

Case IPR2017-01977
Patent No. 8,755,376

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELESIGN CORPORATION

Petitioner

v.

TWILIO INC.

Patent Owner

Case No. IPR2017-01977

Patent: 8,755,376

**PATENT OWNER'S MOTION TO COMPEL ROUTINE DISCOVERY
AND ALTERNATIVE MOTION FOR ADDITIONAL DISCOVERY**

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I. BACKGROUND

Patent Owner requests documents that are solely in Petitioner's possession and relate to Petitioner's development of its infringing products. Evidence in Patent Owner's possession (Patent Owner's own documents) demonstrates that in an effort led by Petitioner's cofounder and product designer Stacy Stubblefield, Petitioner copied Patent Owner's claimed technology to develop Petitioner's infringing products. Petitioner also trumpeted the release of its resulting practicing products as an achievement. Petitioner's development of those products was the result of customer demand years after the priority date of the challenged patent. Patent Owner seeks information from Petitioner's records that will give further weight to Patent Owner's existing evidence that shows copying, Petitioner's need to develop the infringing products to satisfy customer demand, and Petitioner's efforts to develop its infringing products.

In particular, Patent Owner asks the Board to order production of information from Petitioner showing Petitioner's cofounder's and other employees' access of Patent Owner's patented technology, how that information was used by Petitioner, customer requests for Petitioner's resulting infringing products, efforts and time invested in Petitioner's infringing product development, and customer requests that led to the product development.

Copying is an objective indicator of non-obviousness, rendering the sought

evidence relevant to Petitioner’s claims of obviousness. Petitioner knew of the copying allegations well before it filed its Petition but withheld evidence inconsistent with its obviousness claims. The sought information is also relevant to other issues relating to non-obviousness, including long-felt need and failure by others.

While Patent Owner could identify a small number of specific documents that would satisfy its request, Petitioner has threatened Patent Owner with sanctions for even providing the Board with information to identify the specific documents (*e.g.*, by district court Bates number)—even if the information was provided under seal. Petitioner and Patent Owner have those numbers and could provide them quickly if requested by the Board. In an abundance of caution, Patent Owner is not identifying the requested documents more specifically.¹

The Board authorized filing the present motion in its May 24, 2018 Order. Paper No. 16.

II. LEGAL STANDARDS

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

¹ Patent Owner does not object to the Petitioner providing copies of the requested documents to the Board for *in camera* inspection. In the event of such an inspection, Patent Owner contends that full unredacted copies should be provided for context.

documents or things that contains the inconsistency.” 37 C.F.R. § 42.51(b)(1)(iii). The Board may also authorize additional discovery if doing so would be “in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). When authorizing additional discovery, the Board considers whether: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR 2012-00001, Paper 26, at 6–7 (P.T.A.B. Mar. 5, 2013).

III. ARGUMENT

A. Petitioner is Obstructing Discovery into Highly Relevant Information

Petitioner objects to any characterization or attachment of the specific materials Patent Owner seeks—even if filed under seal. Ex. 2036 (May 25, 2018 excerpt of email chain between counsel for the parties). Petitioner is therefore preventing Patent Owner from making the most specific, narrow request possible. Petitioner is using the illusion that its designation of its own documents under the district court protective order somehow prevents it from providing the information in this case. Petitioner is blocking the Board’s ability to assess discovery and the merits in this case.

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