UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIANYANG BOE OPTOELECTRONICS TECHNOLOGY CO., LTD.; WUHAN CHINA STAR OPTOELECTRONICS SEMICONDUCTOR DISPLAY TECHNOLOGY CO., LTD.; TIANMA MICROELECTRONICS CO., LTD.; AND VISIONOX TECHNOLOGY, INC.,
Petitioner,

v.

SAMSUNG DISPLAY CO., LTD.
Patent Owner.

Case IPR2023-00941
U.S. Patent No. 7,414,599

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

INTRODUCTION

Pursuant to 37 C.F.R. § 42.51(b)(2) and the Board's authorization via Order Authorizing Filing of Motion for Additional Discovery, Paper 25, Patent Owner Samsung Display Co., Ltd. ("Samsung Display") moves the Board for additional discovery from Petitioner Mianyang BOE Optoelectronics Technology Co., Ltd. ("Mianyang BOE"). Samsung Display requests the Board order Mianyang BOE to produce specific Mianyang BOE documents (including Mianyang BOE internal documents and excerpts of Mianyang BOE interrogatory responses concerning factual information) and deposition transcripts of Mianyang BOE witnesses that were produced in parallel litigation before the U.S. International Trade Commission ("ITC") involving Samsung Display and Mianyang BOE (*In re Certain Active Matrix Organic Light-Emitting Diode Display Panels & Modules for Mobile Devices, & Components Thereof*, ITC Inv. No. 337-TA-1351), and that support arguments concerning objective indicia of nonobviousness for the challenged claims of U.S. Patent No. 7,414,599 ("the '599 Patent"). Samsung Display submits its proposed discovery request as Appendix A to this motion.

In parallel ITC litigation, as a defense to its infringement of the '599 Patent, Mianyang BOE argues that certain claims of the '599 Patent, which are also challenged claims in this proceeding, would have been obvious in view of prior art. In that litigation, the parties engaged in extensive discovery, including production of

documents from Mianyang BOE concerning evidence of objective indicia of nonobviousness. As part of its validity case in the ITC litigation, Samsung Display cited Mianyang BOE's own documents and witness testimony to demonstrate that numerous objective indicia, including copying, support the nonobviousness of the asserted claims.

IPR counsel for Samsung Display and Mianyang BOE met and conferred regarding Samsung Display's discovery request. Mianyang BOE's counsel requested that Samsung Display's IPR counsel work with Samsung Display's litigation counsel to compile a specific list of Mianyang BOE materials, identified by trial exhibit numbers, that had previously been cited and that Samsung Display would seek to be made available in the IPR proceeding to mitigate any burden of discovery. Samsung Display culled the set of such materials to 51 specific documents and transcripts it cited in briefing in the ITC litigation. These same Mianyang BOE materials, which Mianyang BOE produced in the ITC litigation pursuant to a protective order in that litigation, should be made available in this IPR proceeding, as Samsung Display and the Board would be prejudiced by an incomplete evidentiary record regarding the patentability of the challenged claims.

Samsung Display's discovery request for specifically identified, highly relevant documents that Mianyang BOE has already collected and produced in a parallel proceeding should be granted in accordance with *Garmin International, Inc.*

v. Cuozzo Speed Techs. LLC, IPR2012-00001, Paper No. 26 (March 5, 2013) (precedential). As discussed below, all of the *Garmin* factors weigh in favor of granting Samsung Display's targeted discovery requests, and discovery is in the interest of justice under 35 U.S.C. § 316(a)(5).

Indeed, the Board has regularly ordered discovery where the requesting party specifies targeted sets of documents from a parallel litigation, including before the ITC. For example, in *Apple Inc. v. Masimo Corp*, IPR2022-01465, Paper 23 at 4 (Mar. 17, 2023), the Board ordered production of 36 specified documents and hearing transcripts of five witnesses that had been relied on by patent owner in support of objective indicia arguments in a related ITC proceeding. *See also, e.g.*, *Kolbe & Kolbe Millwork Co. v. Sierra Pac. Indus.*, IPR2019-00933, Paper 33 at 3, 17 (Dec. 30, 2019) (granting "additional discovery concerning evidence relating to objective indicia of non-obviousness" including numerous documents such as sales records, 26 requests for admission, and an interrogatory); *Caterpillar Inc. v. Wirtgen Am., Inc.*, IPR2017-02188, Paper 18 at 2–3, 8 (Aug. 22, 2018) (granting discovery into "documents . . . identified by Exhibit Numbers assigned to the document in the related ITC proceeding" relating to "objective indicia of non-obviousness such as market power, customer demand for claimed features, nexus, and the motivation, intent, and opportunity to copy [patent owner's] technology"); *One World Techs., Inc. v. The Chamberlain Grp., Inc.*, IPR2017-00126, Paper 20 at 2, 7 (Dec. 15, 2017)

