

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOLGE LLC,
Petitioner,

v.

IPA TECHNOLOGIES INC.,
Patent Owner.

IPR2019-00728 (Patent 6,851,115 B1)
IPR2019-00730 (Patent 7,069,560 B1)
IPR2019-00731 (Patent 7,069,560 B1)¹

Before KEN B. BARRETT, TREVOR M. JEFFERSON, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

ORDER

Granting In Part Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ We exercise our discretion to issue this order in each case using a joint caption. Unless otherwise authorized, the parties are not permitted to use a joint caption.

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I. INTRODUCTION

On February 20, 2020, we held a conference call with counsel for Petitioner, Google LLC (“Petitioner”), and Patent Owner, IPA Technologies Inc. (“Patent Owner”). During the call, we authorized Petitioner to file a motion for additional discovery from Patent Owner and third party, SRI International (“SRI”), who provided evidence and supporting declarations to Patent Owner. Paper 44 (“Mot.”), 1.² We also authorized Patent Owner to file an Opposition (Paper 47 (“Opp.”)), and Petitioner to file a reply (Paper 51, (“Reply”)).

At issue in each of these proceedings is whether a publication (Ex. 1011) that lists Dr. Moran as an author with the named inventors of the challenged patents (Adam Cheyer and David Martin) is prior art because it is the work of a different inventive entity than the patents at issue. Mot. 1. Patent Owner’s Response submitted declarations from two SRI employees (Ms. Archana Bhuta and Ms. Allison Wood) that provide Dr. Moran’s employment agreement with SRI and assert that SRI’s records show that Dr. Moran did not file an invention disclosure related to the inventions of the patents at issue. Mot. 1 (citing Paper 40 (“PO Resp.”) 42–45; Ex. 2012 (Declaration of Ms. Archana Bhuta); Ex. 2013 (Declaration of Ms. Allison Wood); Ex. 2022 (employment agreement)).

² Citations to filed papers reference IPR2019-00728. Similar papers were filed in IPR2019-00730 and IPR2019-00731. *See* Papers 43, 45, 49 (IPR2019-00730); Papers 44, 45, 50 (IPR2019-00731).

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In response to Patent Owner's arguments, Petitioner seeks discovery of three sets of documents from Patent Owner and SRI. Specifically, Petitioner seeks:

1. Invention disclosures submitted to SRI by Adam Cheyer, David Martin, or Luc Julia, or submitted by anyone else identifying Adam Cheyer, David Martin, or Luc Julia as an inventor, associated with U.S. Patent Nos. 6,851,115, 7,069,560, or 7,036,128.
2. Adam Cheyer, David Martin, or Luc Julia employment agreements with SRI.
3. Documents or things describing a financial interest that SRI, Archana Bhuta, or Allison Wood have in maintaining the validity of U.S. Patent Nos. 6,851,115, 7,069,560, or 7,036,128, including any financial interest SRI, Archana Bhuta, or Allison Wood have in any litigation or licensing associated with U.S. Patent Nos. 6,851,115, 7,069,560, or 7,036,128.

Mot. 3–4 (citing Mot. Appendices A, B). Although Patent Owner's evidence references Messrs. Cheyer and Martin (PO Resp. 42–45), Petitioner seeks information regarding Cheyer's co-inventor, Luc Julia, on U.S. Patent No. 7,036,128 that is at issue in related cases, IPR2018-00733 and IPR2018-00734, in which the disputed publication (Ex. 1011) is also at issue. Mot. 2–3. Although in the IPR2018-00733 and IPR2018-00734 proceedings, Patent Owner does not contest the Exhibit 1011 publication is prior art, Petitioner argues that Julia's SRI inventor disclosures and

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employment agreement—like those of his co-inventor Cheyer—are relevant to the issue of Dr. Moran’s compliance with SRI’s policies addressed in Patent Owner’s Response. Mot. 3–4 n.3; PO Resp. 42–45.

