

From: [Trials](#)
To: [Tobin, David](#); [Trials](#)
Cc: [Richard Cochrane](#); [Hamad Hamad](#); [Oaks, Brian](#); [PacifiCorp-PTAB-ME2C](#); [rsjohnson](#); [Patton, Thomas](#); [Donels, Cara](#); [Justin Nemunaitis \(jnemunaitis@caldwellcc.com\)](#)
Subject: RE: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425 // Additional Discovery and Briefing on RPI / Privity Issues
Date: Wednesday, January 28, 2026 8:19:56 AM
Attachments: [image001.png](#)

Counsel,

Our Order in each of the above captioned cases unequivocally stated: “within five business days of the issuance of this order, the parties shall provide to the Board, by email, a proposed schedule for depositions, provision of testimonial evidence, and briefing of RPI and privity issues.” The below email does not include a proposed schedule. The parties’ inability to reach agreement and/or compromise frustrates our ability to comply with the Director’s instruction that “RPI and privity issues should be resolved as early as possible.” **Within 48 hours of receipt of this email, the parties shall propose a schedule consistent with the Director’s instruction, our prior Order, and the following guidance.**

In the interest of avoiding further delay and resolving the parties disputes, the Board provides the following guidance:

1. Patent Owner shall file a Supplemental Patent Owner’s Response addressing privity and RPI issues before Petitioner files a Supplemental Reply;
2. If Petitioner offers a corporate designee who also offers declaratory testimony, that witness may be deposed in both their individual and their corporate capacity with total deposition time not to exceed 7 hours. Nonetheless, we do not anticipate that RPI and privity issues will require the full 7 hours of deposition for any individual witness. We hope and expect that Patent Owner will be respectful of witnesses’ time and not unduly burden witnesses, including by seeking individual testimony that duplicates testimony already provided in a witnesses’ corporate capacity (or vice versa).
3. In the interests of expeditiously resolving privity and RPI issues, we treat Petitioner’s email as a motion requesting additional discovery and grant such discovery. Patent Owner shall make available for deposition one or more corporate designees to testify with respect to: Patent Owner’s understanding of the basis for assertions by Patent Owner that a license and/or covenant not to sue in district court does not apply to Petitioners and former Petitioners; and Patent Owner’s understanding of the effect of the agreements produced as Exhibits 2052 and 2053 with respect to Petitioners and former Petitioners, including their ability to enforce such agreements.

Regards,

Andrew Kellogg,
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Patent Trial and Appeal Board
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IPR2025-00422, -00423, 00424, and IPR2025-00425
Ex. 3102

From: Tobin, David <dtobin@mwe.com>
Sent: Monday, January 26, 2026 7:00 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2025-00274, IPR2025-00278, IPR2025-00280, IPR2025-00281, IPR2025-00422, IPR2025-00423, IPR2025-00424, IPR2025-00425 // Additional Discovery and Briefing on RPI / Privity Issues

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Dear Honorable Board,

Petitioners and Patent Owner jointly write in response to the Board's order (January 16, 2026) in IPR2025-00274, -00278, -00280, -00281, -00422, -00423, 00424, and -00425, in which the Board ordered the parties to "provide to the Board, by email, a proposed schedule for depositions, provision of testimonial evidence, and briefing of RPI and privity issues." *See, e.g.,* IPR2025-00274, Paper 64. The parties request the Board's guidance on several issues.

Order of Briefing: The Director ordered that the parties provide “additional briefs” on privity and RPI issues. *See, e.g.,* IPR2025-00274, Paper 57 (“Director Review Order”). The parties dispute who must submit the opening brief on RPI and privity issues.

- **Petitioners contend:** The order should be: (a) Petitioners provides “declaratory testimonial evidence” (if any) and make the declarants and “one or more corporate designees” available for deposition; (b) after discovery on RPI / privity is concluded, Patent Owner files its “Supplemental Patent Owner Response addressing RPI and privity issues”; and (c) Petitioners file a Supplemental Petitioners’ Reply addressing RPI and privity issues. *See* IPR2025-00274, Paper 64 at 7-8; EX3001. After the Board ruled against Patent Owner on the RPI/privity issues and instituted IPR, Petitioners were not the ones that originally requested additional discovery; Patent Owner did. The Director did not hold that Patent Owner met its burden of production; rather, the Director remanded to the Board to allow Patent Owner to obtain the additional discovery it allegedly needed to clarify what the Board held was ambiguous or speculative about Patent Owner’s previously submitted materials. *See* Paper 57. Patent Owner retains the burden of production on RPI/privity issues and, once it obtains the additional discovery, should submit that additional discovery along with a “Supplemental Patent Owner Response addressing RPI and privity issues.” *See* IPR2025-00274, Paper 64 at 7-8; EX3001. Petitioners can then respond with their Supplemental Petitioner’s Reply.
- **Patent Owner contends:** Because Patent Owner has met its burden of production and now the burden of persuasion lies with the Petitioners (*see* IPR2025-00274, Director's Order, Paper 57 at 3-4), the order should be: (a) Petitioners file their brief and any accompanying declarations; (b) Patent Owner deposes the declarants and corporate designees; and (c) Patent Owner files their rebuttal brief. To the extent Petitioners wish to rely on direct testimonial evidence, the Board's order requires that evidence "respond to arguments that have been made in any of Patent Owner’s ***already-filed*** briefing." This is consistent with Petitioners filing the first brief with support from direct testimonial evidence to address Patent Owner's earlier briefing. Moreover, Petitioners' proposal that Patent Owner submit the evidence that Petitioners intend to rely on to meet their burden does not make sense, and will create unnecessary complications if, e.g., Patent Owner has evidentiary objections. The more appropriate course is for Petitioners to submit their evidence with their brief and for Patent Owner to respond.

