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Paper 21
Entered: May 10, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

CYWEE GROUP LTD.,
Patent Owner.

Case IPR2018-01257 (Patent 8,552,978 B2)
Case IPR2018-01258 (Patent 8,441,438 B2)[1]

Before PATRICK M. BOUCHER, KAMRAN JIVANI, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.51(b)(2)

[1] The parties are not authorized to use this style of caption.

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On May 8, 2019, a conference call was conducted with counsel for the parties. During the call, we reminded Patent Owner that email requests for conference calls should be limited to a brief statement of the nature of its request, without attorney argument. *See, e.g., Metrics, Inc. v. Senju Pharmaceutical Co., Ltd.*, Case IPR2014-01041, slip op. at 2 (PTAB Sept. 9, 2014) (Paper 11) ("Th[e] email shall also fairly describe the nub of the dispute, providing the facts and authority that relate to the dispute, without attorney argument.").

Patent Owner requests authorization for supplemental briefing and additional discovery that it believes is warranted by the Board's recent designation of certain decisions as precedential, particularly *Ventex Co., Ltd. v. Columbia Sportswear North America, Inc.*, Case IPR2017-00651, slip op. (PTAB Jan. 24, 2019) (Paper 148) (precedential). That case, and others recently designated as precedential, relates to issues regarding real parties in interest and privies in the context of 35 U.S.C. §§ 312(a)(2) and 315(b). According to Patent Owner, *Ventex* considered a situation similar to facts in these proceedings, in which other accused infringers have a pre-existing contractual relationship that may compel a conclusion that they are unnamed real parties in interest or privies with Petitioner in the context of these proceedings.

Petitioner opposes the request, contending that it is both untimely and substantively defective. According to Petitioner, *Ventex* was an application of principles set forth by the Federal Circuit in *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) ("*AIT*"). Because *AIT* was decided by the Federal Circuit in July 2018, well before the Board decided *Ventex* or designated *Ventex* precedential, Petitioner contends that

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Patent Owner reasonably should have known of those principles and presented its argument sooner. Petitioner also contends that any contractual relationship with unnamed parties is different in character than the contractual relationship at issue in *Ventex*.

No court reporter was present on the call. The panel determines that it would be productive to have the parties' arguments in writing and on the record of these proceedings. Accordingly, we authorize Patent Owner to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2). In its motion, Patent Owner should address the factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26). In addition, the motion should address the timeliness of Patent Owner's request, particularly as related to the Board's recent designation of decisions as precedential and how the facts of *Ventex* relate to the facts at issue here. Petitioner is authorized to oppose the motion, and Patent Owner is authorized to reply, as set forth below. The parties may submit nontestimonial evidence that elucidates the factual relationship with *Ventex*.

It is

ORDERED that Patent Owner is authorized to file a motion for additional discovery as set forth above, limited to ten pages, by May 21, 2019;

FURTHER ORDERED that Petitioner is authorized to file an opposition to Patent Owner's motion, limited to ten pages, by May 28, 2019; and

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FURTHER ORDERED that Patent Owner is authorized to file a reply to Petitioner's opposition, limited to three pages, by June 3, 2019.

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