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Paper 28
Entered: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WIZ, INC.,
Petitioner,

v.

ORCA SECURITY LTD.,
Patent Owner.

IPR2024-00863 (Patent 11,663,031 B2)
IPR2024-00864 (Patent 11,663,032 B2)
IPR2024-00865 (Patent 11,693,685 B2)
IPR2024-01109 (Patent 11,726,809 B2)
IPR2024-01190 (Patent 11,740,926 B2)
IPR2024-01191 (Patent 11,775,326 B2)[1]

Before MICHAEL R. ZECHER, GARTH D. BAER, and SCOTT RAEVSKY, *Administrative Patent Judges*.

Opinion by the Board by *Administrative Patent Judge* BAER.

Opinion dissenting filed by *Administrative Patent Judge* ZECHER.

BAER, *Administrative Patent Judge*.

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

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[1] This order is to be filed in each case. The parties are not authorized to use this style heading in any subsequent papers.

With our authorization, Orca Security Ltd. ("Patent Owner" or "Orca") filed a Motion for Additional Discovery, and Wiz, Inc. ("Petitioner" or "Wiz") filed an Opposition.[2] Orca seeks discovery of 226 internal Wiz documents (the "Requested Documents") that Wiz produced as confidential in a related district-court action and that, according to Orca, are useful in showing objective indicia of non-obviousness. Mot. 4, 9. For the reasons below, we grant Orca's Motion for Additional Discovery.

"The test for a party seeking additional discovery in an inter partes review is a strict one." *Symantec Corp. v. Finjan, Inc.*, IPR2015-01545, Paper 9 at 4 (PTAB Dec. 11, 2015). "The moving party must show that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). We consider the following factors in determining whether the requested discovery meets this standard: (1) whether the movant has provided a specific factual reason for reasonably expecting that the discovery will be "useful," i.e., "favorable in substantive value to a contention"; (2) whether the request seeks the other party's litigation positions and the underlying basis for those positions; (3) the movant's ability to generate equivalent information by other means; (4) whether the request has easily understandable instructions; and (5) whether the request is overly burdensome to answer. *See Garmin Int'l, Inc. v. Cuozzo Speed*

[2] *See* IPR2024-00863, Paper 19 (authorizing the Motion), Paper 20 ("Mot."), and Paper 24 ("Opp."). Although the analysis here applies to all listed proceedings, we refer to the papers filed in IPR2024-00863 for convenience.

Techs. LLC, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (Decision Denying Patent Owner's Motion for Additional Discovery) (precedential) ("*Garmin*"). We address each factor below.

Factor 1: Factual Reason for Reasonably Expecting the Discovery Will be Useful

According to Orca, "the Requested Documents show Wiz's copying of Orca's patented technology, and that Wiz was motivated to do so because Orca overcame skepticism and received significant praise and commercial success as a result of its patented inventions." Mot. 5. Orca explains that "the Requested Documents relate to Wiz's access to and specific efforts to copy Orca's SideScanning™ technology," which, Orca asserts, embodies the challenged claims. Mot. 6.

We agree with Orca that this factor favors discovery because Orca has done more than merely allege that the requested discovery will be useful. *See Garmin*, Paper 26 at 6. Instead, Orca explains with sufficient specificity how the Requested Documents will be useful—i.e., that they show copying, industry praise, and commercial success related to Orca's SideScanning™ technology, which, according to Orca, embodies the challenged claims. Such information would be "favorable in substantive value" to Orca's contention that objective indicia undemines Wiz's obviousness challenges. *See id.* at 7.

Wiz faults Orca for failing "to provide even a nominal showing of nexus between [Patent Owner's] technology and the claims-at-issue." Opp. 2. We disagree. Orca meanifully advances its nexus burden by providing a

technical brief that describes its SideScanning™ technology, as well as documentation that repeatedly characterizes Orca's product as using Orca's "patent-pending" technology. Mot. 6 (citing Exs. 2065, 2066, 2067). Although establishing nexus will ultimately require a more fulsome analysis, we decline to fault Orca for deferring that full analysis until its Patent Owner Response. With Orca's provided materials, given the modest burden on Wiz to produce the Requested Documents as outlined below, Orca's nexus assertion is enough for a threshold showing.

Factor 2: Litigation Positions and Underlying Basis

There is no dispute that *Garmin* Factor 2 weighs in favor of granting Orca's discovery request because none of the Requested Documents relate to Wiz's litigation positions. Mot. 8, Opp. 6.

