

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN PINCAN TECHNOLOGY CO., LTD,
Petitioner

v.

THE RIDGE WALLET LLC
Patent Owner

Case IPR2024-00340
Patent 10,791,808

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

CASE NO. IPR2024-00340
PO MOTION FOR ADDITIONAL DISCOVERY

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Declaration of Gina A. Johnson
Ex. 2002	Deposition Transcript from Deposition of Chunmei Peng
Ex. 2003	Deposition Transcript from Deposition of Dr. Kimberly Cameron
Ex. 2004	Transcript from June 21, 2023 <i>Markman</i> hearing in USITC Case No. 337-TA-1355
Ex. 2005	Ridge's Answer and Affirmative Defenses to Mosaic's Second Amended Complaint and Counterclaim for Patent Infringement in Case No. 2:20-cv-04556-AB-JC in the Central District of California, dated November 12, 2020
Ex. 2006	Declaration of Dr. Kimberly K. Cameron Regarding Claim Construction of the '808 Patent in USITC Case No. 337-TA-1355
Ex. 2007	Patent Owner's Additional Discovery Requests
Ex. 2008	Expert Report of Kimberly K. Cameron, Ph. D. regarding Invalidity of U.S. Patent No. 10,791,808 in USITC Case No. 337-TA-1355
Ex. 2009	Joint Stipulations for Dismissal in Case No. 2:20-cv-04556-AB-JC in the Central District of California.

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Pursuant to the Board's April 5, 2024 email authorization, Patent Owner

The Ridge Wallet LLC ("Patent Owner") hereby submits this motion for additional discovery from Petitioner Shenzhen Pincan Technology Co., Ltd. ("Petitioner") as shown in Ex. 2007. Patent Owner seeks information to indicate whether a time-barred party, Mosaic Brands Inc. d/b/a Storus ("Storus") is in fact a real party-in-interest in this matter.

I. Introduction

Patent Owner and Petitioner were involved in Investigation No. 337-TA-1355 in the United States International Trade Commission that recently resulted in a Final Initial Determination finding Petitioner to be in violation of Section 337 of the Tariff Code (the "ITC Case"). Germane to this Motion, one of the respondents in the ITC Case was a company called Mosaic Brands Inc. d/b/a Storus ("Mosaic"); Mosaic's one-year bar date to file an IPR had long since passed by the time the ITC Case was even filed, much less by the time this IPR was filed.

Mosaic and Petitioner were in a joint defense group, and participated together in activities in defense of the ITC Case before Mosaic settled out in the summer of 2023. These activities included pursuing common invalidity defenses based on testimony from Petitioner's expert here, Dr. Kimberly K. Cameron. Ridge seeks additional discovery here to explore the relationship between Mosaic and Petitioner.

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The Board applies the five Garmin factors to determine whether discovery is “in the interests of justice” under 37 C.F.R. § 42.51(b)(2)(i). *Garmin Int’l v. Cuozzo Speed Tech.* IPR2012-00001, Paper 26, 6–7 (PTAB Mar. 5, 2013) (precedential). The Garmin factors strongly support Patent Owner’s motion and thus additional discovery is warranted under 37 C.F.R. § 42.51(b)(2)(i), and the Board has previously granted similar discovery requests. *See Samsung Electronics Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222, Paper 44 (PTAB August 22, 2023); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031, Paper 50 (PTAB August 11, 2023); *Netflix, Inc. v. VL Collective IP LLC*, IPR2023-00891, Paper 26 (PTAB March 24, 2024).

Here, the requested discovery is likely to yield additional evidence that Mosaic should have been named an RPI in the instant IPR, thereby rendering this IPR time-barred under 35 U.S.C. § 315(b). In particular, the requested discovery is likely to indicate that Mosaic “exercised or could have exercised control over [Petitioner’s] participation in [this IPR] proceeding.” Trial Practice Guide (Nov. 2019) at 15.

The Board need not resolve this control/real party-in-interest argument to grant the requested discovery. The requested discovery is warranted if it supports any of the arguments. It does and should thus be granted.

