

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

COX COMMUNICATIONS INC., et al.,)	
)	
Plaintiffs,)	
)	
v.)	Civil Action No. 12-487-JFB
)	
SPRINT COMMUNICATIONS)	
COMPANY L.P., et al.,)	
)	
Defendants.)	

MEMORANDUM ORDER

At Wilmington this **9th day of August, 2017.**

WHEREAS, Defendant Sprint Communications Company, L.P. (“Defendant” or “Sprint”) has moved for leave to conduct a second deposition of Mr. Stephen Casner (“Casner”) and to compel compliance with the subpoena served on Casner, (“the motion” or the “motion to compel”), (D.I. 525), Plaintiff Cox Communications, Inc. (“Plaintiff” or “Cox”) opposes the motion, and the Court¹ has considered the parties’ briefs, (D.I. 526, 537, 542);

NOW, THEREFORE, IT IS HEREBY ORDERED that Sprint’s motion be resolved as follows:

I. BACKGROUND

1. The case at bar is an action for patent infringement that is related to parallel litigation in the United States District Court for the District of Kansas (the “Kansas litigation”) between Sprint and Comcast Cable Communications, LLC, *et al.* (“Comcast”) (D. Kan. Case No. 11-2684-JWL), Cable One, Inc. (D. Kan. Case No. 11-2685-JWL), and Time Warner Cable, Inc.

¹ The instant motion to compel was referred to the Court for resolution on June 23, 2017. (D.I. 560)

(D. Kan. Case No. 11-2686-JWL) (collectively, the “Kansas Defendants”). Because the case at bar and the Kansas litigation initially involved the same patents-in-suit, Sprint, Cox, and the Kansas Defendants agreed to conduct discovery “in parallel, with an express agreement that witnesses would be deposed jointly in all actions, whenever possible.” (D.I. 537 at 2) In this case, Sprint has reduced the number of asserted claims to 40 claims across 10 telecommunications patents; the patents can be grouped into two areas of technology: call control and broadband networking. (D.I. 520 at 1)

2. In July 2013, Cox and the Kansas Defendants presented Sprint with preliminary invalidity contentions in the respective litigations. With respect to U.S. Patent Nos. 7,286,561, 6,633,561, 6,452,932, and 6,463,052 (the “Call Control” patents), Cox alleged that the Call Control patents are invalid as anticipated, under 35 U.S.C. § 102, by, *inter alia*, what it referred to as the “Network Speech Systems Technology” system. (D.I. 526, ex. B at 4) Cox stated that this system was described by four prior art references. (*Id.*) In the parallel litigation, the Kansas Defendants identified three prior art references to describe the same system.² (D.I. 537, ex. O at 4)

3. Cox submitted supplemental initial disclosures under Federal Rule of Civil Procedure 26(a) in September 2013. (D.I. 526, ex. C) Those disclosures did not identify any witnesses likely to have discoverable information related to the “Network Speech Systems Technology” system, nor to the publications that allegedly described this system. (*Id.*)

² The Kansas Defendants also contended that U.S. Patent Nos. 6,473,429, 6,343,084, and 6,298,064 (the “Broadband” patents) were anticipated by the same “Network Speech Systems Technology” system, as described by the same three prior art references. (D.I. 537, ex. O at 8)

4. In January 2015, counsel for Cox in this case and for Comcast in the Kansas litigation, entered into a contract with Casner to secure his “assistance in connection with [Cox and Comcast’s] investigation and analysis relating to patents, technical projects or products with which [he] ha[s] been involved, and . . . to undertake other specialized projects at [Cox’s and Comcast’s counsel’s] direction.” (D.I. 526, ex. D at 1) At the time, counsel for Cox and Comcast had identified an “initial project” for Casner that included “review[ing] and correct[ing] a transcription . . . of a videotaped lecture given by [Casner] and Danny Cohen and known as ‘A Brief Prehistory of Voice Over IP[.]’” (the “VoIP Presentation”).³ (*Id.*; D.I. 537 at 2) Later that month, pursuant to Rule 26(a), Comcast disclosed Casner as a person likely to have discoverable information, and who is “[k]nowledgeable about the transmission of voice over the ARPANET and related networks and internetworks.” (D.I. 537, ex. M at 19)

