

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOLBY LABORATORIES, INC.,
Petitioner,

v.

INTERDIGITAL MADISON PATENT HOLDINGS, SAS,
Patent Owner

Case IPR2026-00252
Patent 9,185,268

**PETITIONER’S OPPOSITION TO PATENT OWNER’S MOTION FOR
ADDITIONAL DISCOVERY**

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LIST OF EXHIBITS

DOLBY-1001	U.S. Patent No. 9,185,268 to Doser et al. (“the ’268 Patent”)
DOLBY-1002	Prosecution History of the ’268 patent (“the Prosecution History”)
DOLBY-1003	Declaration and Curriculum Vitae of Dr. Eli S. Saber
DOLBY-1004	U.S. Pat. No. 7,053,927 (“Jones”)
DOLBY-1005	International Pat. Pub. No. WO 2007/050091 (“Ollivier”)
DOLBY-1006	U.S. Pat. App. Pub. No. 2007/0058183 (“Osaki”)
DOLBY-1007	U.S. Pat. App. Pub. No. 2007/0211074 (“Yeung”)
DOLBY-1008	Bancroft, Dave, “Emulating the Film Color Model in Digital Movie Production,” <i>Color and Imaging Conference</i> . Vol. 11. Society of Imaging Science and Technology, 2003
DOLBY-1009	Digital Cinema Initiatives, LLC, “Digital Cinema System Specification (V1.0),” 2005
DOLBY-1010	Morovič, Ján & Johan Lammens, “Color Management,” <i>Colorimetry: Understanding the CIE System</i> , John Wiley & Sons, Ch. 7 (pp. 159-203) (2007) (“Morovič”)
DOLBY-1011	Vetro, Anthony, “MPEG-21 Digital Item Adaptation: Enabling Universal Multimedia Access,” <i>IEEE MultiMedia</i> , vol. 11, no. 1, Jan-Mar. 2004, pp. 84-87 (“Vetro”)
DOLBY-1012	Declaration of June Munford
DOLBY-1013	U.S. Pat. No. 5,140,414 to Mowry et al. (“Mowry414”)
DOLBY-1014	U.S. Pat. No. 5,687,011 to Mowry et al. (“Mowry011”)
DOLBY-1015	U.S. Pat. No. 5,255,083 to Capitant et al. (“Capitant”)

DOLBY-1016- DOLBY-1049	RESERVED
DOLBY-1050	Complaint, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (filed Feb. 2, 2025)
DOLBY-1051	RESERVED
DOLBY-1052	Exhibit D2 to Complaint, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (filed Feb. 2, 2025)
DOLBY-1053	Joint Claim Construction and Prehearing Statement, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 15, 2025)
DOLBY-1054	Defendants' Opening Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 22, 2025)
DOLBY-1055	Plaintiff's Opening Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Aug. 22, 2025)
DOLBY-1056	Defendants' Responsive Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Sept. 5, 2025)
DOLBY-1057	Plaintiff's Responsive Claim Construction Brief, <i>InterDigital, Inc. et al. v. The Walt Disney Company et al.</i> , 2:25-cv-00895, CDCA (Sept. 5, 2025)
DOLBY-1058	<i>InterDigital, Inc., et al. v. The Walt Disney Co., et al.</i> , 2:25-cv-00895, Document 156 #7705 (CDCA), filed 3/5/26

I. INTRODUCTION

InterDigital filed its discovery motion despite Dolby's responses and production of materials that addressed all but a single one of InterDigital's original discovery requests, that which is subject of this motion. *See* EX-2020, 5-8. And yet, InterDigital brings this motion still failing to surface information or evidence suggesting that Disney funded, directed, controlled, requested, or coordinated this IPR, or that joint defense agreements are known to exist and inform these issues and thus the contention that Disney is an RPI of Dolby. But this motion is precisely the type of speculative fishing expedition that gave rise to the *Garmin* decision and its limiting factors, which squarely foreclose InterDigital's discovery request here.

