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Paper 10
Entered: October 20, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASSA ABLOY AB, ASSA ABLOY INC., ASSA ABLOY RESIDENTIAL GROUP, INC., AUGUST HOME, INC., HID GLOBAL CORPORATION, and ASSA ABLOY GLOBAL SOLUTIONS, INC.,
Petitioners,

v.

CPC PATENT TECHNOLOGIES PTY LTD.,
Patent Owner.

IPR2022-01006 (Patent 9,665,705 B2)
IPR2022-01045 (Patent 9,269,208 B2)
IPR2022-01089 (Patent 9,269,208 B2)[1]

Before SCOTT A. DANIELS, BARRY L. GROSSMAN, and AMBER L. HAGY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

ORDER
Granting in Part the Joint Request for Additional Briefing
37 C.F.R. § 42.5

[1] A copy of this Order will be entered in each case. The parties are not authorized to use this combined caption.

On October 18, 2022, the parties submitted by email a joint request for additional discovery and additional briefing "regarding the real part[y]-in-interest and privity issues raised in Patent Owner's preliminary responses filed in IPR2022-01006, IPR2022-01045 and IPR2022-01089." *See* Ex. 3001. The email also states "Patent Owner expects to raise substantially similar real party in interest and privity issues in its upcoming preliminary responses in IPR2022-01093 and IPR2022-01094, due November 4, 2022." *Id.*

No preliminary response has been filed in the 01093 and 01094 cases. Thus, we don't know what defenses the Patent Owner actually will raise in those cases. We decline to speculate on the defenses that may be raised. We also decline to authorize in advance additional briefing based on the parties' speculations about the specific arguments and evidence that may arise. Accordingly, this Order applies only to the 01006, 01045, and 01089 IPR cases. After preliminary responses are filed in the 01093 and 01094 cases, the parties may contact the Board requesting additional discovery and/or briefing in those two cases, if deemed necessary.

Additional Discovery

The parties may agree, and apparently have agreed, to limited additional discovery. *See* 37 C.F.R. § 42.51(b)(2); *see also* Ex. 3001 (stating "Petitioner has agreed to respond to a limited set of discovery requests, which comprise one request for document production and five interrogatories."). No further action by the Board is required at this time concerning the agreed additional discovery.

Upon obtaining the additional discovery, the parties may seek authorization to file supplemental information or to file motions for judgment based on the supplemental information. 37 C.F.R. § 42.123; Patent Trial and Appeal Board Consolidated Trial Practice Guide 75–76 (Nov. 2019).[2]

Additional Briefing

The parties' proposed briefing schedule is unreasonable in the context of the December 6, 2022, due date for an opinion stating whether an IPR proceeding will, or will not, be instituted in the 01006 case. The decision due dates in the 01045 and 01089 cases are January 6, 2022. The proposed schedule could have the parties filing briefs into mid-November. Moreover, the parties have waited six weeks since the Preliminary Response in the 01006 case to seek additional discovery and propose additional briefing. The Preliminary Response in the 01006 case was filed on September 6 raising the real party-in-interest or privy issues and the potential statutory bar to the petition under 35 U.S.C. § 315(b) ("collectively the "RPI issues").

Moreover, the RPI issues were not minor, secondary issues in the Preliminary Responses. These issues are the *only issues* raised in the Preliminary Response.

We have evidence in the existing record that there is a business relationship between Apple and Petitioners. *See e.g.*, Ex. 2009 (the "Apple Developer Program License Agreement"). Thus, on the existing record we

[2] available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

can decide the issue presented by Patent Owner, without prejudice to allowing additional discovery to proceed.

The parties' joint email also states, "Petitioners are endeavoring to produce the requested documents as soon as possible but must first obtain Apple's consent to do so, and first require the entry of a Protective Order in these proceedings. Therefore, the precise timing of the document production is somewhat uncertain but Petitioners are *hopeful* that it will occur within two weeks." Ex. 3001 (emphasis added). Thus, there is a possibility that Apple may not consent to producing the documents at issue.

"[W]here 'a patent owner provides sufficient evidence that reasonably brings into question the accuracy of a petitioner's identification of the real parties in interest, the burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all the real parties in interest.'" *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018) (quoting *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, IPR2013-00453, Paper 88 (PTAB Jan. 6, 2015)). As further stated in *Worlds*, "there can be no doubt that the IPR petitioner bears the ultimate burden of persuasion to show that its petitions are not time-barred under § 315(b) based on a complaint served on an alleged real party in interest more than a year earlier." *Id.* at 1242.

Petitioner did not address in the Petition the RPI issue raised by Patent Owner in the Preliminary Response. We agree with the tenor of the parties' joint email request ((Ex. 3001) that obtaining Petitioner's views on the RPI issue would be helpful. Accordingly, we authorize Petitioner to file on or before 5 p.m. (Eastern time) October 27, 2022, a brief not to exceed 10

pages in each of IPR2022-01006; 01045; and 01089 directed to the RPI issue raised in the Preliminary Response in each of the three listed cases. No other briefing is authorized at this time.

It is so ORDERED.

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