

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING and
LEDVANCE LLC,

Petitioner,

v.

FEIT ELECTRIC COMPANY, INC.,

Patent Owner.

IPR2024-01357 (Patent 8,604,678 B2)

SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING,
ELONG INTERNATIONAL USA INC., and
XIAMEN LONGSTAR LIGHTING CO. LTD,

Petitioner,

v.

FEIT ELECTRIC COMPANY, INC.,

Patent Owner.

IPR2025-00260 (Patent 8,604,678 B2)

Before KEVIN W. CHERRY, SCOTT B. HOWARD, and
ANDREW L. NALVEN, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

ORDER
Granting-in-Part Patent Owner’s Motion for Additional Discovery
37 C.F.R. § 42.51

I. INTRODUCTION AND BACKGROUND

On April 3, 2026, Feit Electric Co., Inc. (“Patent Owner”) filed, with our authorization, a Motion for Additional Discovery. Paper 68 (“Motion” or “Mot.”).¹ Savant Technologies LLC and LEDVANCE, LLC (“Petitioner”) filed an opposition to the Motion. Paper 70 (“Opposition” or “Opp.”).

For the reasons that follow, we *grant-in-part* and *deny-in-part* Patent Owner’s motion.

II. BACKGROUND

On January 30, 2026, we granted Patent Owner leave to file a motion to terminate IPR2024-01357 based on Petitioner LEDVANCE LLC’s alleged failure to disclose a real-party-in-interest. Patent Owner filed its motion on February 6, 2026. Paper 57 (“RPI Motion”). In the RPI Motion, Patent Owner alleged that Petitioner LEDVANCE LLC failed to identify its Chinese parent company, MLS Co. Ltd. (“MLS”) as a real-party-in-interest. RPI Motion 1. Patent Owner contended that this failure meant the Petition should lose its filing date, and it was therefore barred under 35 U.S.C. § 315(b). Petitioner filed its opposition to Patent Owner’s RPI Motion on February 20, 2026. Paper 58. With its opposition, Petitioner submitted the

¹ IPR2024-01357 and IPR2025-00260 are consolidated. This motion applies only to IPR2024-01357, so all citations are to the docket in IPR2024-01357.

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Declaration of Mr. Andrew Martin. *See* Paper 59 (“Martin Decl.”).

Mr. Martin is the General Counsel for LEDVANCE LLC. Martin Decl. ¶ 1.

Mr. Martin testified that LEDVANCE LLC is a subsidiary of LEDVANCE GmbH, which in turn is owned by MLS. Martin Decl. ¶ 5. Mr. Martin further testified that LEDVANCE LLC operates independently from LEDVANCE GmbH and MLS, has its own executive leadership team, its own management structure, and its own in-house legal function. *Id.* ¶ 12–13. Mr. Martin also testified that LEDVANCE LLC acted independently of LEDVANCE GmbH and MLS in filing this petition. *Id.* ¶¶ 16–27, 30–31. Furthermore, Mr. Martin testified that LEDVANCE LLC funded this Petition out of its own bank accounts, and has not sought or received any type of financial support from LEDVANCE GmbH or MLS. *Id.* ¶¶ 28–29.

On February 26, 2026, at the Oral Hearing in this matter, Patent Owner stated it wished to take the deposition of Mr. Martin. Paper 67, 62–63. We advised Patent Owner that such a deposition was allowed as routine discovery under our rules, and that no authorization from the panel was required. *Id.* As of this date, Patent Owner has not taken the deposition of Mr. Martin.