5. In early February 2015, both Cox and Comcast provided Sprint with notice of Casner’s deposition. (D.I. 537, ex. N at 1; D.I. 526, ex. A at 1) They also produced Casner’s corrected transcription of the VoIP Presentation to Sprint at around the same time. (D.I. 537 at 2) On February 14, 2015, the Kansas Defendants amended their invalidity contentions in the Kansas litigation regarding the Call Control patents; these amended contentions now identified 25 references (in contrast to the previously-identified three references) that described the “Network Speech Systems Technology” system. (*Id.*, ex. P at 4–6) These newly-added references included the VoIP Presentation slides and transcript. (*Id.*) The Kansas Defendants produced the newly-added references cited therein to Sprint. (D.I. 537 at 4)

³ The VoIP Presentation discussed efforts on ARPANet (the precursor to the modern Internet) to make telephone calls and to hold teleconferences. (D.I. 537, exs. T–U; *see also id.*, ex. Q at 24)

6. On March 10, 2015, counsel for Cox and certain of the Kansas Defendants deposed Casner in Menlo Park, California. (*Id.*, ex. Q at 3, 6–9) During that deposition, Casner acknowledged that he had been compensated by Cox and Comcast for transcribing the VoIP Presentation, but that he was not being compensated on an hourly basis for his attendance at the deposition. (*Id.* at 15–16, 112) Casner then testified extensively about the VoIP Presentation and efforts to transmit telephone calls over ARPANet. (*See generally id.*) Counsel for Cox and Comcast asked Casner about 14 different exhibits during the deposition, (*id.* at 6–9), four of which had been identified in the Kansas litigation as prior art describing the “Network Speech Systems Technology” system,⁴ (*compare id.* at 6–9 with *id.*, ex. P at 4–6). At the end of the deposition, Sprint’s counsel asked questions of Casner for approximately 15 minutes. (*Id.*, ex. Q at 111–23)

7. After Casner’s deposition, on March 16, 2015, Sprint’s counsel contacted counsel for Cox and Comcast and requested “a copy of any agreements with [] Casner regarding any compensation associated with his deposition[.]” (D.I. 542, ex. V at 3) On March 18, 2015, Casner invoiced Cox’s and Comcast’s counsel for his time prior to the deposition, which included “[s]earching for and emailing papers requested by [Cox’s and Comcast’s expert] Scott Bradner[,]” “[a]rranging for document scanning[,]” delivering “scanned documents to Scott[,]” and communicating via e-mail “in preparation for deposition[.]” (*Id.*, ex. X at COM-KS-01355017 (certain non-text items omitted)) On March 23, 2015, Comcast’s counsel produced

⁴ The four exhibits were deposition exhibits 1, 2, 11 and 12. Exhibits 1 and 2 are the slides and transcript of the VoIP Presentation. Exhibit 11 is an Institute of Electrical and Electronics Engineers journal article by C.J. Weinstein (“Weinstein”) and J. Forgie. Exhibit 12 is a 1983 journal article by H. M. Heggstad and Weinstein. (*Compare* D.I. 537, ex. Q at 6–9 with D.I. 537, ex. P at 4–6).

the January 2015 agreement to Sprint, as well as Casner's March 2015 invoice. (*Id.*, ex. W)

8. On July 22, 2015, four months after the Casner deposition, Cox identified Casner in this case as a Rule 26(a) witness who may have discoverable information relating "to the ARPANET Project and industry background." (D.I. 526, ex. E at 33) In the meantime, however, the asserted claims of the Call Control patents had been held invalid as indefinite by this Court in May 2015. (D.I. 231) Sprint had appealed that decision to the United States Court of Appeals for the Federal Circuit, and in 2016, the Federal Circuit eventually determined the relevant claims to be valid, remanding the case back to this Court. *See Cox Commc'ns, Inc. v. Sprint Commc'n Co. LP*, 838 F.3d 1224 (Fed. Cir. 2016).

