

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

JAWBONE INNOVATIONS, LLC, <div style="text-align: right;"><i>Plaintiff,</i></div>	§ § § § § § § § § §	Case No. 2:21-cv-00186-JRG-RSP
v.		
SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS AMERICA, INC., <div style="text-align: right;"><i>Defendants.</i></div>		

**ORDER**

Before the Court are three motions related to discovery disputes:

- Motion to Compel Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. to Provide Technical Discovery filed by Plaintiff Jawbone Innovations, LLC, **Dkt. No. 102**;
- Motion To Compel filed by Defendants Samsung Electronics Co. Ltd. and Samsung America, Inc., **Dkt. No. 108**; and
- Motion to Compel Samsung to Provide Discovery filed by Jawbone, **Dkt. No. 111**.

On August 24, 2022, the Court held a hearing where it heard arguments on the above motions. For the reasons orally assigned at the hearing, the Court resolves the motions as follows.

**I. Jawbone’s Motion to Compel Technical Discovery (Dkt. No. 102)**

In this motion, Jawbone seeks (1) technical specifications concerning the Accused Products, (2) communications between Samsung and its vendors concerning the development of the Accused Products, and (3) a supplemental response to its Interrogatory No. 8.

The Court **GRANTS IN PART** the motion and **ORDERS** that, as to the first issue, Samsung provide written confirmation to Jawbone that it has completed a diligent search and produced any documents identified by Mr. Soonho Baek during his deposition. As to the second issue, the Court directs Jawbone to provide the communications it received from Samsung’s vendors, specifically Goodix and Forte Media, in which the vendors indicated Samsung possesses

relevant technical documentation. Upon receiving the communications from Jawbone, Samsung is to conduct a search to determine whether it does in fact possess the relevant technical documentation and if so, produce it. Finally, Jawbone did not provide an adequate basis for the Court to compel Samsung to supplement its interrogatory response.

## **II. Samsung's Motion to Compel (Dkt. No. 108)**

In its motion to compel, Samsung seeks three items: information related to Jawbone's ownership and control of the Asserted Patents, Jawbone's business related to the Asserted Patents, and production of a supplemental privilege log concerning Jawbone's pre-suit investigation.

Taking the second item first, the parties reached an agreement prior to the hearing that resolved this issue, Dkt. No. 127; therefore, this part of the motion is **DENIED AS MOOT**. For the third item, counsel for Jawbone represented at the hearing that it will not put forth arguments based on any pre-suit investigation, and based on this representation, the Court **DENIES AS MOOT** this part of the motion.

For the first item, Samsung seeks documents to determine whether Jawbone has so called "statutory standing"—i.e. whether Jawbone meets the statutory requirements to be a "patentee" for the purposes 35 U.S.C. § 281 and whether there are co-owners of the Asserted Patents that need to be joined to this suit. To this end, Jawbone seeks documents related to litigation funding and Jawbone's ability to enforce the Asserted Patents.

Samsung's arguments at the hearing diverged from the briefing. Samsung's arguments at the hearing focused on redacted terms of a document— which Samsung had received the night before the hearing—which establishes the membership interests in Jawbone as a business entity. Citing these redactions, Samsung argued that they *could* allow Jawbone's corporate owners to control the ability of Jawbone to enforce Jawbone's rights in the Asserted Patents. In response,

counsel for Jawbone represented that none of the redacted terms controlled Jawbone's ability to maintain a suit, settle a suit, or maintain the Asserted Patents.

The Court finds, not only were Samsung's arguments not ripe because they were not in the briefing on the motion, but the representations made by Jawbone's counsel adequately addressed Samsung's arguments. Furthermore, Samsung's cited case does not support Samsung's argument that, on the facts before the Court, it is entitled to discovery concerning Jawbone's corporate ownership or litigation funding.

Turning to the briefing, Samsung argued that it is entitled to discovery on all financial and ownership interests in the Asserted Patents based on the fact that certain corporate managers of Jawbone were affiliated with previous owners of the Asserted Patents or are affiliated with an entity that manages financial interests in intellectual property. This argument is based on mere speculation and is not enough for the Court to compel Jawbone to go beyond what it has already produced. Jawbone has presented sufficient evidence of ownership of all necessary patent rights. Therefore, the Court **DENIES** this portion of the motion.

### **III. Jawbone's Motion to Compel (Dkt. No. 111)**

At the hearing, counsel for Jawbone informed the Court the parties had reached an agreement that resolves this motion. Therefore, the Court **DENIES AS MOOT** this motion.

**SIGNED this 30th day of August, 2022.**

  
ROY S. PAYNE  
UNITED STATES MAGISTRATE JUDGE