On March 24, 2026, Patent Owner contacted us seeking authorization to file this motion. *See* Ex. 3001. We held a call with the parties on March 26, 2026. *See* Paper 66. On that call, we authorized Patent Owner’s motion for additional discovery and reviewed Patent Owner’s proposed discovery requests and advised them to significantly narrow the requests in view of the Board’s precedent regarding discovery and RPI. *Id.*

In its Motion, Patent Owner contends that it “seeks permission to do two things: (1) prior to the deposition [of Mr. Martin], serve requests for production and requests for admission on Petitioner LEDVANCE LLC . . .; and (2) subsequent to the deposition, submit a reply to Paper 58.” Mot. 1. Patent Owner contends that it requests this additional discovery in the form of requests for production and requests for admission directed to: “(1) unsupported statements that appear in Mr. Martin’s declaration, (2) non-public evidence in the possession, custody, or control of Ledvance LLC, which is not addressed in Mr. Martin’s declaration, and (3) admissions regarding relevant facts that Mr. Martin omitted from his declaration.” *Id.* at 2. More specifically, Patent Owner seeks the following additional discovery:

Requests for Production (“RFPs”):

1. Identify and produce corporate organizational charts showing from 2020 onward the full ownership chain of LEDVANCE LLC up through its ultimate parent entity or entities, including all Affiliates, and all intermediate holding entities, including percentage ownership at each level.
2. Identify and produce documents sufficient to show changes in ownership or capitalization of (1) LEDVANCE LLC, (2) LEDVANCE Holding LLC, (3) LEDVANCE GmbH, and (4) MLS Co., Ltd., including capital contributions by government-linked entities, convertible instruments, or special share classes held by government actors (e.g., “golden shares”).
3. Identify and produce documents sufficient to identify any foreign-government or foreign-government owned entities that have or have had since 2015 any ownership in LEDVANCE LLC, LEDVANCE Holdings LLC, LEDVANCE GmbH, or MLS Co., Ltd., including the percentage ownership.

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4. Identify and produce any agreements between LEDVANCE LLC and/or any Affiliate(s) thereof regarding the supply, sale, and/or importation of goods in the Relevant Industry. Include in your production all agreements governing the relationship between or among LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd., as well as all patent or trademark license agreements between or among LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd.
5. Identify and produce including any conditions, mitigation agreements, or national security assessments issued or mandated by CFIUS (Committee on Foreign Investment in the United States) relating to the acquisition by MLS Co., Ltd. of LEDVANCE LLC (or any direct or indirect parent entity thereof). Include in your production those transaction documents submitted to and/or received from CFIUS that are referenced in the Declaration of Andrew Martin (Paper 59) at paragraphs 8 and 10.
6. Identify and produce all regulatory filings or reports submitted since 2020 by LEDVANCE LLC or any Affiliate thereof to any government agency that describe the ownership or operational relationship between MLS Co., Ltd. and LEDVANCE LLC or LEDVANCE GmbH, including any benefits that LEDVANCE LLC or LEDVANCE GmbH provide to MLS Co. Ltd. (e.g., access to distribution channels in the United States).
7. Identify and produce documents sufficient to identify all instances in which LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in this or any other proceeding before any U.S. court or administrative agency. For purposes of this request, “shared counsel” means that two or more of the entities listed above having engaged, been represented by, or paid (directly or indirectly) the same legal counsel in the same proceeding.

Requests for Admission (“RFAs”):

1. Admit that MLS Co. Ltd. controls the selection of members of the board of directors for LEDVANCE GmbH.

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2. Admit that MLS Co. Ltd. controls the selection of members of the board of directors for LEDVANCE LLC.
3. Admit that MLS Co. Ltd. nominates new members of the board of directors for LEDVANCE GmbH.
4. Admit that MLS Co. Ltd. nominates new members of the board of directors for LEDVANCE LLC.
5. Admit that MLS Co. Ltd., after acquiring ownership of LEDVANCE GmbH, reorganized the board of directors for LEDVANCE GmbH.
6. Admit that MLS Co. Ltd., after acquiring ownership of LEDVANCE LLC, reorganized the board of directors for LEDVANCE LLC.
7. Admit that MLS Co. Ltd., after acquiring ownership of LEDVANCE GmbH, urged then-existing members of the board of directors for LEDVANCE GmbH to resign.
8. Admit that MLS Co. Ltd., after acquiring ownership of LEDVANCE LLC, urged then-existing members of the board of directors for LEDVANCE LLC to resign.
9. Admit that Yiwu State-Owned Assets Operation Center, either directly or indirectly, owns a portion of MLS Co. Ltd.
10. Admit that Yiwu State-owned Assets Operation Center, either directly or indirectly, owns a portion of LEDVANCE LLC.
11. Admit that MLS Co. Ltd. and Shenzhen Mulinsen Technology Co., Ltd. are the same company.
12. Admit that MLS Co. Ltd. is an Affiliate of Shenzhen Mulinsen Technology Co. Ltd.

