UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

DDC TECHNOLOGY, LLC,

Patent Owner

U.S. Patent No. 11,093,001

Case No.: IPR2023-00711

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

I. Introduction

Patent Owner's motion for additional discovery should be denied. Mot., paper 8. Although the Board authorized Patent Owner (DDC) to file its motion, the Board cautioned that it "would not grant a motion for additional discovery because patent owner has failed to satisfy Garmin factor one, based on the information we have available today." EX1013, 37:10-15. In view of this guidance, DDC's motion appears to turn away from its prior request for real-party-in-interest (RPI) and privity discovery, which it had previously noticed to the Board in seeking leave to file its motion. In fact, DDC does not even make any specific discovery request as required by the Board's rules. See 37 C.F.R. § 42.22(a)(1). Instead, DDC'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. The Board should reject DDC's motion.

II. Statement of Material Facts

1. On June 5, 2023, DDC emailed the Board requesting a conference call seeking leave to file a motion for additional discovery "as to real party in interest and privity issues." EX1014, p. 1. That email includes several, wide-ranging document requests about RPI and privity. *Id.* at pp. 1-2 (See *e.g.*, "RFP No. 4: Documents constituting or discussing any contracts,

agreements, or business arrangements between Google and Mattel, Merchsource, UC or OPS.”).

2. On June 13, 2023, the Board held a conference call with the parties. The Board authorized DDC to file an additional discovery motion, but warned that it “would not grant a motion for additional discovery because patent owner has failed to satisfy Garmin factor one, based on the information we have available today.” EX1013, 37:10-15. The Board set a deadline of June 27, 2023 for DDC’s motion if it were to file one, and a deadline of July 11, 2023 for Petitioner’s opposition. *Id.* at 38:8-11, 38:14-20. No reply brief was authorized. *Id.* at 38:20-21.
3. On June 26, 2023, DDC for the first time raised a new discovery issue with Petitioner, seeking blanket authorization to cross-use in the PTAB proceedings any and all confidential Google documents from all prior litigations. See EX1015.
4. On June 27, 2023, the parties held a meet and confer to discuss DDC’s new request. In that call, Petitioner rejected the request for blanket authorization for cross-use, because it was overly broad and some of the documents may be subject to third-party confidentiality or a court order. But Petitioner said that if DDC were to specifically identify which documents it would like to use, Petitioner would consider that request. DDC has not yet responded.

III. DDC Fails to Satisfy its Burden for Additional Discovery

DDC's motion for additional discovery fails on both procedural and substantive grounds.

a. DDC's Motion Fails on Procedural Grounds

As to the RPI-related discovery, the motion does not provide "[a] statement of the precise relief requested" as required by 37 C.F.R. § 42.22(a)(1). In particular, nowhere does the motion discuss the document requests that DDC emailed to the Board (EX1014), and also, the motion does not provide a "full statement of the reasons for the relief requested" as required by 37 C.F.R. § 42.22(a)(2). DDC does not even attempt to rely on its email to the Board which identified this discovery. But even if DDC did, incorporation by reference is improper. 37 C.F.R. § 42.6.

Rather than addressing the discovery for which the Board granted leave to file its motion, DDC improperly makes a new request of the Board, asking it to compel "Google to permit use of Google documents produced in prior litigations concerning infringement of the patents subject to these IPR proceedings." Mot. at 3. DDC only sought leave to file a motion for additional discovery related to RPI/privity. EX1014. DDC gave the Board no prior notice of this new request.

Thus, this request exceeds the authorization the Board granted DDC in filing its motion, and in any event, this issue is not yet ripe for the Board.

DDC first informed Petitioner of this new request the day before its brief was due by stating that it wanted Google to agree that it be permitted "to use in these PTAB proceedings any and all Google documents produced in any prior litigation…." EX1015, p. 1 (emphasis added). Given the overly broad nature of this request, which may implicate court orders or third-party confidentiality issues, as well as many documents that Google produced having nothing to do with RPI/privity issues, Petitioner stated in the meet and confer on the day that DDC's brief was due that it could not agree to blanket authorization. But Petitioner stated that if DDC could specify which documents it would like to use, Petitioner would consider this request. As of the filing of this opposition, DDC has made no such request. As such, the parties are not at an impasse, and this issue is not ready for the Board's intervention. The Board should deny this request.

