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Paper No. 46
Entered: February 27, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

I.M.L. SLU, and
DUODECAD IT SERVICES LUXEMBOURG S.A R.L.,
ACCRETIVE TECHNOLOGY GROUP, INC., ICF TECHNOLOGY, INC.,
and RISER APPS LLC,[1]
Petitioners,

v.

WAG ACQUISITION, LLC,
Patent Owner.

Case IPR2016-01658
Patent 8,364,839 B2

Before TREVOR M. JEFFERSON, BRIAN J. McNAMARA, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DISMISSING PETITION AND
PETITIONER'S MOTION FOR ADVERSE JUDGMENT
37 C.F.R. §§ 42.72, 42.73

[1] DUODECAD IT SERVICES LUXEMBOURG S.À R.L, et al. are present by virtue of the joinder of IPR2017-01179 to IPR2016-01658. Paper 25.

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I. INTRODUCTION

A trial in IPR2016-01658 based on a petition filed by Petitioner, I.M.L. SLU ("IML"), was instituted on February 28, 2016, against claims 2, 5, 9, 12, 16, and 19 of U.S. Patent No. 8,364,839 B2 (Ex. 1001, "the '839 patent") held by Patent Owner, WAG Acquisition, LLC ("WAG"). Paper 10 ("Inst. Dec."). We instituted trial on the grounds that claims 2, 9, and 16 of the '839 patent are unpatentable as obvious under 35 U.S.C. § 103(a) over Chen[2] and Chen FH[3]; and that claims 5, 12, and 19 of the '839 patent are unpatentable as obvious under 35 U.S.C. § 103(a) over Chen, Chen FH, and Willebeek.[4] Paper 10 ("Inst. Dec.").[5]

On October 5, 2017, in IPR2017-01179, Duodecad IT Services Luxembourg S.À R.L., Accretive Technology Group, Inc., ICF Technology, Inc., and Riser Apps LLC ("Duodecad") were joined to IPR2016-01658. Paper 25.[6] Patent Owner filed a Patent Owner Response (Paper 18) and Petitioner filed a Petitioner Reply (Paper 24). Patent Owner also sought additional discovery from IML regarding undisclosed real parties-in-interest, which IML opposed. Paper 21 ("PO Mot. For Add. Disc."); Paper 22.

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[2] U.S. Patent 5,822,524, issued October 13, 1998 (Ex. 1002, "Chen").
[3] File History of U.S. Application 505,488 (Ex. 1003, "Chen FH").
[4] M. H. Willebeek-LeMair, et al, *Bamba-Audio and Video Streaming Over the Internet*, IBM J. RES. DEVELOP., Vol. 42, No. 2 (1998) (Ex. 1004, "Willebeek").
[5] Each of the challenged claims depends directly from cancelled independent claims 1, 8, and 15 of the '839 patent. *See Duodecad IT Services Luxembourg S.À R.L., et al. v. WAG Acquisition, LLC*, Case IPR2015-01036, Paper 17 (PTAB Oct. 20, 2016).
[6] In a related case, IPR2016-01656, IML is the sole Petitioner.

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Shortly before the scheduled trial hearing on the merits, IML requested leave to withdraw the Petition in this proceeding. We conducted a joint hearing for IPR2016-01656 and IPR2016-01658 as scheduled on November 30, 2017. A public transcript of the hearing is included in the record. Paper 33 ("Public Tr.").

IML subsequently moved for adverse judgment for abandonment of contest. Paper 36 ("Mot. For Adv. J."). Patent Owner opposes adverse judgment, filing an opposition under seal and a motion to seal. Paper 37 ("WAG Opp. to Adv. J."); Paper 38 (WAG Mot. to Seal). Subsequently, Duodecad filed a response to IML's Motion for Adverse Judgment (Paper 40, "Duodecad Resp. Adv. J."). Duodecad also filed a Supplemental Response to Patent Owner's Opposition under seal along with a motion to seal the supplemental response (Paper 44, "Duodecad Supp. Resp. to WAG Opp."), and a redacted response (Paper 45).

