

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BUNGIE, INC.,
Bungie,

v.

WORLDS INC.,
Patent Owner.

Case IPR2015-01264 (Patent No. 7,945,856)
Case IPR2015-01319 (Patent No. 8,082,501)
Case IPR2015-01321 (Patent No. 8,145,998)¹

PETITIONER BUNGIE'S BRIEF ON REMAND FROM CAFC

¹ This caption is used and identical papers are being filed in each captioned case pursuant to the Board's November 29, 2018 order (Paper 48).

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ISSUE PRECLUSION BARS WORLDS’S RPI ARGUMENTS.	3
	A. Worlds litigated the same issue in the final and appealed IPRs.	3
	B. The Board’s RPI determinations were essential to the judgment.	5
	C. The appealed IPRs are subsequent actions to the valid final written decisions in the final IPRs.	6
III.	NO EXCEPTION APPLIES HERE.....	8
	A. Worlds’s disagreement with the decision does not create an exception to issue preclusion.....	8
	B. Worlds waived any challenge to the denial of discovery motions.	11
	C. Worlds proposed “issue of law” exception does not exist.	12
	D. The Board did not consolidate the appealed and final IPRs.	14
IV.	THE BOARD SHOULD REINSTATE ITS FINDING THAT ACTIVISION IS NOT AN RPI.	15
	A. Legal Standards	15
	B. Statements of Material Fact (“SMF”)	17
	C. The evidence demonstrates Activision is not an RPI.....	19
	i. Lack of control supports finding Activision is not an RPI.	19
	ii. Bungie is not Activision’s proxy.	22
	iii. Bungie’s relationship with Activision does not make Activision a RPI in Bungie’s IPRs.	25
	D. Equities	28
V.	CONCLUSION.....	30

TABLE OF AUTHORITIES

Page

CASES

<i>Applications in Internet Time, LLC v. RPX Corp.</i> , 897 F.3d 1336 (Fed. Cir. 2018).....	2, 13, 16 23, 26
<i>B &B Hardware, Inc. v. Hargis Indus., Inc.</i> , 135 S. Ct. 1293 (2015).....	3, 6, 8, 11, 14
<i>Cisco Sys., Inc. v. Hewlett Packard Enter. Co.</i> , IPR2017-01933, Paper 9	23
<i>In re Cygnus Telecom. Tech., LLC, Patent Litig.</i> , 536 F.3d 1343 (Fed. Cir. 2008).....	14
<i>Jennings v. United States</i> , 374 F.2d 983 (4th Cir. 1967).....	29
<i>Maxlinear, Inc. v. CF Crespe LLC</i> , 880 F.3d 1373, 1376-77 (Fed. Cir. 2018).....	7, 13
<i>Nestle USA Inc. v. Steuben Food, Inc.</i> , 884 F.3d 1350 (Fed. Cir. 2018).....	7, 12
<i>RPX Corp. v. Virnetx Inc.</i> , IPR2014-00171, Paper 49	23
<i>Samsung Electronics Co., Ltd et al. v. Seven Networks, LLC</i> , IPR2018-01106, Paper 21.....	27
<i>Taylor v. Sturgell</i> , 553 U.S. 880 (2008).....	15, 17, 20 23, 25
<i>Unified Patents, Inc. v. Realtime Adaptive Streaming, LLC</i> , IPR2018-00883, Paper 29.....	17, 26
<i>United States v. Des Moines Valley R. Co.</i> , 84 F. 40 (8th Cir. 1897).....	23
<i>United States v. Munsingwear, Inc.</i> , 340 U.S. 36 (1950)	6
<i>United States v. Utah Construction & Mining Co.</i> , 384 U.S. 394 (1966).....	8

<i>Univ. of Tenn. v. Elliott</i> , 478 U.S. 788 (1986).....	8, 9
<i>WesternGeco LLC v. Ion Geophysical Corp.</i> , 889 F.3d 1308 (Fed. Cir. 2018).....	13, 16, 21, 25
<i>Wi-Fi One, LLC v. Broadcom Corp.</i> , 887 F.3d 1329 (Fed. Cir. 2018)	2, 9, 12 13, 21 25
<i>Wickham Contracting Co. Inc. v. Board of Educ. of City of New York</i> , 715 F.2d 21 (2d Cir. 1983)	12
<i>Worlds Inc. v. Bungie, Inc.</i> , 903 F.3d. 1237 (Fed. Cir. 2018)	1, 2, 3 11, 12
<i>XY, LLC v. Trans Ova Genetics, L.C.</i> , 890 F.3d 1282 (Fed. Cir. 2018).....	7, 13

STATUTES

35 U.S.C. §§ 312(a)(2), 315(b).....	3
35 U.S.C. § 315	30
35 U.S.C. § 318(a)	5
35 U.S.C. §§ 319, 141-144	6
42 U.S.C. § 1983	9

RULES

37 C.F.R. § 42.2	7
37 C.F.R. § 42.8(b)(1).....	3
37 C.F.R. § 42.73	5
37 C.F.R. § 42.73(a).....	7
37 C.F.R. § 42.73(d)(3).....	7
37 C.F.R. § 90.3(a)(1).....	6
77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012)	2, 13, 15

MISCELLANEOUS

18A Wright & Miller, Fed. Prac. & Proc. (3d ed. 2002).....	6, 15, 16, 28, 29, 30
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I. Introduction

After Worlds first threatened to accuse Bungie's *Destiny* product of infringement in November 2014, Bungie independently decided to file six different IPR challenges to Worlds's patents to protect Bungie's own interests as a video game developer. Worlds separately opposed each of the IPRs, arguing with almost identical language and evidence that Activision was an unnamed real party-in-interest ("RPI") in Bungie's IPRs. The Board determined the issue adversely to Worlds each time as a prerequisite to finding claims of the involved patents unpatentable. Worlds failed to exercise its right to appeal the decisions in IPR2015-01268, IPR2015-01269, IPR2015-01325 (hereinafter, the "final IPRs").

The other three IPRs are now remanded to "first address whether Worlds is estopped from arguing the real-party-in-interest issue." *Worlds Inc. v. Bungie, Inc.*, 903 F.3d. 1237, 1248 (Fed. Cir. 2018). The Federal Circuit remanded for consideration whether "the 'issue' is the same between the now-final IPRs and the IPRs currently on appeal" because "[t]he record before us is scant on details regarding the [RPI] issues raised in the three unappealed IPRs." *Id.* at 1247. As explained above, the RPI issue Worlds litigated in the appealed IPRs is identical to what Worlds litigated in the final IPRs. The Board should find Worlds estopped from relitigating the RPI issue and re-instate its decisions of unpatentability.

Alternatively, the Board should reinstate its decisions of unpatentability

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