

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

CYWEE GROUP LTD.,
Patent Owner.

Case IPR2018-01257 (Patent 8,552,978 B2)
Case IPR2018-01258 (Patent 8,441,438 B2)¹

Before PATRICK M. BOUCHER, KAMRAN JIVANI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION

Motions for Additional Discovery
37 C.F.R. §§ 42.5, 42.51(b)(2)

¹ The parties are not authorized to use this style of caption.

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I. INTRODUCTION

In each of these proceedings, pursuant to our authorization, Patent Owner filed a Motion for Additional Discovery, Petitioner opposed, and Patent Owner replied. Papers 24 (“Mot.”), 26 (“Opp.”), 27 (“Reply”).² Patent Owner “seeks discovery directed to Petitioner Google LLC’s (‘Petitioner’ or ‘Google’) failure to name all Real Parties in Interest [(“RPIs”)] to its Petition (Paper 1) in the present IPR, including at least Samsung Electronics Group, Ltd. (‘Samsung’), LG Electronics Inc. (‘LG’), and ZTE (USA), Inc. (‘ZTE’).” Mot. 1. According to Patent Owner, it “raised concerns of RPI in its oppositions to the joinder petitions filed by Samsung, LG, ZTE, and Huawei (collectively, the ‘Joinder Petitioners’)” in related proceedings IPR2019-00525, IPR2019-00526, IPR2019-00534, IPR2019-00535, IPR2019-00559, IPR2019-00560, IPR2019-00563, and IPR2019-00563. *Id.* In light of the Board’s recent designation of *Ventex Co., Ltd. v. Columbia Sportswear N.A, Inc.*, Case IPR2017-00651, slip op. (PTAB Jan. 24, 2019) (Paper 148) as precedential, Patent Owner now seeks “additional discovery and briefing on the issue of RPI” in the instant proceedings. *Id.* at 2.

II. BACKGROUND

Almost a year ago, on July 9, 2018, the Federal Circuit provided guidance regarding the term “real party in interest” in the context of post-grant proceedings before the Office. *Applications in Internet Time, LLC v.*

² The papers filed by both parties are substantially identical in the two proceedings. Accordingly, we address both motions herein, but for convenience cite only to IPR2018-01257.

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RPX Corp., 897 F.3d 1336, 1344 (Fed. Cir. 2018) (“This court has had little occasion to grapple with the meaning of the term ‘real party in interest’ in the context of [35 U.S.C.] § 315(b).”). In a decision issued on January 24, 2019, a panel of the Board applied that guidance in *Ventex* to find that an unnamed party, namely Seirus Innovative Accessories (“Seirus”), was both a real party in interest and in privity with the petitioner, Ventex Co. Ltd. (“Ventex”). *Ventex*, slip op. at 11 (“Based on the record before us, we determine Seirus is a real party in interest.”), 15 (“[W]e conclude that the preexisting contractual relationships between Seirus and Ventex, and Ventex’s role as a proxy for Seirus in these *inter partes* reviews, supports the conclusion that Seirus is in privity with Ventex.”). *Ventex* was designated as precedential by the Board on April 16, 2019.

Ventex involved two agreements between Ventex and Seirus, namely a “Supplier Agreement” that included an indemnification clause and an “Exclusive Manufacturing Arrangement” in which Ventex agreed only to manufacture “Heatwave Material” for Seirus. *Ventex*, slip op. at 7–8. In light of these agreements, the Board found that Ventex and Seirus “had mutual interest in the continuing commercial and financial success of each other.” *Id.* at 8. Considering that interest in combination with admissions that Ventex filed its petition “in concern of potential legal jeopardy for ‘its customers’ and ‘prospective buyers,’” the Board concluded that Seirus was a real party in interest. *Id.* at 8–11. As the Board noted, when Ventex filed its petition, Seirus had been sued for infringement by the patent owner and was itself time-barred from filing its own petition under 35 U.S.C. § 315(b). *Id.* at 8–9. In addition, the Board concluded that Ventex and Seirus were privies in light of the legal relationship created by the two agreements between them

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and in light of a finding that Ventex served as a proxy for Seirus in the *inter partes* review proceeding. *Id.* at 11–15.

Patent Owner contends that similar facts are present in the instant proceedings. Mot. 6. In particular, Patent Owner contends that Petitioner “has had a long, established business relationship with each of the Joinder Petitioners since as early as 2009 as the supplier of the Android [operating system].” *Id.* According to Patent Owner, the Android operating system is “a significant component” of its infringement claims against each of those parties in district court. *Id.* In addition, Patent Owner alleges that at least some of the Joinder Petitioners “are currently or have been parties to agreements with [Petitioner] relating to Android.” *Id.* Patent Owner specifically identifies the “Android Networked Cross-License” (“PAX”), which Patent Owner contends “creates a defense group for [Petitioner] and members of the ‘Android Ecosystem.’” *Id.* (citing Ex. 2016). Patent Owner also identifies the “Mobile Application Distribution Agreement” (“MADA”) between Samsung and Petitioner. *Id.* Patent Owner acknowledges that the MADA has not been in force since 2012, but contends that its inclusion of an indemnification provision “suggests the presence of other indemnification agreements between [Petitioner] and the Joinder Petitioners relating to Android devices.” *Id.*

Tying these facts to *Ventex*, Patent Owner asserts that “Google appears to be the exclusive supplier of [the Android operating system] to the Joinder Petitioners, as all of their infringing smartphones utilize Android.” *Id.* at 7. Patent Owner also observes that Petitioner was aware of Patent Owner’s infringement suits against the Joinder Petitioners “as of the time it filed its Petition because it identified those cases as ‘Related Matters’ in its

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disclosure of mandatory notice information.” *Id.* (citing Paper 1, 5–6).

Patent Owner summarizes: “These facts, taken together, indicate that the Joinder Petitioners have considerable common interests in Google’s efforts to invalidate the patent[s]-at-issue in th[ese] IPR[s] and are RPIs to the IPR[s], warranting additional discovery on the matter.” *Id.* (citing *Ventex*, slip op. at 9).

III. ANALYSIS

With respect to the threshold issue of whether to authorize additional discovery, the fruit of which would underlie further briefing regarding a purported failure by Petitioner to have identified all real parties in interest, Patent Owner seeks:

(1) agreements between Google and any of the Joinder Petitioners relating to the Android Operating System (“OS”) and/or devices utilizing Android, including any licensing, cross-licensing, supplier, manufacturing, joint defense, joint interest, and indemnification agreements; (2) any communications between Google and any of the Joinder Petitioners regarding the Google IPRs, CyWee, U.S. Patents 8,441,438 and 8,552,978, and/or any of the “Related Matters” disclosed in Google’s Petition (Paper 1 at 5-6); and (3) deposition of witness(es) with knowledge of Google’s Android licensing practices and any of the agreements listed above.

Id. In opposing the Motion, Petitioner contends that the Motion is untimely, and that the requests are both too broad and unlikely to produce anything useful. Opp. 1–10. We deny the Motion in both proceedings for the following reasons.

A party moving for additional discovery “must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2).

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