

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

AMERICAN GNC CORPORATION,
Patent Owner

IPR2024-00667
U.S. Patent No. 6,508,122

PATENT OWNER'S MOTION FOR DISCOVERY

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner American GNC Corporation (“American GNC”) respectfully moves to take certain non-routine discovery—described below—on the issue of whether STMicroelectronics N.V. and STMicroelectronics S.R.L. (collectively, “STMicro”), who were long ago “served with a complaint alleging infringement of the patent” here, should have been named as real parties in interest or privies by Nintendo. 35 U.S.C § 315(b).

The Board authorized this motion in an Order entered May 9, 2025, and provided guidance as to the issues to be addressed. Paper 36.

As explained in Section II below, Nintendo has raised a question of apparent first impression on interpreting the estoppel statute. For the reasons given below, American GNC believes that the statutory text and purpose are plainly met on the facts here, and that there is no legal bar to operation of the statute on STMicro.

Regardless of the ultimate outcome of the legal question, procedural efficiency suggests taking the discovery into the basis for finding STMicro to be a real party in interest—which will not be burdensome—in the current proceedings. The specific discovery requested, the reasons such discovery is warranted, and the responses to the Board’s questions in its May 9 Order are given below in Section III.

The Board should grant American GNC’s Motion for Discovery for the reasons further set forth below:

II. STMICRO IS SUBJECT TO A SECTION 315(b) TIME BAR

Section 315(b) bars institution more than one year after a “real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C § 315(b). More than one year before the Petition here, STMicroelectronics N.V. and STMicroelectronics S.R.L. were “served with a complaint.” EX2012, EX2013. That complaint was “alleging infringement of the patent” challenged here. EX2012, ¶47. The literal text of the statute is met, in its entirety. As a result, STMicro is time-barred under the statute. *See also* Response, Paper 21, at 61-64.

Nintendo asserts that this statute must be read to mean “served with a complaint alleging infringement of the patent [against STMicro].” *See* Reply, Paper 27, at 21 (“does not qualify as ‘a complaint alleging infringement of the patent’ against STMicroelectronics N.V.”). If so, then the scenario presented by the facts of the 2020 complaint—STMicro as co-defendant, and possibly indemnitor—would be ruled out.

The problem with Nintendo’s reading is that it adds a requirement—“against [entity X]”—that is not present the literal text of the statute. This is strongly disfavored—and the prohibition against adding limitations to statutes has been well litigated, including in the context of section 315(b). *See, e.g., Click-To-Call Technologies, LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1331

(Fed. Cir. 2018) (vacated on other grounds) (rejecting interpretation that would “impose additional conditions not present in the statute’s text”); *Bilski v. Kappos*, 561 U.S. 593, 602 (2010) (“courts should not read into the patent laws limitations and conditions which the legislature has not expressed”).

Unambiguous statutes are to be read literally. *SAS Institute, Inc. v. Iancu*, 584 U.S. 357, 363 (2018) (“Where a statute’s language carries a plain meaning, the duty of an administrative agency is to follow its commands as written”). Section 315(b) has repeatedly been found to be unambiguous. *Click-To-Call*, 899 F.3d at 1332. The statute does not say that the alleged RPI that is “served with a complaint alleging infringement of the patent” must be the person accused under the patent—rather than being a co-defendant, indemnitor, or otherwise necessary party.

Parties have been deemed to be barred from challenging patent claims even when those claims were not asserted against them in the triggering complaint. *See Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313, 1326-28 (Fed. Cir. 2020); *see also id.* at 1328 (“policy considerations cannot create an ambiguity when the words on the page are clear”). Similarly, the Board has declined to read in a requirement that the triggering complaint originates from the actual Patent Owner. *GoPro, Inc. v. 360Heros, Inc.*, IPR2018-01754, 2019 WL 3992792, *5-6, Paper 38 (P.T.A.B. Aug. 23, 2019) (precedential) (noting time bar triggered by notice, even of a defective complaint).

Nintendo has not found or cited any case holding that “alleging infringement of the patent” by the complaint must be “against” any particular entity. American GNC has not found an example of an unaccused co-defendant on the complaint being held to the bar. This does therefore appear to be a question of first impression. It bears resemblance to the dispute in *Click-To-Call*—which dealt with the adjacent “served with a complaint” clause, and found that this was the event triggering the time bar. 899 F.3d 1321.

