

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL TEL*LINK CORPORATION,
Petitioner,

v.

SECURUS TECHNOLOGIES, INC.,
Patent Owner.

Cases¹

CBM2015-00145 (Patent 7,860,222) IPR2015-01219 (Patent 8,626,118)
IPR2015-01220 (Patent 7,494,061) IPR2015-01221 (Patent 8,489,068)
IPR2015-01222 (Patent 8,750,486) IPR2015-01223 (Patent 7,961,860)
IPR2015-01225 (Patent 8,886,663) IPR2015-01226 (Patent 8,135,115)
PGR2015-00013 (Patent 8,855,280) PGR2015-00014 (Patent 8,929,525)

Before KEVIN F. TURNER, BARBARA A. BENOIT, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

¹ This Order addresses issues that are the same in all ten cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are authorized to use this style heading for only the papers indicated this Order.

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ORDER

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

A conference call in the above proceeding was held on August 13, 2015, between Lori A. Gordon, Michel D. Specht, Michael B. Ray, and Salvador M. Bezos for Petitioner, Darren M. Jiron and Daniel C. Tucker for Patent Owner, and Judges Braden, Benoit, and Turner. Patent Owner sought authorization to file a motion for additional discovery regarding Petitioner Global Tel*Link Corporation's representations regarding the real parties-in-interests identified in the pending Petitions for the above listed cases.

On the call, Patent Owner represented that Petitioner is owned and controlled by American Securities LLC, and that Petitioner does not have authority to settle any of the above listed cases without approval from its parent company. Patent Owner asserted that it is in possession of settlement documents from Petitioner that support its allegations. According to Patent Owner, American Securities LLC should have been identified by Petitioner as a real party-in-interest. Thus, Patent Owner seeks additional discovery regarding American Securities LLC and Petitioner in the above listed cases.

Petitioner opposed Patent Owner's request, arguing that although American Securities LLC owns Global Tel*Link Corporation, it does not control Petitioner in regards to the above listed cases. According to

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Petitioner, Patent Owner relies on mere speculation of finding something useful as the basis to request a motion for additional discovery.

We authorized Patent Owner to file a motion for additional discovery. During the call, we reminded Patent Owner that a party seeking discovery beyond what is expressly permitted by rule must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); 35 U.S.C. § 326(a)(5); 37 C.F.R. § 42.51(b)(2)(i). We generally consider various factors in determining whether additional discovery in a proceeding is necessary in the interest of justice, and such factors are discussed in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, slip op. at 6–7 (PTAB, Mar. 5, 2013) (Paper 26).

One factor, as discussed in *Garmin*, requires more than the “mere possibility of finding something useful” or a “mere allegation that something useful will be found.” *Garmin*, slip op. at 6. A “party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.* Thus, we directed Patent Owner provide with its motion all documents in support of its position.² Another factor, as noted in *Garmin*, is that a request also

² No protective order has been entered in this proceeding. The parties are reminded of the requirement for a protective order when filing a motion to seal. 37 C.F.R. § 42.54. If the parties have agreed to a proposed protective

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should be “responsibly tailored according to a genuine need.” *Id.* We indicated to Patent Owner that all discovery requests must be specific and narrowly tailored; we will not authorize the casting of a broad net into Petitioner’s records with only the mere hope of finding something relevant.

Furthermore, during our call we directed Patent Owner to address how its discovery requests are relevant to an inquiry into a real party-in-interest issue. Our prior cases and our Practice Guide provide guidance regarding factors to consider in determining whether a party is a real party in interest. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759–60 (Aug. 14, 2012); *Shopkick Inc. v. Novitaz, Inc.*, Case No. IPR2015-00279, slip op. at 10–12 (PTAB, May 29, 2015) (Paper 7).

Lastly, we note that Ms. Lori A. Gordon and Mr. Salvador M. Bezos participated in the call on behalf of Petitioner. Ms. Gordon and Mr. Bezos, however, have not been identified as lead or backup counsel for Petitioner in

order, including the Standing Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug 14, 2012), they should file a signed copy of the proposed protective order with the motion to seal. If the parties choose to propose a protective order other than, or departing from, the default Standing Protective Order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board’s Office Patent Trial Practice Guide.

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the case, a power of attorney designating Ms. Gordon or Mr. Bezos as counsel has not been filed by Petitioner, nor has a motion for Pro Hac Vice admission been filed for Ms. Gordon or Mr. Bezos. 37 C.F.R. § 42.10. If Petitioner intends to be represented by Ms. Gordon and/or Mr. Bezos, and Ms. Gordon and Mr. Bezos are authorized to conduct business on behalf of Petitioner's lead counsel, then Ms. Gordon and Mr. Bezos must be identified, as required under 37 C.F.R. § 42.10(a). Without strict compliance with the strictures of 37 C.F.R. § 42.10, Ms. Gordon and Mr. Bezos will not be permitted to participate in this proceeding.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2), said motion limited to seven (7) pages, inclusive of Patent Owner's specific discovery requests;

FURTHER ORDERED that Patent Owner file its motion for additional discovery and all supporting documents on or before **12:00 pm EST on Monday, August 24, 2015**;

FURTHER ORDERED that Patent Owner's motion for additional discovery may address all of the above listed cases in one common document that must be filed separately in each proceeding;

FURTHER ORDERED that Petitioner may file its opposition to the motion on or before by **12:00 pm EST on Monday, August 31, 2015**, said opposition limited to five (5) pages;

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