

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ADOBE INC.,  
Petitioner,

v.

RAH COLOR TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2019-00627 (Patent 7,729,008 B2)  
Case IPR2019-00628 (Patent 8,416,444 B2)  
Case IPR2019-00629 (Patent 7,312,897 B2)  
Case IPR2019-00646 (Patent 7,791,761 B2)<sup>1</sup>

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Before ELENI MANTIS MERCADER, FRANCES L. IPPOLITO, and  
JOHN A. HUDALLA, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION

Granting-in-Part Patent Owner's Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

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<sup>1</sup> This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

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## I. Introduction

Patent Owner RAH Color Technologies LLC (“Patent Owner”)<sup>2</sup> filed a Motion for Additional Discovery (Paper 12, “Mot.”) in the instant proceedings, and Petitioner Adobe Inc. (“Petitioner” or “Adobe”) filed an Opposition (Paper 13, “Opp.”).<sup>3</sup> For the reasons stated below, Patent Owner’s Motion is granted-in-part.

### a. Background

Patent Owner’s Motion requests additional discovery regarding the real parties-in-interest (“RPIs”) to this petition—namely, some or all of the parties involved in a multi-district litigation (“MDL”). Mot. 1–2.

By way of background, we list the various related district court matters involving the patents, to varying degrees, in these four IPR proceedings:

- *RAH Color Technologies LLC v. Adobe Inc.*, Case No. 3:18-cv-03277 (N.D. Cal.)
- *Electronics for Imaging v. RAH Color Technologies LLC*, Case No. 1:18-cv-01436 (E.D. Va.)
- *RAH Color Technologies LLC v. Dalim*, Case No. 1:19-cv-00275 (N.D. Ill.)
- *RAH Color Technologies LLC v. Kodak*, Case No. 6:19-cv-06112 (W.D.N.Y.)
- *RAH Color Technologies LLC v. Heidelberger Druckmaschinen AG*, Case No. 1:19-cv-00193 (N.D. Ill.)

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<sup>2</sup> Patent Owner refers to itself as “RAHCT” in its proposed interrogatories, as discussed below.

<sup>3</sup> See IPR2019-00627, Papers 9 (authorizing filing of the Motion), 12 (“Mot.”), 13 (“Opp.”); IPR2019-00628, Papers 9, 12, 13; IPR2019-00629, Papers 9, 13, 14; IPR2019-00646, Papers 9, 12, 13. Although the analysis herein applies to all four proceedings, we refer to the papers and exhibits filed in Case IPR2019-00627 for convenience.

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- *RAH Color Technologies LLC v. Xerox Corporation*, Case No. 6:18-cv-06746 (W.D.N.Y.)

See IPR2019–00627, Paper 10, 2–3; IPR2019–00628, Paper 10, 2–3; IPR2019–00629, Paper 11, 2; IPR2019–00646, Paper 10, 2–3.

According to the parties, the Judicial Panel on Multidistrict Litigation has transferred and consolidated the Adobe, Xerox, Electronics for Imaging (“EFI”), Kodak, Dalim, and Heidelberger Druckmaschinen AG (“Heidelberger”) cases for coordinated pretrial proceedings in the Northern District of California. *In re: RAH Color Technologies LLC Patent Litigation*, Case No. 3:18-md-02874-SI (N.D. Cal.) (referred to as “MDL”). See IPR2019-00627, Paper 10, 3. The MDL involves ten (10) patents, six (6) of which are not the subject of these four IPR proceedings. Ex. 2004. Of these cases, the parties note that the “Xerox case [was filed] on September 20, 2017 (more than a year before Adobe filed its IPR Petitions).” *Id.*; see Opp. 1 n. 1 (“Xerox would be time-barred under 35 U.S.C. § 315(b).”).

