Trials@uspto.gov
571-272-7822

Paper No. 13
Date Entered: June 3, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

EVOLUTIONARY INTELLIGENCE, LLC
Patent Owner

Case IPR2014-00086
Patent 7,010,536

Before KALYAN K. DESHPANDE, TREVOR M. JEFFERSON, BRIAN J. McNAMARA, NEIL T. POWELL, and GREGG I. ANDERSON, *Administrative Patent Judges.*

McNAMARA, *Administrative Patent Judge*.

ORDER DENYING PATENT OWNER'S REQUEST TO FILE MOTION FOR ADDITIONAL DISCOVERY
37C.F.R. § 42.52

An initial conference in IPR2014-00086, which involves U.S. Patent No. 7,010,536 (the "'536 Patent"), was conducted on May 23, 2014. Apple, Inc. ("Petitioner") was represented by Jeffrey Kushan. Evolutionary Intelligence, LLC ("Patent Owner") was represented by Anthony Patek. This paper concerns a discussion during the conference of Patent Owner's request for authorization to file a motion for additional discovery. Other issues discussed during the initial conference are summarized in a separate paper.

Patent Owner requested authorization to file a motion for additional discovery in order to investigate whether Petitioner is coordinating its pursuit of this proceeding with other parties Patent Owner has sued for alleged infringement of the '536 Patent. Patent Owner argues that, if such coordination is taking place, another defendant could be a real party-in-in interest or a privy with Petitioner in this proceeding, thus creating estoppel. Patent Owner argued that stays issued in the district courts have prevented Patent Owner from taking discovery in those proceedings on this issue. According to Patent Owner, invalidity contentions filed by "Sprint" in one of the suits[1] that is now stayed suggest that the defendants are coordinating their efforts. Patent Owner did not discuss the details of the alleged similarities between Sprint's invalidity contentions in the district court and Petitioner's challenges in this proceeding or the extent of the alleged coordination. Patent Owner argued that it should be permitted some discovery in this proceeding, at least to the extent of any joint defense agreement between Petitioner and the other parties Patent Owner sued in the district courts.

[1] This appears to be a reference to Sprint Nextel Corporation, which is the defendant in *Evolutionary Intelligence, LLC v. Sprint Nextel Corporation et al.* 5:13-cv-04513-RMW(N.D. Cal).

Petitioner responded that it has not been coordinating its efforts in this proceeding with any other party and that Patent Owner's conjecture does not meet our threshold for discovery. Citing the Office Patent Trial Practice Guide, Petitioner also notes that another party's participation with Petitioner in a Joint Defense Group in a patent infringement suit does not mean that the other party is a real party-in-interest or a privy with Petitioner in this proceeding. *See,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48760 (Aug. 14, 2012). Petitioner also argued that estoppel with respect to a real party-in-interest or a privy in proceedings before the office under 35 U.S.C. § 315(e)(1) or in civil actions or in other proceedings under 35 U.S.C. § 315(e)(2) arises only after a final written decision under 35 U.S.C. § 318(a). Thus, Petitioner contends that the discovery Patent Owner seeks is premature.

We do not authorize Patent Owner's filing of a motion for additional discovery. In order to obtain discovery in this proceeding, Patent Owner must already possess evidence tending to show beyond speculation that something useful will be discovered. *See, Garmin International, Inc. v. Cuozzo Speed Technologies LLC,* IPR2012-00001, Paper 26. Evidence that would be useful in the context of qualifying a party as a real party-in-interest or a privy would tend to show that the party funds or directs and controls this IPR proceeding, or has a relationship with Petitioner that extends beyond participation in a Joint Defense Group. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48760. During the teleconference, Patent Owner's primary assertion was that the invalidity contentions filed by a third party (Sprint) in a different proceeding in the district court are similar to the challenges asserted by Petitioner in this proceeding. Arguing that no other invalidity contentions have been filed in the stayed district court proceedings, Patent Owner does not limit its discovery request to Sprint.

We are not convinced that Sprint's filing in a district court of invalidity contentions that are similar to Petitioner's challenges in this *inter partes* review is sufficient to show beyond speculation that something useful will be discovered to indicate that the proceeding is controlled or directed by Sprint or that Sprint played a role in this proceeding. Further, Sprint's filing of invalidity contentions similar to the challenges in this proceeding would not support our granting discovery concerning other parties.

We also agree that the issue is not ripe for discovery. We have not rendered a final decision in this matter. The district court cases are stayed and there are no other proceedings before the Office. In these circumstances, there are no other proceedings in which estoppel would apply. Granting Patent Owner discovery about whether a defendant in any of the stayed lawsuits is a real party-in-interest or a privy of Petitioner, would not resolve any issue in this or any other proceeding at this time.

In consideration of the above, it is

ORDERED that Patent Owner's request to file a Motion for Additional Discovery is DENIED.

PETITIONER:

Jeffrey Kushan
jkushan@sidley.com

PATENT OWNER:

Anthony Patek
pto@gutridesafier.com

Todd Kennedy
todd@guttridesafier.com