Factor 3: Ability To Generate Equivalent Information By Other Means

This factor considers whether Orca can "generate the requested information without need of discovery." *Garmin*, Paper 26 at 6. Orca argues that this factor weighs in favor of granting the requsted discovery because the Requested Documents are Wiz's internal documents that are not publicly available and, "[a]lthough Wiz produced the documents to Orca's counsel in the Wiz Litigation, the District Court Protective Order does not permit Orca to produce them here." Mot. 9. We agree with Orca that this factor favors granting the requested discovery.

Wiz does not assert that Orca can generate equivalent information without the Requested Documents. Opp. 6–8. Instead, Wiz asserts that this factor favors denying the requested discovery because Orca "has the ability

to generate equivalent information by approaching the district court for permission to use the Requested Documents in the IPRs." *Id.* at 6. However, even if Orca were to approach the district court for permission to use the Requested Documents as Wiz suggests, that would not generate the equivalent information "without need of discovery." *See Garmin*, Paper 26 at 6. With or without the district court's permission, the same discovery—i.e., Petitioner's production of the Requested Documents—is still necessary for Orca to generate the equivalent information. Absent a means by which Orca can generate equivalent information without the Requested Documents, this factor weighs in favor of granting Orca's discovery request.[3]

Factor 4: Easily Understandable Instructions

Because Orca seeks specific documents previously produced in the related district court action, we agee with Orca that its discovery requests are easily understandable. *See* Mot. 9. Wiz does not assert otherwise. *See* Opp. 9.

[3] Wiz's suggestion that we deny the requested discovery until Orca gets the district court's permission would make the parties' conduct here depend on the terms of the district court's protective order. That would amount to the Board enforcing the parties' obligations under the district court's protective order by preventing Orca from relying on the Requested Documents until it is permitted to do so under the district court's protective order. We decline to do so. We offer no opinion on the parties' obligations under the district court's protective order and our decision to authorize the requested additional discovery here does not depend on interpreting the district court's protective order in any way.

Factor 5: Requests Not Overly Burdensome To Answer

We agree with Orca that its request is not overly burdensome because "Orca's counsel is already in possession of the Requested Documents," after Wiz produced them in the related district court case. Mot. 9–10. Moreover, as Orca explains, "the parties have agreed to a Protective Order for the IPRs, and Wiz already agreed to use in this proceeding confidentiality designations corresponding to those used in District Court." *Id.* at 10.

Petitioner raises two potential burdens. First, Petitioner notes the "cost to regain and maintain access to the Requested Documents after the production database was archived following the litigation stay." Opp. 10. This alleged cost does not favor denying Orca's motion for two reasons. First, we question whether the cost of accessing an archived production database is significant. More importantly, Petitioner can avoid that cost because Orca's counsel already has the Requested Documents, having received them in production from the related district court case. Mot. 10. Thus, Petitioner can "produce" the documents here with almost no effort at all simply by "acknowledge[ing] production of the specified documents in the IPR," as Orca notes. *Id.*

Next, Wiz complains that the Requested Documents total over 6,500 pages and it "will be required to spend considerable resources to "identify[] appropriate redactions when they are filed as exhibits." Opp. 9–10. However, Wiz need not redact everything confidential in all of the Requested Documents. At most, Wiz will need to redact its confidential business information only in the documents that Orca files as exhibits, and

only to the extent the Board requires the parties to provide public versions of those confidential exhibits. To the extent that task is onerous, Wiz may request that we do not require redacted public versions of confidential documents that Orca actually files.

Conclusion

Because we are persuaded by the arguments and evidence presented by Orca that the additional discovery is in the interests of justice, we grant Orca's request.

For the foregoing reasons it is hereby

ORDERED that Patent Owner's request for additional discovery is *granted*.

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ZECHER, *Administrative Patent Judge*, dissenting.

I do not agree with how the majority weighs factors 1, 3, and 5 set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (Decision Denying Patent Owner's Motion for Additional Discovery) (precedential) ("*Garmin*"). As a result, I respectfully dissent because I would deny the Motion for Additional Discovery filed by Orca Security Ltd. ("Orca"). Paper 20 ("Mot.).[4]

[4] Unless otherwise noted, all citations are to the Motion, Opposition, and exhibits filed in IPR2024-00863. Similar Motions, Oppositions, and exhibits were filed in IPR2024-00864, IPR2024-00865, IPR2024-01109, IPR2024-01190, and IPR2024-01191.

