

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,

Petitioner,

v.

DYNAPASS IP HOLDINGS LLC,

Patent Owner.

Case No. IPR2024-00283

U.S. Patent No. 6,993,658

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION FOR ADDITIONAL DISCOVERY**

Patent Owner's (PO) Motion for Additional Discovery should be denied because the requested information (the "Requested Discovery") is not in the interests of justice and would not impact the Board's analysis of the *General Plastic* ("GP") factors. The Board has repeatedly evaluated a party's potential membership in an entity such as Unified Patents ("Unified") and consistently refused to rely on any purported relationship to deny institution. PO asks the Board to approve additional discovery in a case where Unified filed an IPR on January 6, 2023—before the patent was even asserted against, or known about by, Amazon. PO's speculations do not satisfy its burden of showing why its requests are in the interests of justice.

Under 37 C.F.R. § 42.8, as part of its Mandatory Notices, Petitioner must only identify: (1) each real party-in-interest; (2) related matters; (3) lead and back-up counsel; and (4) service information. Petitioner has complied with these disclosure requirements (Petition at 1-5). Nothing more is required.

I. PATENT OWNER'S REQUESTED DISCOVERY IS IRRELEVANT TO THE *GENERAL PLASTIC* ANALYSIS

PO's primary position is based on alleged relevance of its Requested Discovery to the GP factors, but it never explains why that is so. PO concludes that because the first factor considers whether there is a relationship between different petitioners and that purportedly "publicly available information shows a high likelihood that Petitioner is a member of Unified," this would weigh in favor

of denying the Petition. *See* Mot. at 2-3. PO is incorrect. Even when membership in Unified has been confirmed under the first *GP* factor, the Board has still determined that the membership did not warrant discretionary denial. *See, e.g., Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01404, Paper 12, 12 (PTAB Jan. 22, 2020) (declining to find membership in Unified justified discretionary denial); *Netflix Inc. & Hulu, LLC, v. DIVX, LLC*, IPR2020-00052, Paper 59, 5-9 (PTAB Oct. 20, 2020) (declining to find petitioner and Unified had significant relationship after evaluating membership agreement and payments).

PO's Requested Discovery is not only irrelevant to the *GP* analysis, but it also does not affect Petitioner's RPI statement. The Board has repeatedly determined that Unified's members are not RPIs for Unified's IPRs and PO has no explanation for why learning (1) Petitioner's potential membership and (2) date of association could cause it to be an RPI in a different proceeding with which it has no involvement. *See, e.g., Samsung Elecs. Co., Ltd. v. Memoryweb, LLC*, IPR2022-00222, Ex. 2121, 43-53 (PTAB Dec. 22, 2023) (evaluating evidence and holding Petitioner was not a RPI to Unified's proceeding); *Unified Patents Inc. v. Uniloc USA, Inc.*, IPR2018-00199, Paper 33, 10 (PTAB May 31, 2019) (collecting cases and holding membership in Unified is not enough to make any Unified member that has been sued on a patent an RPI for any Unified challenge to that patent); *Unified Patents Inc. v. Barkan Wireless IP Holdings, L.P.*, IPR2018-

01186, Paper 24, 11 (PTAB Dec. 7, 2018) (holding Unified was sole RPI although members may benefit from the IPR because the question is “whether Petitioner is *specifically representing* the unnamed party’s interest”) (emphasis original).

PO’s cited cases change nothing. PO cites to *Valve Corporation v. Electronic Scripting Products* to support its assertion that the Requested Discovery would be relevant to the first *GP* factor. *Valve* is inapposite because, in *Valve*, Valve and its licensee, HTC, were co-defendants in the same district court litigation and both filed petitions challenging the same claims of the ’934 patent. IPR2019-00062, Paper 11, 9-10 (PTAB Apr. 2, 2019). The Board determined that the first *GP* factor weighed against institution due to the complete overlap in the challenged claims and the significant relationship between Valve and HTC as co-defendants in the same litigation. *Id.* at 10.

Unlike *Valve*, Petitioner’s and Unified’s Petitions do not have complete overlap in the challenged claims and the parties are not co-defendants in district court. Petitioner challenges dependent claims 2 and 7 that were not challenged by Unified. *See also* Petition at 7-9. Although there is overlap in the unpatentability positions presented as to the independent claims from which claims 2 and 7 depend, the Board has found that this overlap is not evidence of prohibited road-mapping under *GP*. *See Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18, 5 (PTAB Aug. 23, 2022). This is especially true here, where efficiency

considerations strongly favor institution because there was no impermissible road-mapping here—instead, Petitioner's challenge focuses on supplements to address two previously unchallenged dependent claims. *See* Pet. at 10. PO's Requested Discovery does not alter the *GP* analysis, which weighs heavily against denial.

II. PATENT OWNER FAILS TO DEMONSTRATE ITS REQUESTED ADDITIONAL DISCOVERY IS IN THE INTEREST OF JUSTICE

PO's Requested Discovery should be denied because it is based purely on speculation and therefore fails to establish that there is a likelihood that useful information will be discovered. Under the first *Garmin* factor, the “mere allegation that something useful will be found, [is] insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 6-7 (PTAB Mar. 5, 2013). The “requester of information should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Id.* at 7. In this context, “useful” does not mean “merely ‘relevant’ and/or ‘admissible’” but “favorable in substantive value to a contention of the party moving for discovery.” *Id.*

PO's arguments are little more than speculation regarding Petitioner's “behavior” and other cases Unified has been involved in. *See* Mot. at 3-4. Indeed, PO omits that the Unified IPR was filed over a month before PO filed its complaint against Petitioner, which was the first time Petitioner learned of the '658 patent.

Compare Unified Patents v. Dynapass, IPR2023-00425, Paper 1 (PTAB filed Jan. 6, 2023), with *Dynapass v. Amazon*, No. 2:23-cv-00063 (E.D. Tex. filed Feb. 20, 2023). PO's citation to Unified's IPR on a patent asserted by *VideoLabs* is again nothing more than unsupported speculation. Indeed, the patent at issue was also asserted against Netflix, a known Unified member. See *Netflix, Inc. v. DIVX, LLC*, IPR2020-00052, 2020 WL 2507408, at *4 (PTAB May 14, 2020). PO's interrogatories (which were not disclosed during the meet-and-confer process) also lack precision by failing to explain what an "indirect" member is. PO's imprecise conjecture does not warrant additional discovery—particularly when, as shown above, the information does not alter the *GP* analysis.

III. CONCLUSION

There is no coordination or impermissible serial IPR challenges implicated here—instead, PO sued numerous defendants and now appropriately faces multiple IPR challenges filed by different parties. The Requested Discovery is not in the interests of justice and the motion should be denied.

Dated: April 5, 2024

Respectfully submitted,
/ Alexander B. Stein /
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), I certify that on April 5, 2024, I caused to be served a true and correct copy of Petitioner's Opposition to Patent Owner's Motion for Additional Discovery by email to Patent Owner's counsel:

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