9. After the Federal Circuit remanded the Call Control patents for continued litigation, "Cox supplemented its invalidity contentions [in this case] as to the Call Control Patents pursuant to the schedule agreed to by the parties and ordered by the Court. . . . [to include] additional detail regarding ARPANET art, and cit[ation] to . . . Casner's deposition." (D.I. 537 at 5 (emphasis omitted) (citations omitted)) Cox's supplemented invalidity contentions, filed on December 9, 2016, now identified 25 references (including Casner's deposition) as describing what was now referred to as the "ARPA Network Secure Communications Project" system, which Cox alleges anticipates the Call Control patents. (D.I. 520, ex. D at 12-14)⁵ Aside from the citation to Casner's deposition, those 25 references were identical to those presented to Sprint in the Kansas litigation in February 2015.⁶ (*See* D.I. 537, ex. P at 4-6; D.I. 520, ex. D at 12-14)

⁵ Cox also contends that the same system (as described by the same 25 references) anticipates two broadband networking patents owned by Sprint. (D.I. 537, ex. S at 4-6)

⁶ The addition of the Casner deposition did not change the number of references to 26, because Cox combined two other references into one. (D.I. 520, ex. D at 12 (merging

10. By January 2017, in the Kansas litigation, Comcast had disclosed that it intended to call Casner as a live witness at trial. (D.I. 526, ex. I at 1) Comcast asserted that Casner “is expected to testify [at trial] about ARPANET, including the use of packets to transmit voice to and from a circuit switched network; his work at the Information Sciences Institute, including its research and products; and Lincoln Laboratory, including its research and products.” (*Id.*, ex. H at 2)

11. In the instant case, on April 17, 2017, Sprint subpoenaed Casner for a second deposition. (D.I. 537, ex. R) Ten days later, Sprint filed the instant motion, seeking leave to conduct the deposition and to compel Casner’s compliance with the subpoena. (D.I. 525) Sprint contends that, with its motion, it “seeks only the ability to question Mr. Casner about his knowledge and understanding of the ARPA system as described in Cox’s recent supplemental invalidity contentions, and about his relationship to and work for Cox’s counsel.” (D.I. 526 at 8)

II. DISCUSSION

12. Under Federal Rule of Civil Procedure 30, when a party seeks to depose a previously-deposed witness, the “party must obtain leave of court, and the court must grant leave to the extent consistent with [Federal Rule of Civil Procedure] 26(b)(1) and (2)[.]” Fed. R. Civ. P. 30(a)(2)(A)(ii). Rule 26(b)(1) permits “discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case[.]” Fed. R. Civ. P. 26(b)(1). Rule 26(b)(2)(C), for its part, provides for a series of protections from discovery abuses and states that:

On motion or on its own, the court must limit the frequency or extent of discovery

“reference #4” and “reference #8” under a single bullet point))

otherwise allowed by these rules or by local rule if it determines that:

(i) the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive;

(ii) the party seeking discovery has had ample opportunity to obtain the information by discovery in the action; or

(iii) the proposed discovery is outside the scope permitted by Rule 26(b)(1).

Fed. R. Civ. P. 26(b)(2)(c). Moreover, pursuant to Federal Rule of Civil Procedure 45, “[o]n timely motion, the court for the district where compliance is required must quash or modify a subpoena that: subjects a person to undue burden.” Fed. R. Civ. P. 45(d)(3)(A)(iv).⁷

13. There appears to be no dispute that the information that is to be sought from Casner pursuant to this second deposition is relevant and within the scope of Rule 26(b)(1). (D.I. 526 at 8) Instead, the parties primarily disagree about whether Sprint previously had ample opportunity, under the meaning of Rule 26(b)(2)(C)(ii), to obtain information about the “ARPA Network Secure Communications Project” system now asserted.⁸ Sprint contends that it had no such

⁷ Here, the parties agreed that Cox would contest Casner’s second deposition by way of responding to Sprint’s motion to compel, without the need for filing a separate motion to quash pursuant to Rule 45. (D.I. 537 at 6)

⁸ As is indicated above, Cox and the Kansas Defendants were, earlier in the respective cases, referring to this system as the “Network Speech Systems Technology” system, but are now referring to it as the “ARPA Network Secure Communications Project[.]” (D.I. 520, ex. D at 12–14) Cox asserts that this was simply a change from a “generic” way of referring to the system to a title that would “better describ[e]” the very same project. (D.I. 537 at 3 n.3) Occasionally, Cox also refers to the system in its briefing as the “ARPA Packet Speech Project[.]” (*Id.* at 9) For its part, Sprint refers to the system similarly in its briefing, but notes that, in its view, “Cox’s invalidity theory is premised on dozens of research grants to a number of distinct institutions staffing scores of academics, [and] Sprint does not agree that the ‘ARPA Network Secure Communications Project’ is a unitary ‘system,’ as required by 35 U.S.C. § 102.” (D.I. 526 at 1 n.1)

