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Paper 42
Date: February 27, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UATP IP LLC,
Petitioner,

v.

SLICK SLIDE LLC,
Patent Owner.

PGR2024-00054
Patent 11,998,854 B1

Before MITCHELL G. WEATHERLY, KRISTINA M. KALAN, and BRIAN D. RANGE, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER
Granting in Part Patent Owner's Motion for Additional Discovery
37 C.F.R. §§ 42.51(b)(2), 42.224
and
Authorizing Patent Owner to File a Motion to Terminate the Proceeding
35 U.S.C. § 312

I. INTRODUCTION

With our prior authorization, Patent Owner moves for additional discovery relating to the identity of entities that it contends to have controlled or had the opportunity to control Petitioner's conduct of this

proceeding. Paper 33, 1 ("Mot." or "Motion"). Petitioner filed an opposition to the Motion. Paper 36 ("Opp." or "Opposition"). Patent Owner filed a reply in support of the Motion. Paper 39 ("Reply"). And, Petitioner filed a sur-reply responding to the Reply. Paper 40 ("Sur-reply").

Patent Owner contends that the additional discovery sought is related to the issue of whether Petitioner has failed to name any entity as a real party-in-interest ("RPI") as required by 37 C.F.R. 42.204 so that the Board may properly determine whether it was permitted to consider the Petition as having met the requirement in 35 U.S.C. § 312(a)(2) to identify all RPIs.

In a memorandum dated October 28, 2025, the Director designated as precedential *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential except for § II.E.I). *Corning* set forth the legal framework that the Board uses for determining whether a party who is not a named participant is an RPI as follows:

> As stated in the Trial Practice Guide, whether a party who is not a named participant in a given proceeding is a "real party-in-interest" to that proceeding "is a highly fact-dependent question." 77 Fed. Reg. at 48,759 (citing *Taylor v. Sturgell*, 533 U.S. 880 (2008)). There is no "bright line test." *Id*. The Supreme Court in Taylor sets forth a list of factors that might be relevant in a particular case. 533 U.S. at 893–95. Although "rarely will one fact, standing alone, be determinative of the inquiry" (Trial Practice Guide, 77 Fed. Reg. at 48,759), "[a] common consideration is whether the non-party exercised or could have exercised control over a party's participation in a proceeding" (id. at 48,761 (citations omitted)); *see also Reflectix, Inc. v. Promethean Insulation Tech. LLC*, Case IPR2015-00039, slip op. at 12 (PTAB April 24, 2015) (Paper 18) ("The proper RPI analysis [] focuses on . . . the degree to which [the related non-named entity] exercised, or could have exercised, control over the Petitions.").

> Other considerations may include whether a non-party "funds and directs and controls" an IPR petition or proceeding; the non-party's relationship with the petitioner; the non-party's relationship to the petition itself, including the nature and/or degree of involvement in the filing; and the nature of the entity filing the petition. Trial Practice Guide, 77 Fed. Reg. at 48,760; *see also id*. at 48,759 (citing *Taylor*, 553 U.S. at 893–95 & n.6 (2008)). A party does not become a RPI merely through association with another party in an endeavor unrelated to the IPR proceeding. *Id*. at 48,760; *see also Denso Corp. v. Beacon Navigation GmbH*, Case IPR2013-00026, slip op. at 10–11 (PTAB Mar. 14, 2014) (Paper 34) (stating that the mere fact that parties are co-defendants or concurrent defendants in related litigation does not make them RPI).

Corning 14–15.

Because determining whether an entity should be named as an RPI involves a "highly fact-dependent" analysis, Patent Owner seeks to gather evidence to inform that analysis. More specifically, Patent Owner seeks the following additional discovery:

> 1. Identify the name(s) of all corporate counsel who was/were considering or intending to be present at any deposition in the PGR, all titles of the individual(s), the entity(ies) with whom the individual(s) is/are employed, and the entity(ies) from whom the individual(s) receives compensation, and provide documents sufficient to confirm this information and the dates relating thereto.
>
> 2. Identify and produce documents sufficient to identify all individuals and entities to which outside counsel for Petitioner in the PGR has directed invoices in connection with services rendered in the PGR, all individuals and entities that have sent payment to outside counsel or experts, and the dates relating thereto.
>
> 3. Identify and produce documents sufficient to identify all individuals and entities who have been consulted in connection with, or provided direction to counsel for Petitioner in, the PGR,

> including all individuals and entities that have been sent PGR papers, have reviewed PGR papers, or have provided comments to PGR papers, or that are mentioned in any time entry narratives sent by outside counsel, and for each individual provide the information and documents requested in item 1.

