

Paper No. ____
Filed: June 5, 2015

Filed on behalf of: Askeladden LLC

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Askeladden LLC
Petitioner

v.

Sean McGhie and Brian Buchheit
Patent Owner

Case IPR2015-00137
U.S. Patent No. 8,297,502

**PETITIONER'S OPPOSITION
TO
PATENT OWNERS' MOTION FOR DISCOVERY AUTHORIZATION**

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I. Introduction

Pursuant to the Board’s May 27, 2015 Order (Paper 34), Petitioner Askeladden LLC (“Askeladden”) hereby opposes Patent Owners’ Motion for Discovery Authorization (Paper 36) (“Motion”). The rules permit additional discovery only in rare instances where the moving party establishes that the discovery is necessary and would be in the interest of justice. 37 C.F.R. §§ 42.20(c), 42.51(b)(2)(i); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (P.T.A.B. Mar. 5, 2013) (“*Garmin*”). The discovery sought by Patent Owners here is improper under these standards.

The proposed discovery is almost entirely unrelated to real party-in-interest (“RPI”) issues, is premised at best on speculative assumptions regarding the information that might be obtained, and is unnecessary in light of information already disclosed or that is available to the Patent Owners. Moreover, the proposed discovery will impose undue burden on Petitioner to inquire with respect to parties that are not within its control—*e.g.*, each of the twenty-six member banks of The Clearing House Payments Company L.L.C. (“PayCo”)—concerning matters that are not remotely related to Askeladden’s IPR efforts. Patent Owners’ failure to enunciate a concise justification for their proposed discovery illustrates its improper nature and that it is not in the interest of justice.

II. Patent Owners' Request for Employment Lists Should Be Denied

The Motion requests the name and role “of each individual employee/committee member/officer/director of the Acknowledged RPI who is an employee/committee member/officer/director of the Alleged RPI” (“1st Request”).¹ Motion at 1. Patent Owners thus seek the names and roles of any person employed by or affiliated with PayCo and Askeladden who is also affiliated with an Alleged RPI—*i.e.*, not only with the Association, but with each of the twenty-six banks that is a member of PayCo. Patent Owners seek this information regardless of whether a person has any relationship to Askeladden or the present IPR. The interests of justice weigh against granting this request.

Under the first *Garmin* factor, the information sought lacks “substantive value to a contention of the party moving for discovery,” and therefore will not be useful. *Garmin* at 6-7. The Motion fails to explain otherwise. For example, if an employee of a PayCo member bank participates in a PayCo committee concerning banking regulatory matters, the identity of that person is called for by the Motion even though such information is entirely irrelevant to Askeladden’s IPR activities

¹ The Motion defines (i) Askeladden and PayCo, collectively, as “Acknowledged RPI,” and (ii) “owning banks” of PayCo and The Clearing House Association (the “Association”) as “Alleged RPI.” Motion at 1.

and would be prohibitively burdensome to identify. At best, therefore, Patent Owners can only speculate that their overly broad 1st Request might reveal something relevant to RPI issues. But the first *Garmin* factor does not countenance such speculation, and the fifth *Garmin* factor does not permit discovery such as this that is not “sensible and responsibly tailored according to a genuine need.” *Id.* at 7.

Moreover, Patent Owners already have evidence of this sort sufficient to the RPI question. Regarding control over this proceeding, Patent Owners already have been provided full information about the membership of Askeladden and PayCo, their governing boards, and the lack of *any* involvement of PayCo’s member banks in Askeladden’s IPR activities. The Reilly Declaration (Ex. 1031) and Askeladden LLC Agreement (Ex. 1033) each establish that [REDACTED]

[REDACTED] is solely responsible for selecting patents to challenge using IPR proceedings, and for independently determining all other aspects of Askeladden’s IPR activities. Ex. 1031 ¶ 11; Ex. 1033 at 2, 8, 12. As the Patent Owners also know, [REDACTED]

[REDACTED]. Ex. 1031 ¶ 15; Ex. 1033 at 2, 10. Petitioner further represents that

[REDACTED]

[REDACTED]

[REDACTED]

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