

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS INC.,  
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,  
Patent Owner.

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Case IPR2016-00364  
Patent 9,043,093 B2

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Before BENJAMIN D. M. WOOD, JENNIFER MEYER CHAGNON, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION

Patent Owner's Request for Authorization to  
File Motion for Additional Discovery  
*37 C.F.R. §§ 42.5, 42.51(b)(2)*

On February 23, 2016, a conference call was held between counsel for both parties and Judges Wood, Chagnon, and Goodson.<sup>1</sup> During the call, Patent Owner requested authorization to file a motion for additional

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<sup>1</sup> A court reporter also was present on the call. Patent Owner shall file a copy of the transcript as an exhibit in due course. This Order summarizes statements made during the conference call. A more detailed record may be found in the transcript.

discovery directed to evidence regarding whether certain additional parties should be listed as real parties-in-interest in this proceeding.

Patent Owner represented that the requests for additional discovery would be directed to communications between Petitioner and its members, if any, that are defendants in a district court proceeding regarding U.S. Patent No. 9,043,093; fees paid by any such members to Petitioner and any activities performed “in return” for any such fees; identification of any *inter partes* review petitions filed by Petitioner in which no member was involved in a related district court proceeding; information concerning the return on investment to members mentioned on Petitioner’s website; and the deposition transcript of Mr. Kevin Jakel (Petitioner’s CEO) filed under seal in *Unified Patents, Inc. v. Dragon IP, LLC*, Case IPR2014-01252, and referenced in Paper 29 of that proceeding. In response, Petitioner argued that Patent Owner’s requests for information were not narrowly tailored and were based only on speculation that something useful will be uncovered. Petitioner also indicated that it had offered to provide to Patent Owner discovery that it believes is narrowly tailored to the issue of real parties-in-interest in this proceeding. The parties have conferred, but have been unable to come to an agreement concerning the scope of additional discovery.

The panel is persuaded that further briefing would assist the Board in deciding whether to permit Patent Owner to obtain additional discovery in this case. Accordingly, we authorize Patent Owner to file a motion for additional discovery. The motion may not exceed ten (10) pages and should include, as an exhibit, proposed discovery requests. Petitioner is authorized to file an opposition to the motion, also not to exceed ten (10) pages. If

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Petitioner objects to the scope of Patent Owner's proposed discovery requests, the opposition also should include, as an exhibit, Petitioner's alternative proposed discovery requests. No reply is authorized at this time.

Patent Owner is reminded that the discovery requests should be responsibly tailored and restrained in scope, and that an important factor is whether Patent Owner can demonstrate more than a possibility that it will obtain the evidence that it seeks. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative).

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery is granted. Patent Owner is authorized to file a 10-page motion, along with an exhibit including proposed discovery requests, by March 1, 2016;

FURTHER ORDERED that Petitioner is authorized to file a 10-page opposition, along with an exhibit including any alternative proposed discovery requests, no later than five (5) business days after the date on which Patent Owner files its Motion; and

FURTHER ORDERED that no reply is authorized at this time.

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