(granting discovery request for 10 documents produced in an ITC litigation relating to "copying as a secondary consideration of nonobviousness"); *Baker Hughes Inc. v. Lubrizol Specialty Prods., Inc.*, IPR2016-00734, Paper 44 at 3, 11–12 (Jan. 16, 2017) (granting discovery request for documents and deposition testimony from parallel district court litigation that "Patent Owner contends relate to Petitioner's copying . . ."); *Taylor Made Golf Co. v. Parsons Xtreme Golf, LLC*, IPR2018-00675, Paper 35 at 3–4, 7–8 (Dec. 20, 2018) (granting discovery for "documents [that] have already been produced in District Court litigation and already have been determined by Patent Owner to be relevant to the objective indicia of nonobviousness"); *Brunswick Corp. v. Cobalt Boats, LLC*, IPR2015-01060, Paper 20 at 2, 5–6 (Dec. 28, 2015) (granting discovery request for "documents [patent owner] seeks to introduce in this proceeding [that] are subject to a protective order in the related district court case, and cannot be used by Patent Owner in this proceeding without authorization from the Petitioner"); *Chevron N. Am., Inc. v. Milwaukee Elec. Tool Corp.*, IPR2015-00595, Paper 31 at 2, 4 (Oct. 30, 2015) (granting discovery request for "twelve documents that Patent Owner contends relate to secondary considerations of non-obviousness," that "were previously produced in related district court actions, and [patent owner's] litigation counsel have 'analyzed these documents and would have used them to support its secondary considerations position in the concurrent litigations'").

ARGUMENT

I. Garmin Factor 1 (More Than A Possibility And Mere Allegation)

This factor strongly favors granting the requested targeted discovery. As the Board has explained, a "[p]atent [o]wner's showing that the material sought would be 'favorable in substantive value to a contention of the party moving for discovery' is supported by the fact that [the] [p]atent [o]wner has relied upon the material in another forum for substantially similar purposes for which it is sought in this proceeding." *Apple*, IPR2022-01465, Paper 23 at 4 (quoting *Garmin*, IPR2012-00001, Paper 26 at 7). This is true even though the ITC protective order limits Samsung Display's counsel's ability to describe the requested documents in this motion. *See Baker Hughes Inc. v. LiquidPower Specialty Prods., Inc.*, IPR2016-01901, Paper 29 at 4–5 (Sept. 18, 2017) (granting additional discovery even though "it is unclear whether [movant] could say much" about the requested documents "[u]nder the restrictions of the district court protective order"). In particular, the Board has "not required that a party seeking additional discovery prove its contentions as a prerequisite for obtaining additional discovery." *Arris Grp., Inc. v. C-Cation Techs., LLC*, IPR2014-00746, Paper 15 at 3 (July 24, 2014) (citing *Garmin*, IPR2012-00001, Paper 26 at 8–9).

In the parallel ITC litigation, Samsung Display sought extensive discovery from Mianyang BOE over an approximately six month fact discovery period. This

included, for example, numerous depositions of Mianyang BOE fact witnesses, interrogatory responses (including multiple supplements), and email and document productions spanning over 600,000 pages. Through discussions with Mianyang BOE's counsel leading up to this motion, Samsung Display's counsel identified a narrow and specifically enumerated set of Mianyang BOE materials as having been relied upon in the ITC litigation in support of objective indicia of nonobviousness for the '599 Patent, including copying of Samsung Display's patented pixel circuits, and as having been identified as trial exhibits for the evidentiary hearing in that litigation.[1]

Thus, Samsung Display has shown beyond speculation that the requested materials are favorable in substantive value. *See Apple*, IPR2022-01465, Paper 23 at 7–8 ("Under the particular circumstances presented here, where the documents

[1] Samsung Display's counsel understands that many of the materials requested in Appendix A were originally produced by Mianyang BOE as partially or fully Chinese language documents, and that English translations of them are included along with the originals in the trial exhibits in the parallel ITC litigation. Thus, the page count of requested materials in Appendix A will reflect that many of the materials are found in duplicate form, once in their native language and a second time translated into English.

sought were produced and relied upon by the parties in the ITC Investigation pertaining to the same patent challenged here, we find sufficient Patent Owner's articulation of the usefulness of the documents sought for purposes of allowing additional discovery."); *Brunswick v. Cobalt Boats*, IPR2015-01060, Paper 20 at 3 (The first Garmin factor favored movant whose "contentions are based on firsthand knowledge of what the documents contain as a result of discovery in the related district court case.").