This motion is not InterDigital's first attempt to obtain common-interest or joint defense materials in service of a speculative coordination theory. InterDigital sought common interest agreements in its related litigation against Disney (*InterDigital, Inc. et al v. The Walt Disney Company et al.*, 2-25-cv-00895 (CDCA)), but the district court rejected that request as "irrelevant" to "InterDigital's hypothesis," which was "that Disney and Amazon are working together to try to drive down the licensing rate for InterDigital's patent." *See* DOLBY-1058, 3-4. InterDigital's present discovery motion rests on a similarly speculative theory, asserting that Disney is an RPI to Dolby and using that speculation as a basis for seeking joint defense agreements. But here again, InterDigital fails to show that the

documents it seeks would yield information relevant to the hypothesis used to justify its request. Indeed, InterDigital concedes the absence of any IPR-specific predicate for discovery, acknowledging “there have been no actual communications or coordination between Dolby and Disney specifically relating to this IPR.” Mot. 5, n. 2.

II. *GARMIN* FACTOR 1—INTERDIGITAL FAILS TO IDENTIFY EVIDENCE THAT ITS REQUESTED PRODUCTION WOULD YIELD USEFUL INFORMATION

A. There Is No Proof of Coordination, Communication, Funding, Or Control Between Disney And Dolby Relating To This IPR

Under *Garmin* factor 1, additional discovery requires evidence “tending to show beyond speculation that in fact something useful will be uncovered,” and “useful” means more than “relevant” or “admissible.” IPR2012-00001, Pap. 26, 6-7 (PTAB Mar. 5, 2013). Here InterDigital identifies no such evidence, let alone a showing that any JDA would contradict Dolby’s undisputed representations that there were no IPR-related communications, no funding by Disney, and no direction or input from Disney regarding the Petition. Indeed, InterDigital, as the moving party, “should **already be in possession** of evidence tending to show beyond speculation that in fact something useful will be uncovered.” IPR2014-00199, Pap. 34, at 4 (PTAB Aug. 11, 2014). But InterDigital acknowledges its speculative reliance on “reasonable inferences drawn from publicly available information,” not

evidence tying any JDA to its RPI hypothesis. Mot., 2-3. *Garmin* factor 1 is dispositive, and InterDigital's motion should be denied.

This is further evident from Interdigital's reliance on alleged "coordinated efforts," which do not support its request for JDA discovery. Mot., 3. The activities InterDigital identifies merely reflect parallel interests arising from separate disputes with InterDigital—not coordination relating to this IPR. For instance, after InterDigital asserted multiple patents against Disney, Disney independently and naturally filed *ex parte* reexamination requests. But those reexaminations concern patents that are substantively unrelated to the '268 patent and involve different accused products. See Mot., 3-5.

Even if InterDigital's cited activities could be characterized as relevant coordination (they cannot), they would still fall short of what is required to justify discovery into alleged RPI status. To demonstrate that an unnamed party has the ability to control, direct or fund an IPR proceeding demands more than "a desire, and common interest" with the petitioner to invalidate a patent, and more than collaborating or even "invoking a common interest privilege" with the petitioner. IPR2014-01478, Pap. 72, 45-46 (PTAB Jul. 11, 2016). Even assuming, *arguendo*, that JDA(s) exist between Disney and Dolby, and even assuming that, *arguendo*, that the JDA(s) reflect collaboration between Disney and Dolby, InterDigital has still failed to show that compelled production would inform an RPI inquiry.

B. JDAs Would Not Yield Useful Information Relating to InterDigital’s RPI Hypothesis

The RPI inquiry focuses on whether a non-party “exercised or could have exercised control over a party’s participation in a proceeding.” IPR2014-00440, Pap. 68, p. 14 (PTAB Aug. 18, 2015). InterDigital speculates that a JDA may specify “detail[] the roles and responsibilities between Dolby and Disney as it relates to their joint defense against InterDigital,” but this is not evidence tending to show beyond speculation that Disney controlled, funded, requested, directed, or coordinated the Petition. Mot., 5.

Prior Board decisions also make clear that a JDA, without more, does not substantively support InterDigital’s RPI hypothesis. In *Box*, the Board declined to find an unnamed party an RPI despite participation in a JDA, shared counsel between petitioner and the unnamed party, and “identical invalidity contentions.” IPR2023-00427, Pap. 64, 9-10 (PTAB Aug. 1, 2024); *see id.*, 14-21. The Board reached this finding in part because “Patent Owner points to no communications between Petitioner and [unnamed party]” and characterized statements that the unnamed party being interested in Board review as “speculation.” *Id.*, 19-20. Likewise, in *Petroleum Geo-Services*, the Board made clear that “undertaking a joint defense and assertion of a common interest privilege does not, without more, indicate privity,” and “[c]ollaboration, by itself, is not evidence” of control or funding of the petition. *Petroleum Geo-Services*, at 45-46. Accordingly, the mere existence of a

JDA—without more, i.e., evidence of control, funding, or direction—does not show that discovery will uncover “useful” information bearing on InterDigital’s RPI theory and as required under *Garmin*.

