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Paper 15 IPR2014-00678
Paper 14 IPR2014-00687
Paper 14 IPR2014-00688
Paper 14 IPR2014-00689
Date: July 24, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PETROLEUM GEO-SERVICES INC,
Petitioner,

v.

WESTERNGECO LLC,

Patent Owner.

Cases[1]
IPR2014-00678(Patent 6,691,038)
IPR2014-00687 (Patent 7,162,967)
IPR2014-00688 (Patent 7,080,607)
IPR2014-00689 (Patent 7,293,520)

Before BRYAN F. MOORE, SCOTT A. DANIELS, and BEVERLY M. BUNTING, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge*.

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[1] This Order addresses issues that are the same in all four cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

On July 2, 2014, a conference call was held in the above proceedings regarding a request via email by Patent Owner for additional discovery. Present on the call were counsel for and Administrative Patent Judges Bryan Moore and Beverly Bunting.

Motion for Additional Discovery

Patent Owner requested authorization to file a motion seeking additional discovery on the issue of whether Petroleum Geophysical AS (PGSAS) is controlling Petitioner in this proceeding such that it should have been named a real party in interest. In support of this request, Patent Owner pointed to the fact that PGSAS is represented by the same firm (and same lawyer) as Petitioner; that the aforementioned firm requested permission for PGS to use prior litigation materials in an IPR filing; that PGSAS is a party in the related District Court case; and that an inventor is a common employee. Patent Owner indicated that it wanted to make sure that PGSAS is subject to any estoppel that may attach after this case concludes. Patent Owner suggested that the aforementioned request to use materials shows PGSAS is controlling, but was unable to point to any fact that would lead one to conclude that this proceeding is being controlled by PGSAS, rather Patent Owner pointed to facts that may lead one to suspect that PGSAS is involved in some way. Petitioner's counsel opposed the request to file a motion. The Board took the request under advisement.

Additional discovery is permitted in an *inter partes* review only in the interests of justice. There must exist more than a "mere possibility" or "mere allegation that something useful [to the proceeding] will be found." *Garmin v. Cuozzo*, IPR2012-0001, Paper 20 (PTAB Feb. 14, 2013). The party seeking discovery must come forward with some threshold amount of factual evidence or reasoning beyond speculation to support its request. *Id.* Paper 26 (March 5, 2013).

Patent Owner's request amounts to no more than a "mere allegation that something useful will be found." *See Garmin*, Paper 20, Factor 1. The question is whether PGSAS is a real party-in-interest. Patent Owner has produced no factual evidence or support beyond speculation that PGSAS is controlling this proceeding and thus is a real party-in-interest. *See* Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2013). We are not persuaded that the use of common counsel or a request to use documents by that counsel, indicates control by PGSAS. Nor are we persuaded by the existence of a common employee. Patent Owner did not suggest that the employee had any power to direct the litigation and, without more, we have no reason to suspect that common employee is controlling the litigation. The suspicion of Patent Owner's counsel, without more, is not enough to persuade us that something useful will result from authorizing the proposed motion. In the absence of any such showing, the request for authorization is denied at this time.

Voluntarily Adding PGSAS as a Real Party-in-Interest

It was discussed whether PGSAS could be added as a real party-in-interest voluntarily by Petitioner to avoid this issue coming up again after the passing of

the one year statutory bar. Petitioner asked, without conceding that PGSAS was in fact a real party-in-interest, whether the PGSAS could be added as a real party-in-interest without changing the filing date. Patent Owner stated that an incorrect real party-in-interest was a statutory defect that could not be corrected.

We note that the patent rules provide for the correction of "clerical or typographical" mistakes in a petition for inter partes review while maintaining the original filing date. 37 C.F.R. § 42.104(c); *see also* 37 C.F.R. § 42.106(b) (allowing for correction of an incomplete petition). Thus, the Board has allowed for the correction of certain papers filed in inter partes review proceedings to address inadvertent mistakes. *See, e.g.*, IPR2013-00063, Paper 21 (PTAB Jan. 16, 2013). The rules contemplate, however, that not all mistakes can be corrected. *See e.g.*, Final Rules of Practice at 48699 ("[t]here is no provision allowing for the correction of a mistake that is not clerical or typographical in nature without a change in filing date.").

Failure to name the proper real party-in-interest in this case does not appear to be a mere typographical error, clerical error or unintentional mistake, for example, a typographic mistake or inadvertent omission, but rather a substantive deficiency requiring a new filing date. *See* IPR2013-00609, Paper 15 at 16-17 (PTAB March 20, 2013). Without more, we find, at this time, that to allow correction of the real party-in-interest in this case is not contemplated by the patent rules allowing for correction of typographical or clerical mistakes. *See*, *e.g.*, 37 C.F.R § 42.104(c) or 37 C.F.R. § 42.106(b). Therefore, we will not allow such a

correction at this time without changing the filing date. We do not now decide whether such a correction could be made without also refiling the petition.[2]

It is

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery under 37 C.F.R. 42.51(b)(2) is denied.

[2] We also note that Petitioner offered, in an email to the Board Staff, an agreement regarding estoppel and any challenge to the real party-in-interest in the IPR. We take no position as to that offer.

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