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Paper 41
Entered: February 28, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

VL COLLECTIVE IP LLC,
Patent Owner.

IPR2022-01086
Patent 8,605,794 B2

Before KARL D. EASTHOM, JEFFREY S. SMITH, and DAVID C. McKONE, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Request
to File a Motion for Additional Discovery
37 C.F.R. § 42.51

VL Collective IP, LLC ("Patent Owner") requested a teleconference with the panel seeking to file a motion for additional discovery related to an alleged real party in interest issue. Ex. 3002 (email by Patent Owner). Petitioner opposes. *Id.*

The challenged patent, U.S. Patent 8,605,794 B2, is also at issue in *Netflix, Inc. v. VL Collective, LLC*, IPR2023-00891 (the "'891 IPR"), in which the Board recently granted Patent Owner leave to file a motion for additional discovery for essentially the same real party in interest issue involved in the instant trial (the "'1086 IPR"). *See* '891 IPR, Paper 20. In the '1086 IPR, similar to its contentions in the '891 IPR, Patent Owner intends

> to show that Netflix is a real party in-interest (RPI) in the '[1]086 IPR and therefore should be estopped from maintaining the '891 IPR for at least the claims addressed in the final written decision in the '[1]086 IPR. Patent Owner seeks authorization from the Board to move to request additional discovery from Unified regarding Netflix's involvement in the '[1]086 IPR. 35 U.S.C. § 315(e)(1); 37 CFR 42.51(b)(2).

Ex. 3002, 1 (Patent Owner's email). Therefore, Patent Owner seeks discovery in the '1086 IPR *in order to seek relief in the '891 IPR*. We deny Patent Owner's request to file a motion for additional discovery in '1086 IPR as a mechanism for relief in the '891 patent for the following reasons.

Primarily, even if we find during the '891 IPR that Netflix was a real party in interest in the '1086 IPR, and as a consequence, we determine that 35 U.S.C. § 315(e)(1) estops Netflix from maintaining the '891 IPR with respect to the claims addressed in the '1086 IPR, this would have no bearing on the outcome of the '1086 IPR. *See Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413, Paper 76 at 5 (PTAB May 22, 2023) (holding that "[t]he Board should not have determined whether Apple and Samsung are

RPIs in this proceeding given that determination was not necessary to resolve the proceeding") (Decision Granting Director Review). Similar to the Director Review decision in *MemoryWeb*, there is no statutory bar or estoppel at issue in IPR2022-01086 "under 35 U.S.C. § 315(b) or 35 U.S.C. § 315(e) that might apply." *See id.*

Other factors mitigate against granting the request. A final written decision issued over two months ago in instant '1086 IPR (Paper 37, issued December 18, 2023). Therefore, this trial is at a late stage, rendering the request untimely. In addition, any discovery is unlikely to produce useful evidence with respect to the outcome in the '1086 IPR. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).

Finally, early in the '1086 IPR, Petitioner Unified already provided voluntary discovery related to the alleged real party in interest issue. *See* Ex. 3002 (citing IPR2020-00052, Ex. 2033); Ex. 1010 ¶¶ 10, 13 (Declaration by CEO of Unified Patents, Mr. Jakel, testifying, *inter alia*, that "Unified has no explicit or implicit agreements with its Members about Unified performing any particular deterrent strategy, including the instant IPR" and "Unified exercised its sole discretion and control in deciding to file a petition in the instant IPR, IPR2022-01086, against U.S. Patent 8,605,794 (the 'Patent-at-Issue'), including paying for all fees and expenses") (filed June 7, 2022). Also, Patent Owner's email states it already has evidence (which existed prior to the beginning of the instant '1086 IPR) showing a

pre-existing relationship between Unified and Netflix. *See* Ex. 3002 (citing IPR2020-00052, Ex. 2033 (filed May 14, 2020)).[1]

ORDER

Based on the foregoing reasons, it is

ORDERED that Patent Owner's request to file a motion for additional discovery is *denied*.

[1] Although *MemoryWeb* indicates Patent Owner could not have used this evidence in the '1086 IPR under the circumstances involved here as indicated above, Patent Owner's email indicates it intends to use at least some of the evidence in the '891 IPR. *See* Ex. 3002.

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