

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DDC TECHNOLOGY, LLC,
Patent Owner.

IPR2023-00707 (Patent 9,420,075 B2)
IPR2023-00708 (Patent 9,811,184 B2)
IPR2023-00709 (Patent 10,528,199 B2)
IPR2023-00710 (Patent 11,093,000 B2)
IPR2023-00711 (Patent 11,093,001 B1)¹

Before KALYAN K. DESHPANDE, *Vice Chief Administrative Patent Judge*, PATRICK M. BOUCHER, SHEILA F. McSHANE, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Additional Discovery
35 U.S.C. § 314

¹ We exercise our discretion to issue one Order to be docketed in each of the listed proceedings. Except as expressly authorized by the Board, the parties may not use this caption.

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On June 5, 2023, DDC Technology, LLC (“Patent Owner”) emailed the Board to request authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2) in these five proceedings, noting that Google LLC (“Petitioner”) opposed Patent Owner’s request. *See* Ex. 1014.²

On June 13, 2023, we held a conference call with the parties. *See* Ex. 1013 (transcript). At that time, Patent Owner sought documents related to communications and agreements between Petitioner and Mattel, Inc., MerchSource LLC, Unofficial Cardboard, Inc., and/or Orora Packaging Solutions (“OPS”). *See id.*; *see also* Ex. 1014, 2 (listing requests for production). Patent Owner argued that the requested documents would show that Petitioner is “precluded by the one year time bar from proceeding with these petitions.” *E.g.*, Ex. 1013, 11:22–12:15. After extensive discussion with the parties, we determined that Patent Owner would not satisfy the first factor of the *Garmin* test “based on the information . . . provided on this call today,” and consequently, “the Board would not grant [Patent Owner’s requested] motion for additional discovery.” *Id.* at 37:10–15; *see Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential) (*cited in* Ex. 3001 (email scheduling conference call)). Nevertheless, we authorized Patent Owner to file a motion for additional discovery “on these matters” in each of the five proceedings on or before June 27, 2023. *Id.* at 37:22–38:24.

² We cite to papers and exhibits in IPR2023-00707. Substantially similar papers and exhibits were also filed in each of the other proceedings.

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Patent Owner thereafter filed a motion in each of these proceedings. Paper 8 (“Motion” or “Mot.”).³ In the Motion, Patent Owner contends that “*Garmin* factor one is satisfied at least as to OPS” because Patent Owner is in possession of evidence “strongly suggesting” that Petitioner intentionally omitted OPS as “a real party in interest or privity” to “significantly impact the *Fintiv*^[4] analysis.” *Id.* at 1. From this, Patent Owner asserts that “the requested discovery is warranted.” *Id.* Patent Owner also states that, “to the extent the Board denies additional discovery at this time, [Patent Owner] requests the limited relief of compelling [Petitioner] to permit use of [Petitioner’s] documents produced in prior litigations concerning infringement of the patents subject to these IPR proceedings.” *Id.* at 3; *see id.* at 2–3 (indicating that those documents are subject to at least two district court protective orders).

Petitioner timely filed an opposition in each proceeding arguing that Patent Owner’s motion fails both on procedural grounds and on the merits.

³ Patent Owner originally filed a motion in only two of the proceedings (IPR2023-00707 and IPR2023-00708), but a footnote in those documents indicated that Patent Owner misunderstood the Board’s oral order. *See* Mot. 1 n.1. On June 29, 2023, the Board emailed the parties to authorize Patent Owner to file a substantially similar document in the other three proceedings by a revised deadline (Ex. 3002), and Patent Owner filed motions in the remaining proceedings before that deadline. Thus, in this Order, we consider the motions filed in all five proceedings.

⁴ In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board identified factors that it will address when deciding whether or not to exercise discretion to deny institution considering the status of co-pending litigation.

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Paper 9 (“Opp.”). Petitioner first asserts that Patent Owner fails to “make any specific discovery request as required by the Board’s rules.” *Id.* at 1 (citing 37 C.F.R. § 42.22(a)(1)); *see also id.* at 3. Petitioner also contends that Patent Owner’s motion “improperly raises a new, sweeping request for cross-use of *all* of Petitioner’s documents from *all* prior district court litigations, for which the Board did not grant authorization.” *Id.* at 1; *see also id.* at 3–4. As for the merits, Petitioner argues that Patent Owner fails to address most of the companies discussed during the conference with the Board (*id.* at 5–6), and regarding OPS, Patent Owner fails to explain its theory or provide any evidence to support it, which “is simply not enough to satisfy either 37 C.F.R. § 42.22(a)(2) or *Garmin* factor one” (*id.* at 6–7).

