the Asserted Patents.

1 **RFP No. 24:** This RFP contains two, separate requests. The first seeks documents
2 relating to licenses or cross-licenses relating to the Asserted Patents. The second requests
3 documents relating to licenses or cross-licenses relating to the Twilio Products that Practice the
4 Claimed Inventions. First, as to Asserted Patents, in the submission to the Court, Twilio states
5 unequivocally that it “has not raised potential infringement or licensing of the Asserted Patents
6 with any third-party other than TeleSign.” ECF 146 at 3. Thus, after Twilio responds to RFP No.
7 4 as modified above, no further response or production will be necessary as to the request relating
8 to licenses or cross-licenses relating to the Asserted Patents.

9 As to the licenses or cross-licenses that relate to the Twilio Products that Practice the
10 Claimed Inventions, the Court finds that these documents have not been covered by other requests.
11 Twilio is ordered to produce the following three categories of documents: 1) Licenses or cross-
12 licenses that relate to the Twilio Products that Practice the Claimed Inventions;
13 2) Communications with third parties regarding those licenses or cross-licenses; and 3) Internal
14 documents relating to those licenses or cross-licenses.

15 **RFP No. 32:** This request seeks agreements with third parties relating to the Asserted
16 Patents. Although Twilio states it is not in possession of any additional agreements with third
17 parties relating to the Asserted Patents, the Court orders Twilio to confirm that it has produced
18 agreements with third parties relating to the invention, reduction to practice, and/or prosecution of
19 the Asserted Patents or state that such agreements do not exist.

20 **RFP No. 36:** Twilio states that it is not aware of having “raised or evaluated potential
21 infringement of the Asserted Patents by any third-party other than TeleSign.” The Court is again
22 puzzled and concerned by statements in the submission that do not appear to have been
23 communicated during the course of meet and confer. Accordingly, for the sake of completeness,
24 the Court orders Twilio to produce any non-privileged documents that identify other products or
25 services, including those of TeleSign, that infringe the Asserted Patents, or confirm that all such
26 documents have been produced.

27 **RFP No. 38:** This dispute presents a semantics game involving the term “manuals.” The
28 language of the RFP does not refer to “support manuals” specifically, although it uses the word

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