In the first two document requests (Requests 1 and 2), Petitioner seeks additional discovery to obtain evidence addressing whether the inventors of the challenged patents in IPR2019-00728, IPR2019-00730, IPR2019-00731, and a closely related patent with common inventors in IPR2019-00733 and IPR2019-00734, were required to submit invention disclosures and submitted such disclosures for U.S. Patent Nos. 6,851,115, 7,069,560, or 7,036,128. In the third request (Request 3), Petitioner seeks documents describing any financial interest that SRI, or Patent Owner’s declarants from SRI, Archana Bhuta, or Allison Wood, have in the litigation or licensing of U.S. Patent Nos. 6,851,115, 7,069,560, or 7,036,128. Mot. 4–5.

We discuss Petitioner’s additional discovery requests below.

A. DISCUSSION

Additional discovery is limited to instances where it is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5). To apply that standard, we consider the factors described in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential).

1. *More Than a Mere Possibility and Mere Allegation*

“[T]he requester of information should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” *Garmin*, Paper 26 at 6, 7. In that context, “‘useful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7.

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With respect to Requests 1 and 2, Petitioner argues that the declarations of Ms. Bhuta and Ms. Wood (Exs. 2012, 2013) support that the existence or nonexistence of the first two document requests are within the purview and control of SRI and their witnesses that Patent Owner proffered in their Response. Mot. 6–8. Petitioner asserts that Patent Owner’s reliance on the lack of an invention disclosure for Dr. Moran, one of the listed authors of Exhibit 1011, to suggest that his contribution to the subject matter was not inventive raises the issue of whether the other authors and inventors followed SRI’s alleged employment agreement based procedures with respect to invention disclosures. Mot. 7.

Patent Owner argues that Petitioner misconstrues its argument, which is limited to Dr. Moran’s lack of corroboration as to the alleged inventions of the challenged claims at issue. Opp. 4. Patent Owner argues that its Response states that, “[g]iven that Moran was required to disclose discoveries, improvements, and inventions to SRI, and he did not, these facts undercut Petitioner’s claim that Moran conceived of any key features described in Martin [Ex. 1011] as it relates to the [patents at issue].” PO Resp. 45; Opp. 4. Thus, Patent Owner’s argument addresses the lack of invention disclosure by Dr. Moran as evidence of Moran’s lack of contribution of inventive matter and not the contributions of the inventors.

We do not find that Patent Owner’s arguments about the lack of invention disclosure for Dr. Moran persuasively address the usefulness of the information sought by Petitioner. We agree instead with Petitioner that regardless of the characterization of Patent Owner’s arguments, the information Petitioner seeks addresses an issue raised by Patent Owner as to

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whether the inventors—Cheyer, Martin, and Julia—followed the practices that Patent Owner’s SRI declarants testify Dr. Moran would have followed with respect to the disclosures in the asserted publication or the claimed invention. Reply 2 n.1. Petitioner also provides sufficient evidence that the existence (or non-existence) of the documents sought is readily obtainable based on the testimony of Patent Owner’s declarants. Mot. 2–3.

In light of the issue raised by Patent Owner, we agree that Petitioner presents a sufficient argument that the information about whether the named inventors provided invention disclosures to SRI as required by employment agreements would be evidence favorable in substantive value and reasonable rebuttal to Patent Owner’s argument regarding the alleged prior art and the claimed inventions.

With respect to the financial interest documents that Petitioner seeks in Request 3, we are not persuaded by Petitioner’s motion. Petitioner’s third request for documents or things describing a financial interest that SRI, Archana Bhuta, or Allison Wood have in the litigation or patents at issue seeks evidence for bias or credibility determinations with respect to the limited testimony Patent Owner relies on in the Patent Owner Response. Mot. 8–9. Petitioner’s arguments amount to credibility and weight evidence regarding the “possibility of Ms. Bhuta and Ms. Wood (who are employees of SRI) being guided to provide testimony favorable to [Patent Owner] due to obligations they may owe to SRI.” Mot. 8–9. Here, the mere possibility that Ms. Bhuta and Ms. Wood or their employer SRI may have financial interest in Patent Owner’s asserted claims does not add to the substantive value of Petitioner’s contentions.