Mot. 5.

II. ANALYSIS

Additional discovery in a post-grant review proceeding is permitted under Rules 42.51(b)(2) and 42.224 when the party seeking the discovery demonstrates good cause to discover information that is "directly related to factual assertions advanced by either party in the proceeding." 37 C.F.R. § 42.224; *see also* 37 C.F.R. § 42.51(b)(2) (permitting a party to move for additional discovery). The Board considers whether good cause exists for additional discovery in a PGR proceeding based on a five-part analytical framework set forth in *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 at 4–5 (PTAB May 29, 2013) (precedential). *Bloomberg* describes those factors as follows:

1. More Than A Possibility And Mere Allegation—

> The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing. "Useful" means favorable in substantive value to a contention of the party moving for discovery. A good cause showing requires the moving party to provide a specific factual reason for expecting reasonably that the discovery will be "useful."

2. Litigation Positions And Underlying Basis—

> Asking for the other party's litigation positions and the underlying basis for those positions is insufficient to demonstrate that the additional discovery is necessary for good cause. The Board has established rules for the

> presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.
>
> 3. Ability To Generate Equivalent Information By Other Means—
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> A party should not seek information that reasonably can be generated without a discovery request.
>
> 4. Easily Understandable Instructions—
>
> Instructions and questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.
>
> 5. Requests Not Overly Burdensome To Answer—
>
> Requests must not be overly burdensome to answer, given the expedited nature of a covered-business method patent review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of the trial. Requests should be sensible and responsibly tailored according to a genuine need.

Bloomberg 5.

A. Factor 1

Bloomberg factor 1 addresses the extent to which the discovery being sought is based on more than mere speculation. Bloomberg 5. Our analysis of Bloomberg Factor 1 turns on whether Patent Owner has established a specific factual reason for expecting that its discovery will uncover useful information on the issue of whether Petitioner failed to identify all RPIs in the Petition. *Bloomberg* 5.

Patent Owner contends that its discovery is narrowly directed to the issue of whether entities not originally named as RPIs should have been

identified in the Petition. Patent Owner's suspicion that Petitioner had failed to identify all RPIs arose from a request by Stephen Polozola, Petitioner's Chief Legal Officer, to attend a deposition. Mot. 2. Patent Owner later uncovered information implying that Mr. Polozola also serves as corporate counsel for numerous third parties, who are related to Petitioners in a "complex corporate web." *Id*. (citing Exs. 2048–2050 (LinkedIn profile for Mr. Polozola and organization charts purporting to reflect corporate relationships among Petitioner and other legal entities not originally named as an RPI).

In response to Patent Owner's allegations, Petitioner submitted a Declaration from Mr. Polozola along with documentary evidence to show that only Petitioners controlled, funded, and directed the filing of the Petition and the litigation of the legal challenges to patentability set forth in the Petition. Opp. 1; *see also* Ex. 1083 (Polozola Declaration); 1081 (checks paying for services related to the Petition); 1082 (invoices from counsel for Petitioner related to the proceeding). Mr. Polozola's testimony and the supporting documents are largely designated as confidential. However, we need not reveal or analyze the details of that testimony to determine whether Patent Owner has established that the discovery it seeks would be useful.

Essentially, Mr. Polozola testifies that he is the only corporate counsel representing Petitioner in connection with this proceeding and that only Petitioner has controlled and funded its efforts in this proceeding. Patent Owner contends that it needs the additional discovery that is "designed to test" the veracity of Mr. Polozola's testimony as supported by the documents supplied by Petitioner. Reply 6. Petitioner argues that Mr. Polozola's testimony and the documentary evidence supplied with that testimony fully

addresses Patent Owner's discovery requests 1 and 2 and aspects of request 3, Sur-reply 3, and that the appropriate mechanism for testing the veracity of Mr. Polozola's testimony is to depose him.