*b. Additional Discovery*

In an *inter partes* review, a party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); see 37 C.F.R. § 42.51(b)(2)(i). Patent Owner, as the movant, bears the burden of demonstrating that it is entitled to the additional discovery sought. 37 C.F.R. § 42.20(c). We consider the five factors set forth in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (“*Garmin*”), in determining whether additional discovery is necessary in the interest of justice. The five *Garmin* factors are: (1) whether there

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exists more than a possibility and mere allegation that something useful will be discovered; (2) whether the requests seek the other party's litigation positions and the underlying basis for those positions; (3) whether the moving party has the ability to generate equivalent information by other means; (4) whether the moving party has provided easily understandable instructions; and (5) whether the requests are overly burdensome to answer. *Id.*

*c. Real Parties In Interest, Privies, And Time Bar*

The AIA requires that “[a] petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” 35 U.S.C. § 312(a). In addition, “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. §315(b). “To decide whether a party other than the petitioner is the real party in interest, the Board seeks to determine whether some party other than the petitioner is the ‘party or parties at whose behest the petition has been filed.’” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018) (emphasis added). “A party that funds and directs and controls an IPR or post-grant review proceeding constitutes a ‘real party-in-interest,’ even if that party is not a ‘privy’ of the petitioner.” *Id.* Also, several relevant factors for determining whether a party is a real party in interest include the party's relationship with the petitioner, the party's relationship to the petition, and the nature of the entity filing the petition. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“AIT”).

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## II. Discussion

### a. Patent Owner's Discovery Requests

Patent Owner in its Motion seeks the following discovery:

#### Interrogatory 1

Identify any joint defense or common interest agreements between Adobe and any of the MDL Counterparties (and anyone representing any MDL Counterparty) that relate to, or include, the coordination of any invalidity defense related to any RAHCT patent, by stating the date of each agreement, the parties to the agreement, and the individuals who participated in making the agreement.

#### Interrogatory 2

Provide a privilege log of the communications that Adobe (or anyone representing Adobe) had with any of the MDL Counterparties (and anyone representing any MDL Counterparty) that discussed the alleged prior art to the RAHCT patents that is included in the Adobe IPR Petitions by stating the date of the communication, the communication type (e.g. email, phone call) and the participants/recipients, and for written communications, the author.

#### Interrogatory 3

Provide a privilege log of the communications that Adobe (or anyone representing Adobe) had with any of the MDL Counterparties (and anyone representing any MDL Counterparty) that discuss any strategy for presenting any invalidity argument (e.g. procedure, timing, forum (district court, PTAB) or selection of references) by stating the date of the communication, the communication type (e.g. email, phone call) and the participants/recipients, and for written communications, the author.

Ex. 2003, 1. For these requests, Patent Owner defines "MDL Counterparty" as Xerox, EFI, Heidelberg, and Dalim. *Id.*

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*b. Patent Owner's Position*

Patent Owner asserts that MDL Counterparties Xerox, EFI, Heidelberger, and Dalim are “potential RPIs” that have not been named in the Petitions. Mot. 2. According to Patent Owner, a “defense group” formed among the MDL Counterparties and Adobe by the time of the December 2018 MDL consolidation.

*Id.* Patent Owner asserts that its requested discovery seeks “basic facts about when the joint defense group formed and what entities are involved by what dates.” *Id.* at 2.

Patent Owner further asserts that Petitioner has taken a leadership role in coordinating the MDL Counterparties, including acting on the MDL Counterparties' behalf and coordinating invalidity strategy/defense. Mot. 2–3. Patent Owner asserts Petitioner has admitted that it assessed and discussed a draft “Joint Preliminary Status Report,” including Patent Owner's proposed summary judgment procedure, with other co-defendants. Mot. 3 (citing Ex. 2007). Further, Patent Owner contends that by January 7, 2019, Adobe had discussed the IPRs with Xerox and EFI, a month before the IPR petitions were filed. Mot. 3 (citing Ex. 2011). Patent Owner contends that a privilege log produced by Adobe shows that Adobe and the MDL Counterparties discussed the strategy of how and when their invalidity defenses should be presented in the IPRs and the MDL litigation. *Id.* (citing Ex. 2006, 2 § 3). Patent Owner asserts that beyond the communications on page 2 of Exhibit 2006, Patent Owner does not know the full extent to which Adobe and the MDL Counterparties discussed their unified strategy for presenting any invalidity argument. Mot. 3–4 (referring to Interrogatory 3).

