

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.

IPR2024-00340
Patent 10,791,808 B2

Before WILLIAM V. SAINDON, JASON W. MELVIN, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*, for the Board;
SAINDON, *Administrative Patent Judge*, concurring.

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

INTRODUCTION

Pursuant to our authorization, The Ridge Wallet LLC (“Patent Owner”) filed a Motion for Additional Discovery on April 12, 2024 (Paper 13, “Mot.” or “Motion”). Shenzhen Pincan Technology Co., Ltd. (“Petitioner”) filed an Opposition to the Motion on April 25, 2024 (Paper 15, “Opp.”). We *deny* the Motion.

Patent Owner seeks discovery from Petitioner indicating whether Mosaic Brands Inc. d/b/a Storus (“Mosaic”) is a real party-in-interest (“RPI”) in this proceeding. Mot. 1; Ex. 2007. Patent Owner asserts that Petitioner and Mosaic were in a joint defense group in the related U.S. International Trade Commission Investigation No. 337-TA-1355 (the “ITC case”), and that the requested discovery regarding that relationship “is likely to yield additional evidence that Mosaic should have been named an RPI in the instant IPR.” Mot. 1–2. According to Patent Owner, if Mosaic were deemed an RPI, it would “render[] this IPR time-barred under 35 U.S.C. § 315(b).” *Id.* at 2. Specifically, Mosaic sued Patent Owner in 2020 in the Central District of California, and Patent Owner then countersued on November 12, 2020, asserting infringement of U.S. Patent No. 10,791,808 B2 (“the ’808 patent”), and so the one-year bar date had passed when the current Petition was filed. *Id.* at 3.

DISCUSSION

Consistent with Congressional intent that *inter partes* review be a quick and cost-effective alternative to litigation, discovery in *inter partes* review is less expensive than that typically available in district-court patent litigation. *See* H. Rep. No. 112-98 at 45–48 (2011). The legislative history of the Leahy-Smith America Invents Act makes clear that additional discovery should be confined to “particular limited situations, such as minor

discovery that [the Office] finds to be routinely useful, or to discovery that is justified by the special circumstances of the case.” 154 Cong. Rec. S9982, S9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). “Given the time deadlines imposed on these proceedings, it is anticipated that . . . [the Office] will be conservative in its grants of discovery.” *Id.* at S9988–S9989.

Under 35 U.S.C. 316(a)(5), discovery is available for the deposition of witnesses submitting affidavits or declarations and for “what is otherwise necessary in the interest of justice.” Patent Owner, as the movant, bears the burden of demonstrating that additional discovery is “in the interest of justice.” *See* 37 C.F.R. §§ 42.20(c), 42.51(b)(2). The Board identified factors important in determining whether a discovery request meets the statutory and regulatory standard of being “in the interest of justice” in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, Paper 26, 6–7 (PTAB, Mar. 5, 2013) (precedential). We address below the parties’ arguments concerning each of the five *Garmin* factors.

1. More Than a Possibility and Mere Allegation

Under the first *Garmin* factor, “[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, Patent Owner argues that the requested discovery would be useful regarding Patent Owner’s contention that Mosaic is an RPI in this proceeding. *See* Mot 4–8. The Board handles RPI questions “on a case-by-case basis taking into consideration how courts have viewed” the term “real party-in-interest.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 13 (84

Fed. Reg. 64,280 (Nov. 21, 2019)) (“CTPG”).¹ In general, an RPI is “the party that desires review of the patent,” which may be the Petitioner, as well as “the party or parties at whose behest the petition has been filed.” *Id.* at 14. One factor that may be considered in evaluating whether a non-party is an RPI is “whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.* at 16 (citing *Taylor v. Sturgell*, 553 U.S. 880, 895 (2008)).

Patent Owner asserts that Mosaic would have desired *inter partes* review of the ’808 patent, having been accused of infringement. Mot. 5. Further, Patent Owner asserts that while Mosaic was in the joint defense group with Petitioner in the ITC case, “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. [Kimberly] Cameron,” who was retained by the other parties in the ITC case and is Petitioner’s expert in this proceeding. *Id.* at 6. In addition, Patent Owner asserts that Mosaic sought to join Petitioner’s claim construction positions in the ITC case, which were based on Dr. Cameron’s testimony. *Id.* at 7. This, Patent Owner argues, provides “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.” *Id.*

Patent Owner also alleges that certain knowledge on behalf of Petitioner regarding Mosaic is relevant to the RPI inquiry, including that “Petitioner’s corporate representatives were aware of the princip[al]s of Mosaic,” “Petitioner’s corporate representative testified that she had heard

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

of Mosaic, and was familiar with Mia Kaminski, the principal at Mosaic,” and “was aware that Ms. Kaminski has a patent,” and that “Petitioner’s corporate representative was also familiar with Storus, the brand name by which Mosaic sells compact wallet products.” Mot. 6.

