

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS
RESEARCH INSTITUTRE,
Patent Owner.

IPR2021-00827
Patents 9,781,448 B2

Before JAMESON LEE and NATHAN A. ENGELS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

Introduction

On July 30, 2021, a telephone conference call was held. The participants were Judge Jameson Lee and Judge Nathan Engels, and respective counsel for the parties. Counsel for Patent Owner requested authorization to file a motion for additional discovery to obtain information relating to Petitioner's membership agreements, fees paid by members, and services provided to members. Patent Owner essentially seeks the same material provided by Petitioner in IPR2021-00275. For three reasons discussed below, authorization is denied.¹

Discussion

I.

Patent Owner requested a telephone conference on July 26, 2021, with regard to seeking discovery on the issue of real parties-in-interest. Patent Owner's preliminary response, in which Patent Owner would (and did) make the assertion that Petitioner failed to identify all real parties-in-interest, was due the next day, July 27, 2021. There could have been no reasonable expectation that a telephone conference call would be arranged, a motion for additional discovery be authorized and filed, an opposition to the motion be filed, a reply to the opposition be filed, and a decision be made on that motion all within a single business day, much less obtaining the information requested and making use of that information within the same business day.

Although we have authorized Petitioner to file a preliminary reply and Patent Owner to file a preliminary sur-reply, on the subject of identification of real parties-in-interest, a sur-reply is not an appropriate place for Patent

¹ If an *inter partes* review is instituted, Patent Owner may seek authorization again, if necessary, within two weeks of the decision instituting review.

Owner to start over with material obtained from additional discovery. The attempt to obtain additional discovery simply was not timely made.

II.

According to *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 19–20 (PTAB Oct. 6, 2020) (precedential), where there is no time bar or estoppel implication with respect to the allegedly unnamed entity, it best serves the interest of cost and efficiency not to engage in a lengthy exercise to determine whether the alleged entity should have been named as a real party-in-interest. We have that circumstance here. It is not necessary to make that determination, at least prior to a decision on whether to institute *inter partes* review. At this time it is not necessary for Patent Owner to obtain the information it seeks.

III.

Based on discussions in the conference call, Petitioner is not unwilling to provide the information sought by Patent Owner without agreement as to certain protections. Petitioner desires to file a motion to seal certain information it would provide, the same as it has filed in IPR2021-00275. Petitioner would like Patent Owner not to litigate the motion to seal twice, once before the panel in IPR2021-00275 and once before the panel here in this proceeding. In that regard, counsel for Patent Owner indicated agreement, so long as Petitioner's motion to seal in this proceeding is based on the same contentions as those contained in the motion to seal filed in IPR2021-00275. Thus, on discovery, there is no actual dispute, in principle, between the parties. It appears that the parties can work out the details and

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be in agreement with each other to permit discovery of the information requested.²

Order

It is

ORDERED that for the foregoing reasons, Patent Owner's request for authorization to file a motion for additional discovery is *denied*; and

FURTHER ORDERED that Patent Owner may seek authorization again, if necessary, within two weeks of institution of *inter partes* review, if review is instituted.

² We noted that a decision by this panel on a motion to seal may differ from a decision on a motion to seal in IPR2021-00275, but we noted that that does not affect Patent Owner's position on the matter.

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