The facts here are straightforward and not in dispute. STMicro and its customer OnePlus were named together as co-defendants in a patent infringement lawsuit filed in 2020. EX2012. OnePlus was accused of infringing the patent challenged in these proceedings. *Id.*, ¶47. STMicro was directly accused of infringing only *different*, but related, American GNC patents. *Id.*, ¶48. The allegations against OnePlus involved OnePlus’ use of STMicro components. *Id.*, ¶164 (“The Accused OnePlus Gyroscope Products include STMicro gyroscope products.”).

American GNC has presented evidence showing that STMicro “was served” (e.g., EX2013), “with a complaint” (EX2012), that was “alleging infringement of the patent” (EX2012, ¶47). 35 U.S.C § 315(b). The language of the statute is met.

In *Click-To-Call*, after determining that it was improper to add limitations to the plain text (*id.* at 1330-31), the Federal Circuit looked to legislative history to

show the core “notice-conferring” purpose of the service requirement. *Id.* at 1331-32. That history also discussed how the time bar was extended to a year to “afford defendants a *reasonable opportunity to identify and understand* the patent claims that are relevant to the litigation.” *Id.* at 1332 (emphasis in original). As in *Facebook*, subsequent events could change the assertions around, but operation of the statute is unambiguously “irrespective of subsequent events.” *Id.* at 1330.

The acknowledged and undisputed purposes of the time bar statute—notice, as well as encouraging timely filing of challenges subsequent to notice—are met here as well. In addition to directly accusing STMicro’s customer of infringing the patent here through its use of STMicro’s products—the complaint made various allegations about STMicro’s independent notice of the American GNC patents. This included the fact that STMicro had been contacted by OnePlus about American GNC’s licensing efforts prior to the lawsuit. EX2020, ¶¶71-74; *see also id.*, ¶¶89-97 (detailing interactions in which STMicro and American GNC corresponded about subpoenas—in which STMicro sought, and American GNC declined to give, assurances that “AGNC has no intentions to and will not sue ST-Inc. or another ST entity directly for infringement of AGNC’s patents?”).

There is no question that STMicro had notice—from a variety of sources including service—of the 2020 complaint. *See, e.g.*, Response, 62-64. American GNC has provided evidence of service of process. *Id.*, 62; EX2013. STMicro knew

that it had been accused of infringing related American GNC patents, and that its customer had been accused of infringing the challenged patent here through its use of STMicro products. EX2012. STMicro has consistently shown concern that it may be sued, or sued again. *Id.*, ¶¶95-98; EX2014, 1-2 (“leaving the door open for American GNC” to bring claims “against ST or a foreign entity yet again”). Yet neither STMicro, nor its customer OnePlus, *ever* filed IPRs as to *any* American GNC patent.

The statutory purpose of the time bar—of providing notice to STMicro that it should investigate and timely bring any challenges—is served by these facts.

But regardless of policy, in view of the many authorities cautioning against, and reversing courts for, adding limitations into this unambiguous statute, the Board should not read in an additional requirement—that STMicro be the entity, rather than, *e.g.*, the co-defendant or indemnitor of the entity, that the complaint was “accusing of infringement of the patent.”

III. DISCOVERY INTO STMICRO’S RPI STATUS SHOULD OCCUR

A. The requested discovery is simple and not burdensome

As requested by the Board, below American GNC details the form and specific scope of discovery sought by this Motion. American GNC tailored these requests so as to seek only information likely to be relevant to or useful and informative about the RPI issue.

For purposes of these requests, American GNC uses “STMicro” to refer to STMicroelectronics N.V., as well as STMicroelectronics S.R.L., STMicroelectronics K.K., STMicroelectronics, Inc., or any other subsidiary, and their personnel, representatives, or counsel. And American GNC uses “Nintendo” to refer to Petitioners Nintendo Co., Ltd. and Nintendo of America, Inc., or any other subsidiary, and their personnel, representatives, or counsel.

Requests for Document Discovery from Nintendo:

1. Documents sufficient to show the terms of any agreement(s) between Nintendo and STMicro related to the products accused of infringing the ’122 Patent.
2. The agreement produced, in the district court litigation between the parties, at NINAGNC-0002845.
3. All agreements, including any common-interest agreement(s), between Nintendo and STMicro related to American GNC or its patents, district court litigation involving the ’122 Patent, and/or this IPR proceeding.
4. All communications between Petitioner and STMicro regarding the ’122 Patent; American GNC’s licensing demands or infringement lawsuits against Nintendo, challenges to the validity or patentability of the ’122 Patent; and/or this IPR proceeding. For avoidance of doubt, this includes but is not limited to any communications mentioning or discussing indemnification. *See, e.g.,* EX2018, 13:13-14 (“STMicro has not agreed to indemnify” Nintendo).