We find that Patent Owner has not established there is more than a possibility or mere allegation that the requested discovery will yield useful information. Patent Owner provides no basis for seeking additional discovery beyond mere speculation. Patent Owner’s assertion that Petitioner and Mosaic were in a joint defense group in the ITC case—a characterization Petitioner challenges (Opp. 4 (“[I]t is a fact that PINCAN has never signed any joint defense agreement with Mosaic, nor are they part of a joint defense group.”))—is not enough to justify the requested discovery, as the Board does not consider such an arrangement, without other pertinent facts bearing on the relationship between a Petitioner and non-party, to necessarily substantiate a non-party’s status as an RPI. *See* CTPG, at 17 (“[I]f Party A is part of a Joint Defense Group with Party B in a patent infringement suit, and Party B files a PGR petition, Party A is not a ‘real party-in-interest’ or a ‘privy’ for the purposes of the PGR petition based solely on its participation in that Group. . . . [D]eeper consideration of the facts in the particular case is necessary to determine whether Party A is a ‘real party-in-interest’ or a ‘privy’ of the petitioner.”). Patent Owner has not provided the evidence or reasoning required to show that such facts bearing on the RPI question, aside from the mere existence of an alleged joint defense group in the ITC case, would be uncovered by Patent Owner’s requested discovery.

Patent Owner’s assertion that Mosaic’s choice not to retain its own expert in either the California case or ITC case suggests some control of Dr.

Cameron's testimony and the Petition in this proceeding (*see* Mot. 5–7) is mere conjecture, and does not tend to show that anything useful will result from the requested discovery regarding the RPI question. As Petitioner persuasively argues, “[n]o reasonable person, let alone the petitioner, would believe Dr. Cameron would have the inclination to work or collaborate with Mosaic, an entity that does not compensate her, or be under its control.” Opp. 3.

Further, Patent Owner's attribution to Petitioner of certain knowledge regarding Mosaic and its business does not tend to show additional discovery would lead to evidence regarding a relationship between Petitioner and Mosaic probative of Mosaic's status as an unnamed RPI in this proceeding. Rather, Patent Owner merely lists facts about Mosaic (*see* Mot. 6–7) that Petitioner would have reasonably been expected to learn having been competitors in the same field and having been involved in the same litigation, without having had a relationship that would lead to Petitioner acting at the behest of Mosaic. *See* Opp. 3–4 (“Even if, as the PO states, lawyers of two defendants in a litigation discussed their views on the case after becoming acquainted, this is a normal and mundane event”); *id.* at 4 (“Both PINCAN and Mosaic sell wallet products, and it is normal in a market like Amazon to be aware of competitor brands or personnel.”).

In short, Patent Owner has not proffered evidence or reasoning that there is anything useful to discover regarding the RPI question as premised on Mosaic's status as a co-defendant of Petitioner in the ITC case, or on discussions between Petitioner and Mosaic pertaining to that litigation. Therefore, we find that this factor weighs against Patent Owner's request.

2. Litigation Positions and Underlying Basis

Patent Owner asserts that “[t]he requested discovery does not seek Petitioner’s litigating positions or basis.” Mot. 8. Instead, “[i]t simply seeks to understand the nature of the relationship between Petitioner and Mosaic as co-defendants in the ITC Case.” *Id.* Petitioner does not dispute Patent Owner’s contention as to this factor. *See Opp.* Therefore, this factor favors Patent Owner’s request.

3. Ability to Generate Equivalent Information by Other Means

Patent Owner argues that the requested discovery “is in the possession of Petitioner, and its counsel, is not publicly available, and Petitioner has refused to provide it.” Mot. 8 (citing Ex. 2007). Moreover, Patent Owner asserts that even though it is currently engaged in litigation with Mosaic, the pertinent communications for which Patent Owner seeks discovery would have been between Mosaic’s prior counsel in the ITC case and Petitioner’s counsel in this proceeding. *Id.* at 8–9.

