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Paper No. 8
Entered: July 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BUNGIE, INC.,
Petitioner,

v.

WORLDS INC.,
Patent Owner.

Case IPR2015-01264, Patent 7,945,856 B2
Case IPR2015-01268, Patent 7,181,690 B1
Case IPR2015-01269, Patent 7,493,558 B2
Case IPR2015-01319, Patent 8,082,501 B2
Case IPR2015-01321, Patent 8,145,998 B2
Case IPR2015-01325, Patent 8,145,998 B2

Before KARL D. EASTHOM, KERRY BEGLEY, and JASON J. CHUNG, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

ORDER
Authorizing Patent Owner's Motion for Routine or Additional Discovery
37 C.F.R. § 42.51

On July 23, 2015, the panel held a conference call, at the request of Patent Owner Worlds Inc. ("Patent Owner"), to discuss Patent Owner's request for authorization to file a motion for routine discovery or,

alternatively, additional discovery in each of the above-captioned cases. The call was attended by Wayne Helge for Patent Owner and Michael Rosato, Matthew Argenti, and Andrew Brown for Petitioner Bungie Inc. ("Petitioner"). Patent Owner filed a transcript of the call as Exhibit 2001 in each case.

During the call, Patent Owner explained that it obtained a publicly available agreement between Petitioner and a third party, Activision Publishing, Inc. ("Activision"), titled "Software Publishing and Development Agreement" ("Bungie-Activision Agreement"). Ex. 2002. Patent Owner seeks five categories of documents related to this agreement: (1) documents related to any use of Activision's development advances pursuant to the agreement or any other money provided by Activision to fund these cases, (2) documents related to Activision's opportunity to review and approve Petitioner's legal review of intellectual property issues, (3) a change of control agreement referenced in the agreement, (4) documents related to any claim by Activision for indemnification by Petitioner regarding Patent Owner's patents, and (5) any communications regarding categories 1–4. In Patent Owner's view, the requested discovery may lead to evidence showing that Activision is an unnamed real party-in-interest—preventing institution of *inter partes* review under 35 U.S.C. § 312(a)(2) and 35 U.S.C. § 315(b).

Counsel for Petitioner explained that he had not received a copy of the Bungie-Activision Agreement. Petitioner further represented that Activision has not funded or controlled the cases. Petitioner also questioned the usefulness of the requested discovery, arguing that there is a threshold legal question regarding whether the time bar of 35 U.S.C. § 315(b) would apply

even if Petitioner were able to establish that Activision is a real party-in-interest in these cases.

Patent Owner then clarified that Patent Owner and Petitioner had not had any discussion regarding the requested discovery. Instead, the parties had an email correspondence with respect to Patent Owner's request for a call with the Board.

In light of the parties' representations regarding the extent of their discussions and communications regarding Patent Owner's discovery requests, we ordered the parties to meet and confer regarding each category of requested discovery. *See* 37 C.F.R. § 42.51(b)(2) (stating that "a party may move for additional discovery" "*[w]here the parties fail to agree*" "to additional discovery between themselves") (emphasis added). We asked the parties to provide an update to the Board regarding the discovery dispute within five business days of the call.

On July 29, 2015, Patent Owner informed the Board that the parties had met and conferred regarding Patent Owner's discovery requests on July 25, 2015. Patent Owner indicated that the parties were unable to reach any agreement and have reached an impasse regarding each requested category of discovery.

After hearing from the parties on the call and the subsequent update regarding the parties' meet and confer, we determine that Patent Owner's motion for routine discovery under 37 C.F.R. § 42.51(b)(1) or additional discovery under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances. Therefore, we grant Patent Owner's request.

In its motion, Patent Owner should explain explicitly what discovery is requested and its position regarding why each category of requested

discovery is "inconsistent with a position advanced by [Petitioner]," 37 C.F.R. § 42.51(b)(1), and/or is necessary and narrowly tailored "in the interests of justice," 37 C.F.R. § 42.51(b)(2). Patent Owner also should explain, with specificity, what evidence suggests that there is relevant and discoverable evidence in each category of requested discovery. In particular, Patent Owner should explain its position and any authority regarding how the discovery would be relevant and useful in establishing that Activision is an unnamed real party-in-interest in violation of 35 U.S.C. § 312(a)(2) and that 35 U.S.C. § 315(b) applies to the facts of each case. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative) (explaining that "[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice").

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a motion for routine or additional discovery is *granted*;

FURTHER ORDERED that Patent Owner's motion for routine or additional discovery must be filed by August 6, 2015 and is limited to ten pages; and

FURTHER ORDERED that Petitioner may file an opposition to Patent Owner's motion, limited to ten pages, within five business days after the motion is filed.

PETITIONER:

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