III. ANALYSIS

A. RPI Legal Standard

In a memorandum dated October 28, 2025, the Director designated as precedential *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential except

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for § II.E.I). *Corning* set forth the legal framework that the Board uses for determining whether a party who is not a named participant is an RPI as follows:

As stated in the Trial Practice Guide, whether a party who is not a named participant in a given proceeding is a “real party in-interest” to that proceeding “is a highly fact-dependent question.” 77 Fed. Reg. at 48,759 (citing *Taylor v. Sturgell*, 533 U.S. 880 (2008)). There is no “bright line test.” *Id.* The Supreme Court in *Taylor* sets forth a list of factors that might be relevant in a particular case. 533 U.S. at 893–95. Although “rarely will one fact, standing alone, be determinative of the inquiry” (Trial Practice Guide, 77 Fed. Reg. at 48,759), “[a] common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding” (*id.* at 48,761 (citations omitted)); *see also Reflectix, Inc. v. Promethean Insulation Tech. LLC*, Case IPR2015-00039, slip op. at 12 (PTAB April 24, 2015) (Paper 18) (“The proper RPI analysis [] focuses on . . . the degree to which [the related non-named entity] exercised, or could have exercised, control over the Petitions.”).

Other considerations may include whether a non-party “funds and directs and controls” an IPR petition or proceeding; the non-party’s relationship with the petitioner; the non-party’s relationship to the petition itself, including the nature and/or degree of involvement in the filing; and the nature of the entity filing the petition. Trial Practice Guide, 77 Fed. Reg. at 48,760; *see also id.* at 48,759 (citing *Taylor*, 533 U.S. at 893–95 & n.6 (2008)). A party does not become a RPI merely through association with another party in an endeavor unrelated to the IPR proceeding. *Id.* at 48,760; *see also Denso Corp. v. Beacon Navigation GmbH*, Case IPR2013-00026, slip op. at 10–11 (PTAB Mar. 14, 2014) (Paper 34) (stating that the mere fact that parties are co-defendants or concurrent defendants in related litigation does not make them RPI).

Corning, at 14–15.

B. Discovery Legal Standard

Discovery in an *inter partes* review proceeding is more limited than in district court patent litigation, as Congress intended our proceedings to provide a more efficient and cost-effective alternative to such litigation. H. Rep. No. 112-98 at 45–48 (2011). Thus, we take a conservative approach to granting additional discovery. 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). Accordingly, a party seeking discovery beyond what is expressly permitted by our rules must establish that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2) (“The moving party must show that such additional discovery is in the interests of justice.”).

The Board has identified five factors (the “*Garmin* Factors”) to be considered in determining whether additional discovery is in the interest of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (“*Garmin*”). In assessing Patent Owner’s motion, we address those factors below.

C. Garmin Factors

- 1. Factor 1 – There must be more than a possibility and mere allegation that something useful will be discovered.*

Pursuant to factor 1, we consider whether Patent Owner is already in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered via the requested discovery. *Garmin*, at 7. “Useful” in this context does not mean merely “relevant” and/or “admissible.” *Id.* Rather, it means favorable in substantive value to a contention of the party moving for discovery. *Id.*

Patent Owner contends that “Mr. Martin’s declaration suggests that Ledvance LLC is in possession of all information sought as part of the requests for production.” Mot. 4. Petitioner responds that Patent Owner’s contentions are “merely an allegation that documents exists” and that “is not a showing that they would be useful.” Opp. 7. Petitioner argues that Board precedent requires “evidence of actual control over this specific IPR—not just corporate affinity.” *Id.* at 6. Petitioner submits that “[e]ven assuming every request produced exactly what PO describes, PO would have more evidence of corporate affiliation—which is already undisputed—and no evidence that MLS directed, funded, or controlled this proceeding.” *Id.* at 7.