Petitioner argues that insofar as the requested discovery pertains to “communications between Mosaic and the Petitioner concerning issues of patent validity,” “they can be directly or indirectly obtained through Dr. Cameron’s expert report or the ’340 IPR petition, rather than requiring additional disclosure.” *Opp.* 5. Further, Petitioner argues that Patent Owner can obtain information on alleged communications between Petitioner and Mosaic in Patent Owner’s current litigation with Mosaic. *Id.* at 6.

We find Petitioner has the better position on this issue. Another factor to consider is whether a request for additional discovery shows what efforts the moving party made to acquire, on its own, any of the requested discovery it now seeks. *Garmin*, Paper 26, 13–14. Based on the record before us, we do not know what efforts Patent Owner made to acquire any of the items it

seeks to retrieve from Petitioner through correspondence with Dr. Cameron or directly with Mosaic.

Therefore, this factor weighs in favor of not granting Patent Owner's request for additional discovery.

*4. Easily Understandable Instructions and
Not Overly Burdensome to Answer*

Patent Owner asserts that “[t]he requested discovery is easily understandable and not overly burdensome,” and that it “merely seek[s] 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.” Mot. 9.

Petitioner argues that “PO’s requests for production and deposition are particularly overbroad and would require PINCAN to expend its limited in-house resources to undertake a burdensome search and potentially provide a witness for a four-hour deposition that is unlikely to yield any substantive value.” Opp. 7. According to Petitioner, Patent Owner’s “requests have no connection with the [Patent Owner]’s basis for their motion that whether Mosaic is the RPI. Even though there are some communication between Mosaic and PINCAN (in fact, there is not), such communication also cannot prove [Petitioner]’s relationship with Mosaic.” *Id.* at 6.

We find Petitioner has the better position on this issue. Although Patent Owner’s instructions appear not to be overly complex, other facts affecting the determined clarity of Patent Owner’s instructions here include the speculative nature of the discovery sought (relating to *Garmin* factor 1) and the breadth of discovery sought (relating to *Garmin* factor 5). *See Google LLC v. Cywee Group LTD*, IPR2018-01257 and IPR2018-01258, Paper 30, 9 (PTAB June 20, 2019) (litigation-style request for broad

categories of documents support a lack of clarity and overly burdensome request for discovery). Because Patent Owner is not aware of any specific evidence that might be discovered, i.e., it is speculating that such evidence might exist, its instructions and discovery requests are necessarily broad, e.g., covering all agreements, communications, and any documents possibly relating to Petitioner's and Mosaic's relationship. *See* Ex. 2007, 4. Such speculative nature and breadth makes Patent Owner's discovery requests and their associated instructions less clear than desirable in an *inter partes* preview proceeding, which is intended to be a quick and cost-effective alternative to litigation, where discovery is less expensive than that typically available in district-court patent litigation. *Garmin*, Paper 26, 5.

Therefore, this factor weighs in favor of not granting Patent Owner's request for additional discovery.

CONCLUSION

Weighing all of the *Garmin* factors together and for reasons discussed above, we conclude that Patent Owner has not met the "interest of justice" standard for the requested additional discovery.

ORDER

It is

ORDERED that Patent Owner's motion for additional discovery is *denied*.

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Before WILLIAM V. SAINDON, JASON W. MELVIN, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*, concurring:

I agree with my colleagues that Patent Owner's Motion should be denied. I join their findings and differ only in how to weigh those findings with respect to *Garmin* factors 1 and 3.

I would find that *Garmin* factor 3 is overwhelmingly against Patent Owner because Dr. Cameron is subject to routine discovery anyway. Thus, Patent Owner has a good, existing opportunity to pursue the concern it raises, which is the core concern in *Garmin* factor 3. Even if Patent Owner

is left unsatisfied, Dr. Cameron's presumably imminent deposition will, at a minimum, help crystallize what further discovery is necessary and why. In this light, it seems entirely unnecessary to order a party to undertake the expense of additional discovery until we know what Dr. Cameron says. Patent Owner does not show that it is in the interests of justice to be granted additional discovery opportunities regarding Dr. Cameron before Patent Owner has exhausted its existing discovery opportunities regarding Dr. Cameron.

Regarding *Garmin* factor 1, I agree with my colleagues that the connection between Dr. Cameron and Mosaic is somewhat tenuous, especially given that it appears to be based on a prior proceeding rather than the current proceeding. However, I would not definitively say that Patent Owner has failed to establish more than a mere allegation that further investigation would yield "useful" information under *Garmin* factor 1. But I leave that analysis for another day, because I view *Garmin* factor 3 to be so overwhelmingly controlling in this situation that I would instead not rule definitively on *Garmin* factor 1 at this time.

I concur in denial of the Motion.

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