Hours of Deposition for Additional Discovery: The Board ordered that each “deposition shall not exceed three hours of cross-examination per corporate designee.” Paper 64 at 6. If a corporate designee also provides a declaration, must that person sit for 3 hours of deposition or 10 hours off deposition?

- **Petitioners contend:** Petitioners state that to the extent they provide any declarations that are limited to privity and RPI issues, the declarants will also be designated as corporate representatives on one or more of the four topics for deposition in Paper 64. Each declarant / corporate designee on RPI/privity issues should be limited to 3 hours of total deposition, as per Paper 64.
- **Patent Owner contends:** Each deposition of a corporate designee should be limited to 3 hours of deposition per corporate designee, and, per 37 C.F.R. § 42.53(c), each declarant should be subject to 7 hours of deposition per declarant. Because Petitioners have not yet provided their declarations or supplemental brief, Petitioners have presented no compelling reason to alter these default rules. Nonetheless, if Petitioners rely on a single witness as designee and declarant, the deposition should be limited to 7 hours.

Additional Discovery from Patent Owner: The Parties dispute whether, as part of this additional discovery on privity/RPI issues, Petitioner may also take a deposition of Patent Owner’s corporate designee regarding Patent Owner’s understanding of the agreements in EX2052 and EX2053.

Petitioners contend: The Board ordered Petitioners to make available one or more corporate designees who can testify *inter alia* regarding:

1. Petitioner’s understanding of the basis for assertions by Petitioners and former Petitioners of license and/or covenant not to sue in district court;
2. Petitioner’s understanding of the effect of the agreements produced as Exhibits 2052 and 2053 with respect to Petitioners and former Petitioners, including their ability to enforce such agreements;

Paper 64. To the extent Petitioners’ understanding of the agreements in EX2052 and EX2053 is relevant to the RPI and privity issues, Patent Owner’s understanding is equally relevant. As the Board stated in its order, “We also note that ‘having filed suit against PacificCorp for

infringement of the '114 patent (Ex. 2007), Patent Owner must not agree that Talen negotiated a license to the '114 patent on PacificCorp's behalf.' DI 21." Paper 64. Accordingly, Petitioners request a reciprocal deposition of Patent Owner's corporate designee, limited to three hours of cross-examination per corporate designee, on the following two mirror Topics:

1. Patent Owner's understanding of the basis for assertions by Patent Owner that a license and/or covenant not to sue in district court does not apply to Petitioners and former Petitioners; and
2. Patent Owner's understanding of the effect of the agreements produced as Exhibits 2052 and 2053 with respect to Petitioners and former Petitioners, including their ability to enforce such agreements.

Petitioners' request for reciprocal discovery was previously identified to Patent Owner and to the Board. *See* IPR2025-00274, EX3001 (12/5/2025 email to the Board) ("if Patent Owner is allowed to take discovery into Petitioners' litigation 'contentions' ..., Petitioners would request reciprocal discovery into Patent Owner's 'contentions' ..."). To the extent the Board requires a formal motion for this additional discovery under 37 CFR 42.51(b)(2), please treat this email as a request for authorization to file a motion for additional discovery.

Patent Owner contends: Patent Owner does not agree to that discovery. No discovery from Patent Owner has been ordered. The Board's January 16, 2026 Order did not contemplate that Petitioner was entitled to any discovery from Patent Owner. If the Board considers Petitioner's position as a request for discovery from Patent Owner, it is untimely, given the fact that RPI/privity related discovery has been a live issue since October, and the Parties and the Board spent a month resolving the scope of RPI/privity related discovery. Also, Petitioners bear the burden of persuasion to prove that all necessary RPIs/privities were appropriately identified and not time-barred. Patent Owner has no burden of persuasion on this issue. Thus, any discovery request by Petitioners would not assist the Board in deciding this issue but would instead introduce unnecessary cost and delay.

Sincerely,

David Tobin

Counsel for PacifiCorp

(Submitted jointly on behalf of Petitioners and Patent Owner)

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