

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)

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

BISK, *Administrative Patent Judge.*

ORDER¹

Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ The combined caption is for administrative convenience only and does not indicate that IPR2024-00667 and IPR2024-00668 have been consolidated. The parties are not authorized to use this caption without express permission of the Board.

I. INTRODUCTION

On May 16, 2025, Patent Owner filed motions requesting additional discovery on the issue of whether STMicroelectronics N.V. and STMicroelectronics S.R.L. (collectively, “STMicro”) should have been named as a real party-in-interest by Petitioner (collectively “Motions”). Paper 40.² Petitioner filed an opposition to the Motions. Paper 43. The issue was discussed at the oral hearing held on May 28, 2025, and a copy of the transcript was entered into the record. Paper 48 (“Tr.”).

A party moving for additional discovery “must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *see also* 35 U.S.C. § 316(a)(5). The Board has identified several factors relevant to the interests of justice standard, including that there must be “[m]ore [t]han a [p]ossibility and [m]ere [a]llegation” that something useful will be discovered. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, 6–7 (PTAB, Mar. 5, 2013) (precedential).

For the reasons provided below, Patent Owner’s Motions are *denied*.

II. ANALYSIS

To satisfy the first *Garmin* factor, Patent Owner’s motion depends on a finding that STMicro is a real party-in-interest that is time-barred under 35 U.S.C. § 315(b), which states:

[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

² For purposes of expediency, we cite to Papers and Exhibits filed in IPR2024-00667. Patent Owner filed similar Papers and Exhibits in IPR2024-00668.

IPR2024-00667 (Patent 6,508,122 B1)

IPR2024-00668 (Patent 6,671,648 B2)

Patent Owner filed a district court complaint on March 4, 2020, naming STMicro and OnePlus as co-defendants in *American GNC Corp. v. OnePlus Tech. (Shenzhen) Co., et al.*, No. 6:20-cv-00171-ADA (W.D. Tex.) (the “2020 Action”). The 2020 Action alleged infringement of the two patents at issue in these proceedings—U.S. Patent No. 6,508,122 (“the ’122 patent”) and U.S. Patent No. 6,671,648 (“the ’648 patent”)—as well as several related patents. Paper 40; Ex. 2012. Patent Owner asserts that, in the 2020 Action, STMicro was served with a complaint alleging that OnePlus infringed the ’122 and ’648 patents, and, therefore, the language of the statute is met and the time bar applies to STMicro. Paper 40, 2 (citing Ex. 2012; Ex. 2013).³ As evidence of this service, Patent Owner relies on Exhibit 2013, which is an “Affidavit of Service” sent to Corporation Service Company (“CSC”) in Albany, NY. Ex. 2013; Paper 40 (citing Ex. 2012 (copy of complaint in 2020 Action); Ex. 2013); Tr. 23:14–18.

Petitioner argues that “Patent Owner has not provided evidence of proper service with respect to either of the STMicro entities named in the 2020 Action.” Paper 43, 11.

The record shows that one week after filing Exhibit 2013, “Patent Owner notified the district court that CSC has provided a ‘Rejection of Service of Process’ dated June 15, 2020, explaining that service on ST Microelectronics N.V. could not be effected.” Paper 43, 12 (citing

³ In addition to the arguments discussed below, Petitioner also argues that the § 315(b) time bar was never triggered because the complaint did not assert *the challenged patents* against STMicro. Paper 43, 2–11. We do not address this argument further because we find that Patent Owner has not shown that STMicro was properly served with the complaint.

IPR2024-00667 (Patent 6,508,122 B1)

IPR2024-00668 (Patent 6,671,648 B2)

Ex. 1068). And STMicroelectronics N.V. subsequently argued that this service was deficient. Ex. 1069 (Reply Brief filed by STMicroelectronics N.V. on June 29, 2020 in the 2020 Action stating “AGNC’s attempted service on STNV’s agent in New York for SEC-related actions was insufficient because that agent is not authorized to accept service for patent-infringement lawsuits”). The district court did not address this issue in the order dismissing both STMicro entities from the 2020 Action. *See* 2020 Action, Notice of Dismissal of STMicroelectronics NV and STMicroelectronics S.R.L. Without Prejudice (Dec. 4, 2020).

Patent Owner agrees that the service attempt in Exhibit 2013 was disputed in the 2020 Action and “then there was at least one or two attempts to serve through the Hague after that.” Tr. 23:20–24:3 (citing Ex. 1070 (Amended Summons to STMicroelectronics NV in 2020 Action filed Nov. 30, 2020); 1071 (same)). According to Patent Owner, “[w]e clearly can’t possibly litigate whether or not service was proper in a dismissed case.” *Id.* at 24:9–16.

We agree with Petitioner that Patent Owner has failed to show that STMicro was properly served with a complaint under Rule 4 of the Federal Rules of Civil Procedure. *See IpDatatel, LLC v. ICN Acquisition, LLC*, IPR 2018-01823, Paper 17 at 13–18 (PTAB Apr. 17, 2019) (finding that service in § 315(b) requires compliance with Rule 4 of the Federal Rules of Civil Procedure) (citing *Freedom Watch, Inc. v. Org. of the Petroleum Exporting Countries*, 766 F.3d 74, 81 (D.C. Cir. 2014)); *see also In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, Paper 14 at 10 (PTAB Sept. 6, 2019) (same); *Lightricks Ltd. v. Plotagraph, Inc.*, IPR2023-00153, Paper 9 at 11–12 (PTAB Sept. 5, 2023) (same). Patent Owner does

IPR2024-00667 (Patent 6,508,122 B1)

IPR2024-00668 (Patent 6,671,648 B2)

not cite any authority holding that § 315(b) may be triggered by delivery of a complaint in a manner that does not constitute service under Rule 4. *See* Tr. 24:9–11 (Patent Owner acknowledging that “the cases say Rule 4—complying with Rule 4 is the touchstone here. It has to be proper under Rule 4.”). And nothing in the record indicates that STMicro was served in compliance with Rule 4.

Accordingly, we determine Patent Owner has failed to show that Petitioner was “served with a complaint alleging infringement of the patent” for purposes of 35 U.S.C. § 315(b). As a result, Patent Owner has not shown it is already in possession of evidence tending to show beyond speculation that something useful will be discovered by its request in the Motions. *See Garmin*, Paper 26 at 6–7. Patent Owner’s Motions are, therefore, denied.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s Motions for Additional Discovery are denied.

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IPR2024-00667 (Patent 6,508,122 B1)

IPR2024-00668 (Patent 6,671,648 B2)

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