No reply was authorized. *See* Ex. 1013, 38:20–21.

LEGAL STANDARD

A motion “must include: (1) A statement of the precise relief requested; and (2) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. § 42.22(a). In addition, the “moving party has the burden of proof to establish that it is entitled to the requested relief.” *Id.* § 42.20(c).

When requesting additional discovery in an *inter partes* review, a party must demonstrate that “such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). In a motion for additional discovery, the Board considers a number of factors, which are often referred to as the

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Garmin factors. *See Garmin*, IPR2012-00001, Paper 26 at 5–7. *Garmin* factor 1 is of particular relevance to this Order:

1. More Than A Possibility And Mere Allegation -- The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

Id. at 6.

ANALYSIS

Patent Owner’s motion requests two types of relief: (1) additional discovery from Petitioner and (2) in the alternative, an order instructing Petitioner to agree that Patent Owner can use, in these proceedings, the documents previously provided by Petitioner to Patent Owner but which are subject to district court protective orders. For the reasons below, we deny each of these requests both on procedural grounds and on the merits.

Additional Discovery

First, we deny Patent Owner’s Motion because it fails to identify “the precise relief requested,” as required by 37 C.F.R. § 42.22(a). *See* Opp. 3. In its June 5 email to the Board, Patent Owner sought documents relating to Mattel, MerchSource, Unofficial Cardboard, and/or OPS, and it listed seven proposed requests for production. *See* Ex. 1014. The Motion, however, includes *no* reference to any requests for production and fails to otherwise identify the discovery sought by Patent Owner. *See* Mot.

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One might assume that the Motion continues to seek the documents identified by Patent Owner's June 5 email (*cf.* Mot. 2 (citing Ex. 2002)), but such an assumption is undercut by the arguments presented in the Motion. Where the June 5 email requests documents relating to any one of four companies (Ex. 1014), the Motion only briefly addresses two of them (*see* Mot. 1 (OPS), 2 n.1 (MerchSource)). One of those two companies (MerchSource) is only referenced in passing in a footnote (*id.* at 2 n.1), and Patent Owner does not explain why production of documents related to it would be in the interest of justice. Ultimately, it is unclear what additional discovery is sought by Patent Owner at this stage.

At most, Patent Owner's Motion seeks some documents relating to OPS,⁵ but even if Patent Owner had sufficiently identified those documents, it still would fail to show that this additional discovery is in the interest of justice.⁶

⁵ The Motion fails to provide any basis for authorizing discovery of documents related to Mattel, MerchSource, and/or Unofficial Cardboard.

⁶ Also, to the extent the Motion can be interpreted as a request for the OPS-related documents identified in Patent Owner's original requests (*see* Ex. 2002; Ex. 1014), the request would also fail under *Garmin* factor 5 as overly burdensome and not "tailored according to a genuine need." *Garmin*, IPR2012-00001, Paper26 at 7, 14. The Motion fails to substantively address this factor, instead arguing that neither Petitioner nor the Board to prove the opposite. *See* Mot. 2. *But see* Ex. 1013, 31:24–32:4 (Board warning Patent Owner that it has the burden on its motion). In addition, Patent Owner's emailed requests for production (on their face) are overbroad, unnecessarily burdensome, and not tailored to a genuine need. For instance, they seek any "[d]ocuments constituting or discussing any contracts, agreements, or business arrangements between [Petitioner] and . . .

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As to *Garmin* factor 1, Patent Owner does not provide evidence or reasoning “tending to show beyond speculation that the information to be discovered will be ‘useful.’” *Garmin*, IPR2012-00001, Paper 26 at 8. In the Motion, Patent Owner simply states:

Patent Owner has obtained additional evidence strongly suggesting that Petitioner Google intentionally omitted Orora Packaging Solutions (“OPS”) as a real party in interest or privy in these proceedings in order to avoid acknowledging the scheduling order in co-pending litigation – *DDC Technology, LLC v. Orora Packaging Solutions*, Case No. 3:22-cv-01263 (N.D. Tex.), a case that originally included Google before it was severed and transferred to the Northern District of California (the “Texas Case”) – which would significantly impact the *Fintiv* analysis. Such a finding would amount to Google having “purposefully omitted [OPS] to gain some advantage,” which would warrant dismissal of the Petitions. *See SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (PTAB Oct. 6, 2020) (precedential) at 19.

