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Honorable Tana Lin

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
SEATTLE DIVISION

AMERICAN GNC CORPORATION;

Plaintiff,

v.

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

Defendants.

Case No. 2:23-cv-00302-TL

UNOPPOSED MOTION FOR ISSUANCE OF REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE PURSUANT TO THE HAGUE CONVENTION

NOTED FOR CONSIDERATION:

MAY 31, 2024

I. INTRODUCTION

Plaintiff American GNC Corporation ("Plaintiff" or "American GNC") respectfully requests that the Court issue a Letter of Request for International Judicial Assistance ("Letter of Request") to assist American GNC with obtaining important discovery for its claims in this proceeding and, in particular, with respect to evidence supporting Plaintiff's claims of patent infringement asserted in this action. Specifically, the Letter of Request will enable American GNC to obtain documentary evidence from STMicroelectronics N.V., the Switzerland-based parent company of STMicroelectronics, and STMicroelectronics, S.r.l. an Italian-based subsidiary. These entities of STMicroelectronics ("STMicro") were involved in the design,

Nintendo Exhibit 1052
IPR2024-00668 - Page 001

manufacture and/or sale of the microelectromechanical systems ("MEMS") inertial measurement unit (IMU) components[1] included in Nintendo video game consoles and controllers, in particular the Nintendo Switch and Switch Lite consoles and associated controllers including Joy-Con and Pro controllers, which are alleged to infringe the Asserted Patents in this matter, U.S. Patent No. 6,508,122 and U.S. Patent No. 6,671,648.

Before bringing this motion, Plaintiff has attempted to obtain STMicro's cooperation in providing such documentary evidence through a Fed. R. Civ. P. 45 subpoena, issued to its domestic entity, STMicroelectronics, Inc., on September 20, 2023. While Plaintiff served detailed and narrowly tailored Requests, seeking technical information regarding the very STMicro IMU components (e.g., the LSM6DS3 and LSM6DS3TR-C components) that STMicro sold to the Nintendo Defendants, and which were incorporated into the Accused Products, STMicroelectronics, Inc. has refused to produce responsive information. That is, STMicro claims that its domestic entity – STMicroelectronics, Inc. – "did not design, manufacture, or sell any STMicro IMU Components to the Nintendo Defendants[.]" (Declaration of Corey Johanningmeier "Decl. Johanningmeier", ¶ 6, Ex. D). Plaintiff undertook additional efforts to obtain STMicro's compliance, in an attempt to avoid the time and money required of both parties to pursue and respond to international Hague Convention process to obtain these STMicro materials, but to no avail. Therefore, for the reasons set forth below, American GNC respectfully requests the Court's assistance in obtaining documentary discovery from STMicroelectronics N.V. and STMicroelectronics S.r.l.

II. FACTUAL BACKGROUND

American GNC is an operating technology company that specializes in innovations in the fields of Guidance, Navigation, Control, and Communications, and that pioneered commercially viable inertial sensors built using Micro-Electrical-Mechanical Systems (MEMS) technology. (Dkt. 1, ¶¶ 16-25). American GNC's motion and position sensing technologies

[1] The "STMicro IMU Components" include, *e.g.*, the LSM6DS3 and LSM6DS3TR-C components that are Accused Components here.

Nintendo Exhibit 1052
IPR2024-00668 - Page 002

were developed initially for applications in the Aerospace and Defense industries, but the improvements in size, reliability, and efficiency enabled by American GNC's patented inventions allowed for accurate and efficient inertial sensing in a myriad of commercial applications – including transportation, guidance and navigation systems, location tracking for smartphones and other devices and motion sensing for gaming control. *Id*. American GNC was among the first companies to patent MEMS Inertial Measurement Unit technology. *Id*. at ¶¶ 26-38. MEMS Inertial Measurement Unit technology is now commonly found in consumer electronics such as cameras, guidance and navigation devices, drones, smartphones and tablets, as well as in video game consoles and controllers, where it enables motion sensing capability critical to customer experience of those systems and many of Nintendo's most popular game titles. *Id*.

Plaintiff American GNC alleges that Defendants Nintendo Co., Ltd. and Nintendo of America, Inc. directly and indirectly infringed U.S. Patent No. 6,508,122 and U.S. Patent No. 6,671,648 by making, importing, using, offering, and/or selling video game consoles and controllers that incorporate infringing inertial measurement units – including in particular the Nintendo Switch and Switch Lite consoles, and associated controllers including Joy-Con and Pro controllers. Plaintiff American GNC further alleges that Defendants Nintendo Co., Ltd. and Nintendo of America, Inc. induced and contributed to the infringement of others. *Id*. at ¶¶ 39-102.