On procedural grounds alone, the Board should reject DDC's motion for failing to specify the requested RPI-related discovery and for departing substantially from the discovery requests it had previously noticed to the Board in seeking leave to file its motion.

b. DDC's Motion Fails on Substantive Grounds

As to the merits, DDC's motion also fails because it does not discuss the companies at the center of its document requests other than MerchSource and Orora Packaging Solutions (OPS). This is an abandonment of its requested discovery related to the other companies that DDC identified in its email (Mattel and Unofficial Cardboard). See EX1014.

As to MerchSource, DDC only mentions MerchSource in a footnote, where DDC admits that it already has the evidence that it needs (failing *Garmin* factor 3) and does not request more. Mot. at 2, n. 2 ("[t]he evidence confirms the opposite, and the documents in DDC's (and Google's) possession will show and demonstrate that Google's discovery responses were deficient….") (emphasis added). Indeed, and contrary to DDC's allegations, Google has already responded to DDC's Requests for Admission at the district court in which Google stated that it had no communications about either MerchSource's PTAB cases or the challenged patents with (1) MerchSource, (2) its general counsel, or (3) various shareholders and

affiliates of MerchSource, thus foreclosing any finding of a privity or RPI relationship. EX1018.[1]

As to OPS, it was sued on the same day as Petitioner. Thus, the one-year time bar and estoppel are not at issue here, and based on *SharkNinja,* there is no reason for the Board to delve into RPI and privity. *SharkNinja Operating LLC v. iRobot Corp.,* IPR2020-00734, Paper No. 11 (precedential). DDC attempts to avoid *SharkNinja* by accusing Petitioner—without any evidence—of intentionally omitting OPS as an RPI or privy in these proceedings "to avoid acknowledging the scheduling order" in its litigation against DDC, "which would significantly impact the *Fintiv* analysis."[2] DDC does not explain this theory, provide any evidence, or

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[1] DDC takes Petitioner's response that "there were no communications with MerchSource whatsoever" out of context. EX1013, p. 18. Petitioner's full response at pages 15-22 is consistent with its discovery responses at the district court. Nevertheless, Petitioner is aware of two communications with MerchSource in which MerchSource mentions one of DDC's pending patent applications. Those emails were produced during the *DDC v. MerchSource* case, and it is Petitioner's understanding that DDC may still be in possession of those emails.

[2] *Fintiv* is not an issue here. The co-pending litigation in which Petitioner is a defendant has been stayed. See EX1016. And, although not mentioned by DDC,

cite to any legal authority, thus failing to satisfy 37 C.F.R. § 42.22(a)(2). Indeed, Petitioner is unaware of any legal authority supporting DDC's position. In fact, the opposite is true. Citing *SharkNinja*, this Board has at least twice declined to perform an RPI/privity analysis when there was no time-bar or estoppel issue even though there was a *Fintiv* issue related to a third party. *See Unified Patents, LLC v. JustService.Net LLC*, IPR2020-01258, Paper No. 18[3]; *Unified Patents, LLC v. Monarch Networking Solutions LLC*, IPR2020-01708, Paper No. 28, Appendix A.

Lastly, DDC did not adequately address the Board's *Garmin* factor one concern. DDC presents nothing new other than vaguely mentioning that it has "obtained additional evidence strongly suggesting that Petitioner Google intentionally omitted" naming OPS as an RPI or privy in these proceedings without any indication of what this evidence is and what it means. This is simply not enough to satisfy either 37 C.F.R. § 42.22(a)(2) or *Garmin* factor one.

OPS has also requested a stay in its litigation in view of these IPR proceedings. See EX1017, pp. 10-11.

[3] Patent Owner's backup counsel in these proceedings was also counsel in IPR2020-01258.

IV. Conclusion

For the foregoing reasons, Petitioner respectfully requests the Board deny DDC's motion.

Respectfully Submitted,

Dated: July 11, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) of PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY and Exhibits 1014, 1015, 1016, 1017, and 1018 by filing these documents through the USPTO Patent Trial and Appeal Case Tracking System and by emailing a copy to the following email addresses:

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Respectfully Submitted,

Dated: July 11, 2023

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