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Paper 31
Date: December 9, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORP.,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

IPR2025-00299
Patent 7,716,217 B2

Before KARL D. EASTHOM, AMBER L. HAGY, and BACH V. HOANG, *Administrative Patent Judges*.

HOANG, *Administrative Patent Judge*.

ORDER
Granting In Part Petitioner's Motion
Requesting Routine and Additional Discovery
37 CFR § 42.51(b)

I. INTRODUCTION

With our authorization (*see* Ex. 1048), Petitioner filed a Motion requesting additional and routine discovery under 37 C.F.R. § 42.51(b)(1) and (2) (Paper 28 ("Motion" or "Mot.")). Patent Owner filed an Opposition to Petitioner's Motion. Paper 30 ("Opposition" or "Opp."). Petitioner's Motion asks us to compel production of all documents listed on Patent Owner's privilege log, filed as Exhibit 2042. Mot. 2. Petitioner also asks us to compel production of an unredacted version of Exhibit 2046, which is an email chain between John Marston, named inventor, and Brian Hoffman, an attorney. *Id.*

As to the documents listed on the privilege log of Exhibit 2042, we deny Petitioner's Motion requesting production of those documents. As to Exhibit 2046, we determine that Petitioner is entitled to a fully unredacted version of Exhibit 2046 as routine discovery. As such, Patent Owner is directed to produce an unredacted version of Exhibit 2046. Our discussion follows.

II. DISCUSSION

A. Exhibit 2046

Petitioner argues that Exhibit 2046, a chain of three emails including certain redactions, should be produced without those redactions as part of routine discovery. Mot. 5 (citing 37 C.F.R. § 42.51(b)). Patent Owner counters that the redacted portions are attorney-client privileged communications between Justin Marston, a named inventor on the challenged patent, and Brian Hoffman, an attorney. Opp. 4–5.

We determine that attorney-client privilege has been waived as to those redacted portions because Mr. Marston relied on those redacted

portions in his testimony supporting arguments in Patent Owner's patentability defense, and his use of unredacted portions of Exhibit 2046 waives privilege to the related, redacted portions of Exhibit 2046.

"Generally disclosure of confidential communications or attorney work product to a third party, such as an adversary in litigation, constitutes a waiver of privilege as to those items." *Genentech, Inc. v. U.S. Int'l Trade Comm'n*, 122 F.3d 1409, 1415 (Fed. Cir. 1997) (citations omitted). Further, "the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter." *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005) (citations omitted). Such a "waiver extends beyond the document initially produced out of concern for fairness, so that a party is prevented from disclosing communications that support its position while simultaneously concealing communications that do not." *Id.* (citations omitted).

Patent Owner asserts it only relies on "an **un**redacted factual statement" and, therefore, privilege is not waived as to the redacted portions. Opp. 4–5. Initially, the emails between Mr. Marston and Mr. Hoffmann were to obtain legal advice for a "New patent" regarding the issue of "inventorship" — and, so, are subject to attorney-client privilege. Ex. 2046; *see Genentech*, 122 F.3d 1415 ("The attorney-client privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice.") (citations omitted). However, Patent Owner is not, under the circumstances before us, entitled to maintain the claim of privilege selectively over the redacted portions of the exhibit. Patent Owner's assertion that only unredacted portions are relied upon is contradicted by Mr. Marston's testimony in his Second Supplemental Declaration (Ex. 2030) and the transcript of his November 11, 2025

deposition (Ex. 1049[1]). Most notably, during his deposition, Mr. Marston acknowledged that his declarations were made on the basis of the redacted information in Exhibit 2046. Ex. 1049, 250:16–20 ("Q. But you relied on the parts under those redactions for when you were drafting your declaration? A. I must have done it because when I wrote it, you know, I saw it."); *see id*. at 247:11–251:5 (discussing Exhibit 2046). Further, in his Second Supplemental Declaration, Mr. Marston cited Exhibit 2046 to support his testimony that work was diligently performed and that Jon Fernyhough did not contribute inventive ideas. Ex. 2030 ¶¶ 32, 55. As such, the record shows that Mr. Marston's testimony relies on redacted portions of Exhibit 2046.

Furthermore, Mr. Marston's undisputed reliance on unredacted communications is related to the redacted communications. Mr. Marston highlights unredacted portions of the emails in Exhibit 2046 discussing inventorship. Ex. 2030 ¶ 32. The subject of every email in Exhibit 2046 reads "New patent – inventorship?" Ex. 2046. Accordingly, the redacted portions of Exhibit 2046 presumptively relate to the same subject matter as the relied-upon unredacted portions, i.e., inventorship.

Because Mr. Marston's testimony (1) is based on redacted communications in Exhibit 2046, and (2) divulges unredacted privileged communications related to those redacted communications, we determine Mr. Marston waived attorney-client privilege as to the redacted communications in Exhibit 2046. Mr. Marston's testimony is used as evidence supporting diligence arguments in Patent Owner's patentability defense. Paper 17, 6 (citing Ex. 2030), 46–47 (citing Ex. 2030) (Patent

[1] We refer to the redacted version of Exhibit 1049.

