

Case IPR2017-01976 (Patent 8,837,465)

Case IPR2017-01977 (Patent 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: IPR2017-01976 (Patent 8,837,465)

Case: IPR2017-01977 (Patent 8,755,376)

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

Table of Contents

I.	Overview.....	1
II.	Relevant Legal Standards	2
III.	Patent Owner’s First Request Should be Denied.	3
	A. <i>Garmin</i> Factor 1 disfavors granting Patent Owner’s motion because 1) mere “access” is not relevant to copying and 2) Patent Owner fails to show more than mere allegations that something useful would be uncovered through discovery relating to copying.....	4
	1. Mere Access to information is not relevant to copying.....	4
	2. Patent Owner relies on mere allegations.....	6
	B. <i>Garmin</i> Factor 2 disfavors granting Patent Owner’s motion because it seeks an admission that Petitioner did something inappropriate.	9
	C. <i>Garmin</i> Factor 4 disfavors granting Patent Owner’s motion because Patent Owner’s first document request is not easily understandable...	9
	D. <i>Garmin</i> Factor 5: Complying with Patent Owner’s first document request would subject Petitioner to an undue burden.	9
IV.	Patent Owner’s Second Request for Documents Should Be Denied.	10
	A. <i>Garmin</i> Factor 1 disfavors granting Patent Owner’s motion because it would not yield useful information and is founded on allegations...	10
	B. <i>Garmin</i> Factor 3 disfavors granting Patent Owner’s motion because Patent Owner could generate equivalent customer-request information on its own.	12
	C. <i>Garmin</i> Factor 4 disfavors granting Patent Owner’s motion because Patent Owner’s first document request is not easily understandable.	12
	D. <i>Garmin</i> Factor 5 disfavors granting Patent Owner’s motion because it would subject Petitioner to an undue burden.	12
V.	Patent Owner’s delay Should Not Be Rewarded.....	13

Case IPR2017-01976 (Patent 8,837,465)

Case IPR2017-01977 (Patent 8,755,376)

VI. Patent Owner’s secondary considerations discovery requests do not constitute routine discovery.	14
VII. Conclusion	15

I. OVERVIEW

Patent Owner seeks the following broad and vague additional discovery:¹

- “Documents showing Stacy Stubblefield’s and other Petitioner agents’ or employees’ access of Patent Owner’s patented technology, including documents showing how that information was used by Petitioner or Stacy Stubblefield.”
- “Documents showing customer requests that led to Petitioner’s development of its products accused of infringement in the related district court proceeding.”

Motion, p. 4. But by providing only allegations, Patent Owner has failed to carry its burden to show that its requested discovery is “necessary” in the interest of justice. Patent Owner advances nothing more than bare assertions and unfounded conclusions to support its motion for additional discovery ostensibly relating to secondary considerations that, even if taken as true, fail to establish more than a mere

¹ Contrary to Patent Owner’s assertion (p. 2), Petitioner’s counsel never threatened Patent Owner with sanctions if it disclosed Bates labels. It is common knowledge that Bates labels themselves are not confidential. But the fact that Patent Owner has chosen to submit discovery requests reveals their impropriety.

Case IPR2017-01976 (Patent 8,837,465)

Case IPR2017-01977 (Patent 8,755,376)

allegation that something useful will be discovered.

Patent Owner fails to provide even the most basic and fundamental information relating to its assertion that it is entitled to discovery relating to secondary indicia. For example, Patent Owner does not identify the novel aspects of the challenged claims or identify any evidence or reasoning tending to show a nexus between these novel aspects and its assertions relating to supposed copying, long-felt unmet need, or customer demand. Nor does Patent Owner identify what Patent Owner products Petitioner has allegedly copied, much less allege or provide any evidence tending to show that these Patent Owner products encompass the challenged claims. Essentially, Patent Owner asks the Board to grant it discovery relating to secondary considerations because it has a hunch it might uncover something useful. This is not the standard. Moreover, granting Patent Owner's motion would be unduly burdensome to Petitioner and stands to unnecessarily and improperly increase the complexity and record of this proceeding inasmuch as Petitioner would need to marshal competing evidence to place any documents into their proper and non-distorted context (including, for example, supporting declarations and obligatory depositions) within a compressed timeframe. Patent Owner's motion should be denied.

II. RELEVANT LEGAL STANDARDS

“Discovery in an *inter partes* review proceeding [] is more limited than what

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