Additionally, Patent Owner asserts that prior to the IPR filings, Adobe's invalidity contentions from the litigation identified about 200 references, and

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contained 105 charts. Mot. 3. Patent Owner argues that the “IPRs contained a smaller set of alleged prior art, which may have been selected for IPR based on discussions of the alleged prior art among the MDL Defendants.” Mot. 4. Patent Owner contends that it is unknown whether Adobe and the MDL Counterparties discussed the alleged prior art to the Patent Owner’s patents that was ultimately included in the IPR Petitions. *Id.* (referring to Interrogatory 2).

*c. Petitioner’s Position*

In its Opposition, Petitioner asserts that on January 7, 2019, Petitioner informed Xerox and EFI of Petitioner’s intent to file IPR petitions while Petitioner (Adobe), Xerox, and EFI were discussing the edits to a joint status report that was to be filed in the MDL. Opp. 2. Petitioner adds that Patent Owner became aware of Petitioner’s intent to file IPRs when Petitioner sent the red-lined joint status report draft to Patent Owner. Then, Patent Owner raised the real party-in-interest issue and sent Petitioner document requests regarding any and all communications relating to invalidity arguments between the Petitioner (Adobe) and any MDL Counterpart. Opp. 2–3 (citing Ex. 1035, 7). In response, Petitioner provided Patent Owner with a privilege log of all communications between Adobe and the MDL Counterparties regarding the IPRs. Ex. 2006. Petitioner further represented in an email response that

[r]egarding Xerox and EFI, Adobe first informed Xerox and EFI that it intended to file IPRs on January 7, 2019. The next day, Adobe informed RAH that Adobe intended to file IPRs when we sent the redlines to the Joint Preliminary Status Report to you. Adobe did not discuss the IPRs with Xerox or EFI before or after that. Neither Xerox nor EFI funded, directed, controlled, or reviewed any part of the IPRs prior to Adobe filing them, nor was any material provided by Xerox or EFI used in the IPRs.

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Ex. 1035, 1–2.

With respect to the requested interrogatories, Petitioner argues that Patent Owner has not presented any evidence tending to show beyond speculation that something useful will be uncovered. Opp. 1. Petitioner reiterates that it has already produced a privilege log showing all communications between Adobe and MDL Counterparties regarding the IPRs. Opp. 4. Petitioner represents that other than notifying Xerox and EFI of Adobe’s intent to file IPRs because the parties were required to update the district court with the status of the co-pending litigations, Adobe did not discuss the IPRs with the MDL Counterparties. *Id.* at 6. Additionally, Petitioner asserts that the four IPR petitions challenge some but not all the claims asserted in the MDL against MDL Counterparties. Opp. 7.

Petitioner’s Exhibit 1037 is reproduced below.

Patent	Claims Against Adobe & Challenged in Adobe’s IPRs	Claims Against Xerox	Claims Challenged By EFI	Claims Against Heidelberger	Claims Against Dalim	Claims Against Kodak
7,729,008	28, 29, 30, 31, 32, 33, 36, 37, 38	28, 30, 31, 37, 39	28, 29, 30, 31, 33, 35, 36, 37, 39, 41	28, 29, 30, 31, 33, 36, 37, 38, 39, 41	28, 29, 30, 31, 36, 41	28, 29, 30, 31, 33, 34, 36, 37, 38, 41
7,312,897	32, 33, 37	61			32, 33, 37	32, 33, 37
8,416,444	11, 13, 15, 18, 19, 26, 27	11, 15, 20, 41, 42	11, 15, 20, 41, 42	11, 13, 15, 20, 21, 23, 24		
7,791,761	7, 8, 9, 10, 11, 13, 15					
6,995,870		34, 39, 43	34, 39, 43	34, 39, 41, 43	34, 39, 41, 42	34, 39, 41, 42, 43
8,760,704		11, 12, 17, 18, 20, 21, 29-32, 34, 35	11, 12, 29, 30, 31, 34, 35	17, 18		17, 18
6,04,3909		36-38				
7,280,251		9, 19-21				
7,710,560				46, 51, 54, 55		
8,638,340						8, 9

\* Red text indicates claims that are not challenged in Adobe’s IPRs

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Exhibit 1037 is a chart created by Petitioner showing the claims asserted by Patent Owner in the MDL for each of the ten (10) patents at issue. The red text indicates claims that are not challenged in Petitioner's four IPR petitions. *Id.*

With regard to coordination of invalidity defense strategy, Petitioner contends that it is simply complying with the district court's order for the MDL Counterparties to coordinate with one another, and the district court's appointment of Petitioner's counsel as the liaison for the MDL Counterparties to streamline administrative issues. *Id.* at 8 (citing Ex. 1038, 17:1–3).