We agree with Petitioner that Mr. Polozola must sit for a deposition (if Patent Owner seeks one). However, we cannot speculate on what Patent Owner might discover in that deposition as it relates to each of the three pending requests for additional discovery or whether Petitioner has already fully complied with request numbers 1 and 2 or sufficiently complied with request number 3. For this reason, we conclude that all three discovery requests reflect more than mere a mere possibility that useful information may be uncovered by Patent Owner's additional discovery. Bloomberg Factor 1 weighs in favor of granting Patent Owner's request for additional discovery.

B. Factors 2 and 3

Bloomberg Factors 2 and 3 focus on whether the additional discovery requests seek to uncover Petitioner's litigation positions (factor 2) and whether alternative means exist for discovering the information sought (factor 3). Patent Owner contends that the additional discovery sought is fully divorced from the merits of Petitioner's challenges but rather is narrowly tailored to determine who has controlled, directed, and funded the Petition and thus does not seek to uncover Petitioner's litigation positions. Mot. 11–12. Patent Owner also contends that only Petitioner possesses the information sought in the additional discovery requests. *Id*. at 12–13.

Petitioner only tangentially addresses Patent Owner's contentions on Bloomberg factors 2 and 3 when it contends that request number 3 in particular calls for "privileged communications, implicating position and

underlying bases." Sur-reply 8. Petitioner also reiterates that a deposition of Mr. Polozola is the appropriate mechanism for Patent Owner to discover the information sought in the additional discover requests. *Id*. at 8–9.

We find that factors 2 and 3 weigh in favor of granting the additional discovery. By providing a declaration from Mr. Polozola and supporting documentation that allegedly "fully respond" to discovery requests 1 and 2 and "aspects" of request 3, Petitioner tacitly admits that it controls the information sought in those requests. Petitioner's contention that the requests necessarily call for privileged communications can be ameliorated by appropriate redaction of information that would reveal Petitioner's litigation positions or strategy. Patent Owner clarified that "[t]o the extent that responsive documents reveal Petitioner's litigation positions or the underlying basis for those positions, Patent Owner specifically requests that Petitioner be allowed to redact any such information." Although such a request is not necessary, we read Patent Owner's statement as reflecting that it does not seek to uncover Petitioner's litigation positions. We also note that Petitioner has already heavily redacted the documentary evidence addressed by Mr. Polozola's testimony, which Petitioner concedes respond to the additional discovery requests. *See* Ex. 1081, 1082 (bearing redactions). Accordingly, both parties have demonstrated that mechanisms exist for exchanging the information sought by Patent Owner's additional discovery without running afoul of the concerns raised in Bloomberg factors 2 and 3.

C. Factor 4

Bloomberg factor 4 counsels that instructions accompanying requests for additional discovery should be "easily understandable" and that, for

example, a complex ten-page set of instructions are disfavored. Bloomberg 5. Patent Owner contends that its requests are "specific, narrowly tailored, and easily understandable." Mot. 13–14. Petitioner contends that it has fully responded to request numbers 1 and 2 and responded to aspects of request number 3. Sur-reply 1. But, Petitioner argues that the breadth of request number 3 demonstrates its lack of clarity. More specifically, Petitioner complains that request 3 would require it to identify and produce documents associated with "'all individuals and entities that have been sent PGR papers, have reviewed PGR papers, or have provided comments to PGR papers,' without regard to their role, affiliation, type of paper (e.g., review of the public record), or purpose." *Id*. at 9. Reading request number 3 thus "encompasses individuals that plainly have no control of this PGR, or that Petitioner might not even be aware of, including even court reporters, legal reporting sites, filing paralegals, for example." *Id*.

We note that Petitioner does not complain about the complexity of "instructions" relating to request numbers 1 and 2. Although we agree with Petitioner that request number 3 is overbroad to the extent that it seeks the identities of third parties having no control over the PGR by any measure, we do not consider request number 3 to be so fatally overbroad as to constitute "complex instructions" that warrant denial of Patent Owner's request for probative information sought in request number 3.

To address Petitioner's concerns about the breadth of request number 3, we will narrow the scope of that request as follows:

> 3. Identify and produce documents sufficient to identify all individuals and entities who have consulted counsel for Petitioner or provided direction to counsel for Petitioner in

> connection with the merits of the challenges to patentability raised in the Petition, including all individuals and entities that have been sent pre-filing versions of a paper that was filed in the proceeding (a "PGR paper"), have reviewed a PGR paper, or have provided comments to a PGR paper, or that are mentioned in any time entry narratives sent by outside counsel, and for each individual provide the information and documents requested in item 1.

