

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.

CLOUDING IP, LLC  
Patent Owner

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Case IPR2013-00586  
Patent 6,738,799 B2

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Before JAMESON LEE, JUSTIN BUSCH, and RAMA G. ELLURU,  
*Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

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

### Introduction

An initial conference call was held on April 21, 2014, between respective counsel for the parties and Judges Lee, Elluru, and Busch. Neither party filed a proposed motions list, and counsel for each party indicated that Due Dates 1-7 as set in the Scheduling Order dated March 21, 2014 (Paper 10) do not pose any problem. Thereafter, counsel for Patent Owner requested permission to file a motion for additional discovery. Although no proposed motions list was filed by the Patent Owner, we permitted counsel for Patent Owner to discuss the request.

### Discussion

The Patent Owner's preliminary response asserts that Petitioner failed to identify Google Inc. as a real party-in-interest, and that because Google Inc. is a real party-in-interest which had been served, on May 24, 2012, with a complaint alleging infringement of U.S. Patent No. 6,738,799, Petitioner's petition is time-barred under 35 U.S.C. § 315(b). Paper 5, 20. According to counsel for Patent Owner, Patent Owner requests merely five or fewer focused interrogatories on the precise issue of the real-party-interest, similar to those which had previously been authorized in IPR2014-00171. As represented by counsel for Patent Owner, the circumstances providing a reasonable basis for its belief that Google Inc. is a real party-in-interest already are presented in its preliminary response (Paper 5).

Counsel for Petitioner opposed authorization of the request on the basis that Patent Owner did not ask for additional discovery on this point prior to the institution of trial, and therefore, Patent Owner should not be allowed to ask for additional discovery now, after institution of trial. The argument is without merit. It is not necessary that a Patent Owner even file a preliminary response. Not having asked for additional discovery prior to institution of trial does not waive Patent Owner's opportunity to ask for additional discovery after institution of trial.

Furthermore, the Section 315(b) bar is a jurisdictional issue that can be raised at any time.

Counsel for Petitioner argued that the information upon which Patent Owner relies to assert that Google Inc. is a real party-in-interest constitutes hearsay. However, that information is not relied on to prove the truth of the matter asserted, just for what it says. Moreover, the information is not offered as proof that Google Inc. is a real party-in-interest, but as the foundation for taking Patent Owner's belief out of the realm of mere speculation. Counsel for Petitioner further acknowledged that the type of interrogatories proposed by Patent Owner, if five or fewer, do not pose excessive burden for Petitioner to answer.

We indicated that prior to deciding whether to authorize the filing by Patent Owner of a motion for additional discovery, we would like to see the interrogatories. Counsel for Patent Owner agreed to provide them. The Patent Owner should file the proposed interrogatories in a paper captioned "Proposed Interrogatories for Additional Discovery."

#### Conclusion

It is

ORDERED that within one week of the date of this communication, Patent Owner shall file a set of "proposed" interrogatories, five or fewer, and label the submission as "First Proposed Interrogatories";

FURTHER ORDERED that we will issue a decision on Patent Owner's request for authorization to file a motion for additional discovery, shortly after filing of Patent Owner's First Proposed Interrogatories;

FURTHER ORDERED that within two business days of the filing of Patent Owner's First Proposed Interrogatories, counsel for Petitioner may initiate a

IPR2013-00586  
Patent 6,738,799

conference call with the Board to discuss any issue it sees with regard to the proposed interrogatories; and

FURTHER ORDERED that Due Dates 1-7 as set in the Scheduling Order dated March 21, 2014 (Paper 10) remain unchanged.

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