

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUMIO CORPORATION,
Petitioner,

v.

FACETEC, INC.,
Patent Owner.

IPR2025-00106 (Patent 10,776,471 B2)
IPR2025-00107 (Patent 11,157,606 B2)
IPR2025-00108 (Patent 11,693,938 B2)
IPR2025-00109 (Patent 11,874,910 B2)¹

Before GARTH D. BAER, NABEEL U. KHAN, and BACH V. HOANG,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.51(b)(2)

¹ This order applies to each of the above-listed proceedings. The parties are not authorized to use this combined case caption. Representative citations are to IPR2025-00106 unless noted.

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On September 18, 2025, we held a teleconference regarding Patent Owner Facetec Inc.’s opposed request for authorization to file a Motion for Additional Discovery addressing whether Petitioner Jumio Corporation has received payments from third-party iProov in satisfaction of an indemnification agreement between iProov and Jumio. *See* Exs. 1055; 1056; 2032.

The statutory standard for permitting additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5). In determining whether additional discovery in an inter partes review proceeding is necessary in the interest of justice, the Board considers the following five factors (“the Garmin Factors”): (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Garmin Int’l, Inc. v. Cuozzo Speed Tech. LLC*, Case IPR2012-00001, Paper 26, slip. op. 6–7 (PTAB Mar. 5, 2013) (informative).

In email correspondence between the parties, Petitioner represented that “[t]here have not been any payments from iProov to Petitioner under the indemnity agreement or otherwise in the IPRs,” and that “iProov neither paid nor reimbursed Jumio’s legal fees—either to Jumio or its counsel—for either the PTAB proceedings or the district court proceeding.” Ex. 1056, 4, 6. On the call, Patent Owner argued that Petitioner’s representations are inconsistent with a statement, filed by iProov, in a district court order that

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iProov has indemnified Jumio. *See* Ex. 2010, 4. That alleged inconsistent statement is in the record before us.² Ex. 2006 (iProov's Reply in Support of Opposed Motion to Intervene, *FaceTec, Inc. v. Jumio Corporation*, No. NDCA-3-24-cv-03623 (N.D. Cal.)). In addition, Petitioner has produced the indemnification agreement between Jumio and iProov. *See* Ex. 1056, 1. Patent Owner may raise any inconsistencies between Jumio's/iProov's conduct and their rights/obligations under the indemnification agreement in its substantive briefing and, if appropriate, in a future request for additional discovery. However, we do not authorize Patent Owner to file a Motion for Additional Discovery at this time because Patent Owner has not identified what specific information, in what specific form, it seeks through additional discovery. Absent clarity as to what specific discovery Patent Owner seeks, Patent Owner's request for additional discovery does not satisfy Garmin factors 1, 4, or 5.

In light of the foregoing, it is:

² Based on the alleged inconsistency between Petitioner's representations and the district court order, Patent Owner suggested on the teleconference that the Board require Petitioner to show cause that it had not violated the Board's prior guidance that Petitioner provide information to Patent Owner regarding payments under the indemnity agreement between iProov and Petitioner. On the current record, which does not include the indemnity agreement between iProov and Jumio, there is insufficient evidence showing that Petitioner has violated our prior guidance and, at this point in the proceeding, we decline to require Petitioner to show cause as Patent Owner requested on the teleconference.

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ORDERED that Patent Owner's request for authorization to file a Motion for Additional Discovery is DENIED.

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