

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

SEVEN NETWORKS, LLC,
Patent Owner.

IPR2018-01106 (Patent 9,516,127) IPR2018-01108 (Patent 9,516,127)
IPR2018-01113 (Patent 8,811,952) IPR2018-01114 (Patent 8,811,952)
IPR2018-01120 (Patent 9,247,019) IPR2018-01122 (Patent 9,325,600)
IPR2018-01124 (Patent 9,351,254) IPR2018-01125 (Patent 9,351,254)
IPR2018-01126 (Patent 9,516,129) IPR2018-01127 (Patent 9,553,816)¹

Before THU A. DANG, KARL D. EASTHOM, JONI Y. CHANG,
THOMAS L. GIANNETTI, ROBERT J. WEINSCHENK, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.²

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Authorizing Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

² This is not an expanded panel of the Board. It is a listing of all the Judges on the panels of the above-listed proceedings.

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I. INTRODUCTION

On August 24, 2018, Judges Dang, Easthom, Chang, Giannetti, Weinschenk, and Harlow held a telephone conference call with counsel for Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Petitioner”) and counsel for SEVEN Networks, LLC (“Patent Owner”). A court reporter was present on the conference call. This order summarizes statements made during the conference call. A more complete record may be found in the court reporter’s transcript, which Patent Owner filed as an exhibit. Ex. 2002.³

II. ANALYSIS

Patent Owner requested authorization to file a motion for additional discovery relating to whether Google LLC (“Google”) is a real party in interest or privy of Petitioner. Patent Owner argued that Google was served with a complaint alleging infringement of the challenged patents more than a year before the petitions were filed in the above-listed proceedings. Thus, according to Patent Owner, if Google is a real party in interest or privy of Petitioner, the petitions in the above-listed proceedings are barred under 35 U.S.C. § 315(b). Patent Owner asserted that Petitioner and Google have entered into indemnification agreements in the past and that Petitioner and Google currently are cooperating in the related district court cases. Patent Owner relied on those assertions as tending to show that the requested discovery will uncover something useful. Petitioner responded that Patent Owner’s request is based on speculation and that Patent Owner’s assertions

³ We cite to the record in IPR2018-01106, unless otherwise noted.

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at most indicate that Petitioner and Google have a typical customer-supplier relationship.

After considering the respective positions of the parties, we direct the parties to meet and confer regarding Patent Owner's proposed discovery requests by September 7, 2018. At least three (3) business days prior to the meet and confer, Patent Owner must provide Petitioner with the proposed discovery requests. If the parties reach an agreement regarding the proposed discovery requests and motion practice is not necessary, the parties should inform the Board by a joint email to Trials@uspto.gov.

On the other hand, if any disputes remain after the meet and confer, we authorize Patent Owner to file a 10-page motion for additional discovery by September 11, 2018. Patent Owner should identify in the motion any agreements reached by the parties during the meet and confer, as well as the remaining disputes. Patent Owner also should identify the exact discovery requests that Patent Owner proposes serving on Petitioner. Patent Owner should explain why the requested discovery is necessary in the interest of justice, including by identifying the evidence already in Patent Owner's possession tending to show beyond speculation that something useful will be uncovered by the requested discovery. Patent Owner is reminded that the proposed discovery requests should be reasonable in number and narrowly tailored. We also authorize Petitioner to file a 10-page opposition to Patent Owner's motion by September 18, 2018, and Patent Owner to file a 3-page reply to Petitioner's opposition by September 21, 2018.

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III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties must meet and confer regarding Patent Owner's proposed discovery requests by September 7, 2018;

FURTHER ORDERED that at least three (3) business days prior to the meet and confer, Patent Owner must provide Petitioner with the proposed discovery requests;

FURTHER ORDERED that if agreement is not reached as a result of the meet and confer, Patent Owner is authorized to file a 10-page motion for additional discovery by September 11, 2018;

FURTHER ORDERED that Petitioner is authorized to file a 10-page opposition to Patent Owner's motion by September 18, 2018; and

FURTHER ORDERED that Patent Owner is authorized to file a 3-page reply to Petitioner's opposition by September 21, 2018.

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