We agree with Petitioner that the mere likelihood that certain information exists is insufficient, but rather Patent Owner must show that this information sought would be useful. In order to determine what would be “useful,” we must be guided by the factors laid out in the *Corning* decision. As *Corning* explains, the key inquiry focuses on whether the unnamed party exercised or could have exercised control over this proceeding. *See Corning* at 14–15.

A number of Patent Owner’s requests do not seem targeted to obtaining useful information. For example, Patent Owner contends (RPI Motion 6), and LEDVANCE LLC has confirmed that MLS indirectly owns 100 percent of LEDVANCE LLC. *See* Martin Decl. ¶ 5; Ex. 1091. Petitioner has further voluntarily provided detailed information regarding the ownership structure of LEDVANCE LLC and related companies. *See* Ex. 1091. Further discovery on the ownership of LEDVANCE LLC (RFPs 1–3, 6) does not appear likely to yield any more information that is useful to

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the key question of control or opportunity to control this IPR. Patent Owner does not explain why it has any reason to doubt what Petitioner has admitted regarding MLS's ownership of LEDVANCE GmbH and LEDVANCE GmbH's ownership of LEDVANCE LLC, or how any further discovery on this point will illuminate the factors articulated in *Corning*.

As for Patent Owner's inquiries into the ownership of MLS (RFPs 2 and 3, RFAs 9–12), Patent Owner's motion contends that the unnamed RPI is MLS, not some owner of MLS. *See* RPI Mot. A Motion for Additional Discovery is not a vehicle for raising new theories not raised in an already filed motion to terminate. If Patent Owner wished to pursue these theories, it should have sought this discovery before its motion was filed, not after. Moreover, even assuming the new theories were timely, in order for Patent Owner's requests to be useful, MLS must first be an RPI. But if Petitioner has failed to carry its burden to show that MLS is not an RPI, then we need not go any further because Petitioner has not named MLS, the Petition would lose its filing date, and the petition would be barred by 35 U.S.C. § 315(b). Thus, the inquiries regarding the ownership structure of MLS are not likely to lead to useful information for our consideration of Patent Owner's RPI Motion.

RFP 4 seeks “any agreements between LEDVANCE LLC and/or any Affiliate(s) thereof regarding the supply, sale, and/or importation of goods in the Relevant Industry.” Mot. A-4. RFP 4 further seeks “all agreements governing the relationship between or among LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd., as well as all patent or trademark license agreements between or among

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LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd.” *Id.* It is unclear how agreements related to unaccused products and “all patent and trademark license agreements” could possibly lead to useful information regarding MLS’s relationship to and control or possibility to control *this* proceeding. Nor does Patent Owner provide any explanation. We do find that agreements between LEDVANCE LLC and MLS regarding indemnification or cooperation related to the ’659 patent or related patents would be useful and, if RFP 4 is narrowed to that scope, it might provide useful information. Thus, we narrow RFP 4 to this scope.

RFP 5 seeks “any conditions, mitigation agreements, or national security assessments issued or mandated by CFIUS (Committee on Foreign Investment in the United States) relating to the acquisition by MLS Co., Ltd. of LEDVANCE LLC (or any direct or indirect parent entity thereof).” Mot. A-5. RFP 5 further requests to “include in your production those transaction documents submitted to and/or received from CFIUS...” *Id.* Although CFIUS approval is mentioned in the Martin Declaration, it is unclear what useful information this discovery, particularly, all the transaction documents, whatever those are exactly, would provide. Patent Owner provides no explanation as to why this information from before MLS actually acquired LEDVANCE LLC would inform MLS’s control or possibility of control of this proceeding.