II. Background

Ridge filed the ITC Case in early 2023, but Ridge and Mosaic were embroiled in litigation long before the ITC Case. In particular, Mosaic sued Ridge in 2020 in the Central District of California, and on November 12, 2020, Ridge countersued Mosaic for infringement of U.S. Patent No. 10,791,808 (“‘808 Patent”). *See* Ex. 2005. Thus, Mosaic became time barred from filing an IPR challenging the validity of the ‘808 Patent as of November 13, 2021.

Petitioner filed the instant Petition on January 2, 2024, long after the one-year bar date that attached to Mosaic by virtue of Ridge’s November 12, 2020 assertion of the ‘808 Patent against Mosaic. *See* Paper 1.

Patent Owner seeks discovery to show that Mosaic is a real party in interest (RPI) in the instant IPR by virtue of its work with Petitioner in defense of the ITC Case.

Apart from issues specific to Mosaic, it is likely true that at least one party—Shenzhen Swztech Co. Ltd. (“Swztech”)—is a real party-in-interest here but is not properly named. Dr. Cameron was retained by and wrote an expert declaration for Swztech in the ITC Case. Ex. 1003 (Cameron IPR Declaration); Ex. 2006 (Cameron Claim Construction Declaration in ITC Case). During her deposition on that declaration, Dr. Cameron testified that she was in the process of preparing an invalidity analysis based on prior art, but that at that time, she was not yet finished.

Ex. 2003 at 21:11-20. And when she submitted her expert report on invalidity in the ITC Case, she also did so on behalf of Swztech. Ex. 2006 at ¶ 4. Dr.

Cameron's report in the ITC Case is very similar (and nearly identical in terms of theories) to the declaration she submitted in this case. Compare Ex. 1003 with Ex. 2006. And Swztech's counsel in the ITC Case was the same law firm as is representing the Petitioner here.

This indicates that Petitioner was not careful in identifying real parties in interest in the Petition, having failed to name at least Swztech as a real-party-in-interest. And as explained below, the *Garmin* factors support the additional discovery Petitioner requests here relating to Mosaic Brands Inc. d/b/a Storus, which Patent Owner suspects will identify another, un-named, real party-in-interest.

III. Garmin Factor 1: Whether There Is More Than A Possibility And Mere Allegation That Useful Information Will Be Found

A. Additional discovery is appropriate to determine if Mosaic is a real-party-in-interest in this IPR

The first Garmin factor states that “[t]he party requesting discovery should already be in possession of evidence” or reasoning “tending to show beyond speculation that in fact something useful will be uncovered.” *Garmin*, Paper 26 at 6. “[U]seful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7.

Here, the contention of the party moving forward is that Mosaic, an unnamed real party in interest, is statutorily barred from filing an IPR. Thus, by virtue of being a real party in interest, the instant Petition is time-barred and should be dismissed.

Determining whether a party is an RPI is a fact-dependent question. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.”); *Unified Patents, LLC v. Memoryweb, LLC*, IPR2021-01413, Paper 76 at 5 (PTAB May 22, 2023). The PTAB Consolidated Trial Practice Guide states that “the ‘real party-in-interest’ is the party that desires review of the patent. Thus, the ‘real party-in-interest’ may be . . . the party or parties at whose behest the petition has been filed.” Trial Practice Guide (Nov. 2019) at 14.

Here, Mosaic would have desired an IPR, as it was an accused infringer of the ‘808 Patent. In fact, it participated in a district court case in which it was an accused infringer of the ‘808 Patent through Federal Circuit reversal/remand of an appeal in the Central District of California. And Mosaic was in a joint defense group with the Petitioner (and another party) at the point in time at

which Dr. Cameron testified that she was working on her invalidity expert report. Ex. 2003 at 21:11-20. Indeed, Mosaic did not settle with Ridge until more than two (2) months after Dr. Cameron so testified. Ex. 2009. Notably, that settlement occurred approximately two weeks before Dr. Cameron issued her voluminous invalidity expert report in the ITC Case. Ex. 2008. Throughout that activity in the ITC Case, Mosaic was also accused of infringing the ‘808 Patent in the pending case between Patent Owner and Mosaic in the Central District of California. Mosaic never retained its own expert (at least to Patent Owner’s knowledge) in either the ITC Case or the California case, lending credence to the idea that it was working with Dr. Cameron.