*d. Analysis*

With the parties' positions in mind, we turn to the specific discovery requests and the *Garmin* Factors.

*i. Interrogatory No. 1*

Interrogatory No. 1 asks Petitioner to identify joint defense agreements with the MDL Counterparties. Ex. 2003. For the first *Garmin* factor, Patent Owner contends that there is no speculation involved because Petitioner's counsel has already confirmed that it has discussed the IPRs with the MDL Counterparties as part of the careful coordination of their unified invalidity defense. Mot. 7. Patent Owner contends that the facts already available show the parties' interests in the IPR filings; coordination of their invalidity defense at the time of the MDL; advance notice of the IPR filings; and opportunity to control the IPR filings. *Id.*

Patent Owner adds that Petitioner has stated there are one or more unwritten joint defense agreements. Mot. 7 (citing Exs. 2006, 2010). Patent Owner argues that the facts of when the agreements were entered and what entities entered them are relevant to determining which entities are coordinating, the extent of their coordination, their control and opportunity to control IPRs. Mot. 7.

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Initially, we observe that Petitioner has not refuted Patent Owner's claim that a joint defense or common interest agreement exists between Petitioner Adobe and the MDL Counterparties. *See generally* Opp. The email correspondence between Petitioner's and Patent Owner's counsel indicates that as of April 4, 2019, there is "*not yet a written* joint defense or common interest agreement between Adobe and any of the Counterparties." Ex. 2010 (emphasis added). Nonetheless, it appears that some agreement, whether oral or written, exists between Petitioner and MDL Counterparties. Petitioner makes several arguments to the effect that a joint defense agreement alone or alignment of litigation positions/interests by itself does not establish a real part-in-interest relationship. Be that as it may, we note that the real party-in-interest inquiry is heavily fact-dependent and the outcome may depend on the contents of the joint defense agreement (if one exists) that outlines the relationship between the Petitioner and a non-party. Petitioner has indicated that some sort of agreement exists between Adobe and the MDL Counterparties. *See* Ex. 2010. Thus, Patent Owner has supplied the required threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.

Next, we determine that the second, third, fourth, and fifth *Garmin* factors weigh in favor of Patent Owner. Patent Owner's Interrogatory No. 1 does not seek the Petitioner's litigation positions and is easily understandable. Further, we agree that Patent Owner has no ability to obtain equivalent information by other means. Mot. 8–9. We also agree that Interrogatory No. 1 is not overly burdensome because Petitioner need only *identify* the joint defense/common interest agreements. That being said, we also determine that Patent Owner's Interrogatory No. 1 is too broad insofar as it seeks any joint defense or common interest

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agreement relating to any of ten (10) patents at issue in the MDL. Ex. 2003, 1 (“any RAHCT patent.”). “[T]he focus of the real-party-in-interest inquiry is on the *patentability of the claims challenged in the IPR petition*, bearing in mind who will benefit from having those claims canceled or invalidated.” *AIT*, 897 F.3d at 1348 (emphasis added). Only four (4) patents from the MDL are involved in the IPRs. Thus, we limit and modify Patent Owner’s Interrogatory No. 1 as follows:

Identify any joint defense or common interest agreements between Adobe and any of the MDL Counterparties (and anyone representing any MDL Counterparty) that relate to, or include, the coordination of any invalidity defense related to ~~any RAHCT patent~~ U.S. Patent Nos. 7,729,008 B2, 8,416,444 B2, 7,312,897 B2, or 7,791,761 B2, by stating the date of each agreement, the parties to the agreement, and the individuals who participated in making the agreement.

With this modification in mind, we determine that, on balance, the *Garmin* factors, indicate that the requested Interrogatory No. 1 is in the interests of justice. Thus, we grant Patent Owner’s motion for additional discovery as to the modified version of Interrogatory No. 1.