RFP 7 seeks “documents sufficient to identify all instances in which LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in this or any other proceeding before any U.S. court or administrative agency.” Mot. A-6. We find, as written, this request does not

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seek useful information. The scope extends far beyond this proceeding or even other patent proceedings to any proceeding before any U.S. court or administrative agency. Moreover, the mere fact of joint representation does not provide much useful information when the real issue is control or opportunity for control. Joint representations can take many forms, and their mere existence provides only minimal information. If this request is limited to “all instances in which LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in this or any other proceeding before any U.S. court or administrative agency in matters relating to the ’659 patent,” then it would seek useful information. Thus, we narrow RFP 7 to this scope.

RFAs 1–8 seek admissions regarding MLS’s control of LEDVANCE LLC’s and LEDVANCE GmbH’s boards of directors. We find that this information may be useful in ascertaining the degree of control that MLS exercises over LEDVANCE LLC. Thus, we find that *Garmin* Factor 1 weighs in favor of these requests.

Accordingly, we find that *Garmin* Factor 1 weighs in favor of granting Patent Owner’s request for RFPs 4 and 7 as modified and RFAs 1–8.

2. Factor 2 – A party may not seek another’s litigation positions or the underlying basis for those positions.

Patent Owner asserts that it does not seek litigation positions or the underlying basis for those positions. Mot. 5. Petitioner does not dispute Patent Owner’s position with respect to the RFPs, but does argue that Patent Owner’s RFAs include an instruction that “[t]o the extent You deny any request for admission, please explain the basis for your denial.” Opp. 9.

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Although we agree with Petitioner that this instruction is problematic, we believe it more properly considered under *Garmin* Factor 4 below.

Petitioner also argues that, if Patent Owner included a statement of material facts in its motion, it could have obtained this information without the need for additional discovery. *Id.* (citing 37 C.F.R. § 42.23(a)). This argument seems more appropriately considered under *Garmin* Factor 3. Thus, we agree with Patent Owner that the requests do not seek litigation positions. As such, *Garmin* Factor 2 weighs in favor of granting Patent Owner's request.

3. *Factor 3 – A party should not seek information that reasonably can be generated without a discovery request.*

Patent Owner contends that “Each of the Discovery Requests is directed to non-public information that is internal to Petitioner Ledvance LLC.” Mot. 6. Petitioner responds that Patent Owner has “routine cross examination of Mr. Martin and has not used it,” and “[t]he corporate-affiliation information PO seeks is publicly available, for example from MLS's Shenzhen Stock Exchange filings.” Opp. 7–8 (citing Ex. 1092; Ex. 2049; Ex. 2050).

We agree with Petitioner that, for RFPs 1–3, 6, and 7 (for the identified instances of joint representation), Patent Owner already has much of the information (through Petitioner's voluntary production of Ex. 1091 or public records). Patent Owner can seek additional information about these matters, and RFP 5 and RFAs 9–12, more easily through the routine cross examination of Mr. Martin. Thus, *Garmin* factor 3 weighs against granting those requests. With respect to RFPs 4 and 7, as narrowed above, and RFAs

1–8, that information can more easily be sought through these discovery requests, so *Garmin* factor 3 weights in favor granting those requests.

4. Factor 4 – Instructions and questions should be easily understandable.

Patent Owner notes that the instructions are less than two pages and “[t]he definitions are provided to clarify the use of certain defined terms throughout the Discovery Requests, and the instructions merely require the Petitioner to furnish responses and documents and to describe any instances where Petitioner cannot do so (either because such information is privileged or otherwise).” Mot. 6. Petitioner argues that Patent Owner’s instructions seek materials in “LEDVANCE LLC’s ‘possession, custody, or control, (including indirect control)’—with ‘indirect control’ undefined.” Opp. 6.

