

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARTESIAN HOME PRODUCTS
and
AMERICAN DIE & ROLLFORMING,
Petitioners,

v.

GUTTERGLOVE, INC.,
Patent Owner.

Case IPR2018-00015 (Patent 9,021,747 B2)
Case IPR2018-00030 (Patent 8,479,454 B2)
Case IPR2018-00031 (Patent 8,479,454 B2)¹

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

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

¹ Because this Decision addresses issues raised in all three cases, we issue one Decision to be entered in each case. The parties are not authorized to use this caption.

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INTRODUCTION

On January 31, 2018, respective counsel for the parties and Judges Petravick, Daniels, and Jeschke held a conference call. The purpose of the conference call was to discuss (1) a request by Patent Owner for authorization to file a motion for additional discovery and (2) a request by Petitioners for authorization to file replies to the Preliminary Responses.

DISCUSSION

Patent Owner's Request for Authorization to File a Motion for Additional Discovery

Patent Owner requests authorization to file a motion for additional discovery regarding alleged real parties-in-interest not identified in the Corrected Petitions (Paper 6²) as required by 35 U.S.C. § 312(a)(2). According to Patent Owner, public documents indicate that unidentified entities are real parties-in-interest because the entities have the same address, conduct the same or similar business, and have the same or similar officers as Petitioners. *See* Paper 13, 49–54 (arguing that the Corrected Petition fails to identify all the real parties-in-interest). Patent Owner also asserted that one of the entities, Quincy, owns the trademark “Valor Gutter Guard” and that Petitioner Artesian Home Products operates under the name “Valor.” Based on these alleged relationships between Petitioners and the entities, Patent Owner alleged that the entities are likely unidentified real parties-in-interest.

² All citations are to IPR2018-00015 unless otherwise noted.

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Petitioners opposed the request. Petitioners stated that the Corrected Petitions identify all entities that exercised control over these proceedings as real parties-of-interest and argued that Patent Owner has not established that the entities exercise control over Petitioners' participation in these proceedings.

Generally, a petition is accorded a rebuttable presumption that its identification of real parties-in-interest is accurate and complete. *See Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, Case IPR2013-00453, slip op. at 2 (PTAB Feb. 23, 2015) (Paper 91). A party that funds, directs, or controls an IPR petition or proceeding constitutes a real party-in-interest. *See Office Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,760 (Aug. 12, 2014). The requested discovery must be directed to this issue.

To be authorized to conduct additional discovery in *inter partes* review, a party must demonstrate that "such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). In deciding whether to grant Patent Owner's request to file a motion for additional discovery, we consider whether Patent Owner is already in possession of a threshold amount of evidence tending to show beyond speculation that something useful will be discovered in determining whether the entities are unidentified real parties-in-interest, i.e., whether any of the entities fund, direct, or control these proceedings. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

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 demonstrate

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that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

Id.; *see also id.* at 7 (stating that “useful” here means “favorable in substantive value to a contention of the party moving for discovery”).

Based on the information received during the conference call, we deny Patent Owner’s request to file a motion for additional discovery. Patent Owner has not provided a threshold amount of evidence to show that any of the entities exercised control over these proceedings. Patent Owner’s request relies on the mere *possibility* that discovery *may* reveal information that the alleged unidentified real parties-in-interest exercise control over these proceedings.

Patent Owner’s request to file a motion for additional discovery is *denied*.

*Petitioners’ Request for Authorization to File
Replies to the Preliminary Responses*

Petitioners request authorization to file replies to the Preliminary Responses to provide Petitioners’ arguments concerning (1) unlisted potential real parties-in-interest and (2) secondary considerations. *See Paper 13, 30–54.* Patent Owner opposes the request.

During the conference call, Petitioners stated that the requested replies would provide a more complete record for the Board to assess whether to institute trials in these cases. Patent Owner responded that the requested replies are not necessary.

The rules for *inter partes* review do not automatically authorize a petitioner to file a reply to a preliminary response. Rather, a petitioner

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seeking leave to file a reply must make a showing of good cause. *See* 37 C.F.R. § 42.108(c). Having considered the parties' positions, we determine that replies, at this stage of the proceedings, on the issues identified by Petitioners are not warranted under the good cause standard. The panel will issue the decisions on institution based on the briefing as currently submitted.

ORDER

It is hereby:

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery regarding real parties-in-interest is *denied*; and

FURTHER ORDERED that Petitioners' request for authorization to file replies to Patent Owner's Preliminary Responses is *denied*.

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