

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC. and VIZIO, INC.,
Petitioner

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner

Case IPR2021-01406
U.S. Patent No. 6,411,941

**PETITIONER'S UNOPPOSED MOTION FOR
ADDITIONAL DISCOVERY**

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 A. Garmin Factor 1: The requested discovery is based on more than a mere possibility of finding something useful.....4

 B. Garmin Factor 2: The requested discovery does not seek Ancora’s litigation positions or the basis for those positions.4

 C. Garmin Factor 3: The information cannot reasonably be generated without the discovery request.....4

 D. Garmin Factor 4: The requested discovery is easily understandable.....5

 E. Garmin Factor 5: The requested discovery is not overly burdensome for Patent Owner to answer.5

IV. CONCLUSION..... 5

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 6,411,941 to Mullor et al. (“941 Patent”)
1002	Image File Wrapper of U.S. Patent No. 6,411,941 (“941 Patent File History”)
1003	Declaration of Andrew Wolfe, Ph.D. (“Wolfe Decl.”)
1004	U.S. Patent No. 4,658,093 (“Hellman”)
1005	U.S. Patent No. 5,892,906 (“Chou”)
1006	U.S. Patent No. 5,933,498 (“Schneck”)
1007	Scheduling Order, <i>Ancora Techs., Inc. v. TCT Mobile (US), Inc.</i> , No. 8:19-cv-2192 (C.D. Cal. Mar. 17, 2020) (ECF No. 34)
1008	In re: Coronavirus Public Emergency, Order Concerning Phased Reopening of the Court, General Order No. 20-09, United States District Court for the Central District of California, Aug. 6, 2020
1009	Civil Docket, <i>Ancora Techs., Inc. v. Sony Mobile Commc’ns AB</i> , No. 1:19-cv-01703 (D. Del.)
1010	Civil Docket, <i>Ancora Techs., Inc. v. Lenovo Grp. Ltd.</i> , No. 1:19-cv-01712 (D. Del.)
1011	Claim Construction Order, <i>Ancora Techs., Inc. v. Apple Inc.</i> , No. 4:11-cv-06357 (N.D. Cal. Dec. 31, 2012) (ECF No. 107)
1012	Final Claim Constructions of the Court, <i>Ancora Techs., Inc. v. LG Elecs., Inc.</i> , No. 1:20-cv-00034 (W.D. Tex. June 2, 2020) (ECF No. 69)
1013	Supplemental Claim Construction Order, <i>Ancora Techs., Inc. v. LG Elecs., Inc.</i> , No. 1:20-cv-00034 (W.D. Tex. Aug. 19, 2020) (ECF No. 93)
1014	Joint Claim Construction and Prehearing Statement, <i>Ancora Techs., Inc. v. TCT Mobile (US), Inc.</i> , No. 8:19-cv-2192 (C.D. Cal. July 17, 2020) (ECF No. 49)
1015	European Patent Application No. EP 0766165A2 (“165 Application”)
1016	U.S. Patent No. 5,724,425 (“425 Patent”)
1017	U.S. Patent No. 6,138,236 (“236 Patent”)
1018	U.S. Patent No. 5,802,592 (“592 Patent”)
1019	U.S. Patent No. 5,835,594 (“594 Patent”)

Exhibit No.	Description
1020	Telephonic Markman Hearing, <i>Ancora Techs., Inc. v. TCT Mobile (US), Inc., et al.</i> , No. 8:19-cv-2192 (C.D. Cal. Oct. 15, 2020) (ECF No. 60)
1021	Telephonic Markman Hearing, <i>Ancora Techs., Inc. v. TCT Mobile (US), Inc., et al.</i> , No. 8:19-cv-2192 (C.D. Cal. Oct. 15, 2020) (ECF No. 69)
1022	Complaint, <i>Ancora Techs., Inc. v. TCL Corp., et al.</i> , No. 4:19-cv-00624 (E.D. Tex. Aug. 27, 2019) (ECF No. 1)
1023	U.S. Patent No. 5,734,819 (“Lewis”)
1024	File Wrapper of <i>Ex Parte</i> Reexamination of U.S. Patent No. 6,411,941, Control No. 90/010,560 (“560 Reexam File Wrapper”)
1025	Order Re: Joint Stipulation Re Stay Pending <i>Inter Partes</i> Review, <i>Ancora Techs., Inc. v. Vizio, Inc.</i> , No. 2:21-cv-08534 (C.D. Cal.) (ECF No. 78)
1026	Order Granting Joint Motion to Stay Pending <i>Inter Partes</i> Review, <i>Ancora Techs., Inc. v. Roku, Inc.</i> , No. 6:21-cv-00737 (W.D. Tex.) (ECF No. 33)
1027	Order Granting Joint Motion to Stay Pending <i>Inter Partes</i> Review, <i>Ancora Techs., Inc. v. Nintendo Co., Ltd., et al.</i> , No. 6:21-cv-00738 (W.D. Tex.) (ECF No. 46)
1028	Board Email Authorizing Motion For Additional Discovery, May 27, 2022

Roku, Inc. and Vizio, Inc. (“Petitioner”) seek 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. Patent Owner has alleged that it has not produced all of its agreements involving the ’941 patent because of confidentiality provisions associated with those agreements. But in a meet-and-confer preceding this motion, Patent Owner said it would not oppose this motion requesting an order requiring it to produce its additional ’941 patent licenses as long as they are subject to the proposed protective order (EX2038). Consistent with this agreement between Petitioner and Patent Owner, Petitioner submits this targeted additional discovery request under 37 C.F.R. § 42.51(b)(2), which the Board authorized by email dated May 25, 2022. EX1028. As shown below, the motion satisfies all five “Garmin factors” set forth in *Garmin Int’l Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper No. 26, at 6–7 (P.T.A.B. Mar. 5, 2013) (precedential).

I. STATEMENT OF THE FACTS

In its POR, Patent Owner argues that objective evidence in the form of certain licenses for the challenged ’941 patent support its non-obviousness arguments. POR, 66-70. In support, Patent Owner selectively produced three licenses under the Protective Order. *See* EX2029, EX2031, EX2032 (all designated as Confidential and produced under proposed protective order EX2038).

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