Overall, the instructions are mostly easily understandable. However, there are several problematic instructions. For example, we find Instruction 2, which provides in part: “[i]n answering the following requests for production, furnish all available documents and things, within your possession custody, or control (including indirect control),” to be problematic. Mot. A-3. We agree with Petitioner that “indirect control” is unclear. Also, we agree with Petitioner that Instruction 4, which instructs “[t]o the extent [LEDVANCE LLC] den[ies] any request for admission, please explain the basis for your denial,” Mot. A-3, transforms the Requests for Admission into interrogatories. Federal Rule of Civil Procedure 36, which governs requests for admission in federal court, provides that “[i]f a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it.” Thus, Fed. R. Civ. P. 36 only requires an explanation if the party “cannot truthfully admit

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or deny it.” *See* Fed. R. Civ. P. 36(a)(4). Instruction 4 is not consistent with how RFAs operate under the Federal Rules of Civil Procedure.

We believe the appropriate course is to narrow the problematic instructions. Thus, we remove the provision in Instruction 2 of “including indirect control.” We also modify Instruction 4 to eliminate the requirement to explain any denial to be consistent with the requirements of Fed. R. Civ. P. 36(a)(4). An explanation of a response to a request for admission will only be required if LEDVANCE LLC cannot truthfully admit or deny a request. *Id.* Accordingly, with those modifications, we agree that *Garmin* Factor 4 weighs in favor of granting Patent Owner’s request.

5. *Factor 5 – The discovery requests must not be overly burdensome to answer.*

Patent Owner argues that Petitioner will not be unduly burdened as it has already conducted much of the necessary searching in preparation of Mr. Martin’s Declaration. Mot. 7. Petitioner argues that several of Patent Owner’s requests are actually broader than the requests they originally proposed. Opp. 8.

We agree with Petitioner that a number of the requests are unduly burdensome. As an initial matter, we note that Patent Owner’s delay in seeking this motion for additional discovery has imposed a substantial burden on the Board and Petitioner. The current due date for IPR2025-00260, which is consolidated with IPR2024-001357, is June 23, 2026. Even if the due date for IPR2025-00260 is extended—which it almost certainly will have to be—the non-extendable due date for IPR2024-01357 is September 5, 2026. The time to complete discovery and allow for any additional briefing is short. This delay is largely Patent Owner’s own

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making. The *Corning* decision was designated “precedential” on October 28, 2025. *See Corning* at 1. Patent Owner filed an authorized Director Review request that was similar to its RPI motion on November 14, 2025. *See Paper 47*. The Director denied that request as untimely on November 18, 2025. *See Ex. 3100*. Patent Owner received the Martin Declaration on February 20, 2026, and waited more than a month to request this motion for additional discovery. This lack of urgency has significantly impaired the ability of the Board to complete this proceeding in a timely manner, and has already imposed a significant burden on the parties and the Board.

In the face of this tight timeline, Patent Owner has not heeded our admonition to seek targeted discovery. Instead, Patent Owner’s expansive discovery requests would further exacerbate this problem. RFPs 1–8, as written, would be overly burdensome especially given that they are unlikely to yield useful information, as explained above.

For example, RFP 1 seeks all corporate organization charts since 2020, without any limitation. Mot. A-4. RFP 4 seeks “any agreements between LEDVANCE LLC and/or any Affiliate(s) thereof regarding the supply, sale, and/or importation of goods in the Relevant Industry.” *Id.* at A-4–A-5.

As written, RFP 4 further seeks “all agreements governing the relationship between or among LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd., as well as all patent or trademark license agreements between or among LEDVANCE LLC and LEDVANCE Holdings LLC, LEDVANCE GmbH, and MLS Co., Ltd.” This request is not focused in any way and encompasses material of

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no or, at most, marginal value. This burden further weighs in favor of the narrowing this request discussed above.

In addition, RFP 5 seeks “any conditions, mitigation agreements, or national security assessments issued or mandated by CFIUS (Committee on Foreign Investment in the United States) relating to the acquisition by MLS Co., Ltd. of LEDVANCE LLC (or any direct or indirect parent entity thereof),” and “those transaction documents submitted to and/or received from CFIUS.” Mot. A-5. There is no explanation what Patent Owner thinks this information will show, and how potentially voluminous financial transaction materials can be produced and then reviewed in a timely way.

