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Paper No. 6
Filed: January 31, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARM LIMITED AND ARM, INC.,
Petitioner,

v.

COMPLEX MEMORY, LLC,
Patent Owner.

———————

Case IPR2019-00053 (Patent 5,890,195)
Case IPR2019-00058 (Patent 6,658,576 B1)[1]

———————

Before KARL D. EASTHOM, DENISE M. POTHIER, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
*37 C.F.R. § 42.5(a)*

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[1] This Order issues in both cases as it addresses an identical issue in each case. The parties, however, must seek prior authorization to use this heading style for any subsequent papers. For simplicity, we refer to the papers submitted in IPR2019-00053 in this Order.

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# I. BACKGROUND

On October 12, 2018, Petitioner, ARM Ltd and ARM, Inc. ("ARM"), filed two Petitions, requesting *inter partes* review of certain claims of U.S. Patent Nos. 5,890,195 and 6,658,576. IPR2019-00053, Paper 2; IPR2019-00058, Paper 2.

A teleconference was held on January 10, 2019, among counsel for Petitioner and Patent Owner, and Judges Easthom, Pothier, and Boudreau, related to the above IPRs. During the conference, Patent Owner requested authorization to file a motion for additional discovery. Patent Owner identified the three categories of discovery it seeks: (1) limited communications between ARM and its licensees, (2) indemnification obligations, and (3) one deposition.

Patent Owner explained only ARM has been identified as the real party in interest in these proceedings, while ARM has not been identified in related infringement suits. Patent Owner identified five litigations listed in Mandatory Notice by Patent Owner Under 37 C.F.R. § 42.8 ("Paper 3"): (1) *Complex Memory LLC v. Renesas Electronics Corp. et al*, Case No. 5:18-cv-04103 (N.D. Cal. July 10, 2018), (2) *Complex Memory, LLC v. Motorola Mobility LLC*, Case No. 1:18-cv06255 (N.D. Ill. September 13, 2018), (3) *Complex Memory LLC v. ZTE Corporation et al*, Case No. 3:17-cv03196 (N.D. Tex. November 21, 2017), (4) *Complex Memory, LLC v. Texas Instruments, Inc. et al*, Case No. 2:17-cv-00699 (E.D. Tex. October 13, 2017, terminated July 6, 2018), and (5) *Complex Memory, LLC v. Huawei Device USA Inc. et al*, Case No. 2:17-cv-00700 (E.D. Tex. October 13, 2017, terminated July 26, 2018). Paper 3, 1–2.

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For Patent Owner, these litigations raise questions concerning the extent the parties named in the infringement suits have control over or financial involvement with the instant IPRs. Patent Owner argues IPR2019-00053 is identical to IPR2018-00823 filed by Texas Instruments Inc. ("Texas Instruments"), which has been dismissed. *Texas Instruments Inc. v. Complex Memory LLC*, Case IPR2018-00823 (PTAB August 8, 2018) (Paper 12). Patent Owner stated specifically it has an interest to identify the correct real party-in-interests in these proceedings, including an interest in having the ability to raise estoppel, and the above requested discovery may lead to evidence showing unnamed real parties in interest in these proceedings.

We deny the request for the below-stated reasons.

## II. INTRODUCTION

### A. *Additional Discovery*

Under the Leahy-Smith America Invents Act ("AIA"), discovery is available for the deposition of witnesses submitting affidavits or declarations and for "what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5). Our corresponding rules allow for routine discovery, providing: "[c]ross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set." 37 C.F.R. § 42.51(b)(1)(ii).

In addition to routine discovery, our rules allow for additional discovery, further providing: "[t]he moving party must show that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). As the movant, Patent Owner bears the burden of establishing that the

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request is in the interest of justice. We generally consider five factors (the "*Garmin* factors") in determining whether the interests of justice would be served by granting additional discovery requests. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential). In *Garmin*, we held that the following factors (the so-called "Garmin factors") are important in determining whether additional discovery is necessary in the interest of justice:

> 1. More Than A Possibility And Mere Allegation — The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.
>
> 2. Litigation Positions And Underlying Basis — Asking for the other party's litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.
>
> 3. Ability To Generate Equivalent Information By Other Means — Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.
>
> 4. Easily Understandable Instructions —The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear.

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> Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.
>
> 5. Requests Not Overly Burdensome To Answer — The requests must not be overly burdensome to answer, given the expedited nature of Inter Partes Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of Inter Partes Review. Requests should be sensible and responsibly tailored according to a genuine need.

*Id.*

*B. Real Parties In Interest, Privies, And Time Bar*

The AIA requires that "[a] petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest." 35 U.S.C. § 312(a). In addition, "[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. §315(b). Our corresponding rules allow any "person who is not the owner of a patent" to file a petition unless "[t]he petition requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent." 37 C.F.R. § 42.101.

"To decide whether a party other than the petitioner is the real party in interest, the Board seeks to determine whether some party other than the petitioner is the 'party or parties *at whose behest the petition has been filed*.'" *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018) (emphasis added). "A party that funds and directs and controls an IPR

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