

**From:** [Director Discretionary Decision](#)  
**To:** [Rafatijo, Homayoon](#); [Director Discretionary Decision](#)  
**Cc:** [MDT-Samsung-BR](#); [DG-Samsung-MDT](#); [Gordon, Lori A](#); [Birbach, Naomi](#); [Robinson, Erick](#); [Piana, Jayne](#); [Partridge, Jayme](#); [Dunn, Patrick](#)  
**Subject:** RE: IPR2025-00538, -00540, -00542, 00544: Authorization to File Motion to Compel Routine Discovery or for Additional Discovery  
**Date:** Tuesday, June 17, 2025 10:07:26 AM

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Counsel – Patent Owner’s request for additional discovery for discretionary considerations is denied. The request for additional discovery is referred to the Board for a Board panel to grant any discovery that is needed for the merits and non-discretionary considerations.

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**From:** Rafatijo, Homayoon <HRafatijo@brownrudnick.com>  
**Sent:** Tuesday, June 10, 2025 2:15 PM  
**To:** Director\_Discretionary\_Decision <Director\_Discretionary\_Decision@uspto.gov>  
**Cc:** MDT-Samsung-BR <MDT-Samsung-BR@brownrudnick.com>; DG-Samsung-MDT <dg-samsung-mdt@goodwinlaw.com>; Gordon, Lori A <lorigordon@goodwinlaw.com>; Birbach, Naomi <nbirbach@goodwinlaw.com>; Robinson, Erick <ERobinson@brownrudnick.com>; Piana, Jayne <JPiana@brownrudnick.com>; Partridge, Jayme <JPartridge@brownrudnick.com>; Dunn, Patrick <PDunn@brownrudnick.com>  
**Subject:** IPR2025-00538, -00540, -00542, 00544: Authorization to File Motion to Compel Routine Discovery or for Additional Discovery

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Dear Honorable Director:

For Patent Owner’s Discretionary Denial Briefs in IPR2025-00538, -00540, -00542, and -00544, Patent Owner respectfully seeks authorization for additional and early discovery from Petitioners limited to the nature and extent of Petitioners’ relationship with Unified Patents LLC. Specifically, Patent Owner requests Petitioners respond to the following special interrogatories (“ROGs”) and/or produce the following documents (“RFPs”):

1. **ROG 1:** Identify all dates when Petitioner was a member of Unified Patents LLC from November 1, 2022 until present.
2. **ROG 2:** Identify, by amount, date and purpose of payment, all payments, including without limitation subscription fee payments and initiation payments, made by Petitioner to Unified Patents LLC from November 1,

2022 until present.

3. **RFP 1:** All communications, and all documents evidencing communications, between Petitioners and Unified Patents LLC regarding Patent Owner and/or the Asserted Patents from November 1, 2022 until present.

The '336 Patent, which has the earliest filing date of all Asserted Patents, was the subject of an unsuccessful reexamination challenge filed by Unified Patents LLC in June 2023. Given Petitioners' ties with Unified Patents LLC, which was also discussed in a recent Federal Circuit decision, Patent Owner is entitled to information that shows Petitioners had previously attempted to invalidate the '336 Patent through Unified Patents LLC. Furthermore, Patent Owner respectfully submits that Petitioners failed to list "all real parties in interest" in violation of 35 U.S. Code § 312(a)(2).

Good cause exists for Patent Owner to seek discovery of this information. The CTPG expressly contemplates "additional discovery of information pertaining to real party-in-interest." Furthermore, in light of the June 6, 2025 Director's decision to discretionarily deny institution in *iRhythm Technologies, Inc. v. Welch Allyn Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025), Patent Owner is entitled to know whether Petitioners have had actual or constructive notice of the '336 Patent as of June 2023 (i.e., when Unified Patents LLC filed the request for reexamination). Consistent with the CTPG's guidance, Patent Owner's request is narrowly tailored and easily understandable.

The Board has previously granted such discovery requests. See, e.g., *Netflix, Inc. and Hulu, LLC v. DivX, LLC*, IPR2020-00052, Paper 7, 3 (PTAB, Dec. 19, 2019) (granting authorization to file a motion to seek additional discovery regarding the relationship between the petitioners and Unified Patents LLC); see also *id.*, Paper 10, 12 (PTAB, Jan. 14, 2020) ("ORDERED that Petitioners shall provide the additional discovery set forth in Patent Owner's Interrogatory Numbers 1 and 2 (Ex. 2001, 1).").

