

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG DISPLAY CO., LTD.,
Petitioner

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,
Patent Owner

Case IPR2014-01357
Case IPR2014-01362¹

Before THOMAS L. GIANNETTI, NEIL T. POWELL, and BEVERLY M.
BUNTING, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ The parties are not authorized to use this caption.

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A telephone conference was held in these cases on December 2, 2014. The conference was requested by Patent Owner to seek authorization to file a motion for additional discovery directed to the issue of privity. Counsel for the parties participated, along with Administrative Patent Judges Giannetti, Bunting, and Powell. Patent Owner arranged for a court reporter and has filed the transcript as an exhibit in each of the proceedings. For the reasons that follow, the request is denied.

DISCUSSION

The Petitions in these proceedings were filed on August 21, 2014, and August 22, 2014, respectively. Preliminary Responses were filed by Patent Owner in IPR2014-01357 on November 28, 2014 and in IPR2014-01362 on December 4, 2014.

On November 26, 2014, two days before its first Preliminary Response was due, Patent Owner contacted the Board seeking authorization to file a motion for additional discovery directed to the relationship between Petitioner and certain defendants, Dell and HP, in infringement lawsuits brought by Patent Owner in the Eastern District of Texas. Patent Owner contends that Petitioner is barred from bringing these IPR proceedings under 35 U.S.C. § 315(b) because Petitioner is in privity with Dell and HP. Each was served with a complaint charging infringement of the patents in these proceedings more than a year before the Petitions were filed. Patent Owner does not contend that either Dell or HP controls these IPR proceedings. Instead, Patent Owner contends that discovery will show Petitioner controls the District Court litigations involving Dell and HP.

Petitioner opposes the request. Petitioner contends that while Petitioner is a supplier of liquid crystal displays to Dell and HP, and that

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Petitioner indemnifies those parties for patent infringement, Petitioner does not control the District Court litigations in which they are involved.

The Board is concerned with the timing of Patent Owner's request. Normally, discovery in an *inter partes* review does not start until a trial is instituted. *See* Office Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012) (“To streamline the proceedings, the rules and Scheduling Order provide a sequenced discovery process upon institution of the trial.”). Patent Owner's request for pre-institution discovery, therefore, must be closely scrutinized in light of the normal schedule for discovery. *See Wavemarket, Inc. D/B/A/ Location Labs v. Locationet Sys., Ltd.*, Case IPR2014-00920, Paper No. 10 (PTAB November 25, 2014)(denying authorization to file pre-institution motion requesting additional discovery on privity).

The Board's deadline for deciding whether to institute *inter partes* review after receiving a preliminary response is three months. 35 U.S.C. § 314(b). Yet Patent Owner waited until the due dates for filing its preliminary responses were near before seeking from the Board authorization to file its motion. Now that Patent Owner's Preliminary Responses have been filed, and with the three-month statutory period for institution running, we are not convinced that providing Patent Owner with an opportunity to seek discovery would be in the interests of justice. 37 C.F.R. § 42.51(b)(2). Therefore, Patent Owner's request for authorization to file a motion for additional discovery is denied.

We do not reach the merits of Patent Owner's request at this time. Should the Petition be granted and a trial instituted, Patent Owner may ask the Board to reconsider its request.

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