

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RPX CORPORATION,
Petitioner,

v.

APPLICATIONS IN INTERNET TIME, LLC,
Patent Owner.

Cases IPR2015-01750, IPR2015-01751, IPR2015-01752
Patents 7,356,482 B2 and 8,484,111 B2

Before LYNNE E. PETTIGREW, MITCHELL G. WEATHERLY, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

I. BACKGROUND

A conference call was conducted on November 16, 2018, to discuss the conduct of the proceeding on remand from the decision in *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) (“RPX”). Judges Pettigrew, Weatherly, and Chagnon presided. Mr. Giunta represented Petitioner and Mr. Sereboff represented Patent Owner during the

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call. Before the conference call and at the request of the panel, the parties also submitted an e-mail on November 15, detailing points of agreement and disagreement regarding procedures for remand.

The e-mail reveals that the parties disagree on two main issues: (1) the scope of the factual and legal issues to be addressed on remand, and (2) the scope of discovery. For example, Petitioner contends that the panel need only resolve whether the Petition is barred under 35 U.S.C. § 315(b) because Salesforce.com, Inc. (“Salesforce”) is a real party-in-interest or a privy of Petitioner. Petitioner volunteers to produce in discovery all evidence relevant to these issues before it files an opening brief, which would be followed by an opposition from Patent Owner and a reply by Petitioner.

Patent Owner contends that the panel must resolve whether Petitioner has failed to name not only Salesforce, but also any other entity that might be a real party-in-interest or privy. During the call, however, Patent Owner confirmed that it has no information indicating that the identification of any entity other than Salesforce might result in the Petition being barred under § 315.

Patent Owner also contends that, because the record is already complete on the issue of whether Salesforce is a real party-in-interest, briefing on that issue should proceed without new evidence. If, and only if, the panel decides on the current record that Salesforce need not be named as a real party-in-interest or privy, Patent Owner contends that the panel should permit additional discovery relating to Petitioner’s duty to name Salesforce or other entities as a real party-in-interest or privy.

II. ANALYSIS

At trial, Patent Owner focused solely upon Salesforce as an allegedly missing real party-in-interest, with its entire argument stating:

In its decision instituting [this trial], the Board stated that there was insufficient evidence to find that the real party in interest is Salesforce.com, Inc. Patent Owner disagrees with the Board's view of the law and the facts, and in particular believes that the Board misconstrued the law. As explained previously, the AIA was intended to prevent defendants from getting "a second bite at the apple." Yet, the Board is doing just that by allowing Petitioner to act indirectly for Salesforce. In its decision, the Board set an improperly high burden of proof for the patent owner, and also improperly shifted the burden of proof to the patent owner. As explained in Patent Owner's Preliminary Response, Salesforce is the real party in interest and Petitioner is acting as its proxy. Because Salesforce is time limited, so is Petitioner and patentability should be confirmed on this basis.

PO Resp. 8. Even if we were to consider Patent Owner's arguments made in its Preliminary Response, Patent Owner focused its arguments in that Paper solely upon its contention that Salesforce is a real party-in-interest¹ in this proceeding. Prelim. Resp. 2–20.

The Federal Circuit similarly focused its analysis on whether Salesforce should have been named as a real party-in-interest. *See RPX*, 897 F.3d at 1353–56 (analyzing only whether Salesforce should be identified as real party-in-interest). The Federal Circuit vacated the Final Written Decisions in these proceedings because:

¹ Patent Owner contended that "[p]rivacy of RPX and Salesforce goes to the highest level" without specifically alleging that Petitioner should have identified Salesforce as a privy. Prelim. Resp. 1. For the first time on appeal, Patent Owner "raised the possibility that RPX might be time-barred under § 315(b) as a 'privy' of Salesforce." *RPX*, 897 F.3d at 1343.

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The Board's decisions in this case neither considered the full range of relationships under § 315(b) and the common law that could make Salesforce a real party in interest with respect to this IPR nor properly applied the principles articulated in the Trial Practice Guide upon which it purported to rely.

Id. at 1358. The Federal Circuit arguably expanded the scope of the inquiry on remand by indicating that: "In its discretion, the Board may authorize additional discovery relevant to whether Salesforce is *either* a real party in interest *or* a privy of RPX for purposes of § 315(b)." *Id.* The concurrence identified the panel's failure to address fully the question of whether the Petitions were time barred under the privity provision of § 315(b) as an independent basis for vacatur and remand. *Id.* at 1358 (Reyna, J. concurring).

To ensure that we have a fulsome record upon which to determine whether Salesforce is a real party-in-interest or privy, we will authorize discovery by Patent Owner on those topics. However, we discern no basis for expanding the scope of the inquiry to the question of whether Petitioner should identify entities other than Salesforce as a real party-in-interest or privy.

The inquiry on remand thus relates to whether Salesforce must be identified as a real party-in-interest or privy. Discovery shall be limited to those issues and shall be completed in advance of the parties filing any briefing on the merits. Petitioner shall file the opening brief, followed by an opposition from Patent Owner, and a reply from Petitioner. Based upon our ruling on the scope of the remand in these proceedings, the panel instructs the parties to confer again to determine whether they can agree on a discovery plan and briefing schedule.

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III. ORDER

For the reasons given, it is:

ORDERED that the proceeding on remand is limited to the issues of whether Salesforce is a real party-in-interest or a privy of Petitioner;

FURTHER ORDERED that the parties shall confer to develop a joint discovery plan and briefing schedule; and

FURTHER ORDERED that the parties shall report back to the panel via e-mail by no later than November 30, 2018, outlining their proposal regarding discovery and briefing on remand, indicating the points on which the parties agree and those on which they disagree.

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