Factor 1: More Than a Possibility and Mere Allegation

I do not agree with the majority that Orca demonstrates this factor favors granting its additional discovery request because, in my view, Orca has not done enough to allege that the requested discovery will be useful. *See Garmin*, Paper 26 at 6. In the Motion, Orca contends that "the Requested Documents relate to [Petitioner's, Wiz, Inc.'s ("Wiz")] access to and specific efforts to copy Orca's SideScanning™ technology, which Orca will show in its Patent Owner Response was implemented in 2019, before Wiz was founded and embodies the challenged claims." Mot. 6 (citing Ex. 2065, 3–4, 5; Ex. 2066, 16; Ex. 2067, 5). In the Opposition (Paper 24, "Opp."), Wiz contends that "[Orca]—by its own admission—neglects to provide even a nominal showing of nexus between [Orca's SideScanning™] technology and the claims-at-issue." Opp. 2. I agree with Wiz.

In *Garmin*, when addressing the patent owner's, Cuozzo Speed Technologies LLC's ("Cuozzo"), assertion of commercial success, the Board stated that "there is an insufficient showing of nexus between the claimed invention and Cuozzo's discovery requests." *Garmin*, Paper 26 at 8. The Board later stated that, "if Garmin's devices are navigational devices and if navigational assistance is a substantial and desirable feature, Cuozzo's requests lack critical nexus with its claimed invention." *Id.* at 9. Board panels have consistently held that, when seeking additional discovery regarding objective indicia of non-obviousness, the moving party must make at least a threshold showing of nexus between the claimed invention and the evidence sought. *See, e.g.*, *Palo Alto Networks v. Juniper Networks*,

IPR2013-00369, Paper 36 at 4 (PTAB Feb. 5, 2014) (Decision Denying Patent Owner's Motion for Additional Discovery) ("Although a conclusive showing of nexus is not required at this juncture, some showing of relevance is necessary to ascertain what constitutes the 'Block IP' feature, and how the claims for which trial was instituted embody the 'Block IP' feature."); *Ashworth Bros., Inc. v. Laitram, L.L.C.*, IPR2020-00593, Paper 17 at 7 (PTAB Oct. 28, 2020) (Order Denying Patent Owner's Motion for Additional Discovery) ("Although a conclusive showing of nexus is not required at this stage of the proceeding, a party seeking additional discovery as to objective indicia must provide a threshold showing of nexus between the claimed invention and the evidence sought." (citing *Garmin*, Paper 26 at 8)).

Notably, even the Board decision cited by Orca in the Motion itself required a threshold showing of nexus between the claimed invention and the evidence sought. *See* Mot. 5, 7 (citing *MOM Enters., LLC v. Veith*, IPR2023-00726, Paper 45 at 4 (PTAB Dec. 6, 2023) (Decision Granting Patent Owner's Motion for Additional Discovery) ("*MOM Enters.*")). As Wiz correctly points out in the Opposition, the Board panel in *MOM Enters.* based its analysis of the *Garmin* factors on the patent owner's, Vieth's, prior showing of nexus between the claims at issue and the BabyDdrops® product. Opp. 3–4 (citing *MOM Enters.*, Paper 45 at 1 n.2). Stated differently, Vieth made a threshold showing of nexus between the claims at issue and the BabyDdrops® product during the preliminary phase of that proceeding so it appears the Board panel determined that Vieth need

not repeat its showing of nexus in the Motion for Additional Discovery itself.

Here, Orca does not even attempt to make a threshold showing of nexus between the claims at issue and the Requested Documents that purportedly implicate Orca's SideScanning™ Technology. Instead, Orca punts this showing to the Patent Owner Response, which has not yet been filed. I don't see how it is possible for us to assess whether the Requested Documents would be useful in demonstrating objective indicia of non-obviousness, without at least a threshold showing of nexus between the claims at issue and Orca's SideScanning™ Technology.