**C. The Board Has Denied The Type of JDA Discovery
InterDigital Seeks**

In *Wavemarket*, the Board denied discovery requests seeking production of JDAs despite “shared counsel” among petitioner and unnamed parties and the admitted existence of JDAs between them because these facts failed to “demonstrate[] beyond speculation that something useful will be uncovered and will factually support [patent owner’s] contention that the Petition fails to identify all real parties-in-interest...” IPR2014-00199, at 5. The facts here are even weaker—there is no shared counsel between Dolby and Disney, no evidence of any IPR-related communications, and no information suggesting funding, direction, control, request, or input by Disney concerning the Petition.

In contrast, none of the authority cited in InterDigital’s Motion involved the same type of request—production of JDAs on a factual record lacking specific communication, coordination, funding, or control. *Corning* addresses the RPI framework, not JDA discovery. *Savant* and *Samsung/Netlist* similarly did not implicate JDA discovery and further involved discovery into agreements under materially different facts. See IPR2024-01357, Pap. 73 (PTAB Apr. 30, 2026); IPR2022-00615, Pap. 40 (PTAB Feb. 3, 2023). These decisions do not supply the

missing factual nexus between InterDigital’s JDA discovery request and its RPI hypothesis.

The Board’s prior grants of JDA production involved factual indicia not present here, such as evidence of coordination and discussion of IPRs prior to petition filing (IPR2019-00627, Pap. 15, 6-8 (PTAB Apr. 25, 2019)), evidence of a petitioner and an unnamed party jointly preparing a witness and invoking privilege concerning communications amongst counsel (IPR2020-00882, Pap. 13, 16-17 (PTAB Jul. 30, 2020)), or a petitioner allegedly receiving prior art from an unnamed party (IPR2022-01311, Pap. 28, 3-5 (PTAB Jun. 2, 2023)).

III. *GARMIN* FACTORS 2-5 DO NOT OVERCOME INTERDIGITAL’S EVIDENTIARY FAILURE

The remaining *Garmin* factors do not cure InterDigital’s failure under Factor 1. Factor 3 weighs against production because Dolby already produced the indemnity materials on which InterDigital relies. Mot., 3 n.1. And as the Board has made clear, indemnity obligations do not establish RPI status where, as here, “there is no evidence on this record of control, funding, or substantial coordination” in connection with filing the petition. *Luminex Int’l Co. v. Signify Holdings B.V.*, IPR2024-00101, Pap. 47, 4-5 (PTAB Aug. 13, 2025). Indeed, even a third party’s desire to avoid infringement liability and requests for indemnity do not establish that the petition was filed at the party’s behest. *Id.* InterDigital effectively confirms the absence of any connection between indemnity agreements and its RPI theory by

failing to identify any indemnity provision suggesting control, funding, or substantial coordination between Dolby and Disney relating to this proceeding.

Garmin Factors 2, 4, and 5 likewise support denial. As to Factor 2, InterDigital argues that it does not seek litigation positions because it requests only a JDA and proposes redactions. Mot., 6. But the proposal of redactions cannot substitute for the threshold showing required to justify discovery, and JDAs may contain sensitive information concerning litigation-related relationships and litigation-related obligations. Nor is discovery warranted simply because the request is understandable or directed to an identifiable document.

IV. ORDERING PRODUCTION WOULD IMPROPERLY ENCOURAGE SPECULATIVE JDA DISCOVERY

Given the absence of any compelling showing under *Garmin*, ordering production of a confidential agreement between two parties would invite the use of PTAB discovery as a vehicle for fishing expeditions into sensitive information. Indeed, with its motion, InterDigital has asked the Board for relief that would serve to undermine not only the limits that have been thoughtfully imposed on PTAB discovery but, in them, the safeguards that have led to efficiencies and reduced burdens for the Board and parties alike.

V. CONCLUSION

For the foregoing reasons, the Director should deny InterDigital's Motion for Additional Discovery.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that the captioned PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY, and Exhibit 1058 were provided electronically via e-mail, on May 12, 2026, to the Patent Owner by serving the correspondence addresses of record as follows:

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