

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.; INSTAGRAM, INC.; WHATSAPP LLC; META
PLATFORMS TECHNOLOGIES, LLC; AND GIPHY, INC.

Petitioners

v.

VL COLLECTIVE IP LLC

Patent Owner

Case IPR2023-00924
U.S. Patent 7,436,980

**PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR
AUTHORIZATION TO COMPEL TESTIMONY AND PRODUCTION OF
DOCUMENTS UNDER 37 C.F.R. § 42.52(A)**

TABLE OF CONTENTS

I.	RESPONSE TO STATEMENT OF MATERIAL FACTS.....	2
II.	PETITIONERS’ REQUESTED DISCOVERY IS NOT NECESSARY IN THE INTEREST OF JUSTICE.....	2
A.	Standard of Review	2
B.	Argument.....	3
1.	Petitioners fail to raise more than a possibility or mere allegation that something “useful” will be found.	3
2.	Litigation positions and underlying basis are not at issue.	7
3.	Petitioners have the ability to generate equivalent information by other means.	8
4.	Petitioners have not disclosed their proposed instructions.	8
5.	Petitioners’ request is not responsibly tailored to a genuine need and thus is overly burdensome.	9
III.	CONCLUSION.....	10

TABLE OF AUTHORITIES

CASES

<i>Avocent Huntsville Corp. v. Cyber Switching Patents, LLC</i> , IPR2015-00690, Paper 28 (PTAB Oct. 2, 2015).....	8
<i>Axonics Modulation Technologies, Inc. v. Medtronic, Inc.</i> , IPR2020-00679, Paper 24 (PTAB Dec. 10, 2020).....	3
<i>Bestway (USA) Inc. v. Intex Marketing Ltd.</i> , IPR2020-01405, Paper 30 (PTAB Apr. 23, 2021)	3
<i>Cellco P’ship v. Gen. Access Sol’ns, LTD</i> , IPR2023-00978, Paper 14 (PTAB Sept. 15, 2023)	4
<i>Corephotonics, Ltd. v. Apple Inc.</i> , 84 F.4th 990 (Fed. Cir. 2023).....	5, 9, 10
<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001, Paper 26 (Mar. 5, 2013).....	3, 5, 8, 9
<i>Google LLC v. IPA Techs., Inc.</i> , IPR2019-00730, Paper 55 (PTAB Apr. 14, 2020)	8
<i>Hulu, LLC v. Sound View Innovations, LLC</i> , IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019).....	10
<i>Medtronic, Inc. v. Teleflex Innovations S.à.r.l.</i> , IPR2020-00126, Paper 77 (PTAB Dec. 8, 2020).....	3
<i>Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth</i> , IPR2023-00726, Paper 44 (PTAB Dec. 6, 2023).....	3, 8
<i>Redline Detection LLC v. Star Envirotech, Inc.</i> , 811 F.3d 435 (Fed. Cir. 2015)	10
<i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	9
<i>SNF S.A. v. Chevron U.S.A.</i> , IPR2022-01534, Paper 27 (PTAB Aug. 8, 2023)	3

STATUTES

35 U.S.C. § 316(a)(5).....2

OTHER AUTHORITIES

Patent Trial and Appeal Board Consolidated Trial Practice Guide (2019) 10

REGULATIONS

37 C.F.R. § 42.123 6

37 C.F.R. § 42.51(b)(2)(i) 2

37 C.F.R. § 42.63 6

Petitioners' motion should be denied in full. Petitioners seek permission to hunt for new evidence in support of new theories of public accessibility because the evidence and theories in their Petition was insufficient. The Petition had two theories of public accessibility for TLP based on allegedly supporting evidence. Paper 3 ("Pet.") at 6. Patent Owner explained that Petitioners' showing was insufficient as a matter of law to demonstrate public accessibility of TLP. Paper 7 at 22-27. The Board found "that the Petition does not show a reasonable likelihood that TLP was published before May 27, 2004." Paper 11 at 49.

Though Petitioners maintain that "the information submitted with its Petition is sufficient to establish the public availability of TLP," Paper 17 at 6, they now seek permission to probe ten or more third parties across three countries and two continents for "additional" evidence. Petitioners' request does not pass muster under *Garmin*. Petitioners seek unspecified and hypothetical information that they have not shown (beyond speculation) will be found or will be useful to their contentions. The scope of requested discovery exceeds the scope of Petitioners' public accessibility contentions, underscoring its improper and unduly burdensome nature. And Petitioners fail to demonstrate why they cannot obtain public accessibility information for TLP without discovery or non-public information when they allege that TLP was "widely disseminated and made publicly available." Pet. 6.