Factor 3: Ability to Generate Equivalent Information by Other Means

I do not agree with the majority that Orca demonstrates this factor favors granting its additional discovery rquest because Orca did not attempt to approach the district court for permission to use the Requested Documents. *See Garmin*, Paper 26 at 6. In the Motion, Orca contends that the district court protective order "expressly provides that Wiz can produce the documents in other proceedings . . . , but Wiz has refused to do so absent the Board ordering Orca's discovery request." Mot. 9 (citing Ex. 2057 ¶ 27). Orca asserts that the district court protective order should not prevent the Board from granting its additional discovery request because it does not preclude Wiz from authorizing Orca to use Wiz's own information in these *inter partes* review ("IPRs"). *See id.* (citing MOM Enter., Paper 45, 9). In the Opposition, Wiz contends that Orca's refusal to approach the district court for permission to use the Requested Documents is dispositive because

Orca has not pursued other available means for obtaining the additional discovery. Opp. 7. Wiz notes that, when negotiating to stay the district court case, "[Orca] proposed language explicitly preserving its ability to approach the district court to 'facilitate the disclosure' of protected documents in [these] IPRs without violating the stay." *Id.* at 8 (citing Ex. 1112 ¶ 4). According to Wiz, the language in the district court's stay order demonstrates that other means exist to obtain the Requested Documents. *Id.* I agree with Wiz.

The "Stipulated Protective Order" entered in the district court states, in relevant part:

> Documents, information or material produced pursuant to any discovery request in this Action that include Protected Material designated as DESIGNATED MATERIAL shall be used by the Parties only in the litigation of this Action and shall not be used for any other purpose, including without limitation any other litigation, patent prosecution or acquisition, patent reexamination or reissue proceedings . . . , or any business or competitive purpose or function.

Ex. 2057 ¶ 7. Although this language does not identify explicitly an IPR, the language that precludes a party from using documents obtained through district court discovery in "any other litigation" appears to encompass these IPRs.

The "Stipulation and Order for Staying Pending *Inter Partes* Review" entered in the district court states, in relevant part:

> Pending further Order of this Court, all discovery obligations are stayed and no party shall take any action the sole purpose of which is to advance this litigation other than in relation to the

> IPR proceedings and/or moving to lift the stay, provided however, that *the parties may pursue procedures to facilitate the disclosure of information produced in this case in the Wiz IPRs* without violating the stay.

Ex. 1112 ¶ 4 (emphasis added). In my view, the language "the parties may pursue procedures to facilitate the disclosure of information produced in this case in the Wiz IPRs" is an invitation for Orca to return to the district court to seek permission to use the Requested Documents in these IPRs, regardless of the stay. Because Orca did not attempt to approach the district court before seeking authorization to file its Motion, I would determine that Orca still has alternative means for obtaining the Requested Documents.

Factor 5: Not Overly Burdensome to Answer

I do not agree with the majority that Orca demonstrates this factor favors discovery because I have concerns regarding the efforts that must be undertaken to maintain the business confidential information contained within the Requested Documents. *See Garmin*, Paper 26 at 7. In the Motion, Orca contends that there would be no financial burden imposed upon Wiz to produce the Requested Documents in these IPRs because Orca's counsel is already in possession of the Requested Documents, the parties have already agreed to a protective order for use in these IPRs, and Wiz already agreed to use the same confidential designations used in the district court case. Mot. 10. In the Opposition, Wiz represents that the Requested Documents "total over 6,500 pages." Opp. 9. Wiz also appears to dispute Orca's representation that the parties agreed to confidential designations for the Requested Documents because it argues that it "will be

required to spend considerable resources to preserve the confidentiality of those documents, including by identifying appropriate redactions when they are filed as exhibits." *Id.* at 10. I agree with Wiz.

Although Orca represents that it has reached an agreement with Wiz as to certain confidential designations, Wiz appears to dispute that such an agreement has been reached. In my view, there will be a non-trivial burden imposed on Wiz to cull through 6,500 pages to ensure that any business confidential information contained within those pages is maintained as confidential. The majority speculates that this effort may be reduced if Orca chooses to file less than all the Requested Documents in these IPRs. Orca, however, has not represented that it will only file a limited number of the Requested Documents in these IPRs. Without any assurance from Orca, the burdensome effort required by Wiz to ensure the confidentiality of its' business confidential information contained within the Requested Documents should not be discounted.

In summary, I'm not persuaded that Orca's request for additional discovery meets the interests of justice standard for the following reasons: I would weigh *Garmin* factor 1 against Orca because it did not attempt to make a threshold showing of nexus between the claims at issue and the Requested Documents that purportedly implicate Orca's SideScanning™ Technology; I would weigh *Garmin* factor 3 against Orca because it has an alternative means for obtaining the Requested Documents; and *Garmin* factor 5 imposes at least some burden on Wiz to ensure the confidentiality of

its' business confidential information contained with the Requested Documents. As a result, I would *deny* Orca's Motion.