

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.

IPR2023-00941
Patent 7,414,599 B2

Before JAMESON LEE, TERRENCE W. McMILLIN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

We instituted *inter partes* review on December 15, 2023. Paper 12. With our authorization, Patent Owner filed a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2). Paper 26 (hereinafter “Motion” or “Mot”). Petitioner filed an Opposition to Patent Owner’s Motion for Additional Discovery. Paper 28 (hereinafter “Opposition” or “Opp.”). The Motion identifies the information sought as follows:

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.

Mot. 1 (emphasis added). Appendix A provides a list of trial exhibit numbers from the above-identified related proceeding before the ITC. Mot. App. A.

Patent Owner represents that this set of materials consists of “51 specific documents and transcripts it cited in briefing in the ITC litigation.” *Id.* at 2. Patent Owner further represents: “As part of its validity case in the ITC litigation, [Patent Owner] *cited* Mianyang BOE’s own documents and witness testimony to demonstrate that numerous objective indicia, including copying, support the nonobviousness of the asserted claims.” Mot. 2 (emphasis added). The ITC briefings including such citations, however,

have not been provided as a part of the Motion. It is also undisputed that Patent Owner already is in possession of all the materials it seeks by this Motion for Additional Discovery.

On February 21, 2024, Patent Owner sent an email communication to the Board, stating: “Patent Owner has agreed to withdraw its request for deposition transcripts of Petitioner Mianyang BOE’s witness (i.e., CS-1606C, CX-1607C, CX-1608C, CX-1620C, and CX-1622C) from parallel litigation before the U.S. International Trade Commission (Inv. No. 337-TA-1351).” Ex. 3001. In a further email communication, and responding to a request for information from the Board, Patent Owner indicates that after its partial withdrawal of the request, the number of requested documents is 45 and the total number of requested pages still exceed 5,000 pages. Ex. 3002.

For reasons discussed below, the Motion is *denied*.

II. DISCUSSION

A. 37 C.F.R. § 42.51(b)(2)(i)

Section 42.51(b)(2)(i) of Title 37, Code of Federal Regulations, provides:

(2) *Additional discovery*. (i) The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interest of justice, except in post-grant reviews where additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding (*see* § 42.224). The Board may specify conditions for such additional discovery.

37 C.F.R. § 42.51(b)(2)(i); *see also* 35 U.S.C. § 316(a)(5) (“discovery shall be limited to . . . what is otherwise necessary in the interest of justice”).

The Board has set forth specific factors to be considered in determining whether additional discovery in an *inter partes* review is “necessary in the interest of justice”:

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.
2. Litigation Positions And Underlying Basis -- Asking for the other party’s litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.
3. Ability To Generate Equivalent Information By Other Means -- Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.
4. Easily Understandable Instructions -- The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is *prima facie* unclear. Such instructions are counter-productive and tend to undermine the responder’s ability to answer efficiently, accurately, and confidently.
5. Requests Not Overly Burdensome To Answer -- The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests

should be sensible and responsibly tailored according to a genuine need.

Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC, IPR2012-00001, Paper 26 at 6–7 (PTAB March 5, 2013) (precedential).

B. Analysis

Patent Owner asserts that “all of the *Garmin* factors weigh in favor of granting [Patent Owner’s] targeted discovery requests, and discovery is in the interest of justice under 35 U.S.C. § 316(a)(5).” Mot. 5. For reasons discussed below, we disagree. We determine that *Garmin* Factors 1, 3, and 5 each weigh very strongly against granting the Motion, and that *Garmin* Factors 2 and 4 each weigh toward granting the Motion. As a whole, considering all of the *Garmin* factors holistically, we conclude Patent Owner has not shown that granting the Motion would be in the interest of justice.

1. Garmin Factor 1

As noted above, *Garmin* Factor 1 is:

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*.

Garmin, Paper 26, at 6 (emphasis added). In *Garmin*, the Board explained the meaning of “useful” in the context of Factor (1): “In the context of Factor (1), ‘useful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7.

Patent Owner explains: “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.” Pet. 2 (emphasis added). Patent Owner further notes that the documents it now seeks from Petitioner are already a subset of such material previously cited by Patent Owner in the ITC litigation. *Id.*

Patent Owner’s reasoning based on mere previous citation by Patent Owner’s ITC counsel in briefing before the ITC is vague and tenuous. For its Motion, Patent Owner has not provided the Board, for example, a copy of its briefing before the ITC, in which citations are made to the requested material, or quotations of content in such briefing, to show the manner of alleged support for contentions regarding objective evidence of nonobviousness.

In essence, we are asked simply to trust Patent Owner that it is not mere speculation that the requested material, if produced, will be useful under *Garmin* Factor 1 for Patent Owner to present objective evidence of nonobviousness in this proceeding. We decline to do so, as we must make our own assessment in that regard, and not just adopt Patent Owner’s “self-serving” assessment that is not backed by any reviewable evidence. *See, e.g., Silicon Labs. Inc. v. Cresta Tech. Corp.*, IPR2014-00728, Paper 27, at 3 (PTAB Dec. 10, 2014) (“Patent Owner has not offered any evidence from which [the Board] can assess the accuracy of its contentions.”); *Dynamic Air Inc. v. M-I Drilling Fluids UK Ltd.*, IPR2016-00260, Paper 39, at 6 (PTAB Nov. 30, 2016) (Patent Owner is asking the Board to “accept at face value the representation of its litigation counsel that the requested documents are ‘[useful] to disputed issues in these IPR proceedings.’”); *Duncan Parking Techs., Inc. v. IPS Grp., Inc.*, IPR2016-00067, Paper 18, at 3 (PTAB Sept. 27, 2016) (the movant for additional discovery did not provide

substantive analysis and the Board found such lack of analysis “problematic in meeting the ‘interest of justice’ standard.”).