IML's one-page request seeks to abandon the contest pursuant to 36 C.F.R. § 42.73(b)(4) resulting in an adverse judgment. Mot. For Adv. J. 1. Patent Owner argues that this *inter partes* review should instead be terminated because IML failed to name at least one real party-in-interest, i.e., an entity known as CoolVision that was served with Patent Owner's infringement suit more than one year before the filing date of the Petition, thus barring the Petition under 35 U.S.C. § 315(b). WAG Opp. to Adv. J. 13–14. Duodecad argues that termination is not appropriate as WAG has failed to establish that CoolVision is a real party-in-interest or privy of IML. Duodecad Supp. Resp. to WAG Opp. 1–5.

For the reasons discussed herein, the proceeding is terminated.

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II. BACKGROUND

Whether IML's Petition named all real parties-in-interest (RPIs) has been an issue for some time. We first granted Patent Owner's Motion for Discovery on this issue on April 27, 2017, where we ordered IML to produce:

> documents sufficient to show ownership and/or control of operations between Petitioner, Muly Litvak, and CoolVision, and documents sufficient to identify any role Muly Litvak, CoolVision[,] or its personnel or owners may have played in (i) deciding to file the Petition, (ii) drafting, supervising, approving, or otherwise exerting control over the content of the Petition, and (iii) financing or paying for the Petition.

Paper 12, 9.

On June 5, 2017, we conducted a teleconference with the parties during which we discussed Patent Owner's request for authorization to move for additional discovery and several related discovery matters, including the absence of additional documentation, certain stipulations of fact, and possible interrogatories. Ex. 2006, Transcript of Teleconference ("Jun 5, 2017 Tr."). As we authorized (Jun 5, 2017 Tr., 23), Patent Owner moved for additional discovery (Paper 21) and IML Opposed (Paper 22). On November 3, 2017, we conducted another conference with the parties, but no agreement was reached on discovery as to real parties-in-interest matters.[7]

On November 15, 2017, we entered a Trial Hearing Order in which we stated that, consistent with our previously entered Scheduling Order, we would conduct a consolidated hearing on the merits of each *inter partes*

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[7] A transcript of our November 3, 2017 teleconference has not been made of record.

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review on November 30, 2017. Paper 29, 2. We also stated that we would conduct a separate hearing to address Patent Owner's outstanding Motion for Discovery of information concerning Petitioner's real parties-in-interest. *Id.* at 3.

On November 29, 2017, IML sent the Board e-mail correspondence with a proposed motion attached seeking to withdraw the Petitions in IPR2016-01658 and IPR2016-01656. We responded by e-mail that the hearing would take place as scheduled on November 30, 2017, and that we would take up the matter of IML's proposed withdrawal from this proceeding and related proceeding IPR2016-01656 at the discovery hearing.

On November 30, 2017, we conducted a public hearing on the merits and a separate discovery hearing, closed to the public ("Discovery Hearing"). Public Tr. 2:3–6. At the Discovery Hearing, the first issue addressed was IML's proposed withdrawal of the Petition in this proceeding and related proceeding IPR2016-01656. Having not objected to the joinder of Duodecad to the instant proceeding, IML clarified that it sought only to withdraw its own participation in IPR2016-01658 and did not speak for Duodecad;[8] in contrast, as the sole Petitioner in IPR2016-01656, IML indicated it sought to withdraw the Petition in IPR2016-01656. Paper 34, Transcript of Discovery Hearing held on Nov. 30, 2017 ("Discovery Hr'g. Tr.") 7:1–12, 8:1–11.

[8] Although we instituted on Duodecad's petition, which was substantially identical to that filed by IML, Duodecad's petition would have been time barred under 35 U.S.C. § 315(b), but for the joinder provisions of 35 U.S.C. § 315(c). Paper 25.

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