

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION AND
BLACKBERRY LIMITED
Petitioner,

v.

WI-LAN USA INC.
Patent Owner.

Case IPR2013-00126 (JL)
Patent 6,240,088

Before JAMESON LEE, GLENN J. PERRY, and THOMAS L. GIANNETTI,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Introduction

A joint telephone conference call was held on August 16, 2013, among Judges Lee, Perry, and Giannetti, and respective counsel for the parties. The

purpose of the call was to discuss Patent Owner (“Wi-Lan”)’s First Request for Production of Documents and Things, which is attached as an Appendix to this Order. Counsel for Wi-Lan stated that the response provided by Petitioner (“BlackBerry”) was that the request does not constitute routine discovery under 37 C.F.R. § 42.51(b)(1)(i) and is, therefore, not permitted in an *inter partes* review. Counsel for Wi-Lan sought the Board’s guidance on whether Items 1-7 in that request constitute “routine discovery.”

Discussion

The Board explained that routine discovery under 37 C.F.R. § 42.51(b)(1) is self-executing and self-enforcing, and thus there is no occasion for Wi-Lan to serve a discovery request that purports to be “routine discovery.” Thus, requests for production of documents are neither required nor authorized by the rules for routine discovery. *See* 37 C.F.R. § 42.51(c) (“Production of Documents”). On the other hand, if Wi-Lan has specific reasons to doubt that BlackBerry has complied with the requirements of routine discovery under 37 C.F.R. § 42.51(b)(1), it may communicate those concerns to BlackBerry and ask BlackBerry to reaffirm that it has complied with the requirements of routine discovery.

The Board also explained that the Federal Rules of Civil Procedure does not apply in an *inter partes* review, and therefore the instructions in Wi-Lan’s request appear inappropriate insofar as they seek to apply those rules in this proceeding.

The Board further noted that in Item 1 of the request, Wi-Lan went beyond the limitations on routine discovery provided by the Board’s rules by adding “or relied upon” to just “cited,” which appears not to be in accordance with the requirements of routine discovery. Finally, the Board noted that in Items 2-7, Wi-

Lan added a level of indirection by using the words “relating to information inconsistent with ...,” rather than just “information inconsistent with ...” That also appears not to be in accordance with the requirements of routine discovery.

Conclusion

Items 1-7 of Wi-Lan’s First Request for Production of Documents and Things, dated July 19, 2013, do not constitute routine discovery under 37 C.F.R. § 42.51(b)(1).

It is

ORDERED that BlackBerry need not respond to Items 1-7 of Wi-Lan’s First Request for Production of Documents and Things, dated July 19, 2013, as routine discovery.

Case IPR2013-00126
Patent 6,240,088

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORPORATION
Petitioner,

v.

Patent of WI-LAN USA INC.
Patent Owner.

Case IPR2013-00126
Patent U.S. 6,240,088

**PATENT OWNER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS AND
THINGS TO RESEARCH IN MOTION CORPORATION**

Wi-LAN USA Inc. ("Patent Owner") requests Research In Motion Corporation, now known as BlackBerry Corporation ("Petitioner"), to respond and produce the following documents and things pursuant to Rules 26 and 34 of the Fed. R. Civ. P. and the Patent Trial and Appeal Board's Scheduling Order.

I. INSTRUCTIONS AND DEFINITIONS

In responding and producing documents and things responsive to these Requests, please comply with the Board's Scheduling Order and instructions in the Office Patent Trial Practice Guide.

1. "You," "Your," or "Petitioner" means Research In Motion Corporation, RIM, and/or BlackBerry Corporation and includes any and all agents, affiliated companies, predecessors or successor in interest, divisions, related business entities, officers, directors,

managers, employees, representatives, privies, expert witnesses, or others authorized to act on their behalf.

2. “Identify” means provide information sufficient to enable Patent Owner to locate the person, document, thing, communication, or other information with minimal effort.

