

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC., HTC CORPORATION, and HTC AMERICA, INC.,  
Petitioner,

v.

SUMMIT 6 LLC,  
Patent Owner.

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Case IPR2015-00806  
Patent 7,765,482 B2

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Before HOWARD B. BLANKENSHIP, GEORGIANNA W. BRADEN, and  
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

ORDER  
Conduct of Proceeding  
37 C.F.R. § 42.5

On April 10, 2015, Patent Owner Summit 6 LLC (“Patent Owner”) requested authorization to file a motion for additional discovery. On April 15, 2015, the panel held a conference call to discuss Patent Owner’s request, which was attended by John Alemanni and Michael Morlock for Petitioners Google Inc. (“Google”), HTC Corporation, and HTC America,

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Inc. (collectively, “Petitioner”); and John Shumaker, Brian Mangum, and Bob Carlson for Patent Owner.

During the call, Patent Owner explained that the basis for its request for authorization to file a motion for additional discovery is a Mobile Application Distribution Agreement (“MADA”) between Google and a third-party, Samsung, which Patent Owner found in its own research. According to Patent Owner, the terms of the MADA obligated Google to defend Samsung when Patent Owner sued Samsung in 2011 in the U.S. District Court for the Northern District of Texas (“the Samsung Case”) for infringement of U.S. Patent No. 7,765,482 B2—the patent at issue in this proceeding. Patent Owner intends to seek discovery regarding the relationship between Google and Samsung. Patent Owner acknowledged that Petitioner agreed to search for correspondence between Google and Samsung regarding any obligation of Google to defend Samsung in the Samsung Case. Nonetheless, Patent Owner represented that its request for authorization to file a motion for additional discovery is ripe, because the proposed additional discovery relates to a potential argument that institution of *inter partes* review is barred under 35 U.S.C. § 315(b) and Patent Owner’s Preliminary Response is due in approximately two months. In addition, Patent Owner indicated that if Petitioner finds any relevant documents, the parties will need to negotiate a protective order, which could further delay any document production.

In response, Petitioner indicated that on April 9, 2015—before Patent Owner requested authorization to file a motion for additional discovery—Ppetitioner agreed to perform a good faith search for correspondence between Google and Samsung related to any obligation of Google to defend Samsung

in the Samsung Case, and indicated to Patent Owner that its search would take approximately two weeks. Petitioner represented that it has started and is pursuing diligently a search for relevant documents. Petitioner stated that if it finds relevant documents during its search, Petitioner will produce them to Patent Owner, subject to a protective order, the terms of which Petitioner and Patent Owner will need to negotiate.

Patent Owner responded that the additional discovery it intends to seek is broader in scope than the documents Petitioner has agreed to search for and produce. For example, Patent Owner argued that the additional discovery should include any co-development agreements and other executed agreements between Google and Samsung. Both Patent Owner and Petitioner, however, indicated that Patent Owner had not raised the issue of expanding the scope of Petitioner's ongoing document search before the call.

Under 37 C.F.R. § 42.51(b)(2)(i), “[t]he parties may agree to additional discovery between themselves. *Where the parties fail to agree, a party may move for additional discovery.*” 37 C.F.R. § 42.51(b)(2)(i) (emphasis added). Accordingly, this rule permits a motion for additional discovery only where the parties are unable to reach an agreement regarding additional discovery. Here, there is no dispute that in response to Patent Owner's request for additional discovery, Petitioner agreed to and began to search for correspondence between Google and Samsung related to any obligation of Google to defend Samsung in the Samsung Case, and Petitioner will produce to Patent Owner any relevant documents uncovered in its search. Because Patent Owner had not raised any objections to the scope of Google's searches before requesting authorization to file a motion for additional discovery, we are not persuaded that Patent Owner has made

sufficient efforts to reach an agreement with Petitioner regarding the scope of additional discovery. Patent Owner's request for a motion for additional discovery is premature and is not permitted under 37 C.F.R. § 42.51(b)(2)(i) at this time.

We expect the parties to confer and make reasonable, good faith efforts to reach an agreement regarding the scope of additional discovery. If such efforts are unsuccessful, Patent Owner may renew its request for authorization to file a motion for additional discovery no earlier than May 6, 2015. Any further request for authorization to file a motion for additional discovery from Patent Owner must list the specific additional discovery in dispute and represent that reasonable, good faith efforts to agree on the scope of this additional discovery were unsuccessful.

Further, we note that a protective order does not exist in this proceeding unless the parties file one and the Board approves it. If the parties conclude that a protective order is necessary, we encourage the parties to adopt the Board's default protective order. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences.

#### ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery is denied;

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FURTHER ORDERED that Petitioner and Patent Owner shall make reasonable, good faith efforts to reach an agreement regarding the scope of additional discovery;

FURTHER ORDERED that if Petitioner and Patent Owner do not reach an agreement regarding the scope of additional discovery after such reasonable, good faith efforts, Patent Owner may renew its request for authorization to file a motion for additional discovery no earlier than May 6, 2015; and

FURTHER ORDERED that any further request for authorization to file a motion for additional discovery from Patent Owner must list the specific additional discovery in dispute and represent that reasonable, good faith efforts to agree on the scope of this additional discovery were unsuccessful.

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