Plaintiff's investigation indicates that Defendants Nintendo Co., Ltd. and Nintendo of America, Inc. purchased MEMS inertial measurement unit (IMU) components from STMicroelectronics N.V., which were designed and/or manufactured in part by STMicroelectronics, S.r.l., for inclusion in its video game consoles and controllers that incorporate infringing inertial measurement units—including in particular the Nintendo Switch and Switch Lite consoles, and associated controllers including Joy-Con and Pro controllers, which are alleged as infringing U.S. Patent No. 6,508,122 and U.S. Patent No. 6,671,648, as described in the Complaint. *Id*. at ¶¶ 63-74, 87-93. These STMicro IMU Components include,

Nintendo Exhibit 1052
IPR2024-00668 - Page 003

for example, the LSM6DS3 and LSM6DS3TR-C components. *Id.* Therefore, STMicroelectronics N.V. and STMicroelectronics, S.r.l. are likely to have information relevant to, in particular, the scope of, and quantum of damages caused by, Defendants Nintendo Co., Ltd. and Nintendo of America, Inc.'s alleged patent infringement. The evidence is intended to be used in connection with the claim construction briefing and hearing, which is expected to occur shortly after the Patent Trial and Appeal Board issues rulings on September 12, 2024, and will be used at trial against Defendants Nintendo Co., Ltd. and Nintendo of America, Inc. on those allegations of patent infringement. (Johanningmeier Decl., ¶ 4).

Plaintiff undertook significant efforts to obtain this evidence before filing the instant motion. On August 23, 2023, Plaintiff issued a Fed. R. Civ. P. 45 subpoena to STMicroelectronics, Inc. (*Id.* at ¶ 3, Ex. A). With that subpoena, Plaintiff served correspondence, which was copied to STMicro in-house counsel, offering to discuss the scope of the requests as well as the timing of the document production. (*Id.* at ¶ 5, Ex. B). However, STMicro did not accept that offer, and instead served objections to each of Plaintiff's Requests for technical, engineering and other product information for the STMicro IMU Components at issue. (*Id.* at 6, Ex. C). Indeed, STMicro refused to produce documents for any of the Requests for technical information "because ST did not design, manufacture, or sell any STMicro IMU Components to the Nintendo Defendants." (*Id.* at 6, Ex. C, pp. 13-18).

In an effort to obtain STMicro's compliance without further expense or court involvement, counsel for Plaintiff and STMicro exchanged correspondence regarding Plaintiff's bases for the discovery sought, the objections lodged by STMicro, STMicro's access to the materials requested, and Plaintiff's need to resort to international Hague Convention process to obtain materials from STMicro's parent and Italian design and manufacturing subsidiary, STMicroelectronics N.V. and STMicroelectronics, S.r.l., respectively. (*Id.* at ¶¶ 5-7, Exs. B, D and E). STMicro's counsel again refused to produce any of the requested documents, reiterating its earlier position: "with respect to any device that ST Inc. could interpret as an STMicro IMU Component, ST Inc. did not design or manufacture any such

Nintendo Exhibit 1052
IPR2024-00668 - Page 004

device, nor has it sold any such device to Nintendo." (*Id*. at ¶ 8, Ex. E, p. 2). Moreover, STMicro remained unmoved by the time and expense required of issuing and responding to requests via the Hague Convention: "AGNC is welcome to attempt to pursue discovery on any foreign third-parties through international process or conventions." (*Id.*).

The claim construction hearing is expected to occur shortly after the Patent Trial and Appeal Board issues rulings on September 12, 2024. The requested evidence, sought to be produced by the foreign STMicro entities in advance of the claim construction hearing date, will help the Court and the parties to understand the requested information about the products in advance of that hearing. (*Id*. at ¶ 4); *see also* Exs. 1-2.