II. Garmin Factor 2 (Litigation Positions And Underlying Basis)

Samsung Display does not seek Mianyang BOE's litigation positions or the underlying basis. Rather, Samsung Display's discovery request seeks Mianyang BOE's internal documents, Mianyang BOE's responses to interrogatories seeking factual information, and deposition transcripts of Mianyang BOE's own witnesses. Samsung Display's goal is to ensure that a complete trial record regarding objective indicia of nonobviousness is available in this proceeding.

III. Garmin Factor 3 (Ability To Generate Equivalent Information By Other Means)

The sought-after discovery cannot reasonably be generated elsewhere. The requested materials are Mianyang BOE's own internal documents, fact interrogatory responses, and witness testimony, which are germane to objective indicia of nonobviousness including copying of the inventions of the '599 Patent. *See Telesign Corp. v. Twilio Inc.*, IPR2017-01976, Paper 22, at 5–6 (June 7, 2018) ("[W]e do not

see how Patent Owner can generate the information in Petitioner's internal documents regarding customer requests for Petitioner's products without the need for discovery."). Indeed, the Board has routinely granted motions for additional discovery under similar circumstances. *See, e.g.*, *id*.; *Apple*, IPR2022-01465, Paper 23 (granting additional discovery for documents under an ITC protective order); *Caterpillar*, IPR2017-02188, Paper 18 (same); *One World Techs*., IPR2017-00126, Paper 20 (same).

IV. Garmin Factors 4 & 5 (Requests Are Easily Understandable And Not Overly Burdensome)

Samsung Display's discovery request is easily understandable and not overly burdensome. During the February 7, 2024 teleconference with the Board, Mianyang BOE's counsel suggested that Samsung Display is seeking "district court-like discovery" with overly extensive or open-ended requests. Not so. As shown in Appendix A, Samsung Display is seeking specific, identified Mianyang BOE documents and deposition transcripts of Mianyang BOE's witnesses. This is an easily understandable request for targeted materials. Moreover, the documents sought are already in Mianyang BOE's counsel's possession, were already produced to Samsung Display in the parallel ITC litigation, and have been designated as trial exhibits in that litigation. *See Apple*, IPR2022-01465, Paper 23 at 4 ("Patent Owner shows that the requests are easily understandable and identify specific documents by their name, as filed in the ITC, including exhibit numbers.").

Additionally, there is no material burden on Mianyang BOE to make the same materials (which have already been collected and produced in the ITC litigation) available in this proceeding. *See id*. (finding patent owner's request to "pose little burden to Petitioner as they are clearly identified documents in Petitioner's possession that do not require any searching to locate").

Finally, any concerns by Mianyang BOE to ensure confidential treatment of its internal documents would be adequately met in this proceeding, as the parties have agreed in principle to a protective order that is commensurate in scope with the protective order in the parallel ITC proceeding. Thus, "[t]here is simply no basis for Petitioner, having sought *inter partes* review, to now argue [the Board] should restrict Patent Owner from obtaining and asserting evidence that supports its positions, including evidence of objective indicia of nonobviousness, regardless of whether that evidence pertains to Petitioner's 'highly sensitive . . . data.'" *Id.* at 7.

CONCLUSION

Samsung Display has shown that the proposed additional discovery is "necessary in the interest of justice" under 35 U.S.C. § 316(a)(5). The motion should be granted.

Date: February 9, 2024

Respectfully submitted,

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APPENDIX A (REQUEST FOR PRODUCTION)

Patent Owner Samsung Display Co., Ltd. requests that Petitioner Mianyang BOE Optoelectronics Technology Co., Ltd. produce the following trial exhibits from *Certain Active Matrix Organic Light-Emitting Diode Display Panels & Modules for Mobile Devices, & Components Thereof*, ITC Inv. No. 337-TA-1351, for use in this proceeding, within one week of the order granting the motion for additional discovery: CX-0032C; CX-0054C; CX-0084C; CX-0091C; CX-0093C; CX-0095C; CX-0098C; CX-0100C–CX-0102C; CX-0107C–CX-0111C; CX-0117C; CX-0119C; CX-0121C; CX-0125C; CX-0126C; CX-0130C–CX-0132C; CX-0136C; CX-0138C; CX-0142C; CX-0146C–CX-0148C; CX-0151C; CX-0154C; CX-0155C; CX-0158C; CX-0160C; CX-0165C; CX-0189C; CX-0194C; CX-0232C; CX-0269C; CX-0294C; CX-0337C; CX-0339C; CX-1464C.6–11; CX-1517C.2–3; CX-1524C.9–10; CX-1606C–CX-1608C; CX-1620C; CX-1622C.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Patent Owner's Motion for Additional Discovery was served by electronic mail on the following counsel of record for petitioner:

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Date: February 9, 2024

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