

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.

Petitioners,

v.

DYNAPASS IP HOLDINGS LLC

Patent Owner

Inter Partes Review No. IPR2024-00283

Patent No. 6,993,658

**DYNAPASS IP HOLDINGS LLC'S
MOTION FOR ADDITIONAL DISCOVERY**

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Email authorizing Patent Owner to file a Motion for Additional Discovery (Mar. 21, 2024).
2002	Dynapass IP Holdings LLC's Discovery Requests to Petitioner.
2003	Email correspondence between Patent Owner and Petitioner regarding Patent Owner's request that Petitioner identify whether it has ever been a direct or indirect member of Unified Patents.
2004	https://www.unifiedpatents.com/success .

Pursuant to 37 C.F.R. § 42.51(b)(2)(i), Patent Owner Dynapass IP Holdings LLC (“Patent Owner”) requests that the Board order Petitioner to produce the information requested in Patent Owner’s Discovery Requests (EX2002) (“Requested Discovery”). The Board authorized Patent Owner to file this motion by close of business on March 29. EX2001.

I. Introduction

The Requested Discovery is narrowly tailored to two simple questions: (1) has Petitioner ever been a direct or indirect member of Unified Patents? (2) If so, when? The answers to those questions are highly relevant to the first factor of *General Plastic* because there is likely a material relationship between Petitioner and Unified Patents that weighs in favor of denying institution of this follow-on petition. Unified Patents had already filed a petition for *inter partes* review of the same patent subject to this proceeding (IPR2023-00425) eight months before Petitioner filed this follow-on Petition, and Petitioner was able to review the Board’s institution decision in the Unified IPR for two months before filing this follow-on Petition. Petitioner even concedes that its instant Petition “substantially adopts the unpatentability grounds and arguments raised in” IPR2023-00425, supposedly “eliminating the need for the Board to re-analyze” independent claims 1 and 5. Pet., p. 1.

Petitioner's response to the Requested Discovery is telling—the world's largest online retailer doth protest too much. Rather than litigate on the merits related to its apparent relationship with Unified Patents, Petitioner has unfortunately chosen to withhold highly relevant information from the Board and Patent Owner. Fortunately, however, the Board has the authority to order Petitioner to provide the Requested Discovery. Patent Owner respectfully submits that the Board should exercise that authority for the following reasons.

II. The Requested Discovery Will Likely Show a Material Relationship Between Petitioner and Unified Patents That Is Relevant to the First General Plastic Factor.

The Board evaluates the *General Plastic* factors when determining whether to exercise its discretion to deny follow-on petitions. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 8-10 (P.T.A.B. Sep. 6, 2017) (precedential). The first factor considers “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *Id.* at 9. But the first factor is not limited to the same petitioner when there is a relationship between different petitioners. *See Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, -00063, -00084, Paper 11 at 2 (P.T.A.B. Apr. 2, 2019) (“when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.”). That is the case here because, as discussed in further detail below, publicly available information shows

a high likelihood that Petitioner is a member of Unified Patents. And based on the relative timing between the two petitions, several additional *General Plastic* factors weigh in favor of denying the instant Petition.

III. The Requested Discovery Is Necessary in the Interest of Justice.

The Requested Discovery satisfies each of the *Garmin* factors, so it is necessary in the interest of justice. 37 C.F.R. § 42.51(b)(2)(i); *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR2012-00001, Paper 26 at 6-7 (P.T.A.B. Mar. 5, 2013) (precedential).

A. *Garmin* Factor 1

Petitioner's behavior alone indicates that it is likely a member of Unified Patents—Petitioner could have simply answered “no” if it was not a member. *See* EX2003. Beyond that, however, publicly available information shows a high likelihood that Petitioner is a member of Unified Patents. Unified Patents is one of the most prolific filers of IPRs. *See, e.g.,* EX2004. And the patent owner in IPR2020-01201 established, that as of September 19, 2020, more than 17% of all of the IPRs filed by Unified Patents were directed to patents asserted against Facebook or Amazon. *Unified Patents LLC v. MasterObjects, Inc.*, IPR2020-01201, Paper 12, pp. 58-59 (P.T.A.B. Oct. 16, 2020). More recently, Unified Patents has filed IPRs on patents that Amazon is litigating in two other cases: Patent Owner's case

asserting the '658 Patent, and *VideoLabs, Inc. et al v. Amazon.com, Inc. et al*, No. 6:22-cv-00079 (W.D. Tex.). Accordingly, it is highly likely that the Requested Discovery will uncover information that is highly relevant to the *General Plastic* analysis.

B. *Garmin* Factor 2

The Requested Discovery seeks neither Petitioner's litigation positions nor the underlying basis for those positions. *See* Ex. 2002; *see also Garmin*, Paper 26 at 6. Patent Owner seeks the Requested Discovery to provide a complete record to the Board when it evaluates the *General Plastic* factors to determine whether to exercise its discretion to deny Petitioner's follow-on petition. *See General Plastic*, IPR2016-01357, Paper 19 at 8-10; *Valve*, IPR2019-00062, -00063, -00084, Paper 11 at 2.

C. *Garmin* Factor 3

The Requested Discovery cannot be obtained through other means. Petitioner refuses to provide the Requested Discovery, and Patent Owner understands that Unified Patents does not publish a complete list of its members. Although publicly available information shows a high likelihood that Petitioner is a member of Unified Patents—as discussed for *Garmin* factor 1—only Petitioner or Unified Patents can

confirm that such a relationship exists. Of those two entities, only Petitioner is a party to this proceeding.

D. *Garmin* Factor 4

The Requested Discovery consists of two interrogatories narrowly tailored to the question of whether Petitioner has ever been a direct or indirect member of Unified Patents. Given the straightforward nature of the two interrogatories, neither definitions nor instructions are strictly necessary. But Patent Owner includes definitions and instructions in the Requested Discovery to avoid any confusion or further delay by Petitioner.

E. *Garmin* Factor 5

The Requested Discovery is not overly burdensome to answer. The first interrogatory merely requires a yes/no answer. Ex. 2002. To the extent Petitioner's answer to the first interrogatory is "yes," the second interrogatory can be answered with a date range. *Id.* To the extent Petitioner argues that the Requested Discovery is overly burdensome due to confidentiality concerns, no such concerns exist because Unified Patents itself has previously identified members in publicly filed pleadings before the PTAB. *See, e.g., Unified Patents, LLC v. Gesture Technology Partners, LLC*, IPR2021-00917, Paper 7, p. 1, n. 2 (P.T.A.B. Sep. 22, 2021). Alternatively, the Requested Discovery could be disclosed under a Protective Order.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 29, 2024, the foregoing document was served on counsel of record for Petitioners by filing this document through the End-to-End System, as well as via electronic mail to counsel of record for Petitioner at the following addresses:

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Respectfully submitted,

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