5. To the extent that Nintendo or STMicro assert that any of the requested communications are subject to privilege, then a detailed privilege log, identifying the non-privileged facts (dates, participants, etc.) of such communications and the basis for the privilege assertion.

Requests for Interrogatory Discovery from Nintendo:

Interrogatory No. 1: Identify and describe any indemnification or defense being provided, or that you contend or have contended is owed, by STMicro, related to American GNC, its patents and its demands or litigation thereof against Nintendo, or this proceeding—including by identifying the specific corporate entities of STMicro that are providing, or that you contend should provide, any indemnification or defense; by description of the specific duties (e.g., reimbursement, defense, consultation) that are being provided or are contended to be owed; and by describing when fulfillment of such duties was requested or begun.

Interrogatory No. 2. Identify and describe any and all communications between you and any STMicro entity or representative, relating to Nintendo's responses, defenses, contentions, or petitions concerning American GNC's patents.

American GNC expects that this narrowly focused discovery will provide compelling evidence that STMicro is a time-barred RPI or privy of Petitioners. The requested document discovery is consistent with that proposed in meet and confer

discussions prior to American GNC's seeking authorization for this motion. *See also* EX2018 at 5:21-6:14. American GNC has suggested Interrogatories as a mechanism to provide written narrative in lieu of a more time-consuming declaration and cross-examination of a Nintendo corporate representative on these matters.

B. The requested discovery is available in this proceeding

This specific document discovery, on this specific issue, was ordered by Director Vidal on Director Review in *Samsung Electronics Co., Ltd. v. Netlist, Inc.*, IPR2022-00615, 2023 WL 9787488 at *4 (P.T.A.B. Feb. 3, 2023) (granting discovery into agreements related to accused products, indemnification agreements and related communications, agreements related to litigation or IPR proceedings, and all communications regarding the asserted patent or challenges to it).

The requested discovery is likely to be confidential to Nintendo and/or STMicro. American GNC has already drafted a proposed protective order, modified from the Board's standard, to address the specific concerns here. The parties could cooperate to finalize and propose entry of such an order in a short amount of time, should the Board grant this Motion.

In its May 9, 2025 Order, the Board specifically requested briefing about the availability of the agreement previously produced by Nintendo in district court litigation. Paper 36. Nintendo has not shown why it could not simply produce the subject agreement here under a protective order preserving confidentiality.

Nintendo should not be allowed to oppose discovery on counsel's bare suggestion concerning an alleged need to give notice—which it could have done long ago—or an alleged need to get permission from STMicro. EX2018, 23:6-23.

The agreement either does, or doesn't, require permission from STMicro. The parties here agree the agreement is confidential, and so neither party can openly discuss whether STMicro is required to give, or has been asked for or has denied, permission to produce the agreement under seal here.¹

The simplest way to resolve these concerns is for the Board to order the requested discovery, for the parties to agree on and propose a protective order, and for the agreement, and/or communications about the agreement between Nintendo and STMicro—which could include communications about its production—to be produced. There could be no reasonable suggestion that the confidentiality procedures of the Board are somehow less protective of STMicro's confidential information than those of the district court where this agreement has already been produced.

In its order, the Board also asked about interactions with the district court

¹ Refusing production of an agreement alleged to be relevant to RPI status could well be deemed suggestive as to whether the alleged RPI has an interest in these proceedings.

related to this requested discovery. American GNC does not seek interpretation of the district court's Protective Order, or production in cooperation with the district court. Prior to the district court's latest Order on the scope of its stay pending resolution of these IPRs, the parties submitted a Joint Status Report. EX2026. American GNC discussed the discovery overlap, as well as Nintendo's non-compliance in that case and its objections in this proceeding, and suggested that the district court hold discovery open relative to Nintendo's relationship to STMicro. *Id.*, 4-5. Nintendo objected to what it called an attempt to make the court "a discovery magistrate for the IPRs." *Id.*, 9. Nintendo told the district court: "If the PTAB believes discovery is needed or relevant to the IPR proceedings, then the PTAB will order it." *Id.* Subsequently, the district court maintained its stay and noted that: "Any dispute regarding discovery before the PTAB is for the PTAB to address, and Plaintiff should file a motion there if appropriate." EX2027, 2.

In short, the Board can and should use its authority to order discovery into, *e.g.*, a document undisputedly in Nintendo's possession, and related communication, as requested above.

C. The requested discovery is in the interest of justice

American GNC requests narrowly tailored discovery consistent with the five factors outlined in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013) (precedential). These requests are "necessary

in the interest of justice,” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2), to determine whether the petition was time-barred, which is a “highly fact-dependent question.” PTAB Consolidated Trial Practice Guide 13 (Nov. 2019).

