

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIVISION BLIZZARD, INC., ELECTRONIC ARTS INC.,
TAKE-TWO INTERACTIVE SOFTWARE, INC.,
2K SPORTS, INC., ROCKSTAR GAMES, INC., and
BUNGIE, INC.,
Petitioner,

v.

ACCELERATION BAY, LLC,
Patent Owner.

Cases IPR2015-01951, IPR2015-01953 (Patent 6,714,966 B1)¹
Cases IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
Cases IPR2015-01970, IPR2015-01972 (Patent 6,701,344 B1)

Before SALLY C. MEDLEY, LYNNE E. PETTIGREW and
WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be entered in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

IPR2015-01951, IPR2015-01953 (Patent 6,714,966 B1)
IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
IPR2015-01970, IPR2015-01972 (Patent 6,701,344 B1)

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

On July 11, 2015, a conference call was held for the following six proceedings: IPR2015-01951, IPR2015-01953, IPR2015-01964, IPR2015-01970, IPR2015-01972, and IPR2015-01996 (the “Proceedings”). The following individuals were present on the call: Mr. Baughman and Mr. Davis, lead and backup counsel, respectively, for Petitioners Activision Blizzard, Inc., Electronic Arts Inc., Take-Two Interactive Software, Ind., 2K Sports, Inc., and Rockstar Games, Inc. and Mr. Brown, lead counsel for Petitioner Bungie, Inc. (collectively, “Petitioner”); Mr. Hannah, lead counsel for Acceleration Bay, LLC (“Acceleration Bay”); and Judges Medley, Pettigrew, and Fink.

The parties requested the call to address two separate issues. Petitioner requested the call to seek relief as a result of the United States District Court for the District of Delaware’s June 17, 2016, Order, in which, Petitioner represents, the court determined that Acceleration Bay—Patent Owner of record in these Proceedings—was an exclusive licensee with less than all substantial rights to the patents at issue. Patent Owner requested the call to confer with the Board prior to filing a Motion to Amend, pursuant to section A(2)(c) of the Scheduling Order in these proceedings (e.g., IPR2015-01951, Paper 12). We addressed these issues on the call.

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A. Impact of Boeing's Interest in the Patents-at-Issue

In regards to the first issue, we treat the parties' oral submissions as a respective motion and opposition and summarize the relevant facts here.² Petitioner contends the district court determined that Boeing had retained some substantial rights in the patents-at-issue and, therefore, should have been a party to the Proceedings, at least until recently, when Acceleration Bay and Boeing entered into an "Amended and Restated Patent Purchase Agreement" (the "Agreement"). Prior to this agreement, however, Petitioner contends that because Acceleration Bay was not the true or only patent owner in these Proceedings, Boeing should (1) be required to adopt Acceleration Bay's filings to-date; and (2) be required to comply with the production requirements as a party to the proceedings under 37 C.F.R. § 42.51(b)(1)(iii).

Acceleration Bay contends Petitioner is not entitled to any relief. According to Acceleration Bay, it was the properly named Patent Owner at the time the Petitions were filed as evidenced by the USPTO assignment records, and, therefore, Acceleration Bay properly responded by filing the proper notices and power of attorney. Citing the Board's opinion in *Legend3D, Inc. v. Prime Focus Creative Services Canada, Inc.*, Case IPR2015-01350 (PTAB Nov. 19, 2015) (Paper 12), Acceleration Bay argues that to the extent it lacked standing to sue for infringement in district court, that requirement does not apply to its standing as Patent Owner in these

² The full transcript of the teleconference was filed. *E.g.*, IPR2015-01951 (Paper 29) ("Tr.").

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IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
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proceedings. Moreover, Acceleration Bay represents that in any event any interest Boeing retained in the patents-at-issue no longer exists under the Agreement. Consequently, Acceleration Bay contends there is no reason for Boeing to adopt Acceleration Bay's filings and Boeing cannot be required to provide discovery as a party.

We are not persuaded by Petitioner's contentions. As an initial matter, Acceleration Bay was indisputably the assignee of record and the named Patent Owner at the time of the filing of the Petitions. To the extent Acceleration Bay lacked some ownership rights in the patents-at-issue, as the district court determined, that issue was relevant to Acceleration Bay's standing to sue for infringement. Tr. 12:16–22. We determine that there is not the same standing requirement for a party to prosecute an *inter partes* review. See, e.g., *Legend3D*, slip op. at 5. This result is consistent with the Board's rules. For example, under 37 C.F.R. § 42.9(b), an owner of a part interest in a patent may move to act to the exclusion of a co-owner of the patent if the co-owner is unwilling or unable to participate in the proceeding, or for some other reason why it would be in the interest of justice to permit a co-owner to act in the trial. In that situation, there is no requirement for the absentee co-owner, such as Boeing allegedly was here, to adopt the filings of the participating co-owner or produce discovery.

Significantly, as a result of the Agreement, Petitioner no longer intends to challenge Acceleration Bay's status as the Patent Owner in these Proceedings. Tr. at 11:20–23. Consequently, any requirement for Acceleration Bay to move to act to the exclusion of Boeing under 37 C.F.R. § 42.9(b) now appears to be moot. Moreover, because we do not discern any

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IPR2015-01964, IPR2015-01996 (Patent 6,829,634 B1)
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reason why Boeing would have been required to adopt Acceleration Bay's filings or produce routine discovery even if it remained an alleged co-owner, but not a party to the Proceedings, we determine Petitioner is not entitled to such relief now, when Boeing is not alleged to retain any ownership interest.³ Accordingly, we deny Petitioner's motion for the requested relief.

B. Motion to Amend

During the call, Acceleration Bay sought to confer with the Board regarding its intention to file a Motion to Amend, as required by the Scheduling Order. We deemed Acceleration Bay in satisfaction with its requirement to confer with the Board and directed Acceleration Bay to review the Board's opinions in *MasterImage 3D, Inc. v. RealD, Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (precedential) and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, Case IPR2013-00422 (PTAB Mar. 7, 2014) (Paper 25) for guidance.

Acceleration Bay directed several questions regarding the propriety of submitting amended dependent claims. We agreed to consider Acceleration Bay's questions, and having done so, we direct Acceleration Bay to numbered paragraphs 1–4 in *Toyota*, slip op. 2–3, which sets forth in detail the procedure for proposing substitute claims including dependent claims. We also point out that any request to amend claims and propose a substitute claim will be regarded as contingent (i.e., it will only be considered if the

³ We point out that Petitioner has other means for obtaining discovery from Boeing. *See* 37 C.F.R. § 42.52.

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