III. THE HAGUE CONVENTION PERMITS PLAINTIFF'S DOCUMENTARY REQUESTS

The Hague Evidence Convention provides mechanisms to obtain discovery in a foreign country that is a signatory to the Convention. Specifically, "[i]n civil or commercial matters a judicial authority of a Contracting State may, in accordance with the provisions of the law of that State, request the competent authority of another Contracting State, by means of a Letter of Request, to obtain evidence, or to perform some other judicial act." Hague Evidence Convention, ch. 1, art. 1; *see also Utherverse Gaming LLC v. Epic Games Inc*., No. 2:21-cv-00799-RSM-TLF, 2022 WL 2717672, at *1 (W.D. Wash. May 18, 2022) (granting motion for issuance of letter rogatory in patent infringement matter and noting that "[c]ourts have the inherent authority to issue Letters Rogatory and Letters of Request to Foreign nations") (*citing* 28 U.S.C. § 1781(b)(2) and *quoting In re Cedar Shake & Shingle Antitrust Litig*., No. 2:19-cv-00288-MJP, 2020 WL 39144, *1 (W.D. Wash. Jan. 2, 2020)). The United States, Switzerland and Italy are all signatories to the Hague Evidence Convention. *See Societe Nationale Industrielle Aerospatiale v. United States Dist. Court for the S. Dist. of Iowa*, 482 U.S. 522, 524 fn. 1, 558, fn. 13 (1987).

The Hague Evidence Convention is neither the sole means nor the means of first resort to obtain discovery in a foreign country from parties or third parties. *Id.* at 541; *see also Pronova*

BioPharma Norge AS v. Teva Pharms. USA, Inc., 708 F. Supp. 2d 450, 452 (D. Del. 2010). Courts have held that the party seeking to employ the Hague Evidence Convention procedures has the burden of persuading the Court of the necessity of doing so; however, "[t]hat burden is not great . . . since the Convention procedures are available whenever they will facilitate the gathering of evidence by the means authorized in the Convention." *Pronova*, 708 F. Supp. 2d at 452-53 (internal quotation marks omitted); *see also SEC v. Leslie*, No. C-07-03444-JF (PVT), 2009 WL 688836, at *3 (N.D. Cal. Mar. 16, 2009) (holding "[t]he opposing party must show good cause for a court to deny an application for a letter rogatory.") (*citing DBMS Consultants Ltd. v. Computer Associates Int'l, Inc.*, 131 F.R.D. 367 (D. Mass. 1990)). Indeed, "some courts have gone so far as to hold that the party opposing issuance of a letter rogatory must establish good cause for the denial." *Leslie*, 2009 WL 688836, at *3 (*quoting Evanston Ins. Co. v. OEA, Inc.*, No. Civ. S-02-1505 DFL PAN, 2006 WL 1652315, at *2 (E.D. Cal. June 13, 2006)). "Courts routinely issue such letters where the movant makes a reasonable showing that the evidence sought may be material or may lead to the discovery of material evidence." *Image Processing Technologies, LLC v. Canon, Inc.*, No. CV 10-3867 (SJF) (ETB), 2011 WL 13312041, at * 1 (E.D.N.Y. Sept. 13, 2011) (*quoting Netherby Ltd. v. Jones Apparel Grp., Inc.*, No. 04 Civ. 7028, 2005 WL 1214345, at *1 (S.D.N.Y. May 18, 2005)).

In patent infringement matters, in particular, there is a "compelling reason" to grant a letter rogatory seeking evidence from a third party manufacturer of components or starting materials of Accused Products, who is not subject to the Court's jurisdiction under Rule 45. *See, e.g., Abraxis Bioscience, LLC, et al. v. Actavis, LLC*, No. 16-1925 (JMV), 2017 WL 2293347, *2-4 (D.N.J. May 25, 2017) (granting patentee's motion for letter rogatory to request evidence from a third party located in Canada who was the supplier of certain starting materials to the accused infringer and their impact on the infringement determination not fully resolved by the discovery the accused infringer had produced). Indeed, in *Abraxis*, where discovery revealed that the starting materials of the Accused Products were in the possession of a foreign third party, but the Defendant disputed what precise materials that third party possessed, the court noted that

Nintendo Exhibit 1052
IPR2024-00668 - Page 006

"in the context of an application for a letter rogatory, the request may be granted even if 'the admissibility is not immediately apparent as long as the inquiry is reasonably calculated to lead to the discovery of admissible evidence.'" *Id*. at *2-3.