opportunity, (D.I. 526 at 6–8), while Cox disagrees, (D.I. 537 at 9). According to Cox, “Sprint knew [at the time of the Casner deposition] that all of the cable defendants were asserting the ARPA Packet Speech Project as an invalidity defense against the Call Control Patents, and Sprint had extensive detail about those allegations, including allegations regarding the significance of the documents it now characterizes as ‘new.’”⁹ (*Id.*)

14. Cox is right, of course, that at the time of the Casner deposition, *in the Kansas litigation, Comcast and the other Kansas Defendants* had taken certain steps to specifically call out Casner to Sprint as a knowledgeable witness about the system at issue, and to better identify all of the relevant art that described the system. That is, by the time of that deposition: (1) Comcast had specifically identified Casner to Sprint as a potential witness with knowledge of ARPANet, (D.I. 537, ex. M at 19), and (2) the Kansas Defendants set out their contention that what was then being referred to as the “Network Speech Systems Technology” system—a system said to anticipate the Call Control patents—was described by essentially all of the 25 different references that are now at issue here. (D.I. 537, ex. P at 4–6) Thus, Cox is right when it asserts that Casner should not then have been a stranger to Sprint, and that his association with the system at issue should not then have been a complete surprise to Sprint, either. And yet, on the other hand, at the time of Casner’s deposition, it is also true that *Cox* had not identified Casner *in this case* as a person with potentially discoverable information. (D.I. 526, ex. C) Also, at the time of Casner’s deposition, at least *in this case*, *Cox* had not put Sprint on notice that *Cox*’s invalidity contentions regarding the Call Control patents also implicated some 25 references

⁹ Cox also describes the referenced documents as having been “publicly available” to Sprint as of the date they were first identified in the Kansas litigation, and notes that the documents had been produced to Sprint before the Casner deposition. (D.I. 537 at 1, 4, 12)

describing the alleged system. (*Compare* D.I. 526, ex. B at 4 *with* D.I. 520, ex. D at 12–14; *see also* D.I. 542 at 1 n.1 (Sprint noting that “[u]ntil Cox supplemented its invalidity contentions in December 2016, the new materials and theories it now advances were not *at issue in this case*”) (emphasis added)) This leaves Sprint in better position, at least *in this case*, to argue that at the time of the prior deposition, it was not on notice of the full importance that *Cox* would ascribe to Casner and the additional references—and so it should get a chance to examine Casner on those fronts. *Cf. Le v. Diligence, Inc.*, 312 F.R.D. 245, 246–47 (D. Mass. 2015) (allowing a second deposition pursuant to Rule 30(a)(2), where at the time of the first deposition, the plaintiff did not have access to certain material regarding a weather sensor that was later provided in defendant’s supplemental discovery responses, even though the weather sensor was itself the subject of some discussion during the first deposition).

15. There are other reasons why, in the Court’s view, Sprint did not have “ample opportunity to obtain . . . information” of importance from Casner in his prior deposition. For one thing, at the time of the deposition, Sprint was not aware of the full extent of Casner’s ongoing consulting relationship with counsel for Cox and Comcast. (D.I. 542 at 3) A few questions were asked of Casner during the deposition (including by Sprint’s counsel) about the extent to which Casner had been compensated for transcription work, or for his time in the deposition itself. (D.I. 537, ex. Q at 15–16, 112)¹⁰ But Sprint was not then aware of the fact that Casner had signed a consulting agreement with Cox’s and Comcast’s counsel, nor had Sprint yet been provided with a copy of that agreement. (D.I. 542 at 2; *id.*, ex. V) And Sprint was not then

¹⁰ Sprint asserts that even these facts (that Casner had been compensated in this way, or that he had completed certain work at Cox’s and Comcast’s counsel’s direction prior to the deposition) were unknown to it prior to the start of the deposition. (D.I. 542 at 3)

aware that Casner had shared materials with Mr. Bradner. (*Id.*, ex. X) Had Sprint known about the full extent of Casner’s consulting relationship with Cox’s and Comcast’s counsel at the time of the deposition, that might well have prompted Sprint to ask further questions of Casner.

