

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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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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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).

In addition to these produced licenses, Patent Owner also references certain additional unproduced licenses in its POR. *See* POR [Confidential], 69-70.

Moreover, Patent Owner's declarant explicitly confirmed the existence of additional licenses other than those produced so far. *See* EX2030 (Confidential), ¶7.

During a meet-and-confer on May 25, Patent Owner represented that confidentiality provisions of certain license agreements prevent it from producing the additional licenses absent an order from an official tribunal. EX1028.

II. THE PARTIES HAVE REACHED AN AGREEMENT FOR PATENT OWNER TO PRODUCE ADDITIONAL DOCUMENTS BUT REQUIRE ACTION FROM THE BOARD.

Patent Owner has agreed not to oppose this motion as long as the requested documents will be subject to the proposed protective order (EX2038), and will produce the requested licenses upon entry of an order from the Board in this proceeding. EX1028. The Board's grant of this motion is therefore merely a condition to the parties' agreement. This alone should be sufficient for the Board to grant the motion. 37 C.F.R. § 41.51(b)(2)(i) ("The parties may agree to additional discovery between themselves").

III. THE INTERESTS OF JUSTICE SUPPORT GRANTING ADDITIONAL DISCOVERY.

The *Garmin* factors also support granting this motion.

As Patent Owner has itself confirmed, the three licenses produced by Patent

Owner do not represent the full universe of licenses or settlement agreements involving the '941 patent. Patent Owner characterizes these additional unproduced licenses, along with the already produced licenses, as “confirm[ing] the value of the '941 patent.” POR [Confidential], 70. In support, Patent Owner’s declarant further stated the total amount of licensing revenue from both the produced and unproduced licenses. EX2030 [Confidential], ¶7.

Without additional discovery, Patent Owner’s unverified statements would be the final word on this issue. Petitioner would be unable to evaluate or rebut Patent Owner’s characterizations. Any unproduced licenses, or settlement agreements involving the '941 patent that did not result in a license, are necessary for Petitioner to fully evaluate Patent Owner’s objective-indicia arguments. Justice is not served by allowing Patent Owner to selectively produce evidence that allegedly supports patentability, but withhold potentially conflicting evidence of the same character. This is especially true where the Patent Owner is undoubtedly in possession of the withheld evidence. Accordingly, discovery of any unproduced licenses (or settlement agreements that did not result in a license) is necessary to permit Petitioner fully develop its rebuttal to Patent Owner’s objective-indicia arguments.

All five *Garmin* factors weigh in favor of granting this additional discovery.

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

The requested discovery is limited to any unproduced licenses or settlement agreements involving the challenged '941 patent, including at least the additional licenses specifically identified by Patent Owner's declarant. Additional unproduced licenses exist and Patent Owner currently possesses them. Their production would be useful to complete the record for this proceeding and permit Petitioner the opportunity to fully respond to Patent Owner's objective evidence arguments. Petitioner cannot adequately rebut Patent Owner's arguments without reviewing all license agreements involving the '941 patent.

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

The requested documents contain factual evidence related to Patent Owner's claim that objective indicia of non-obviousness support its patentability arguments. The documents are not believed to include Patent Owner's litigation positions (or the basis for such positions).

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

The requested documents are Patent Owner's confidential documents and Petitioner is not currently aware of a way to obtain them from any other source without this discovery request. Moreover, the documents can be produced under the current proposed protective order (not yet granted), which provides additional

confidentiality protections.

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

The requested discovery is easily understandable because Patent Owner itself has specifically identified at least some of the requested documents in EX2030 and references them in the POR. The request for all unproduced licenses or settlement agreements is clear on its face.

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

The requested discovery is limited to specific documents either confirmed to exist by Patent Owner, or very likely to exist. Patent Owner is already in possession of the documents and has already produced related documents. Patent Owner therefore has limited, if any, search or production burden responding to this request. And the current proposed protective order, once granted, will be in place to protect confidentiality of the agreements. Moreover, there should be no impact on the timing of the IPR as long as the documents are timely produced.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully asks the Board to grant Petitioner's motion for additional discovery and that it order Patent Owner to produce 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.

Respectfully submitted,

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Date: June 6, 2022

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned certifies that true and correct copies of the above-captioned
PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY and Exhibit
1028 were served in their entireties on June 6, 2022 upon the following parties via
electronic mail:

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