As explained in detail below, because the discovery Petitioners seek is not “necessary in the interest of justice,” Petitioners’ motion should be denied.

I. RESPONSE TO STATEMENT OF MATERIAL FACTS

1. Patent Owner objects to this statement as not material. Admitted.

2. Patent Owner objects to this statement as not material. Admitted.

3. Patent Owner objects to this statement as not material. Patent Owner objects to this statement to the extent it mischaracterizes Exhibit 1044; the document speaks for itself. Patent Owner denies this statement to the extent it implies that, as part of the Assignment, the ’980 Inventors agreed to communicate “facts” and “history” to the Assignee other than “when requested” per the Assignment. Otherwise, Admitted.

4. Patent Owner objects to this statement as not material. Patent Owner objects to this statement to the extent it is not supported by the cited exhibits. Patent Owner objects to this statement as vague and unclear. To the extent it can be understood, Patent Owner denies this statement.

II. PETITIONERS’ REQUESTED DISCOVERY IS NOT NECESSARY IN THE INTEREST OF JUSTICE

A. Standard of Review

A party seeking additional discovery must prove that it is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2)(i). The test “is a strict one.” *Mom Enterprises, LLC v. Elaine and Reinhold W. Vieth*,

IPR2023-00726, Paper 44 at 8 (PTAB Dec. 6, 2023). To determine whether additional discovery is “necessary in the interest of justice,” the Board applies the five *Garmin* factors. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (Mar. 5, 2013) (precedential) (“*Garmin*”).

B. Argument

Petitioners have failed to demonstrate that the requested discovery is necessary in the interest of justice under *Garmin* or otherwise.

1. Petitioners fail to raise more than a possibility or mere allegation that something “useful” will be found.

Garmin factor 1 has been found dispositive by numerous panels of the Board. *SNF S.A. v. Chevron U.S.A.*, IPR2022-01534, Paper 27 at 5 (PTAB Aug. 8, 2023); *Bestway (USA) Inc. v. Intex Marketing Ltd.*, IPR2020-01405, Paper 30 at 10 (PTAB Apr. 23, 2021); *Axonics Modulation Technologies, Inc. v. Medtronic, Inc.*, IPR2020-00679, Paper 24 at 3 (PTAB Dec. 10, 2020); *Medtronic, Inc. v. Teleflex Innovations S.à.r.l.*, IPR2020-00126, Paper 77 at 5 (PTAB Dec. 8, 2020).

Under *Garmin*’s first factor, the movant “should already be in possession of a threshold amount of evidence or reasoning tending to show *beyond speculation* that something *useful* will be uncovered,” where “‘useful’ means *favorable in substantive value to a contention* of the party moving for discovery.” *Garmin*, Paper 26 at 6 (emphasis added). Thus, the focus should be whether Petitioner has shown *beyond speculation* that something *favorable to* (not merely relevant to) *their*

contentions (not new contentions) will be found. *Id.*; see *Cellco P'ship v. Gen. Access Sol'ns, LTD*, IPR2023-00978, Paper 14 at 5 (PTAB Sept. 15, 2023).

Here, Petitioners have not raised more than a mere possibility or speculation that the requested discovery will yield something favorable to their public accessibility contentions for TLP. Petitioners contended that TLP was publicly accessible through the internal peer review process of 2004 CVPR, Pet. 6 (citing EX1004, ¶ 65-66), and that TLP “was disclosed during prosecution” in an information disclosure statement “and is cited as prior art on the face of the ’980 Patent and its provisional application” with a CVPR publication date of “2004,” Pet. 6. Petitioners have not raised more than a mere possibility or speculation that the requested discovery will in fact yield something favorable to *those* contentions.

Petitioners’ *first* argument speculates that “[b]ecause the provisional application cites and discusses TLP, the ’980 Inventors ... have information about TLP’s public availability before the provisional application was filed on May 27, 2004.” Paper 17 at 4. Petitioners fail to explain why the inventors’ citations to TLP shows, beyond speculation, that the inventors will in fact have information favorable to Petitioners contentions based on (a) the 2004 CVPR peer review process or (b) the “2004” CVPR conference publication date. For example, the citations do not suggest (let alone demonstrate beyond speculation) that the inventors have information about how the CVPR peer review process from 20 years ago was

conducted. Nor do the citations demonstrate beyond speculation that TLP was made publicly accessible as a 2004 CVPR conference publication before the conference began on June 27, 2004—a month *after* May 27, 2004. Paper 17 at 5; EX1010.