These may have included queries as to matters described in the consulting agreement, such as:

(1) the extent of Casner’s “assistance . . . with [Cox’s and Comcast’s counsel’s] investigation and analysis relating to patents, technical projects or products with which [Casner had] been involved”; (2) the extent of his work on “other specialized projects” at counsels’ direction; or (3) the different types of Cox-related or Comcast-related work for which Casner had or had not been compensated. (D.I. 526, ex. D at 1–2)

16. Additionally, the prospect that Casner could be a trial witness for Cox seems much more pronounced now than it was at the time of the prior deposition. In the meantime, Casner has been identified as an expected trial witness for Comcast in the Kansas litigation. (D.I. 526, ex. I at 1) And when Sprint recently asked Cox if it intended to call Casner as a witness at trial in this case, Cox would not say one way or the other. (D.I. 526 at 9 n.7)

17. Next, as to the burden on Casner—a factor relevant to both the Rule 26(b)(2) and Rule 45(d)(3)(a)(iv) analyses—Cox notes that Casner is “not a party” to this case and thus argues that he “should not be burdened” by a second deposition. (D.I. 537 at 1) But as Sprint points out, Casner is not a “typical third party[,]” either. (D.I. 542 at 5) Instead, he is “a paid consultant working with the cable companies in support of their invalidity theories [who] has acted as an expert in other patent and technology-related cases.” (D.I. 526 at 2–3) Cox’s counsel represents Casner in the matter of Sprint’s subpoena, and Casner is otherwise prepared to testify at trial (about the same subject matter) for Comcast in the Kansas litigation. He is the kind of witness,

then, who might have reasonably expected that, in this case, more would be asked of him by Sprint. *Cf. Purdue Pharma L.P. v. Ranbaxy Inc.*, No. 3:12-MC-1 (CAR), 2012 WL 1414308, at *3 (M.D. Ga. Apr. 20, 2012) (continuing the deposition of a Rule 30(b)(6) witness for a third-party company that had “a relationship with [defendant] that is relevant to the litigation.”)¹¹

III. CONCLUSION

18. For the reasons stated above, with respect to Sprint’s motion, (D.I. 525), the Court GRANTS Sprint’s request and ORDERS that Sprint will be allowed to conduct a seven-hour deposition of Mr. Stephen Casner in San Francisco, California (a location that the Court understands is near Casner’s home), on a date and time to be agreed upon by the parties. (D.I. 542 at 1) The deposition should be limited to “matters not [specifically] addressed in the first deposition.” *Christy v. Pennsylvania Tpk. Comm’n*, 160 F.R.D. 51, 53 (E.D. Pa. 1995) (citation omitted).¹² (D.I. 526 at 8)

19. Because this Memorandum Order may contain confidential information, it has been released under seal, pending review by the parties to allow them to submit a single, jointly proposed, redacted version (if necessary) of the Memorandum Order. Any such redacted version

¹¹ Cox attempts to distinguish *Purdue Pharma* by arguing that “unlike the deponent [there], the full seven hours permitted under the Federal Rules were not exhausted by [Cox’s and certain of the Kansas Defendants’] questioning of [Casner in his prior deposition,]” such that in that deposition, “Sprint had plenty of time to ask whatever questions it had in March 2015.” (D.I. 537 at 12) That is true, in that Casner’s deposition was a little over three hours old when Sprint’s counsel began to ask questions of him. But on the other hand, the deposition had started in the afternoon, and Sprint did not get to begin its examination of Casner until 4:12 p.m. (*Id.*, ex. Q at 111) It does not seem as if that deposition was scheduled in a manner such that—were Sprint’s counsel prepared to have done so—Sprint’s counsel would have had the ability to question Casner for hours until “late into the night[.]” (D.I. 542 at 2)

¹² Cox’s request for oral argument on the motion, (D.I. 543), is hereby DENIED.

shall be submitted no later than **August 16, 2017** for review by the Court, along with a motion for redaction that includes a clear, factually-detailed explanation as to why disclosure of any proposed redacted material would “work a clearly defined and serious injury to the party seeking closure.” *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir. 1994) (internal quotation marks and citation omitted). The Court will subsequently issue a publicly-available version of its Memorandum Order.



Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE