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Paper 10 IPR2014-01475
Paper 10 IPR2014-01476
Paper 10 IPR2014-01477
Paper 10 IPR2014-01478
Date: November 26, 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]
IPR2014-01475 (Patent 7,162,967 B2)
IPR2014-01476 (Patent 6,691,038 B2)
IPR2014-01477 (Patent 7,080,607 B2)
IPR2014-01478 (Patent 7,293,520 B2)

Before SCOTT A. DANIELS, BEVERLY M. BUNTING, and BARBARA A. PARVIS, *Administrative Patent Judges.*

BUNTING, *Administrative Patent Judge*.

ORDER
37 C.F.R. § 42.5

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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.

A conference call in IPR2014-01475, IPR2014-01476, IPR2014-01477 and IPR2014-01478 ("Present Proceedings") was held on November 13, 2014 among respective counsel for Petroleum Geo-Services, Inc. ("Petitioner"), Westerngeco LLC. ("Patent Owner") and Administrative Patent Judges Beverly Bunting, Scott Daniels, and Barbara Parvis. The purpose of the call was to discuss Patent Owner's request for authorization to file a motion for additional discovery.

During the conference call, Patent Owner asserted that additional discovery is necessary concerning whether an unnamed company, ION, is controlling Petitioner and the Present Proceedings, such that ION should have been named a real party-in-interest. Ex. 2001, 7. Specifically, Patent Owner requested a response to three interrogatories ("Present Interrogatories") pertaining to identification of "the client here that's between these petitions" (*Id.* at 8) and the legal relationship between the entities (*Id.* at 9). In support thereof, Patent Owner pointed broadly to evidence uncovered in related IPR2014-00678, IPR2014-00687, IPR2014-00688, and IPR2014-00689 ("Related Proceedings") of communication between ION and some of the named petitioners (*Id.* at 8); communication generally on prior art (*Id*. at 8–9); and that these companies worked closely together in developing the allegedly infringing product (*Id*.). Further, Patent Owner pointed out that ION has been embroiled in litigation concerning the patents at issue in the Present Proceedings for several years, and is now barred under 35 U.S.C. § 315(b) from *inter partes* review. *Id.* at 7.

Petitioner countered that they responded to a set of five interrogatories ("Earlier Interrogatories") directed to the question of real party-in-interest in the Related Proceedings, which challenge the same patents as in the Present Proceedings and involve the same parties. According to Patent Owner, Petitioner's responses to the Earlier Interrogatories were limited specifically to the Related Proceedings, and not to the patents themselves. *Id.* at 7. Asserting that Patent Owner's characterization of ION's participation in the Present Proceedings is "speculative", Petitioner nonetheless expressed a willingness to update their answers to the Earlier Interrogatories "to reflect what happened, if anything, between ION and Petitioner in relation to these petitions." *Id.* at 12.

Based on Petitioner's offer, we encouraged Petitioner, to the extent possible, to respond to the Present Interrogatories by November 20, 2014, after which we would issue a decision concerning Patent Owner's request for authorization to file a motion for additional discovery. As indicated in an email from Patent Owner's counsel to the Panel dated November 24, 2014, Petitioner did provide a response to the Present Interrogatories.

There are three types of discovery in an AIA trial, routine discovery, mandatory initial disclosures, and additional discovery.[2] Additional discovery is

[2] *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012). S*ee also* 37 C.F.R. § 42.51(b)(1)(iii), "Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency."

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 Int'l Inc. v. Cuozzo Speed Techs LLC*, IPR2012-0001, Paper 20 (February 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.

Patent Owner's request amounts to no more than a "mere allegation that something useful will be found." *See Garmin*, Paper 20, Factor 1. For example, Patent Owner questioned whether ION is a real party-in-interest based on unidentified prior art allegedly provided by ION to Petitioner. Ex. 2001, 12–13. Patent Owner proffered no direct evidence of this unidentified prior art in the Present Proceedings. Moreover, Patent Owner has produced no factual evidence or support, beyond speculation, that ION is controlling the Present Proceedings and thus is a real party-in-interest. *See* Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2013). Based on the evidence presently of record in the Present Proceedings, we are not persuaded at this time that the reference to communications regarding prior art, indicates control, or the ability to control, by ION. 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 showing adequate foundation for discovery that is sufficiently narrowly tailored, the request for authorization is denied at this time.

In consideration of the foregoing, it is hereby:

IPR2014-01475 (Patent 7,162,967 B2)
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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.

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