1. American GNC has shown more than a mere speculative possibility of uncovering useful evidence (factor 1)

As detailed above and in American GNC’s papers here (*e.g.*, Response, 61-64), American GNC has shown that Nintendo and STMicro have a customer / supplier relationship related to products that American GNC accuses of infringement in the district court. *See, e.g.*, EX2007, ¶¶46-56, 63-74; EX2025.

American GNC expects that—in view of this discovery—Nintendo will be unable to bear “the burden of proving its petitions were not time-barred under § 315(b),” which in this case requires it to show that STMicro is not an RPI. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). As such, the information sought will be “useful” because it may require the Board to vacate its institution decision and thus would be “favorable in substantive value to a contention of [American GNC].” *Garmin*, Paper 26, at 7.

The sections above detail the relevance of the requests to the issue of STMicro’s alleged RPI status here.

Nintendo has not denied the alleged relevance or usefulness of the discovery sought—but instead has argued that there is a legal bar to application of the statute,

or that the unproduced agreement wouldn't be sufficient on its own. *See, e.g.,* Reply, Paper 27, 20, 25 (arguing counsel's assertion that "STMicro has not agreed to indemnify," and a panel decision that "an indemnification agreement, without something more, is insufficient to establish a RPI relationship").

But these are reasons to permit additional discovery, not reasons to foreclose it. If indeed "STMicro has not agreed to indemnify," or to assist here, because doing so would create RPI problems with Nintendo's challenge, that would be a real concern. Additional discovery into the relevant communications will likely establish whether there is "something more" to the relationship here.

It is worth noting that courts routinely permit discovery to occur while allegedly dispositive legal questions are litigated. To do otherwise risks inefficient proceedings and prejudicial delays in resolution—putting discovery at the end of proceedings or on remand only after the alleged legal bar to the issue is decided. *See, e.g., Semiconductor Components Industries, LLC v. Greenthread, LLC*, IPR2023-01242, Decision on Director Review, Paper 94 (P.T.A.B. April 24, 2025) (remanding for discovery into RPI status). Discovery is needed at the beginning of a trial, not the end.

American GNC strongly believes, for instance, that its substantive papers and evidence, including of the non-obviousness of its pioneering inventions here, requires upholding the challenged claims. *See, e.g.,* Response, Reply, EX2019,

EX2023. That outcome would moot the RPI issue here. Even so, it is more efficient for the parties to proceed in discovery of the RPI facts in parallel with working toward substantive resolution by the Board of the merits.

2. American GNC does not seek “litigation positions” or their basis (factor 2)

American GNC seeks neither Nintendo’s “litigation positions,” nor “the underlying basis for those positions.” *Garmin*, Paper 26, at 6. American GNC is instead seeing facts about Nintendo’s relationship with its component supplier STMicro. Nintendo has told the district court that the discovery American GNC is seeking is not relevant to the district court litigation. EX2026, at 7, 9 (“plainly **not relevant** to the claims in this case”). American GNC does not seek privileged information, specifically requesting a privilege log instead of any communications that Nintendo reasonably believes are privileged.

3. Only Nintendo can provide the requested information (factor 3)

American GNC seeks information from Nintendo that it cannot secure through other channels or generate by other means. *See Garmin*, Paper 26, at 13-14. The requested agreements and communications are solely within Nintendo’s (or STMicro’s) possession and are not available to American GNC without the requested discovery.

4. American GNC's requests are easily understandable (factor 4) and not burdensome (factor 5)

American GNC has provided “easily understandable instructions” in the form of narrowly tailored requests for documents and communications that reflect a genuine need, that are already in Nintendo’s possession, and that would not be burdensome to produce. *Garmin*, Paper 26, at 7. American GNC’s requests for agreements are directed narrowly to agreements relating to the accused products (Nintendo’s “Switch” console and related controllers), to the specific issue of indemnification, or to the specific patent and proceedings here. As for communications, if indeed the parties did not coordinate as Nintendo alleges, there should not be a large number of these. If there is a large number, or indeed *any* relevant communications, then to the extent that Nintendo asserts a burden, is far outweighed by American GNC’s need for information accurately portraying the relationship between Nintendo and STMicro regarding this proceeding.

In short, each of the *Garmin* factors supports granting the narrowly tailored and non-burdensome discovery according to the requests detailed above.

IV. CONCLUSION

For the foregoing reasons, American GNC respectfully requests that its Motion be granted and that a schedule be set for Nintendo to produce the requested documents and responses.

Dated: May 16, 2025

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on May 16, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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