*ii. Interrogatory No. 2*

Interrogatory No. 2 seeks a privilege log of communications related to discussions of the prior art asserted in these proceedings. Ex. 2003. For the first *Garmin* factor, Patent Owner contends that there is no speculation involved because Petitioner’s counsel has already confirmed that it has discussed the IPRs with the MDL Counterparties as part of their unified invalidity defense. Mot. 7. Patent Owner adds that Adobe’s email in Exhibit 2011 only states that Adobe “did not discuss the IPRs with Xerox or EFI before or after” January 7, 2019. Mot. 7. Patent Owner argues that “[i]f Adobe and the MDL Counterparties jointly

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discussed the strengths and shortcomings of the references, combinations of references, or the like, these conversations are relevant to the RPI issue.” *Id.* at 8.

We determine that Patent Owner’s assertions that the requested log of communications are “likely” to uncover relevant evidence are not sufficient to establish evidence or reasoning tending to show beyond speculation that something useful will be uncovered. *See Garmin*, slip op. at 7 (Paper 26) (useful “does not mean merely ‘relevant’”). To start, Patent Owner does not explain adequately why the logs are likely to produce anything that is useful as opposed to merely potentially relevant. Petitioner has already provided a privilege log of *all* communications between the MDL Counterparties regarding the IPR proceedings. Ex. 2006. Further, Petitioner has represented to Patent Owner that “Adobe first informed Xerox and EFI that it intended to file IPRs on January 7, 2019. The next day, Adobe informed RAH that Adobe intended to file IPRs when we sent the redlines to the Joint Preliminary Status Report to you. *Adobe did not discuss the IPRs with Xerox or EFI before or after that.*” Ex. 2011 (emphasis added). Patent Owner does not dispute Petitioner’s representations. Rather, Patent Owner postulates that there “may” be communications beyond what Petitioner has provided because Petitioner chose a smaller set of alleged prior art for the IPRs from the larger set of references at issue in the litigation “based on discussions of the alleged prior art among the MDL Defendants.” Mot. 4 (referring to Interrogatory 2). However, there is no threshold evidence or reasoning tending to show that (1) the alleged communications occurred; and (2) the selection of prior art references for the IPRs was based on these communications (if any). In any case, it is mere speculation to assume that such communications exist and that these possible communications discussed by MDL Counterparties would be

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potentially useful for a real party-in-interest inquiry. For these reasons, we determine that the first *Garmin* factor favors Petitioner with respect to Interrogatory No. 1.

As for the second *Garmin* factor, Patent Owner argues that its requests do not seek Petitioner's litigation positions. Mot. 8. Petitioner asserts that the requested logs indicate when the discussions happened and which entities participated, but not the substance of those communications. *Id.* Given that the log would not include the substance of discussions, we determine that the second *Garmin* factor favors Patent Owner.

Next, we determine that the third *Garmin* factor favors Petitioner. Patent Owner has already received Petitioner's privilege log of *all* communications between Adobe and the MDL Counterparties regarding the IPRs. Ex. 2006. Further, Petitioner has represented to Patent Owner that other than informing Xerox and EFI that it intended to file IPRs on January 7, 2019, Adobe did not discuss the IPRs with Xerox or EFI before or after that. Ex. 1035, 1–2. Based on the produced privilege log and Petitioner's representations, we understand Patent Owner to possess the information that it seeks in Interrogatory No. 2. Namely, Petitioner represents expressly that there are no other communications between Adobe and MDL Counterparties regarding the IPRs that have not otherwise been identified in the log provided to Patent Owner. Exs. 1035, 2006. Thus, we determine that Patent Owner already has obtained equivalent information by other means (e.g., Exhibits 1023 and 2006). Accordingly, the third *Garmin* factor favors Petitioner with respect to Interrogatory No. 2.

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With regard to the fourth *Garmin* factor, Interrogatory No. 2 is understandable and Patent Owner provides some instructions and definitions for guidance. Ex. 2003, 1. We determine that this factor favors Patent Owner.

With regard to the fifth *Garmin* factor, we consider Interrogatory No. 2 to require Petitioner to reproduce the responsive information that Petitioner has already provided Patent Owner. As discussed, we accept Petitioner's representation that it has identified *all* communications between Adobe and MDL Counterparties regarding the IPRs in the privilege log, and that this information has been produced to Patent Owner. Exs. 1035, 2006. We determine that requiring Petitioner to reproduce this information is unnecessary and unduly burdensome. Thus, the fifth *Garmin* factor favors Petitioner with respect to Interrogatory No. 2.

