

Quincy Lu

From: Yap, Alex S. <AYap@mofo.com>
Sent: Wednesday, October 9, 2024 12:58 AM
To: Jim Glass; Arjomand, Mehran; Nguyen, Jean; Yuan, Anna Y.; Mao, Stella
Cc: Sean Pak; John McKee; Quincy Lu
Subject: RE: IPR2024-00984, -01052, -01164, -01165, -01186

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[EXTERNAL EMAIL from ayap@mofo.com]

Counsel,

We do not agree that Petitioner needs to produce documents on secondary considerations when the issue was not raised in the Petition. Your cases also do not support your position that documents relevant to secondary considerations of non-obviousness must be produced as part of routine discovery. In fact, the PTAB has recognized that discovery into secondary considerations of non-obviousness is not part of routine discovery. According to Vice Chief Judge Michael Kim, Patent Owner's request for "relevant information that is inconsistent with a position advanced by the party during the proceeding," . . . with respect to . . . secondary considerations" under 37 C.F.R. § 41.51(b)(1)(iii) does not "fall[] under routine discovery" because "routine discovery under 37 C.F.R. § 41.51(b)(1)(iii) is narrowly directed to specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information." *Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, No. IPR2017-00573, 2017 WL 3447874 (PTAB August 10, 2017).

The PTAB has also "decline[d] to make additional discovery on secondary considerations available as a matter of right, given that all other types of additional discovery may be obtained only upon a showing based on the *Garmin* factors." ([Federal Register :: Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board](#).) According to the PTAB:

A patent owner seeking secondary consideration evidence from a petitioner should present a threshold amount of evidence *or reasoning* tending to show beyond speculation that something useful will be uncovered. A mere infringement contention or allegation that the claims reasonably could be read to cover the petitioner's product is generally insufficient, because such a contention or allegation, for example, does not show necessarily that the alleged commercial success derives from the claimed feature.

([Federal Register :: Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board](#).) The PTAB also rejected the proposition from some commentators that the "Office should permit discovery of evidence of non-obviousness held by the petitioner in all cases," stating that "the *Garmin* factors currently provide appropriate and sufficient guidance for how to handle requests for additional discovery, which the Office will continue to decide on a case-by-case basis." ([Federal Register :: Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board](#).) In its response to other comments, the PTAB further noted that "some showing of nexus is required to ensure that additional discovery is necessary in the interest of justice, in an inter partes review, or is supported by a good cause showing, in a post-grant review" and that "[a] patent owner seeking secondary consideration evidence from a petitioner should present a threshold amount of evidence *or reasoning* tending to show beyond speculation that something useful will be uncovered." (*Id.*) This makes sense because most post grant proceedings are related to some district court or ITC proceedings and in those proceedings, patent owners will argue secondary considerations of non-obviousness. Requiring a petitioner to address secondary considerations in PTAB proceedings in the first instance, when it is not at issue in those proceedings, is counter intuitive and not required under the rules. Secondary considerations of non-obviousness is Patent Owner's burden and Petitioner will respond to this issue, if necessary, at the appropriate time.

Petitioner has also satisfied its duty of candor. Petitioner did not cite to any Arashi documents in its responses to GoPro's interrogatories in the related ITC action that is contrary to its unpatentability positions before the PTAB. We understand that in the related ITC action, GoPro has cited to some Arashi documents in arguing secondary considerations of non-obviousness. Just because GoPro alleges that those documents support its allegations of long felt need and copying in the related ITC action does not

automatically make those documents inconsistent with Petitioner's unpatentability positions before the PTAB and it certainly does not impute a duty on Petitioner to produce those documents in these proceedings. GoPro's allegations are simply just that. To the extent Patent Owner intends to use those documents to argue secondary considerations of non-obviousness in these proceedings, Patent Owner should meet and confer with Petitioner. See *Coastal Indus., Inc.*, 2017 WL 3447874, *1 ("To the extent that any party desires to seek any evidence or information under additional discovery, the parties are instructed to confer with respect to the specific types of evidence and information being sought.")

Finally, we understand that GoPro's counsel has made the same argument recently before the Federal Circuit on behalf of AliveCorp, Inc. in its appeal of three IPRs. See *AliveCorp, Inc. v. Apple Inc.*, Appeal Nos. 23-1512, -1513, -1514. We expect that Patent Owner will exercise its duty of candor to the PTAB and inform the PTAB of the Federal Circuit's ruling if this issue is still germane to these proceedings.

Regards,

Alex

Alex S. Yap
Partner, LA
ayap@mofo.com

Morrison Foerster
707 Wilshire Boulevard
Los Angeles, CA 90017-3543

**MORRISON
FOERSTER**

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From: Jim Glass <jimglass@quinnemanuel.com>
Sent: Thursday, October 3, 2024 6:28 PM
To: Yap, Alex S. <AYap@mofo.com>; Arjomand, Mehran <MARjomand@mofo.com>; Nguyen, Jean <JNguyen@mofo.com>; Yuan, Anna Y. <AYuan@mofo.com>; Mao, Stella <SMao@mofo.com>
Cc: Sean Pak <seanpak@quinnemanuel.com>; John McKee <johnmckee@quinnemanuel.com>; Quincy Lu <quincylu@quinnemanuel.com>
Subject: IPR2024-00984, -01052, -01164, -01165, -01186

External Email

Counsel,

As you are aware, Patent Owner's preliminary response are due October 16, 28, and 31. We remind Petitioner of its ongoing, self-executing, and self-enforcing obligation to produce all "relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency." 37 C.F.R. § 42.51(b)(1)(iii). The Board has noted that parties have a "duty of candor and good faith to the Office." *L'Oreal USA, Inc. v. Liqwd, Inc.*, PGR2017-00012, Paper 37 at 13 (PTAB Sep. 27, 2017).

As you know, Petitioner has served a non-confidential interrogatory in the ITC requesting evidence of secondary considerations, and Patent Owner responded. To the extent Petitioner is aware of any evidence inconsistent with its obviousness positions, including any identified documents that may support secondary considerations, they must be produced. See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 20 at 2-5 (PTAB Feb. 28, 2018) (finding that documents demonstrating copying and long-felt need must be produced as “routine discovery” because they are inconsistent with Petitioner’s obviousness positions); *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1336 (Fed. Cir. 2016) (“The fact that a competitor copied technology suggests it would not have been obvious.”); *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2017 WL 1217157 at *2-3 (D. Or. Apr. 3, 2017) (explaining that under § 42.51(b)(1)(iii), evidence of copying as an indicator of non-obviousness would be contrary to an “assertion of obviousness in [an] IPR proceeding[.]”). Such documents should also include any of Petitioner’s confidential business information, to the extent they exist. *Aker Biomarine AS v. Neptun*, IPR2014-00003, Paper 93 at 6 (PTAB Oct. 6, 2014) (that “information may be business confidential ... does not shield it from routine discovery”).

To the extent any such documents do contain Petitioner’s confidential business information, Patent Owner would be willing to agree to entry of a protective order based off of the Trial Practice Guide’s default protective order, and would not object to a motion to seal. In light of the upcoming deadlines, Patent Owner requests that the relevant documents be produced by October 9, 2024.

Regards,
Jim

James M. Glass |Chair, Post-Grant Patent Practice| **Quinn Emanuel Urquhart & Sullivan, LLP** | 51 Madison Avenue, 22nd Floor, New York, NY 10010 | Office: +1.212.849.7142| [Web Bio](#)

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