IV. DOCUMENTS SOUGHT IN SWITZERLAND AND ITALY FROM STMICRO ARE RELEVANT, PROPER AND NARROWLY TAILORED

Here, the facts support granting American GNC's motion for a Letters of Request seeking documentary evidence from STMicroelectronics N.V. and STMicroelectronics, S.r.l. in connection with Defendants' use of STMicro IMU Components in the Accused Products. First, the parties here do not dispute that STMicroelectronics N.V. and STMicroelectronics, S.r.l. participated in developing or providing the STMicro IMU components that are included in the Accused Products. "That alone is a compelling reason to grant [Plaintiff's] request." *Id*. at *2. The STMicro IMU components (e.g., the LSM6DS3 and LSM6DS3TR-C components), which are included in the Accused Products, were designed, manufactured, and/or sold by STMicroelectronics N.V., STMicroelectronics, S.r.l. STMicroelectronics, Inc. has represented in this and other cases that it does not have the engineering documents requested, and has fought attempts to compel it to obtain such documents from its corporate parent. (Johanningmeier Decl., ¶ 9).

Second, because these STMicro entities are located in Switzerland and Italy, respectively, and are not parties to this litigation, they are not subject to the jurisdiction of this Court. Additionally, despite Plaintiff's attempts to obtain STMicro's compliance with the document requests via a Rule 45 subpoena issued to STMicro's domestic entity, STMicroelectronics, Inc., STMicro has refused to produce any responsive documentation. (*Id*. at ¶¶ 6-8). In such circumstances, courts find that employing the procedures provided by the Hague Evidence Convention – rather than the Federal Rules of Civil Procedure – is the appropriate means to obtain discovery from a foreign nonparty. *See, e.g., Inv'r Prot. Corp. v. Bernard L. Madoff Inv. Sec. LLC,* No. 08-07189 (SMB), 2019 WL 1055958, at *5 (S.D.N.Y. Mar. 5, 2019) ("Letter rogatory … may be the only means to request documents or testimony from foreign non-partes

Nintendo Exhibit 1052
IPR2024-00668 - Page 007

over whom the court has no personal jurisdiction and who are beyond the subpoena power of the court."); *see also Tulip Computs. Int'l B.V. v. Dell Comput. Corp*., 254 F. Supp. 2d 469, 474 (D. Del. 2003) ("Resort to the Hague Evidence Convention in this instance is appropriate since both [witnesses] are not parties to the lawsuit, have not voluntarily subjected themselves to discovery, are citizens of the Netherlands, and are not otherwise subject to the jurisdiction of the Court."); *and see Pronova*, 708 F. Supp. 2d at 453 (finding it "appropriate to turn to the Hague Evidence Convention" where the targets of the discovery were not parties to the lawsuit, had not voluntarily subjected themselves to discovery, and as citizens of foreign countries were not subject to the U.S. court's jurisdiction).

Finally, the document requests to STMicroelectronics N.V. and STMicroelectronics, S.r.l. seek evidence that is directly relevant to American GNC's claims against the Nintendo defendants and are narrowly drafted to obtain only such evidence for purposes of supporting Plaintiff's patent infringement claims. Specifically, the document requests are narrowly targeted at the entities which design, manufacture and/or sell the STMicro IMU components (e.g., the LSM6DS3 and LSM6DS3TR-C components) that STMicro sold to the Nintendo Defendants, and which were included in the Accused Products. The requests are directed to engineering materials showing the design and structure of the electrical control circuitry and mechanical elements of the devices. Such evidence is narrowly tailored to support Plaintiff's claims of infringement. *See* Exhibits 1-2 (Request Nos. 1-5).

Nintendo Exhibit 1052
IPR2024-00668 - Page 008

Dated: May 13, 2024

Respectfully submitted,

By: */s/ Corey Johanningmeier*

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CERTIFICATION OF COUNSEL

Consistent with this Court's Standing Order for All Civil Cases, I hereby certify that the Parties have, in good faith, met and conferred regarding the relief requested in this Motion. Nintendo indicated that it does not oppose the relief requested herein. Nintendo's counsel asked to include the following statement:

Defendants Nintendo Co., Ltd. and Nintendo of America Inc. ("Nintendo") do not oppose AGNC's motion for international judicial assistance with respect to STMicro. Nintendo takes no position on the breadth of the motion or information being sought, nor the relevance or admissibility of any documents received as a result. Nintendo reserves all rights to object to the use of any information obtained, and by not opposing the request, is not intending to waive any objections. Nintendo also reserves all rights to oppose or object to any representations AGNC makes in the motion, including regarding its alleged technology.

Dated: May 13, 2024

/s/ Corey Johanningmeier
Corey Johanningmeier

Nintendo Exhibit 1052
IPR2024-00668 - Page 010