

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD., and NINTENDO OF AMERICA INC.,
Petitioner,

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-01338
Patent 6,411,941 B1

Before THU A. DANG, KEVIN W. CHERRY, and RYAN H. FLAX,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION

Granting Petitioner's Motion for Additional Discovery
35 U.S.C. § 42.51(b)(2)

I. INTRODUCTION

Pursuant to our authorization email dated May 27, 2022 (Ex. 1018), Petitioner, Nintendo Co., Ltd. and Nintendo of America Inc. (collectively, “Nintendo”), filed a Motion for Additional Discovery (Paper 26, “Mot.”) seeking additional discovery from Patent Owner, Ancora Technologies, Inc. In particular, Petitioner seeks production of “all unproduced licenses or settlement agreements involving the challenged ’941 patent,” including “at least the additional unproduced licenses that were explicitly cited by Patent Owner and its declarant in its papers.” Mot. 1. According to Petitioner, “Patent Owner said it would not oppose this motion . . . as long as they are subject to the proposed protective order.” *Id.* (citing Ex. 2038 (“Protective Order”)).

Petitioner contends that, in Patent Owner’s Response, Patent Owner’s objective-indicia evidence “in the form of certain licenses for the challenged ’941 patent” is cited to support its non-obviousness argument, wherein Patent Owner selectively produced three of the licenses under the Protective Order. Mot. 1–2 (citing PO Resp. 66–70 (citing Ex. 2029; Ex. 2031; Ex. 2032)). According to Petitioner, Patent Owner also references certain additional unproduced licenses in the Response, and “Patent Owner’s declarant also explicitly confirmed the existence” of these additional licenses other than those produced. *Id.* at 2 (citing PO Resp. 69–70; Ex. 2030 ¶ 7). Petitioner contends that, without additional discovery, “Patent Owner’s unverified statements would be the final word on this issue,” whereas “Petitioners would be unable to evaluate or rebut Patent Owner’s characterizations.” *Id.* at 3. That is, any unproduced licenses, or settlement

agreements involving the '941 patent that did not result in a license, “are necessary for Petitioners to fully evaluate Patent Owner’s objective-indicia arguments,” especially “where the Patent Owner is undoubtedly in possession of the withheld evidence.” *Id.*

II. ANALYSIS

Additional discovery may be ordered if the party moving for the discovery shows “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *see also* 35 U.S.C. § 316(a)(5) (requiring discovery in *inter partes* review proceedings to be limited to “what is . . . necessary in the interest of justice”). The Board has identified five factors (“the *Garmin* factors”) important in determining whether additional discovery is in the interests of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative) (“*Garmin*”).

Petitioner alleges facts sufficient to persuade us that its request for discovery meets the first *Garmin* factor, i.e., that the requested discovery is based on more than a possibility and allegation of finding something useful. *See Garmin* at 6. In particular, as Petitioner points out, Patent Owner cited as “objective evidence” licenses for the challenged '941 patent to support its non-obviousness argument, wherein Patent Owner references certain additional unproduced licenses in the Response, and “Patent Owner’s declarant also explicitly confirmed the existence” of these additional licenses. Mot. 2 (citing PO Resp. 69–70; Ex. 2030 ¶ 7). We are persuaded that, without additional discovery, Petitioner “would be unable to evaluate or rebut Patent Owner’s characterizations.” *Id.* at 3.

Further, as Petitioner contends, the requested discovery is “limited to any unproduced licenses or settlement agreement involving the challenged ’941 patent,” including “the additional licenses specifically identified by Patent Owner’s declarant.” Mot. 4. Thus, we are persuaded that Petitioner’s request for discovery also meets the second *Garmin* factor, i.e., that the requested discovery does not seek Patent Owner’s litigation positions or the underlying basis for those positions. *See Garmin* at 6.

We are also persuaded that Petitioner’s request for discovery meets the third *Garmin* factor, i.e., that the information cannot be reasonable be generated without the discovery request. *See Garmin* at 6. As Petitioner set forth in its email request seeking authorization to file the Motion, Patent Owner “represented that confidentiality provisions of certain license agreements prevent it from producing them absent an order from an official tribunal” wherein a grant of a motion for additional discovery would resolve Patent Owner’s production hurdle. *See Ex. 1018*.

Petitioner also alleges facts sufficient to persuade us that its request for discovery meets the fourth *Garmin* factor, i.e., that the requested discovery is easily understandable. *See Garmin* at 6–7. As Petitioner points out, “Patent Owner itself has specifically identified at least some of the requested documents” in its expert’s declaration, and references them in the Response. Mot. 5 (citing Ex. 2030).

We are also persuaded that Petitioner’s request also meets the fifth *Garmin* factor, i.e., that the requested discovery is not overly burdensome for Patent Owner to answer. *See Garmin* at 7. As Petitioner points out, the requested discovery is “either confirmed to exist by Patent Owner, or very

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likely to exist,” wherein “Patent Owner is already in possession of the document and has already produced related documents.” Mot. 5.

Upon consideration of each of the *Garmin* factors, and for the foregoing reasons, we grant Petitioner’s Motion for Additional Discovery.

III. ORDER

Accordingly, it is

ORDERED that Petitioner’s Motion for Additional Discovery is *GRANTED*;

FURTHER ORDERED that Petitioner shall serve the authorized Requests no later than June 21, 2022; and

FURTHER ORDERED that, following Petitioner’s service of its Requests, Patent Owner shall produce and deliver to Petitioner all responsive documents no later than July 5, 2022. The production and delivery of the responsive documents shall be governed by the proposed protective order. Ex. 2038.

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