Accordingly, DDC submits that *Garmin* factor one is satisfied at least as to OPS, and thus the requested discovery is warranted.

Mot. 1. This is insufficient to satisfy *Garmin* factor 1.

OPS,” and all communications between Petitioner and OPS “that concern or relate to demands or requests for indemnification regarding any product . . . or legal proceeding.” Ex. 1014, 2. We discern no sufficient reason why such extensive discovery is justified to support Patent Owner’s theory that Petitioner intentionally omitted OPS to significantly impact the *Fintiv* analysis. *See* Mot. 1. It bears restating that only limited discovery is permitted in an *inter partes* review. *See Garmin*, IPR2012-00001, Paper 26 at 5 (“[I]n *inter partes* review, discovery is limited as compared to that available in district court litigation.”); *see also id.* at 5–6 (explaining the approach to discovery).

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In particular, even assuming that the evidence sought would be *useful* (e.g., because it would weigh in favor of a discretionary denial under *Fintiv*),⁷ Patent Owner fails to provide evidence or rationale to support its assertion that the evidence *exists*. Patent Owner says that it has “additional evidence” that supports its theory, but fails to provide anything more than this blanket assertion. Mot. 1. Patent Owner does not include the “additional evidence” as an exhibit to its Motion, and it does not even provide a vague description of it. As a result, we are unable to evaluate the merit of Patent Owner’s arguments. Ultimately, Patent Owner provides only a “mere allegation” that something useful will be uncovered, which is “insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Garmin*, IPR2012-00001, Paper 26 at 6; *see also, e.g., id.* at 11 (noting that movant failed to present “a threshold amount of evidence or reasoning” to support its requests for discovery).

Later in the Motion, Patent Owner suggests that protective orders entered by district courts prevent Patent Owner from introducing the necessary evidence. *See* Mot. 2–4. Patent Owner never identifies the relevant protective orders, but even if Patent Owner accurately characterizes the situation, this does not excuse the failure to substantiate its Motion. “In cases where a district court protective order includes a Restricted Use Provision, the Board has advised the parties to negotiate a waiver of the

⁷ Incidentally, we are not persuaded that the evidence would be useful. We note that the district court has stayed the “Texas case” in view of a settlement between the parties to that case. *See DDC Technology LLC v. Landsberg Orora*, Civ. Action No. 3:22-cv-01263, Dkt #150 (N.D. Tex.).

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Restricted Use Provision for the requested information or modify the protective order in the district court.” *Samsung Elecs. Co., Ltd v. Acorn Semi, LLC*, IPR2020-01183, Paper 24 at 3 (PTAB Mar. 30, 2021). The district court clearly has authority to modify its own protective order, and Patent Owner identifies no authority indicating that the Board can (or should) do so.

In addition, given the context of these proceedings, we question Patent Owner’s assertions regarding the evidence, to the extent it exists. Patent Owner originally argued that Petitioner’s relationship with Mattel, MerchSource, Unofficial Cardboard, and OPS resulted in a time bar under 35 U.S.C. § 315(b) (*see* Exs. 1013, 1014), but now, Patent Owner argues that Petitioner’s relationship with OPS affects the analysis of whether review should be discretionarily denied under *Fintiv* (*see* Mot.). These are two different theories – both of which we are not persuaded by. The Motion presents insufficient evidence or rationale to support any of Patent Owner’s theories. As a result, Patent Owner assertions are tantamount to a “fishing expedition,” rather than a request for specific documents to support a particular substantive contention. *See Garmin*, IPR2012-00001, Paper 26 at 7–8.

Order Regarding Documents in Patent Owner’s Possession

We deny Patent Owner request for an order requiring Petitioner to consent to Patent Owner’s use of all documents produced by Petitioner in district court litigations (*see* Mot. 3–4) for at least two reasons.

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First, the request is procedurally improper. We authorized Patent Owner to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51, and Patent Owner neither requested nor received authorization to include a request for this type of relief in its motion.

Second, the request is vague and overbroad because Patent Owner seeks an order that applies to *any* and *all* documents previously produced by Petitioner. We are not persuaded that a blanket consent is required or appropriate. Patent Owner admits that Petitioner agreed to consider requests “on a case-by-case basis,” and Patent Owner fails to explain (and we cannot discern) any problem with Petitioner’s approach. Mot. 3–4 n.3; *see also* Opp. 2. Patent Owner does not articulate any specific requests. *See* Mot.; Opp. 4.

ORDER

Accordingly, it is:

ORDERED that Patent Owner’s Motions (Paper 8) are *denied*.

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