In conclusion, we determine that, on balance, the *Garmin* factors, particularly the *first*, *third*, and *fifth* *Garmin* factor, do not indicate that the requested Interrogatory No. 2 is in the interests of justice. Thus, we deny Patent Owner's motion for additional discovery as to Interrogatory No. 2.

*iii. Interrogatory No. 3*

Interrogatory No. 3 seeks a privilege log of communications related to discussions of "any strategy for presenting any invalidity argument." Ex. 2003.

For the *first* *Garmin* factor, Patent Owner argues that the MDL Counterparties' preparation of a unified and coordinated invalidity strategy in the IPRs and through the MDL litigation is relevant to whether they are RPIs. Mot. 8. Patent Owner proposes that the MDL Counterparties "may have discussed which forum might be most receptive to their arguments, and how the MDL litigation should be handled in light of the IPRs (although they may or may not have said the word "IPR" in these conversations)." *Id.*

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We observe first that Interrogatory No. 3 suffers the same failings as Interrogatory No. 2. As discussed, Petitioner's privilege log (Exhibit 2006) identifies all communications between Adobe and MDL Counterparties regarding the IPRs. These communications do not describe or suggest that other communications occurred regarding any forum selection considerations. Ex. 2006. Moreover, Petitioner has already expressly represented that there are no other communications regarding the IPRs between Adobe and MDL Counterparties. *See* Ex. 1035. We note further that Petitioner Adobe has been appointed by the district court as the "liaison" for the MDL counterparties. Ex. 2005, 2. This role necessarily requires some communication between Adobe and the MDL Counterparties regarding scheduling issues (e.g., briefing schedules), appearances, etc., in the MDL. *See* Ex. 2004. Even so, the fact remains that with respect to communications about these IPR proceedings, Petitioner has already identified *all* the communications. Thus, Patent Owner's requested discovery would trawl the seabed without a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered. For these reasons, we determine that the first *Garmin* factor favors Petitioner.

For the second *Garmin* factor, Patent Owner argues that its requests do not seek Petitioner's litigation positions. Mot. 8. Petitioner asserts that the requested logs indicate when the discussions happened and which entities participated, but not the substance of those communications. *Id.* Given that the log would not include the substance of discussions, we determine that the second *Garmin* factor favors Patent Owner.

Additionally, we determine that the third *Garmin* factor favors the Petitioner. As discussed, Patent Owner has Petitioner's privilege log of *all*

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communications between Adobe and the MDL Counterparties regarding the IPRs. Ex. 2006. Petitioner has represented to Patent Owner that there are no other communications regarding the IPRs between Adobe and MDL Counterparties. Ex. 1035, 1–2. Thus, Patent Owner already has obtained equivalent information sought in Interrogatory No. 3 by other means (e.g., Exhibits 1023 and 2006). Accordingly, the third *Garmin* factor favors Petitioner.

With regard to the fourth *Garmin* factor, we determine Interrogatory No. 3 is understandable, and Patent Owner has provided instructions and definitions for guidance. Ex. 2003, 1. We determine that this factor favors Patent Owner.

Finally, we determine that the fifth *Garmin* factor favors Petitioner. Interrogatory No. 3 essentially burdens Petitioner with the task of reproducing responsive information that Petitioner has already provided to Patent Owner. *See* Exs. 1035, 2006. We consider this to be unduly burdensome. Thus, the fifth *Garmin* factor weighs in favor of Petitioner.

In conclusion, we determine that, on balance, the *Garmin* factors, particularly the *first*, *third*, and *fifth* *Garmin* factor, do not indicate that the requested Interrogatory No. 3 is in the interests of justice. Thus, we deny Patent Owner's motion for additional discovery as to Interrogatory No. 3.

#### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion for Additional Discovery is granted as to Interrogatory No. 1, except that the request is limited to U.S. Patent Nos. 7,729,008 B2, 8,416,444 B2, 7,312,897 B2, or 7,791,761 B2, as modified above;

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ORDERED that Patent Owner's Motion for Additional Discovery is denied as to Interrogatory Nos. 2 and 3; and

FURTHER ORDERED that Petitioner is ordered to produce the requested discovery no later than May 3, 2019.

For Petitioner:

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