

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner.

IPR2024-00283
Patent 6,993,658

Before KEVIN F. TURNER, LYNNE H. BROWNE, and
JASON M. REPKO, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

On March 21, 2024, we authorized Patent Owner to file a Motion for Additional Discovery limited to the issue of whether Petitioner has ever been a direct or indirect member of Unified Patents. Ex. 2001, 1. With our authorization, Patent Owner timely filed its Motion for Additional Discovery (Paper 6, “Mot.”). Petitioner timely filed its Opposition. Paper 7 (“Opp.”). Patent Owner seeks discovery tailored to two discovery requests: “[1] has Petitioner ever been a direct or indirect member of Unified Patents? [2] If so, when?” Mot. 1. For the reasons below, we *deny* Patent Owner’s Motion for Additional Discovery.

II. DISCUSSION

In *inter partes* reviews, “[t]he moving party has the burden of proof to establish that it is entitled to the requested relief.” See 37 C.F.R. § 42.20(b) (2019). To conduct additional discovery, a requesting party must demonstrate that “such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). In deciding whether to grant a motion for additional discovery, the Board considers a number of factors, including whether the movant is already in possession of a threshold amount of evidence “tending to show beyond speculation that in fact something useful will be uncovered.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, at 6 (PTAB Mar. 5, 2013) (precedential), 7 (stating “useful” means “favorable in substantive value to a contention of the party moving for discovery”).

A. Patent Owner’s Position

Patent Owner asserts that its request will likely show a material

relationship between Petitioner and Unified Patents. Mot. 2. Patent Owner asserts further that this information will be useful in that it pertains to the Board's evaluation of the *General Plastic* factors in its determination of whether to exercise discretion to deny the Petition. *Id.* As evidence that something useful will be uncovered if its request is granted, Patent Owner argues that Petitioner's "behavior alone indicates that it is likely a member of Unified Patents." Mot. 3 (citing Ex. 2003). Additionally, Patent Owner points to Unified Patents' status as a prolific filer of IPRs. *Id.* (citing Ex. 2004). In this regard, Patent Owner asserts 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. *Id.* (citing *Unified Patents LLC v. MasterObjects, Inc.*, IPR2020-01201, Paper 12, pp. 58-59 (P.T.A.B. Oct. 16, 2020)).

B. Petitioner's Position

Petitioner contends that "Patent Owner's primary position is based on alleged relevance of its Requested Discovery to the [*General Plastic*] factors, but it never explains why that is so." Opp. 1. Petitioner contends further that "[e]ven 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." *Id.* at 2 (citing *Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01404, Paper 12, 12 (PTAB Jan. 22, 2020); *Netflix Inc. & Hulu, LLC, v. DIVX, LLC*, IPR2020-00052, Paper 59, 5-9 (PTAB Oct. 20, 2020)). In addition, Petitioner contends that Patent Owner's request is not only irrelevant to the *GP* analysis, but it also does not affect Petitioner's RPI statement." *Id.* According to Petitioner, "[t]he 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.” *Id.* at 2–3 (citing *Samsung Elecs. Co., Ltd. v. Memoryweb, LLC*, IPR2022-00222, Ex. 2121, 43-53 (PTAB Dec. 22, 2023); *Unified Patents Inc. v. Barkan Wireless IP Holdings, L.P.*, IPR2018-01186, Paper 24, 11 (PTAB Dec. 7, 2018)).

In addition, Petitioner distinguishes *Valve Corporation v. Electronic Scripting Products* by explaining that “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,” whereas “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.” *Opp.* 3 (citing *Valve Corp. v. Electr. Scripting Products* IPR2019-00062, Paper 11, 9–10 (PTAB Apr. 2, 2019)).

C. Analysis

As a threshold matter as discussed in the context of the first *Garmin* factor, Patent Owner must present some evidence beyond speculation to support its position. *Garmin*, Paper 26, 6–7. Patent Owner proffers Exhibits 2003 and 2004 to meet this requirement.

Exhibit 2003 is a copy of an email exchange between Patent Owner and Petitioner. Ex. 2003. In this email exchange Patent Owner asks Petitioner whether it is a direct or indirect member of Unified Patents and Petitioner queries Patent Owner’s authority for asking this question. *Id.* at 1–2. Patent Owner asserts that this email chain supports its claim that “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.” Mot. 3 (citing Ex. 2003). We disagree. Petitioner’s query as to Patent Owner’s authority to ask if it is or was a direct or indirect member of Unified Patents is not evidence that Petitioner is or was a member (direct or indirect) of Unified Patents. Patent Owner presumes that Petitioner refuses to answer because it is a member, but Patent Owner presents no basis for this presumption. As such, Patent Owner’s presumption amounts to no more than speculation and does not constitute evidence in support of its position.

Exhibit 2004 is a screen shot of a single webpage that is part of Unified Patents’ website. Ex. 2004. This webpage touts Unified Patent’s success in challenging patents. *Id.* To the extent that this evidence support’s Patent Owner’s position that Unified Patents is a prolific filer of petitions requesting *inter partes* review, such evidence is irrelevant to this proceeding as Patent Owner is not requesting additional discovery from Unified Patents, which is not a party to this proceeding. Moreover, Patent Owner’s assertion that 17% of the petitions for *inter partes* review filed by Unified Patents are directed to patents asserted against *Facebook* and Amazon, provides little, if any, evidentiary support for Patent Owner’s position in that Patent Owner does not provide context for the 17% claim. Without context, such as the number of petitions Unified Patents filed prior to September 19, 2020, we have no basis on which to determine how many petitions 17% represents. Moreover, Patent Owner does not provide evidence as to how many petitions are directed to patents asserted against Facebook, as opposed to Amazon. In addition, Patent Owner has not explained the difference between a direct and indirect member of Unified Patents.

Given that the evidence proffered by Patent Owner (Exhibits 2003 and 2004) does not support its position, Patent Owner’s request amounts to little more than a fishing expedition which is unlikely to provide useful

information. Accordingly, Patent Owner's evidence is insufficient to demonstrate that the requested discovery is necessary in the interest of justice.¹

CONCLUSION

Based on the current record, we determine Patent Owner is not entitled to the additional discovery it seeks.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner's Motion for additional discovery is *denied*.

¹ As we have determined that Patent Owner's evidence fails to meet the threshold requirement "to show beyond speculation that in fact something useful will be uncovered," we need not consider the other *Garmin* factors. *Garmin*, Paper 26, 6–7.

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For PETITIONER:

James B. Hatten
R. Scott Feldmann
BAKER & HOSTETLER LLP
jhatten@bakerlaw.com
feldmann@bakerlaw.com

For PATENT OWNER:

John Wittenzellner
Todd E. Landis
Michael J. Fagan, Jr.
Mark McCarthy
WILLIAMS SIMONS & LANDIS PLLC
johnw@wsltrial.com
tlandis@wsltrial.com
mfagan@wsltrial.com
mmccarthy@wsltrial.com
IPRDYNAPASSWSL@wsltrial.com