To the extent Petitioners are suggesting that the inventors have information about other ways TLP may have been publicly accessible, or that TLP was publicly accessible because it was made available to Ying Zhu and Dorin Comaniciu, such information is beyond the scope of Petitioners’ public accessibility contentions and thus is not “useful” under *Garmin*. Pet. 6; *Garmin* at 6-7; *see also Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1008 (Fed. Cir. 2023) (petitioners may not raise new *prima facie* theories after institution).

Petitioners’ assertion that “[p]rior assignees should have similar evidence” fails for the same reasons discussed above. Furthermore, Petitioners identify no facts that indicate, beyond speculation, that any prior assignee in fact has such “similar information.” Petitioners assert that the inventors agreed in an assignment to communicate certain “facts” and “history” and to do other things at the request of the assignee. Paper 17 at 2. However, the existence of that assignment does not indicate or suggest (beyond speculation) that the inventors ever communicated to a prior assignee any such “similar evidence.”

Petitioners’ *second* argument—that “Michael Black specified a public availability date for TLP of January 2004”—is improper and fails substantively.

Petitioners’ argument relies on new evidence of alleged public accessibility (a ResearchGate website) that is not proper evidence (37 C.F.R. § 42.63), was not submitted with or discussed in the Petition, (Pet. 6), and has not been authorized for submission (37 C.F.R. § 42.123), thus the Board should not consider it. Moreover, the cited website does not indicate that *Michael Black* specified the January 2004 date and, in fact, suggests otherwise. Content that the website indicates was “uploaded by Michael Black” is identified by hovering your cursor over the grey “Author content” boxes on the website. Nothing on the website indicates that information in the area displaying the “January 2004” date was specified by Michael Black. There is thus no evidence (just speculation) that Michael Black has any information about that date. Nor does the website indicate what “January 2004” means—Petitioners call it a “public availability date” but point to no evidence that indicates how (if at all) TLP was publicly accessible in January 2004. Petitioners also fail to show how information about the alleged January 2004 publication date is favorable to their public accessibility contentions—Petitioners have not shown that the January 2004 date on the ResearchGate website relates to TLP’s alleged public accessibility through the 2004 CVPR peer review process or conference (which did not begin until June 27, 2004). Paper 17 at 5; Pet. 6.

Petitioners’ *third* argument—that “TLP went through the paper registration process [for 2004 CVPR] and was publicly available and circulated amongst

conference goes”—also fails. Paper 17 at 5-6. Petitioners speculate that the TLP Authors “*likely* all attended CVPR 2004” and that they “*should* be in possession” of unspecified “evidence confirming the public availability of TLP. *Id.* (emphasis added). But Petitioners point to no evidence tending to show beyond speculation which, if any (let alone all) of the TLP Authors attended the conference or, if they did attend, that they possess the unspecified evidence that Petitioners speculate they “should” have. *Id.* Indeed, Petitioners only speculate (they cite no evidence) that the TLP authors “may” have emails that allegedly confirm dates of submission and dissemination. *Id.* Petitioners point to no evidence that TLP was submitted electronically or that such emails were (or even would have been) generated. Nor have Petitioners shown beyond speculation that the unspecified and hypothetical evidence they seek would be favorable to their contentions. For instance, Petitioners fail to explain how anything “circulated amongst conference goes” would demonstrate public accessibility before May 27, 2004, especially when the conference did not begin until June 27, 2004. *See id.* at 5. And Petitioners have not shown the contents of any supposed emails would be favorable to their contentions as they have not demonstrated (beyond speculation) that such emails ever existed.

2. Litigation positions and underlying basis are not at issue.

Garmin factor 2 is inapplicable here in light of Petitioners representation that they “do not seek PO’s litigation positions.” Paper 17 at 6.

3. Petitioners have the ability to generate equivalent information by other means.

Petitioners seek “evidence showing the public availability of TLP before May 27, 2004,” which is something that Petitioners “can reasonably figure out or assemble without a discovery request.” *Garmin* at 6. “Prior art publications ... are by definition publicly accessible.” *Mom Enterprises*, IPR2023-00726, Paper 44 at 11-12. Petitioners fail to explain why they need *private* documents to demonstrate what was allegedly “widely disseminated and made publicly available.” Pet. 6. Denial of a motion to compel discovery is appropriate where, as here, the movant fails to explain why it could not have obtained other evidence accomplishing the same goal prior to filing its petition. *See Avocent Huntsville Corp. v. Cyber Switching Patents, LLC*, IPR2015-00690, Paper 28 at 7 (PTAB Oct. 2, 2015).

