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Paper 36
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NINTENDO CO., LTD. and
NINTENDO OF AMERICA INC.,
Petitioner,

v.

AMERICAN GNC CORPORATION,
Patent Owner.

IPR2024-00667 (Patent 6,508,122 B1)
IPR2024-00668 (Patent 6,671,648 B2)[1]

Before JENNIFER S. BISK, SCOTT A. DANIELS, and LISA L. TSANG, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
Authorizing Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.5(a)

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[1] This Order applies to each of the captioned proceedings. The parties are not permitted to use this style of caption.

On October 15, 2024, we conducted a telephonic hearing to address a request by American GNC Corporation ("Patent Owner") for authorization to file a Motion for Additional Discovery. *See* Ex. 2018 (Hr'g Tr.). The subject matter of the requested discovery is an agreement ("the Agreement") between at least one of the Petitioner entities, Nintendo Co., Ltd and Nintendo of America Inc. (collectively, "Petitioner") and ST Micro, and communications between Petitioner and ST Micro about the challenged patents and the petitions in these proceeding. Hr'g Tr. 6:6–14. Patent Owner seeks discovery in these proceedings on the basis that ST Micro is a real party in interest served with a complaint alleging infringement of the patents that are the subject of these proceedings ("the Subject Patents"), possibly triggering a statutory bar to this proceeding under 35 U.S.C § 315(b). *See* Ex. 2012.

We understand that the Agreement has been produced in corresponding district court litigation; but the Agreement has not been filed in this proceeding because the Agreement is covered by a Protective Order in the district court that does not allow the Agreement's use in this proceeding. Hr'g Tr. 10:5–18, 12:8–9. Petitioner acknowledges ST Micro is a defendant in a district court proceeding alleging infringement of multiple patents that include the Subject Patents. Hr'g Tr. 13:13–14:1. Nevertheless, Petitioner contends we should not authorize a Motion

for Additional Discovery here because ST Micro was not alleged to infringe the Subject Patents and, therefore, Patent Owner cannot rely on the discovery to demonstrate this proceeding is statutorily barred under 35 U.S.C. § 315(b). Hr'g Tr. 13:16–14:22.

We tend to agree, at this point, with Petitioner's position on the statutory interpretation issue under 35 U.S.C. § 315(b). However, briefing on the issue would be helpful in making a further determination on this issue. Moreover, even if we were to agree with Patent Owner (*see* Hr'g Tr. 8:2–9:11), it is unclear whether the Agreement can be produced in this proceeding at all. Petitioner acknowledges it has not asked ST Micro for permission to produce the Agreement in this proceeding. Hr'g Tr. 11:6–23. Neither party has indicated whether it has approached the district court for its position on whether the Agreement can be produced in this proceeding.

In view of the circumstances, Patent Owner is authorized to file a Motion for Additional Discovery not exceeding 15 pages, due within five business days of this Order. The Motion should address whether 35 U.S.C. § 315(b) would apply in these circumstances. In addition, the Motion should indicate the form of discovery sought, e.g., specific documents sought that fall outside the scope of routine discovery, specific interrogatories that fall outside the scope of routine discovery,

and specific deposition testimony that falls outside the scope of routine discovery. The Motion should also address what efforts Patent Owner has made to obtain authorization to use in this proceeding the subject matter of the discovery already obtained in the district court and covered by applicable Protective Orders. The parties should be aware that, to the extent any provision of any applicable district court Protective Order requires interpretation, that interpretation must come from the district court; this panel will not interpret the district court's Protective Order.

Petitioner is authorized to file a 15 page opposition to Patent Owner's motion directed solely to the issues raised therein, which is due within five business days of the date Patent Owner files its Motion.

ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b) is *granted*;

FURTHER ORDERED that Patent Owner's motion is limited to 15 pages of argument and must be filed within five business days of this Order; and

FURTHER ORDERED that Petitioner may file an opposition limited to 15 pages of argument within five business days of Patent Owner filing its motion.

IPR2024-00667 (Patent 6,508,122 B1)
IPR2024-00668 (Patent 6,671,648 B2)

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