RFP 6 seeks “*all* regulatory filings or reports *since 2020* by LEDVANCE LLC *or any Affiliate thereof* to *any* government agency that describe the ownership or operational relationship between MLS Co. Ltd. and LEDVANCE LLC or LEDVANCE GmbH, including *any* benefits that LEDVANCE LLC or LEDVANCE GmbH provide to MLS Co. Ltd. (e.g., access to distribution channels in the United States). Mot. A-5 (emphasis added). As the emphasized portions make clear, the sweep of these request is extremely broad and will require a great deal of effort to investigate and collect. Moreover, such broad request is almost certainly to sweep in huge swaths of documents of minimal usefulness to Patent Owner’s RPI Motion. In addition, RFP 6 vaguely seeks “any benefits that LEDVANCE LLC or LEDVANCE GmbH provide to MLS Co. Ltd.” *Id.* It is not only unclear what “useful” information this will provide beyond the information already in the record, but it also has the potential to sweep in vast swaths of documents.

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RFP 7, as written, seeks “*all* instances where LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in this or *any other proceeding* before *any* U.S. court or administrative agency.” Moreover, Patent Owner states in its Motion that this RFP seeks identification of “non-public instances in which they have shared counsel.” Mot. 5. n. 3. The lack of any time, forum, or subject matter limitation makes RFP, as written, potentially very burdensome.

Thus, this factor weighs against Patent Owner’s request for RFPs 1, 4 (as written), 5, 6, and 7 (as written). We find that this factor weighs in favor of the narrowed RFPs 4 and 7 and RFAs 1–8.

6. *Summary*

Weighing all the factors together, we find that the *Garmin* factors weigh in favor of allowing RFPs 4 and 7 (as narrowed above and with Instruction 2 modified) and RFAs 1–8 (with the modified Instruction 4).

IV. CONCLUSION

Upon review of Patent Owner’s arguments and supporting evidence in view of the *Garmin* factors, we conclude that it is in the interests of justice to grant-in-part Patent Owner’s motion for additional discovery.² Patent Owner will be permitted to serve: (1) RFP 4, as limited above to agreements regarding indemnification or cooperation regarding the ’659 patent (with Instruction 2 narrowed as described above), and (2) RFP 7, as limited to

² Patent Owner also requests a reply brief, but as we explained at the Oral Hearing, we want the parties to come up with a plan for the discovery and then propose a schedule for any reply and sur-reply. Without some idea of when discovery will be complete and what type of reply is requested, it is futile for us to allow and try to schedule a reply and sur-reply.

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documents sufficient to identify all instances in which LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in any proceeding involving the '659 patent or patents related thereto (with Instruction 2 narrowed as described above), and (3) RFAs 1–8 (subject to our modification of Instruction 4).

The parties shall meet and confer and, within five business days of this order, submit to the Board a proposed schedule for the completion of discovery, including the deposition of Mr. Martin. The proposed schedule shall also include proposed dates for a potential reply and sur-reply.

V. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Motion for Additional Discovery is *granted-in-part* and *denied-in-part*;

FURTHER ORDERED that Patent Owner is authorized to serve the following additional discovery: (1) RFP 4, as limited above to agreements regarding indemnification or cooperation regarding the '659 patent (with Instruction 2 narrowed as described above), and (2) RFP 7, as limited to documents sufficient to identify all instances in which LEDVANCE LLC, LEDVANCE GmbH, and/or MLS Co. Ltd. have shared legal counsel in any proceeding involving the '659 patent or patents related thereto (with Instruction 2 narrowed as described above), and (3) RFAs 1–8 (subject to our modification of Instruction 4);

FURTHER ORDERED that the parties shall meet and confer and agree on a schedule to complete the granted additional discovery, to take the

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deposition of Mr. Martin, and upon a schedule for any proposed further briefing; and

FURTHER ORDERED that the parties shall submit to the Board, by a joint email, the agreed upon proposed schedule within five business days of this Order.

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