3. The terms “documents” and “things” encompass the broadest meaning in accordance with Federal Rules of Civil Procedure, including, without limitation, every writing or recording of every kind, whether handwritten, typed, printed or recorded by any physical mechanical, or electronic means, electronically stored information (ESI), and any physical specimen or tangible item.

4. “Proceeding” shall mean *Inter Partes* Review Case No. IPR2013-00126.

5. “Petition” shall mean the Corrected Petition for *Inter Partes* Review of U.S. Patent No. 6,240,088.

6. Please timely amend Your responses if You learn that any response is incomplete or additional responsive information is found.

7. You must produce documents and things either (a) as they are kept in the usual course of business, or (b) organized and labeled to correspond with the particular categories set forth below. Please copy and/or produce any files or containers in which the responsive documents are kept.

8. Identify any responsive documents You are aware of but cannot produce because they have been lost or destroyed or are no longer in Your possession with information sufficient to enable Patent Owner to understand the subject matter of any such documents.

9. If You object to a portion or an aspect of any Request, state the grounds of Your objection with specificity and respond to the remainder of the Request.

10. If, in answering these Requests, You believe there is any ambiguity in a Request, instruction, or definition, Your response shall set forth the matter deemed ambiguous and the construction used in responding.

11. For any document withheld based upon a claim of privilege, please provide a privilege log according to the requirements of Fed. R. Civ. P. 26.

II. DOCUMENTS AND THINGS REQUESTED

1. All documents and things cited or relied upon in any of Petitioner's papers in this Proceeding that have not already been attached as an Exhibit to a paper in this Proceeding.

2. All documents and things relating to information that is inconsistent with a position You advanced during this Proceeding.

3. All documents and things relating to information inconsistent with Your position that "the broadest reasonable interpretation of claim 19 of the '088 Patent does not require that the first portion include any portion of the body of the alphanumeric message." (Petition at pg. 4).

4. All documents and things relating to information inconsistent with Your position that U.S. Patent No. 6,157,630 to Adler teaches "transmitting from the electronic communication transmitter to the electronic communication receiver the first portion of the alphanumeric message, the first portion being an initial portion of the alphanumeric message." (Petition at pg. 25).

5. All documents and things relating to information inconsistent with Your position that U.S. Patent No. 5,838,252 to Kikinis describes "transmitting from the electronic communication transmitter to the electronic communication receiver the first portion of the

alphanumeric message, the first portion being an initial portion of the alphanumeric message.” (Petition at p. 30).

6. All documents and things relating to or supporting any claim construction position advanced by Petitioner in any other proceeding that is inconsistent with any position advanced by Petitioner in this Proceeding.

7. All documents and things relating to information inconsistent with Your position that the “challenged claims are given their broadest reasonable interpretation in light of the specification.” (Petition at pg. 4).

8. All documents and things reviewed or relied upon by Kevin J. Negus in the December 14, 2012 Declaration of Dr. Kevin J. Negus Regarding Claim Construction of the ‘369, ‘969, and ‘088 Patents (“Negus Decl.”) regarding his opinion that “one of ordinary skill in the art would understand that an MCR formatted message is not needed if the final stage of data is being transmitted because there is not a need for a user to request more data since there is no more data to send.” (Negus Decl. at ¶ 24).

9. With respect to ¶ 25 of the Negus Decl., which quotes the following language from the ‘088 Patent’s prosecution history,

[t]he claimed invention is directed to a process in which each data portion is transmitted in a ‘human comprehensible form,’ not an intermediate form. No additional data conversion is permitted in the data transmission process claimed by the applicants[.]

all documents and things reviewed or relied upon by Negus regarding his opinion that “[o]ne of ordinary skill in the art would understand that this phrase excludes, for example, transmissions of compressed or encrypted data.” (Negus Decl. at ¶ 25).

Wi-LAN USA Inc.

Dated: July 19, 2013

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO RESEARCH IN MOTION CORPORATION** is being served on July 19, 2013 via e-mail to:

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