In addition, the evidence of record demonstrates that Petitioner’s corporate representatives were aware of the principles of Mosaic, lending further credence to the idea that counsel for Petitioner was speaking with counsel for Mosaic about their common defenses. Petitioner’s corporate representative testified that she had heard of Mosaic, and was familiar with Mia Kaminski, the principal at Mosaic. Ex. 2002 at 55:10-15. She was aware that Ms. Kaminski has a patent (*id.*), indicating that her awareness very likely came because of the common patent infringement litigation with Ridge. Petitioner’s corporate representative was also familiar with Storus, the brand name by which Mosaic sells compact wallet products. Ex. 2002 at 53:25-54:2; *see also* Ex. 2005 at

Caption (identifying Storus as the “d/b/a” name for Mosaic Brands Inc.).

Finally, at the Markman hearing in the ITC case, a lawyer at the law firm representing Petitioner here (Glacier Law LLP) represented, on the record, that he had had a telephone conversation with Mosaic’s counsel (one that would be relevant and responsive to the discovery requests submitted here as Ex. 2007), in which Mosaic’s counsel sought to join Petitioner’s claim construction positions (and to thereby adopt the expert testimony of Dr. Cameron, Petitioner’s expert in this IPR). Ex. 2004 at 13:21-14:1.

Since Mosaic was an accused infringer in both California and the ITC Case, was in a joint defense group with Petitioner’s counsel here (and also with the party that retained Dr. Cameron for claim construction opinions and for opinions about invalidity based on prior art), and never retained its own expert regarding invalidity, there is strong circumstantial evidence suggesting that Mosaic may have controlled, or at least had the right to control, the contents of Dr. Cameron’s opinions regarding invalidity and the Petition in this case based on the same. There is little reason why Petitioner would wish to avoid estoppel, while it would greatly benefit Mosaic (since it was estopped as of the date of filing of the ITC Case).

Additional evidence is likely to show that Mosaic controlled, or could have controlled, the contents of the expert opinions from Dr. Cameron (and thus

the contents of the instant petition).

B. Finding That Mosaic Was An RPI Would Have Substantive Value

In the event the Board finds that Mosaic is a real party in interest, this proceeding can be dismissed as time barred. 35 U.S.C. § 315(b). This substantive value warrants the ordering of Petitioners responses to the relatively unintrusive requests for discovery submitted herewith. Ex. 2007.

IV. Garmin Factor 2: Whether The Discovery Seeks Litigation Positions

The requested discovery does not seek Petitioner's litigating positions or basis. It simply seeks to understand the nature of the relationship between Petitioner and Mosaic as co-defendants in the ITC Case.

V. Garmin Factor 3: The Movant's Ability To Generate Equivalent Information By Other Means

Patent Owner cannot generate equivalent information by other means. *Garmin*, Paper 26 at 6. The discovery requested in Ex. 2007 is in the possession of Petitioner, and its counsel, is not publicly available, and Petitioner has refused to provide it.

Indeed, even though Patent Owner is in litigation with Mosaic in California regarding Mosaic's breach of the parties' settlement agreement, Mosaic is represented by different counsel than represented it in the ITC Case. And in all likelihood, communications between Petitioner and Mosaic would have been through Mosaic's then counsel of record and Petitioner's counsel of

record here (as reflected in Petitioner’s counsel’s comments during the ITC Case Markman hearing). The Board has previously allowed supplemental information when the possessing party opposes the request. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 447 (Fed. Cir. 2015); *see also Glob. Shade Corp. v. with-U E-Com. (Shanghai) Co., Ltd.*, No. IPR2021-00365, Paper 36 at 92 (PTAB July 25, 2022).

VI. Garmin Factors 4 and 5: Whether The Requests Are Easily Understandable And Whether The Requests Are Overly Burdensome

The requested discovery is easily understandable and not overly burdensome. The requests merely seek information about whether and (to the extent not privileged) the nature of any communications between Mosaic and Petitioner with regard to issues of patent validity.

VII. Conclusion

For the reasons stated above, the Garmin factors strongly support Patent Owner’s motion, and thus, additional discovery should be granted.

Date: April 12, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 12, 2024, I caused a true and correct copy of the foregoing to be served electronically on the following counsel of record for Petitioner at the following email addresses:

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