Owner's Response). In defending itself "by disclosing an attorney-client communication," Patent Owner "waives the attorney-client privilege as to all such communications regarding the same subject matter." *In re EchoStar Commc'ns Corp.*, 448 F.3d 1294, 1301 (Fed. Cir. 2006). Further, it would be unfair to allow Patent Owner to selectively disclose and rely upon what it views as helpful disclosures in Exhibit 2046 without giving Petitioner access to review the related context of those disclosures. *Milwaukee Elec. Tool Corp. v. Chervon N. Am. Inc*., 2017 WL 2929522, at *1 (E.D. Wis. July 10, 2017) ("The scope of waiver should generally be construed narrowly in patent cases, but it should also be informed by notions of fairness and a concern with stopping a party from deriving a tactical advantage through selective disclosure.").

Accordingly, we determine that Petitioner is entitled to an unredacted copy of Exhibit 2046 as routine discovery under 37 C.F.R. § 42.51(b)(1).

B. Exhibit 2042

The emails listed in the privilege log of Exhibit 2042 present a different case than Exhibit 2046. Petitioner, citing Mr. Marston's November 11, 2025 deposition, asserts that Patent Owner relies "on the ***substance*** of documents in the privilege log to support its arguments." Mot. 4 (citing Ex. 1049[2], 224:4–17; 229:18–5, 245:14–247:8, 250:16–20). However, those cited portions of Mr. Marston's deposition testimony, at most, confirm email subject lines listed on the privilege log, rather than discuss specific email content. *See* Ex. 1049, 224:4–17, 229:18–5, 245:14–

[2] Petitioner cites Exhibit 2049; this appears to be a typographical error as that exhibit does not appear relevant to this particular dispute. We understand Petitioner to cite Exhibit 1049.

247:8, 250:16–20. And, rather than relying on the specific substance of the emails in the privilege log, Mr. Marston merely relies on the *existence* of those emails to show the exchange of emails. *See* Ex. 2030 ¶ 19 ("The e-mails maintained by counsel for BlueSpace show that I exchanged correspondence with counsel for BlueSpace." (citing Ex. 2042)); *see id.* ¶¶ 36, 49–50, 53, 55 (describing similar exchanges).

Accordingly, we determine that Petitioner is not entitled to the production of the documents listed in Exhibit 2042 as routine discovery. 37 C.F.R. § 42.51(b)(1).

C. Additional Discovery

The parties also dispute whether the documents listed in the privilege log of Exhibit 2042 and whether Exhibit 2046 should be produced as additional discovery under 37 C.F.R. § 42.51(b)(2). Mot. 5; Opp. As discussed above, we determine Petitioner is entitled to an unredacted version of Exhibit 2046 as part of routine discovery and, accordingly, additional discovery for that exhibit is moot.

As to the documents listed in the privilege log of Exhibit 2042, we do not grant additional discovery on those documents based on weighing the factors of *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential). The first factor requires us to consider whether the request is

> 1. More Than A Possibility And Mere Allegation -- The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

Id. at 6. Under the facts before us, we determine that Petitioner's request for the production of 77 attorney-client privileged documents is not necessary in the interest of justice. It does not show beyond speculation that something useful will be uncovered (first factor) and this factor outweighs the other four *Garmin* factors. Although there is no ability to generate equivalent information (third factor), the instructions are easily understandable (fourth factor), and are not overly burdensome to answer (fifth factor), the first factor outweighs these factors because they apply to discovery of information not likely to be useful. The second factor is at best neutral as it is plausible that some of the 77 attorney-client privileged documents may reveal or shed light on current litigation positions (second factor).

Petitioner merely states that its "tailored request for document specific[ally] identified documents show[ing] Mr. Marston's alleged inventive diligence." Mot. 5. That statement does not identify what specific information, and any purported usefulness, Petitioner seeks in any one of those 77 documents. Rather, Petitioner makes a broad request for 77 documents — even though Petitioner's questioning of Mr. Marston points out that not all the 77 documents were related to the challenged patent. Ex. 1049, 209:21–210:4 ("Q. So these documents don't necessarily relate to the claimed invention, correct? A. Again, not all of them, some of them nay if we went through the list, but, yes."). Petitioner's request that attorney-client privilege be breached for a speculative request counsels against granting additional discovery. Accordingly, we do not grant Petitioner's Motion requesting additional discovery for the documents listed in the privilege log of Exhibit 2042.

III. CONCLUSION

We deny Petitioner's request for routine or additional discovery for the documents listed in the privilege log of Exhibit 2042.

We grant Petitioner's request for routine discovery of an unredacted version of Exhibit 2046. Should Patent Owner determine that an unredacted version of Exhibit 2046 includes applicable secret or confidential information, Patent Owner may file that unredacted version under seal and move to seal it according to the protective order, which we concurrently enter in a separate paper along with this Order.

IV. ORDER

It is:

ORDERED Petitioner's Motion requesting routine discovery of an unredacted version of Exhibit 2046 is *granted*;

FURTHER ORDERED Patent Owner shall produce an unredacted version of Exhibit 2046; and

FURTHER ORDERED Petitioner's Motion requesting routine or additional discovery of the documents listed in the privilege log of Exhibit 2042 as for routine or additional discovery under 37 C.F.R. § 42.51(b) is *denied*.

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