D. Factor 5

Bloomberg factor 5 relates to whether Patent Owner's requests for additional discovery are "overly burdensome." Bloomberg 5. Patent Owner contends that identifying names of individuals known only to Petitioner is not burdensome at all. Mot. 14. We agree. Patent Owner also contends that the specific documents connected to individuals identified in response to its requests should be similarly easy to find and produce.

Petitioner argues that Patent Owner "ignores issues of privilege" and that the discovery requests seek information about individuals over which Petitioner has no control due to the "mere mention of a name." Sur-reply 10.

We find that request numbers 1 and 2, to which Petitioner claims to have fully responded already, and request number 3 as narrowed above are not likely to impose an undue burden on Petitioner. However, we recognize that our attempt to narrow request number 3 may not reflect the wisdom of Solomon despite our best effort to balance both parties' interests. To ensure that Petitioner's interests in preserving any valid privilege associated with material that is responsive to any of the discovery requests as set forth in this Order, Petitioner shall concurrently serve a privilege log providing information to Patent Owner sufficient for it to discern the basis for any claim of privilege along with its responses to the discovery requests.

E. Conclusion

For the reasons set forth above, we find that Patent Owner has established good cause for additional discovery as set forth in the original versions of its request numbers 1 and 2 and as set forth in the narrowed version of request number 3 set forth above. Accordingly, we grant the Motion in part by ordering Petitioner to respond to discovery requests 1 and 2 as originally served by Patent Owner and request number 3 as modified by the panel above. The schedule for responding to such additional discovery is set forth in Part IV below.

III. PATENT OWNER'S REQUEST FOR AUTHORIZATION TO FILE A MOTION TO TERMINATE

On February 17, 2026, we conducted a teleconference to address Patent Owner's request for authorization to file a motion to terminate this proceeding. During that call, it became apparent that at least some of the arguments that Patent Owner's wished to advance in such a motion would rest upon information discovered in response to its requests for additional discovery. On February 17, the Motion was not yet fully briefed, and therefore, not ripe for decision. Therefore, we considered Patent Owner's request for authorization to move to terminate the proceeding to be premature.

Now that the we have ruled on the Motion, granted the Motion in part, and set a schedule for the additional discovery sought, Patent Owner's request for authorization to move to terminate the proceeding is no longer premature. Accordingly, we authorize Patent Owner to file a motion to terminate of up to fifteen (15) pages. Petitioner is authorized to file an opposition of up to fifteen (15) pages. Patent Owner is authorized to file a

reply in support of its motion of up to five (5) pages, and Petitioner may respond to Patent Owner's reply in a sur-reply of up to five (5) pages. The schedule for briefing on the issue of whether to terminate the proceeding is set forth below.

IV. ORDER

For the reasons given, it is:

ORDERED, that Petitioner shall respond to Patent Owner's requests for additional discovery numbers 1 and 2 as set forth in the Motion for Additional Discovery (Paper 33);

FURTHER ORDERED that Petitioner shall respond to Patent Owner's requests for additional discovery number 3 as set forth above in this Paper;

FURTHER ORDERED Petitioner shall serve the documents sought in discovery requests 1–3 as described immediately above within 5 business days of this entry of this Order;

FURTHER ORDERED that Petitioner shall concurrently serve to Patent Owner a privilege log describing the substance of any material redacted from documents produced in response to the additional discovery requests described immediately above;

FURTHER ORDERED that Petitioner shall make Mr. Stephen Polozola available for deposition on the testimony set forth in Exhibit 1083 and the substance of any document produced in response to the additional discovery set forth above within 15 business days from the entry of this Order;

FURTHER ORDERED that Patent Owner is authorized to file a motion to terminate this proceeding of up to fifteen (15) pages no later than April 2, 2026;

FURTHER ORDERED that Petitioner may oppose any motion to terminate this proceeding in a paper of up to fifteen (15) pages filed no later than April 16, 2026;

FURTHER ORDERED that Patent Owner may file a reply in support of its motion to terminate the proceeding of up to five (5) pages filed no later than five (5) business days after Petitioner files its opposition to the motion; and

FURTHER ORDERED that Petitioner may file a sur-reply in response to any reply filed by Patent Owner of up to five (5) pages by no later than five (5) business days after the filing of any reply.

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