

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BUNGIE, INC.,
Petitioner

v.

WORLDS INC.,
Patent Owner

Case IPR2015-01319
Patent 8,082,501

**PATENT OWNER WORLDS INC.'S
MOTION FOR ROUTINE DISCOVERY OR,
ALTERNATIVELY, ADDITIONAL DISCOVERY¹**

¹ An identical motion, including exhibits, is being filed in each of IPR2015-01264, -01268, -01269, -01319, -01321, and -01325.

LIST OF PATENT OWNER'S EXHIBITS

<u>Exhibit</u>	<u>Description</u>
2001	Transcript of Conference Call of July 23, 2015
2002	“Exhibit 1” to Exhibit 2001 (Software Publishing and Development Agreement, dated April 16, 2010)
2003	Proof of Service in <i>Worlds Inc. v. Activision Blizzard, Inc., et al.</i> , Case No. 1:12-cv-10576 (D. Mass.)
2004	Letter dated November 13, 2014, from Worlds’ litigation counsel to Activision’s litigation counsel
2005	Patent Owner’s First [Proposed] Set of Requests for Production of Documents and Things to Petitioner (Nos. 1-6)

I. REQUEST FOR RELIEF

Pursuant to the Board's Order (paper 8), Worlds Inc. moves under 37 C.F.R. § 42.51(b) for Petitioner Bungie, Inc. to produce as "routine discovery" information inconsistent with positions taken in Bungie's Petition, or in the alternative to produce additional discovery. Worlds requests that the Board grant discovery into the following categories related to real party-in-interest ("RPI"):

(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) [omitted], (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.

Order at 2. The associated requests sought by this motion are:

Category 1

RFP NO. 1 - Documents identifying the Bungie account(s) from which payment was tendered for all legal reviews associated with the Worlds Patent(s), including legal analysis of the Worlds Patent(s), drafting the Bungie IPR petitions, and paying the USPTO filing fees for the IPRs.

RFP NO. 2 - Documents identifying all Bungie account(s) into which Activision's Development Advances are or were held or deposited, directly or indirectly, for the

purpose of developing the Destiny Products.

RFP NO. 3 - Documents showing that funds received from Activision were used, directly or indirectly, to pay for, or co-mingled with funds used to pay for Bungie's legal review(s) relating to any Worlds Patent(s).

Category 2

RFP NO. 4 - Communications between Bungie and Activision concerning legal review of any Worlds Patent(s), including Activision's review or approval, or opportunity to review or approve Bungie's legal reviews of any Worlds Patent(s) or any version(s) of an IPR Petition associated with any Worlds Patent(s).

Category 4

RFP NO. 5 - Communications between Bungie and Activision related to Bungie's indemnification of or obligation to indemnify Activision based on any of the Worlds Patent(s).

Category 5

RFP NO. 6 - For all Communications/Documents responsive to RFPs Nos. 1-5 but withheld on privilege, a privilege log identifying the Communication/Document being withheld, the author or sender, recipient(s), subject matter, date, and the RFP to which the Communication/Document is responsive.

II. FACTUAL BACKGROUND

On April 16, 2010, Activision Publishing, Inc. and Bungie entered into a

Software Development and Publishing Agreement (“Agreement”), under which Bungie developed a game (Destiny) published by Activision. Ex. 2002. Under this Agreement, Bungie is obligated to conduct “legal reviews of the Products to ensure that all Intellectual Property and other rights are fully cleared for use.” Ex. 2002 at 10 (Sec. 7A.15(j)). Bungie also warrants that “the use, development, distribution and publishing [of the Product Intellectual Property] ... shall not infringe upon or violate the rights of, nor require consent of, any other party.” Ex. 2002 at 19 (Sec. 14.1.2). This warranty requires Bungie’s “reasonable investigation.” *Id.* And while Bungie must perform the legal reviews for IP clearance, Bungie’s reviews are subject to Activision’s “prior review and approval.” Ex. 2002 at 10 (Sec. 7A.15).

The Agreement also provides for financial support from Activision to Bungie for development of Destiny. Activision and Bungie “understand and acknowledge that the Development Advances shall fully fund [Bungie’s] operations directly related to the development of the Products (including overhead costs associated therewith, but excluding any built-in profit margin) during the Development Term.” Ex. 2002 at 15 (Sec. 10.1). These operations include the legal reviews required under Sec. 7A.15(j), which Bungie and Activision intended to be paid for by the Development Advances. Bungie in fact warrants this usage to Activision: “All Development Advances paid by Activision to [Bungie] hereunder shall be utilized by [Bungie] solely to fund the costs of creation and development

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