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The Board accords witnesses weight and credibility in accordance with the circumstances of the case, which the parties may argue and support on the existing or developed record. Petitioner's search for financial evidence of bias by these SRI declarants or their employer in light of the limited testimony these declarants provide does not entitle Petitioner to this additional discovery.

Thus, with respect to Petitioner's Request 3, Petitioner has not shown that the evidence would be favorable in substantive value to Petitioner's contention.

2. Litigation Positions and Underlying Basis; Easily Understandable Instructions; and Ability to Generate Equivalent Information by Other Means

We agree that Petitioner's Requests 1 and 2 do not seek litigation positions or the basis for those positions. Mot. 9. We also agree that Petitioner's requests are understandable. *Id.* at 10.

With respect to generating equivalent information by other means, Patent Owner asserts that Petitioner should have obtained the employment agreement discovery and invention disclosure discovery (Requests 1 and 2) during its previous depositions of inventors Cheyer and Martin. Opp. 9. Petitioner replies that the depositions of Cheyer and Martin took place before Patent Owner filed its response arguing that the absence of a Dr. Moran invention disclosure supports its contention regarding the prior art and the claimed invention. Reply 4. Accordingly, we do not agree with Patent Owner that Petitioner should have sought the information via discovery from the inventors.

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Patent Owner also notes that “[Petitioner] has served discovery requests in the parallel district court litigation that cover the Requests 1 and 2 documents it seeks through the instant Motion.” Opp. 9. Thus, Patent Owner argues that Petitioner could have proceeded through district court litigation to obtain permission to use pertinent documents responsive to related discovery requests and produced under a protective order. *Id.* at 10 (citing *Duncan Parking Tech., Inc. v. IPS Grp. Inc.*, IPR2016-00067, Paper 18 at 3 (PTAB Sep. 27, 2016); *St. Jude Medical, LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 37 at 6 (PTAB Oct. 18, 2018)). Based on the circumstances in this case, we are not persuaded. Neither Patent Owner nor Petitioner asserts that the particular documents Petitioner seeks were produced in district court litigation or that SRI is a party to that litigation. Opp. 9; Reply 5. Accordingly, we are not persuaded that the documents sought are available by other means requiring Petitioner to seek them in related district court litigation.

3. Requests Not Overly Burdensome to Answer

Petitioner argues that its requested discovery is “sensible and responsibly tailored according to a genuine need.” *Garmin*, Paper 26 at 14–16; Mot. 10. We also agree, with respect to Requests 1 and 2, that Petitioner has demonstrated the information sought would not be overly burdensome. Mot. 10; *see* Ex. 2012; Ex. 2013.

With respect to Request 3, we are not persuaded that the request for financial interests of SRI or the individual SRI declarants is sufficiently limited to warrant the breadth of Petitioner’s request.

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B. CONCLUSION

After considering the *Garmin* factors, we determine that Petitioner is entitled to the discovery it seeks with respect to Requests 1 and 2. We are not persuaded that Petitioner is entitled to the financial information sought in Request 3. Accordingly, we determine that Petitioner's Requests 1 and 2 are in the interests of justice pursuant to 37 C.F.R. § 42.51(b)(2). We do not find that Request 3 is in the interests of justice pursuant to 37 C.F.R. § 42.51(b)(2).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for Additional Discovery is *granted* for Requests 1 and 2 and *denied* for Request 3;

FURTHER ORDERED that Petitioner's discovery request to compel production of documents from SRI International for Requests 1 and 2 is *granted*; and

FURTHER ORDERED that Petitioner is authorized under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States court for the district where SRI International document production regarding Requests 1 and 2 is located.

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FOR PETITIONER:

Naveen Modi
Joseph Palys
Daniel Zeilberger
Arvind Jairam
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com
arvindjairam@paulhastings.com

FOR PATENT OWNER:

Steven Hartsell
Alexander Gasser
Sarah Spires
SKIERMONT DERBY LLP
shartsell@skiermontderby.com
agasser@skiermontderby.com
sspires@skiermontderby.com