

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K. J. PRETECH CO., LTD.,
Petitioner,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,
Patent Owner.

Cases¹

IPR2015-01866 (Patent 8,215,816)

IPR2015-01867 (Patent 7,537,370)

IPR2015-01868 (Patent 7,434,974)

Before THOMAS L. GIANNETTI, MIRIAM L. QUINN, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in each case. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2015-01866 (Patent 8,215,816)

IPR2015-01867 (Patent 7,537,370)

IPR2015-01868 (Patent 7,434,974)

INTRODUCTION

Patent Owner, Innovative Display Technologies LLC (“Patent Owner”), filed a motion for additional discovery (Paper 7, “Mot.”) in the instant proceedings, and Petitioner, K. J. Pretech Co., LTD. (“Petitioner”), filed an opposition (Paper 9, “Opp.”).² For the reasons stated below, Patent Owner’s motion is denied.

MOTION FOR ADDITIONAL DISCOVERY

We authorized Patent Owner to file a motion for additional discovery limited to the issue of privity between LG Display, LG Electronics (collectively “LG”), and Petitioner. Specifically, the motion was to address production of the supplier agreement between LG and Petitioner, and referred to discovery response admissions. (Paper 6, 3) The parties were ordered to meet and confer to work out any confidentiality issues regarding the requested supplier agreement and discovery response admissions. *Id.* at 4.

In the present motion, Patent Owner requests production from Petitioner of:

1. The intercompany agreements between KJ Pretech and LG regarding rights, obligations or indemnification for allegations of infringement of third party intellectual property rights, and any joint defense agreements among Petitioner and any of the defendants in the Delaware Litigation concerning the handling of intellectual property disputes.

² For purposes of convenience, all citations are to papers filed in Case IPR2015-01866, as representative, unless otherwise noted.

IPR2015-01866 (Patent 8,215,816)

IPR2015-01867 (Patent 7,537,370)

IPR2015-01868 (Patent 7,434,974)

2. Written communications between LG and KJ Pretech regarding either (a) indemnity for patent infringement claims made by Innovative Display Technologies, LLC, against LG or LG customers; and/or (b) the filing and maintenance of inter partes review actions against patents owned by Innovative Display Technologies, LLC.

Mot. 9–10.

Petitioner, in its opposition, avers that there are no privity issues, and that they “reached out to Patent Owner prior to the filing of the motion to agree to provide the supply agreement and to relay LG’s agreement to permit cross use of the relevant discovery responses (i.e., the materials the Board permitted Patent Owner to move for discovery on) in order to avoid motion practice.” Opp. 1. We note that LG, who is not a party in the present proceeding, agreed to the use in this proceeding, of the supplier agreement and specific discovery responses produced in the related district court litigation, and that Petitioner’s offer is contingent on entry of an appropriate protective order. *Id.* at 2. Based on Petitioner’s agreement to produce the supplier agreement between LG and Petitioner and specific discovery responses from the district court litigation, Petitioner asserts Patent Owner’s first request is “moot”. *Id.* at 2, 4–5.

With regards to Patent Owner’s second request, Petitioner “confirms that no written communications in any form related to these IPRs exist between LG and Petitioner.” *Id.* at 5–6. As such, Petitioner asserts that Patent Owner’s second request “is also moot.” *Id.* at 6.

We agree with Petitioner’s assertions. Petitioner agrees to provide Patent Owner with the supplier agreement between Petitioner and LG that was produced in the related district court litigation, as well as specific discovery responses. Petitioner seeks entry reasonably of a protective order

IPR2015-01866 (Patent 8,215,816)

IPR2015-01867 (Patent 7,537,370)

IPR2015-01868 (Patent 7,434,974)

prior to providing this information. Moreover, Petitioner affirmatively states that it is not in privity with LG, and that “no written communications exist between the parties relating these proceedings.” *Id.* at 7.

As such, the parties are to meet and confer by January 11, 2016 and agree to a protective order, to be entered in the record by close of business on January 13, 2016. Once the protective order is entered, Petitioner should produce the supplier agreement between Petitioner and LG and specific discovery responses by close of business on January 15, 2015. Should the parties be unable to agree to a protective order, the parties are to contact the panel via an email message to Trials@uspto.gov, if necessary, to facilitate the resolution of any remaining dispute.

ORDER

Accordingly, it is

ORDERED that Patent Owner’s Motion for Additional Discovery is denied;

FURTHER ORDERED that the parties meet and confer by January 11, 2016 and agree to a protective order, to be entered in the record by close of business on January 13, 2016;

FURTHER ORDERED that after entry of the protective order, Petitioner shall serve on Patent Owner a copy of the supplier agreement between Petitioner and LG and specific discovery responses, by close of business on January 15, 2015.

IPR2015-01866 (Patent 8,215,816)

IPR2015-01867 (Patent 7,537,370)

IPR2015-01868 (Patent 7,434,974)

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