

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

VL COLLECTIVE IP LLC,
Patent Owner.

IPR2023-00891
Patent 8,605,794 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and
DAVID C. McKONE, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Request
to File a Motion for Additional Discovery
37 C.F.R. § 42.51

VL Collective IP, LLC (“Patent Owner”) requested a teleconference with the panel seeking to file a motion to “(1) terminate the ’891 IPR because Netflix and Unified are estopped from maintaining the [’]891 IPR; (2) request additional discovery from Netflix in support of Patent Owner’s motion to terminate; and (3) request authorization for third party subpoenas to Unified Patents in support of Patent Owner’s motion to terminate.” *See* Ex. 3001, 3 (requesting teleconference). The panel held a teleconference with the parties on February 7, 2024.

During the teleconference, Patent Owner discussed its intention to seek additional discovery and move to terminate this proceeding on the basis that 35 U.S.C. § 315(e)(1) estops Netflix, Inc. (“Petitioner”) from maintaining the proceeding based on an alleged real party in interest status of Petitioner and Unified Patents, LLC (“Unified Patents”). According to Patent Owner, estoppel under § 315(e)(1) applies because the Board issued a final written decision in *Unified Patents, LLC v. VL Collective IP, LLC*, IPR2022-01086, which addressed claims 1, 3, 5, 9, 12, 13, 15, 20, and 21 of Patent No. 8,605,794 B2 (“the ’794 patent”). *See* Ex. 3001, 3. To support its real party in interest allegation, Patent Owner stated it seeks to move for additional discovery under 37 CFR § 42.51(b)(2)(i) as to Petitioner’s membership status with Unified Patents, including, for example, membership agreements, documentation of payment, details as to the scope of Petitioner’s membership, and communications between Unified Patents and Petitioner. Patent Owner further stated it seeks to move for additional discovery from Unified Patents, including information as to how Unified Patents internally categorizes the ’794 patent.

Petitioner opposed the proposed motion for additional discovery, arguing that Patent Owner has not sufficiently alleged evidence of a real

party in interest relationship between Petitioner and Unified Patents.

Petitioner argued that in a similar discovery request in *Netflix Inc. and Hulu, LLC v. DivX LLC*, IPR2020-00052, the request did not satisfy Factor (1) of *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).

We pointed out that Petitioner challenges dependent claims in this proceeding that were not addressed in IPR2022-01086, but that depend from claims that were addressed. We asked Patent Owner, if § 315(e)(1) were to apply to the claims addressed in IPR2022-01086, how we should proceed as to the dependent claims included in this proceeding that were not addressed in IPR2022-01086. Patent Owner asserted that in its view the entire proceeding should be terminated, but that it would need to consider the issue further. Petitioner asserted that even if Petitioner somehow was a real party in interest in IPR2022-01086, the dependent claims cannot be bifurcated from their independent claims, and because some claims in this proceeding were not addressed in IPR2022-01086, this proceeding could not be dismissed entirely.

We asked the parties to meet and confer to discuss whether an agreement could be reached as to limited discovery. The parties contacted the Board on February 12, 2024, to confirm that they did not reach an agreement. Ex. 3001, 1.

In view of the above, we authorize Patent Owner to file a motion for additional discovery under 37 CFR § 42.51(b)(2)(i) not to exceed 10 pages. We further authorize Petitioner to file an opposition not to exceed 10 pages, and also authorize Patent Owner to file a reply not to exceed 5 pages. As part of the briefing, we request that the parties propose how we should proceed with respect to the claims challenged in this proceeding and not

addressed in IPR2022-01086, in the event § 315(e)(1) were to apply. We expect such explanation to be necessary to satisfy *Garmin* Factor (1), that is, to “show beyond speculation that in fact something useful will be uncovered.” *Garmin*, IPR2012-00001, Paper 26, 6.

Garmin states explicitly, “‘useful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7. As we noted during the conference call, termination of this entire proceeding based on § 315(e)(1) is unlikely. Therefore, in order to demonstrate what is useful in substantive value to Patent Owner’s contention, we request that Patent Owner propose how the Board proceeds on a claim-by-claim basis as part of its motion for additional discovery.

ORDER

Accordingly, it is

ORDERED that Patent Owner may file a motion for additional discovery not to exceed ten pages on or before February 28, 2024;

Petitioner may file an opposition to the motion for additional discovery not to exceed ten pages on or before March 6, 2024; and,

Patent Owner may file a reply to the opposition not to exceed five pages on or before March 12, 2024.

IPR2023-00891
Patent 8,605,794 B2

For PETITIONER:

Aliza Carrano
Indranil Mukerji
John Moulder
WILLKIE FARR & GALLAGHER LLP
acarrano@willkie.com
imukerji@willkie.com
cmoulder@willkie.com

For PATENT OWNER:

Christine Lehman
Michael Matulewicz-Crowley
Naveed Hasan
Jaime Cardenas-Navia
REICHMAN JORGENSEN LEHMAN & FELDBERG LLP
clehman@reichmanjorgensen.com
mmatulewicz-crowley@reichmanjorgensen.com,
nhasan@reichmanjorgensen.com
jcardenas-navia@reichmanjorgensen.com