Google LLC v. IPA Techs., Inc. is inapposite. Paper 17 at 7. There, the Board rejected an argument that documents could have been obtained through the district court because the documents were not produced there. IPR2019-00730, Paper 55 at 8 (PTAB Apr. 14, 2020). It did not hold that discovery should be compelled whenever information cannot be obtained from a third party “willingly” or “voluntarily.”

4. Petitioners have not disclosed their proposed instructions.

Garmin factor 4 is inapplicable here because Petitioners have not disclosed their proposed instructions.

5. Petitioners’ request is not responsibly tailored to a genuine need and thus is overly burdensome.

Discovery requests “should be sensible and responsibly tailored according to a genuine need.” *Garmin* at 7. Petitioners’ statement that “the information submitted with its Petition is sufficient to establish the public availability of TLP” demonstrates that no genuine need exists for the discovery it seeks—Petitioners just want to search for what more might exist. Paper 17 at 6. Nor is Petitioners’ request tailored to their contentions. The contentions relied on the 2004 CVPR peer review process, and TLP’s appearance on an information disclosure statement, the ’980 Patent, and the patent’s provisional application with a CVPR publication date of “2004.” Pet. 6. Petitioners’ discovery request is not tailored to ask about any of these specific bases—instead it broadly seeks discovery of “the date of public availability of TLP.” This invites a search for information related to any conceivable form of accessibility—it is not tailored to the actual public accessibility contentions and thus is beyond “the scope of the litigation.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1357 (2018). Petitioners are fishing for new evidence upon which to base new public accessibility theories or to change the evidence cited in the Petition. Because such information is not “useful” under *Garmin*, “[t]he undue breadth of such a request is self-evident.” *Garmin* at 7, 16 (emphasis added). Petitioners’ reliance on the requested discovery would therefore be improper, *see Corephotonics*, 84 F.4th at

1008, and would impact the trial schedule because motion practice would be necessary to strike Petitioners' arguments relying on such evidence.

Petitioners did not act diligently in seeking the requested discovery—*i.e.*, “documents and/or testimony ‘sufficient to show’ the date of public availability of TLP.” Paper 17 at 7-8. Petitioners’ burden of presenting evidence “sufficient to show” a *prima facie* case of public accessibility—which it failed to do, Paper 11 at 49, and now seeks to do through discovery—did not arise upon institution and may not be satisfied for the first time in reply to Patent Owner’s Response. Patent Trial and Appeal Board Consolidated Trial Practice Guide (2019) at 73; *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 11-13 (PTAB Dec. 20, 2019); *Corephotonics*, 84 F.4th at 1008; *see Redline Detection LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 448 (Fed. Cir. 2015) (no “bolstering deficiencies”).

While Petitioners claim that discovery from Mr. Black and Mr. Sigal is “readily possible” through an “ordinary process,” that process requires that it be “necessary in the interest of justice,” which it is not. *See supra*. Moreover, Petitioners seek discovery from not two, but ten or more third parties on this single issue, which underscores the improper and burdensome nature of their request.

III. CONCLUSION

Patent Owner respectfully requests denial of Petitioners’ motion.

Case IPR2023-00924

Patent No. 7,436,980

Dated: January 23, 2024

By: / Christine E. Lehman /
Christine E. Lehman
PTO Reg. No. 38,535
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that this Patent Owner's Opposition to Petitioners' Motion for Authorization to Compel Testimony and Production of Documents Under 37 C.F.R. § 45.52(a) complies with the type-volume limits of 37 C.F.R. § 42.24 and the Board's January 8, 2024 email and consists of no more than 10 pages, excluding the table of contents, table of authorities, certificate of service, and this certificate of compliance.

Dated: January 23, 2024

Respectfully submitted,

/Christine E. Lehman/

Christine E. Lehman

PTO Reg. No. 38,535

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Opposition to Petitioners' Motion for Authorization to Compel Testimony and Production of Documents Under 37 C.F.R. § 45.52(a) was served on January 23, 2024, via electronic mail to Meta_VideoLabs@kirkland.com, as agreed to by counsel for Petitioners, upon the following counsel:

W. Todd Baker
todd.baker@kirkland.com
KIRKLAND & ELLIS LLP
1301 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

Ellisen Shelton Turner
ellisen.turner@kirkland.com
KIRKLAND & ELLIS LLP
2049 Century Park East
Los Angeles, CA 90067

Jonathan D. Brit
jonathan.brit@kirkland.com
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022

Jennifer R. Bush
jbush@fenwick.com
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Telephone: (650) 988-8500

Dated: January 23, 2024

/Christine E. Lehman/
Christine E. Lehman