To the extent that some of the Board cases cited by Patent Owner on pages 3–4 of the Petition take the word of Patent Owner’s litigation counsel at face value as sufficient for satisfaction of *Garmin* Factor 1, they are non-precedential decisions by which we are not bound. *E.g., Kolbe & Kolbe Milwork Co. v. Sierra Pac. Indus.*, IPR2019-00933, Paper 33, at 3, 17 (PTAB Dec. 30, 2019); *Caterpillar Inc. v. Wirtgen Am., Inc.*, IPR2017-02188, Paper 18, at 2–3, 8 (PTAB Aug. 22, 2018); *Taylor Made Golf Co. v. Parsons Xtreme Golf, LLC*, IPR2018-00675, Paper 35 at 3–4, 7–8 (PTAB Dec. 20, 2018); *Brunswick Corp. v. Cobalt Boats, LLC*, IPR2015-01060, Paper 20 at 2, 5–6 (Dec. 28, 2015); *Chevron N. Am., Inc. v. Milwaukee Elec. Tool Corp.*, IPR2015-00595, Paper 31 at 2, 4 (Oct. 30, 2015).

Also, we find Patent Owner’s own assessment of its requested discovery to be unacceptably vague. We cannot ascertain from Patent Owner’s showing whether all 5,000 plus pages of the requested material were specifically cited in Patent Owner’s ITC briefing. It may be that Patent Owner regards a document including hundreds of pages as “cited” when only several pages of the hundreds of pages were actually specifically cited. Pertinence of a few pages of a document among hundreds of pages does not necessarily justify producing the entire document. Such over-inclusiveness would be inappropriate under *Garmin* Factor 1. Given that Patent Owner’s motion fails to explain this aspect of its request, we find that this circumstance undermines Patent Owner’s showing for *Garmin* Factor 1.

Patent Owner cites *Apple v. Masimo Corp.*, IPR2022-01465, Paper 23 (PTAB March 17, 2023), as supporting its Motion. Mot. 3. We disagree.

Apple is distinguishable from the circumstance here because, in *Apple*, there was already a public ITC ruling that partially upheld the validity of the involved patent because of the patent owner's reliance on the requested material as objective evidence of nonobviousness. Here, in contrast, there has been no such favorable ruling from the ITC for Patent Owner. We additionally note that "the ITC's Office of Unfair Import Investigations ('OUII') has evaluated PO's secondary-consideration argument and concluded that it 'does not believe that the alleged secondary considerations affect the obviousness analysis.'" Opp. 3–4 (citing Ex. 1022, 17). Given the OUII's role as an independent third party that represents the public interest (*see id.* at 4), the OUII's position suggests that the requested discovery would not uncover useful information for this proceeding.

For the foregoing reasons, *Garmin* Factor 1 weighs very strongly against granting the Motion for Additional Discovery.

2. *Garmin* Factor 3

As noted above, *Garmin* Factor 3 is:

3. Ability To Generate Equivalent Information By Other Means – Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.

Garmin, Paper 26, at 6.

Patent Owner asserts: "The sought-after discovery cannot reasonably be generated elsewhere." Mot. 7. Yet Patent Owner acknowledged to the Board that it is already in possession of all of the requested material. Paper 25, 2. Thus, Patent Owner has no need to discover the requested materials. Rather, Patent Owner's request for production merely is a device

to avoid the restrictions of an ITC protective order that precludes Patent Owner from using the material in this *inter partes* review proceeding. *Id.* Because the restrictions stem from the ITC, Patent Owner may go back to the ITC to seek a modification of the protective order to permit Patent Owner to use the information in this proceeding. The parties also may propose a protective order in this proceeding to govern the submission of any confidential information that might be submitted. *See* 37 C.F.R. § 42.54.

Importantly, Patent Owner apparently has not attempted to seek a modification of the ITC’s protective order. Instead, during a telephone conference with the Board on February 7, 2024, counsel for Patent Owner indicated that Patent Owner believes coming to the Board in the first instance is the best course of action. We disagree.

Accordingly, *Garmin* Factor 3 weighs very strongly against granting the Motion for Additional Discovery.

3. *Garmin Factor 5*

As noted above, *Garmin* Factor 5 is:

5. Requests Not Overly Burdensome To Answer -- The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests should be sensible and *responsibly tailored according to a genuine need*.

Garmin, Paper 26, at 6–7 (emphasis added).

Patent Owner argues that the discovery it seeks has already been produced by Petitioner in the ITC proceeding, so Petitioner would not be burdened by its requests. Mot. 8–9. Nevertheless, as explained above, we find that Patent Owner fails to show that its requests are “responsibly

tailored according to a genuine need.” Patent Owner already possesses the requested discovery, so we find that Patent Owner fails to establish a genuine need.

Accordingly, *Garmin* Factor 5 weighs against granting the Motion for Additional Discovery.

4. *Garmin* Factors 2 and 4

With regard to *Garmin* Factor 2, it is undisputed that Patent Owner does not seek Petitioner’s litigation positions and the underlying basis for those positions. Opp. 7. This factor weighs toward granting the Motion for Additional Discovery.

With regard to *Garmin* Factor 4, Petitioner does not contend that Patent Owner’s instructions are not easily understandable. Opp. 8. We find that the instructions are easily understandable. This factor weighs toward granting the Motion for Additional Discovery.

C. *Conclusion*

We have considered the present circumstances in light of all of the *Garmin* factors, holistically, and find that Patent Owner has not shown that granting the Motion for Additional Discovery would be in the interest of justice.

III. ORDER

Patent Owner’s Motion for Additional Discovery is *denied*.

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