

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, ZTE (USA), INC.,
SAMSUNG ELECTRONICS CO., LTD.,
LG ELECTRONICS INC., HUAWEI DEVICE USA, INC.,
HUAWEI DEVICE CO. LTD., HUAWEI TECHNOLOGIES CO. LTD.,
HUAWEI DEVICE (DONGGUAN) CO. LTD.,
HUAWEI INVESTMENT & HOLDING CO. LTD.,
HUAWEI TECH. INVESTMENT CO. LTD., and
HUAWEI DEVICE (HONG KONG) CO. LTD.,
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, 42.123

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

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IPR2018-01258 (Patent 8,441,438 B2)

At issue in these proceedings is whether Petitioner properly identified all real parties in interest as required by 35 U.S.C. § 312(a)(2) and whether the Petition is barred by 35 U.S.C. § 315(b) because a real party in interest or privy was served with a complaint alleging infringement more than one year before the Petition was filed. *See* Paper 40² (Patent Owner’s Motion to Terminate). We previously denied Patent Owner’s Motion for Additional Discovery related to this issue, noting that our “principal concern” with Patent Owner’s motion involved the understandability and degree of burden to answer Patent Owner’s proposed instructions. Paper 30, 8.

In a related proceeding involving one of the petitioner parties to these proceedings, i.e. ZTE (USA), Inc., we granted Patent Owner’s motion for additional discovery, which proposed more narrowly tailored discovery requests appropriate for an *inter partes* review proceeding. *ZTE (USA), Inc. v. CyWee Group Ltd.*, IPR2019-00143, Paper 20 (PTAB Aug. 13, 2019). Patent Owner seeks authorization to file certain fruit of that discovery in these proceedings under the provisions of 37 C.F.R. § 42.123(b), which requires a showing that the “supplemental information reasonably could not have been obtained earlier” and that “consideration of the supplemental information would be in the interests of justice.”

On October 24, 2019, a conference call was held with the parties to discuss Patent Owner’s request. Patent Owner specifically identified several agreements, particularly related to the Mobile Application Distribution Agreement discussed in Patent Owner’s Motion to Terminate. Patent Owner also identified a privilege log that it wishes to submit. Patent Owner

² Citations are to IPR2018-01257. Similar papers have been filed in IPR2018-01258.

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contends that the information could not reasonably have been obtained earlier because it became available only as additional discovery in the related proceeding. Patent Owner also contends that consideration of that material would be in the interests of justice, given the importance of the real party in interest and privity issues to these proceedings.

During the call, the parties reached general agreement on filing of the identified agreements in these proceedings, but did not agree on filing of the privilege log. In particular, the parties agree to have Patent Owner file the identified agreements, together with brief, nonargumentative statements identifying the portions of the agreements relevant to Patent Owner's arguments advanced in its Motion to Terminate.³

In light of this agreement, we authorize submission of the identified agreements as supplemental information under 37 C.F.R. § 123(b). We direct the parties to confer before submission of the identified agreements to ensure that both sides agree that the statements made by Patent Owner with its submission conform with the agreement reached during the call. The parties are also directed to confer regarding submission of the privilege log to determine whether agreement can be reached on its submission. No decision is made at this time by the panel whether to authorize submission of the privilege log.

³ All petitioner parties other than Google were joined to these proceedings in an "understudy" role. Nevertheless, because ZTE is the only petitioner party to the related proceeding, we invited ZTE to comment on the issues raised by Patent Owner's request to file the additional evidence in these proceedings. ZTE indicated that it agreed with the positions taken by Google.

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It is

ORDERED that Patent Owner is authorized to file, as supplemental information, agreements produced as additional discovery in IPR2019-00143, together with brief nonargumentative statements identifying relevant portions of those agreements, after conferring with Petitioner; and

FURTHER ORDERED that Patent Owner's filing is due on or before November 7, 2019.

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For Petitioner:

Matthew A. Smith
Andrew S. Baluch
SMITH BALUCH LLP
smith@smithbaluch.com
baluch@smithbaluch.com

James Sobieraj
Jon Beaupre
Yeuzhong Feng
Andres Shoffstall
BRINKS GILSON & LIONE
jsobieraj@brinksgilson.com
jbeaupre@brinksgilson.com
yfen@brinksgilson.com
ashoffstall@brinksgilson.com

Naveen Modi
Chetan Bansal
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
chetanbansal@paulhastings.com

Collin Park
Andrew Devkar
Jeremy Peterson
Adam Brooke
MORGAN LEWIS & BOCKIUS LLP
Collin.park@morganlewis.com
Andrew.devkar@morganlewis.com
jpeterson@morganlewis.com
adam.brooke@morganlewis.com

Kristopher Reed
Benjamin Klein
Norris Booth
KILPATRICK TOWNSEND
kreed@kilpatricktownsend.com

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