

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PAYPAL, INC., UPWORK GLOBAL INC., SHOPIFY, INC., SHOPIFY (USA),  
INC., STRAVA INC., VALASSIS COMMUNICATIONS, INC.,  
RETAILMENOT, INC., and DOLLAR SHAVE CLUB, INC.,  
Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC,  
Patent Owner.

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Cases

IPR2019-01089 (Patent 8,099,420 B2)  
IPR2019-01091 (Patent 8,099,420 B2)  
IPR2019-01092 (Patent 6,928,442 B2)  
IPR2019-01093 (Patent 7,945,544 B2)  
IPR2019-01111 (Patent 7,802,310 B2)<sup>1</sup>

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Before JONI Y. CHANG, DENISE M. POTHIER, and MICHAEL R. ZECHER,  
*Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5(a)*

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<sup>1</sup> This Order addresses an issue that is identical in all five proceedings. We, therefore, exercise our discretion to issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style heading in any subsequent papers.

IPR2019-01089 (Patent 8,099,420 B2) IPR2019-01093 (Patent 7,945,544 B2)  
IPR2019-01091 (Patent 8,099,420 B2) IPR2019-01111 (Patent 7,802,310 B2)  
IPR2019-01092 (Patent 6,928,442 B2)

## I. INTRODUCTION

A conference call in these proceedings was held on September 24, 2019, among respective counsel for the parties and Judges Chang, Pothier, and Zecher. The call was requested by the panel to discuss the privy and real party in interest issues raised by Patent Owner, PersonalWeb Technologies, LLC (“PersonalWeb”), in the Preliminary Responses filed in each proceeding. Petitioner, PayPal, Inc., Upwork Global Inc., Shopify, Inc., Shopify (USA), Inc., Strava Inc., Valassis Communications, Inc., RetailMeNot, Inc., and Dollar Shave Club, Inc. (collectively, “Petitioner entities”), arranged for a court reporter and agreed to file a transcript of the conference call as a separate exhibit in each proceeding. 37 C.F.R. § 42.63(a) (“All evidence must be filed in the form of an exhibit.”) We reiterate some of the discussion here, but we need not repeat all of the details because the complete discussion will be reflected in the transcript.

## II. DISCUSSION

We began the conference call by discussing the following procedural history applicable to each proceeding: (1) on December 8, 2011, PersonalWeb filed a complaint against three parties, two of which were Amazon.com, Inc. and Amazon Web Service LLC (collectively, “Amazon”), asserting infringement of U.S. Patent Nos. 6,928,442 B2 (“the ’442 patent”), 7,802,310 B2 (“the ’310 patent”), and 7,945,544 B2 (“the ’544

IPR2019-01089 (Patent 8,099,420 B2) IPR2019-01093 (Patent 7,945,544 B2)  
IPR2019-01091 (Patent 8,099,420 B2) IPR2019-01111 (Patent 7,802,310 B2)  
IPR2019-01092 (Patent 6,928,442 B2)

patent) (Ex. 2008,<sup>2</sup> “the 2011 complaint”)—notably, PersonalWeb did not assert infringement of U.S. Patent No. 8,099,420 B2 (“the ’420 patent”) in the 2011 complaint; (2) on June 9, 2014, the 2011 complaint was dismissed with prejudice pursuant to a joint stipulation of dismissal by PersonalWeb and Amazon (Ex. 2009); (3) on February 5, 2018, Amazon filed a declaratory judgment action against PersonalWeb seeking a declaration of non-infringement of the ’442 patent, the ’310 patent, the ’544 patent, and the ’420 patent, among other patents (Ex. 2011); (4) according to the parties, on May 25, 2018, PersonalWeb filed a counterclaim against Petitioner entities alleging infringement of certain patents, including the ’420 patent;<sup>3</sup> (5) between August and October of 2018, PersonalWeb served Petitioner entities with complaints alleging infringement of the ’442 patent, the ’310 patent, the ’544 patent, and the ’420 patent (*see, e.g.*, Ex. 1011 (listing cases where PersonalWeb asserted the ’420 patent)); (6) on March 13, 2019, the U.S. District Court for the Northern District of California issued an Order Granting-in-Part and Denying-in-Part Amazon’s Motion for Summary Judgement, in which the court determined that, with respect to certain products, Amazon is in privity with its customers, including some of the Petitioner entities in these proceedings (Ex. 2012); and (7) on May 14 and 20, 2019, Petitioner entities filed five Petitions challenging a certain subset

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<sup>2</sup> For purposes of expediency, we refer to the exhibits filed in IPR2019-01089. Similar exhibits were filed in IPR2019-01091, IPR2019-01092, IPR2019-01093, and IPR2019-01111.

<sup>3</sup> As we indicated during the conference call, the panel underscores that filing PersonalWeb’s counterclaims, dated May 25, 2018, as an exhibit in these proceedings will be helpful to analyze the issues of privity and real party in interest and their applicability to 35 U.S.C. §§ 315(a)(1) and/or 315(b).

IPR2019-01089 (Patent 8,099,420 B2) IPR2019-01093 (Patent 7,945,544 B2)  
IPR2019-01091 (Patent 8,099,420 B2) IPR2019-01111 (Patent 7,802,310 B2)  
IPR2019-01092 (Patent 6,928,442 B2)

of claims of the '442 patent (IPR2019-01092), the '310 patent (IPR2019-01111), the '544 patent (IPR2019-01093), and the '420 patent (IPR2019-01089 and IPR2019-01091). During the conference call, both parties confirmed the aforementioned procedural history.

Upon inquiry from the panel, Petitioner entities and PersonalWeb expressed a desire to provide additional briefing in each proceeding regarding whether Amazon is a privy of at least one of Petitioner entities, or real party in interest for Petitioner entities, and whether the statutory bar set forth in 35 U.S.C. §§ 315(a)(1) and/or 315(b) applies. Based on the specific facts of these proceedings, the panel determined that it would benefit from additional briefing on the issues identified above. *See* Trial Practice Guide Update (July 2019) at 20, *available at* <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf> (stating that “whether a petitioner will be afforded a reply and the appropriate scope of such a reply rests with the panel deciding the proceeding to take into account the specific facts of the particular case”).

### III. ORDER

Accordingly, it is

ORDERED that Petitioner entities are authorized to file a ten page reply in each proceeding no later than Tuesday, October 1, 2019, that is tailored narrowly to address whether Amazon is a privy of at least one of Petitioner entities, or real party in interest for Petitioner entities, and whether the statutory bar set forth in 35 U.S.C. §§ 315(a)(1) and/or 315(b) applies;

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IPR2019-01092 (Patent 6,928,442 B2)

FURTHER ORDERED that Petitioner entities are authorized to file new evidence with each reply, but the evidence must be pertinent to the issues identified above;

FURTHER ORDERED that PersonalWeb is authorized to file a five page sur-reply in each proceeding no later than Tuesday, October 8, 2019, that is responsive to the issues addressed by Petitioner entities in each reply; and

FURTHER ORDERED that PersonalWeb is authorized to file new evidence with each sur-reply, but it must be responsive to the issues addressed by Petitioner entities in each reply.

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