Patent Owner's request is timely as the deadline for Patent Owner's discretionary denial brief in the above-referenced IPRs has not yet passed. Petitioners' statement misses the purpose of Patent Owner's requested discovery. Patent Owner's requested discovery is relevant because

1. In view of the recent Federal Circuit decision, Petitioners failed to identify Unified Patents as a real party-in-interest in violation of 35 U.S. Code § 312(a)(2). Petitioners had to identify "all real parties in interest" regardless of whether those "real parties in interest" had previously filed a

reexamination or an IPR. Petitioners' reliance on *SharkNinja* is misplaced, because the April 25, 2025 FAQs expressly allow Patent Owner to raise "non-discretionary considerations include[ing] those relevant to, for example, 35 U.S.C. §§ 311, 312."

2. Additionally, given Petitioners' membership in Unified Patents, Patent Owner is entitled to know whether Petitioners have had notice of Patent Owner's Patents since June 2023 when Unified Patents filed the reexamination request. Patent Owner's requested discovery is justified under *iRhythm Technologies*.

Finally, Petitioners' request that the Board strikes Patent Owner's request is disingenuous given the extent of their response.

If a call is necessary, Patent Owner is available for a conference call on June 11, 12, and 13 between 10 AM EDT and 5 PM EDT.

#### Petitioners' Statement

Petitioner asks the Board strike Patent Owner's email as impermissibly including substantive argument in violation of the Board's procedure set forth in Patent Trial and Appeal Board Boardside Chat: AIA Motions Practice, March 18, 2021, at slide 7.

Should the Board consider Patent Owner's substantive arguments, Petitioner responds to those arguments as follows.

Petitioner opposes Patent Owner's request for additional and early discovery. Patent Owner's request is an attempt to circumvent the Board's discovery procedure set forth in 37 C.F.R. 42.20-25 which requires Patent Owner file a Motion requesting the additional discovery (if authorized) and allows Petitioner to file an Opposition.

If Patent Owner's email is interpreted as a request for authorization to file a Motion for Additional Discovery, Petitioner opposes.

Patent Owner's request is untimely. The Director set forth the "settled expectations" rationale in the March 26, 2025 Discretionary Denial Memo and there has been no change of law related to real-party-in-interest identification in the last week justifying Patent Owner's delayed request. See *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (PTAB October 6, 2020) (precedential)(AIA § 312(a)(2), instituting review – no RPI analysis necessary at institution absent allegation of time bar or estoppel based on unnamed RPI). Patent Owner has had over two months to seek discovery but instead waited until 4 days before the due date for its brief to request.

Third, the interests of justice do not support Patent Owner’s request. Patent Owner’s request is premised on unsupported speculations and is nothing more than an overly burdensome fishing expedition. Patent Owner has not identified any time-bar or serial petition issue justifying real party-in-interest discovery. Although Patent Owner contends “a recent Federal Circuit decision” discusses Petitioners’ ties with Unified Patents, Patent Owner provides no citation to such case and provides no evidence beyond speculation that such ties exist.

Regardless, Unified Patents files declarations in its IPR proceedings testifying that it “exercises sole and absolute discretion over its decision to contest patents” and determines the patents to challenge in IPR, PGR and ex parte reexamination “independently without the input, assistance, or approval of any of Unified’s Members.” (See IPR2023-00338, Exhibit 1042 (Declaration of Kevin Jakel).) This declaration confirms no party coordinates with Unified Patents in its ex parte reexamination filings, belying Patent Owner’s core contention.

Fourth, the *iRhythm* case is distinguishable. *Welch Allyn* was the original applicant and assignee of the challenged patents, not a non-practicing entity that recently acquired the patents, like MDT in the present proceedings. Moreover, the alleged knowledge of the *Welch Allyn* patents was acquired through an IDS filing over a decade before the Petition’s filing. The *Netflix* case is also distinguishable. *Netflix* involved an earlier IPR filed by Unified Patents implicating a potential *General Plastic* **serial petition** issue. Here, the earlier filed case is an ex parte reexamination, not a prior IPR.

Petitioner is available for a call at the times identified by the Patent Owner.

Sincerely,

**brownrudnick**

**Homayoon Rafatijo, Ph.D., Esq.**

IP Litigation Attorney

Brown Rudnick LLP  
1900 N Street NW  
Washington, D.C. 20036  
T: +1 202.536.8309  
[HRafatijo@brownrudnick.com](mailto:HRafatijo@brownrudnick.com)  
[www.brownrudnick.com](http://www.brownrudnick.com)

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