

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RED.COM, LLC,
Patent Owner

IPR2019-01065
Patent No. 9,245,314

**PETITIONER'S MOTION FOR PRE-INSTITUTION
DISCOVERY FROM PATENT OWNER**

PETITIONER'S EXHIBIT LIST

Updated: Sept. 4, 2019

Ex. 1001	U.S. Patent No. 9,245,314
Ex. 1002	Prosecution History of U.S. Patent No. 9,245,314
Ex. 1003	Declaration of Cliff Reader, Ph.D. under 37 C.F.R. § 1.68
Ex. 1004	Curriculum Vitae of Cliff Reader, Ph.D.
Ex. 1005	U.S. Patent No. 9,565,419 to Presler ("Presler")
Ex. 1006	U.S. Patent No. 7,656,561 to Molgaard et al. ("Molgaard")
Ex. 1007	Ning Zhang et al., "Lossless Compression of Color Mosaic Images," <i>IEEE Transactions on Image Processing Vol. 15, No. 6</i> (June 2006) ("Zhang")
Ex. 1008	Ben Long, REAL WORLD APERTURE, 1 st Ed., ISBN: 0-321-44193-1 (July 11, 2006) ("Long")
Ex. 1009	Serial ATA International Organization: Serial ATA Revision 2.6 (Feb. 15, 2007)
Ex. 1010	U.S. Provisional Application No. 60/911,196 ("The '196 Application")
Ex. 1011	U.S. Provisional Application No. 61/017,406 ("The '406 Application")
Ex. 1012	U.S. Provisional Application No. 60/923,339 ("the '339 Application")
Ex. 1013	U.S. Patent No. 7,349,574 to Sodini et al. ("Sodini")
Ex. 1014	U.S. Patent No. 8,170,402 to Frost-Ruebling et al. ("Frost")
Ex. 1015	Reserved
Ex. 1016	U.S. Patent No. 3,971,065 to Bayer ("Bayer")
Ex. 1017	Excerpts from comment board

I. RELIEF REQUESTED

Patent Owner RED.COM, LLC (“RED”) asserts actual reduction to practice of two cameras and relies on the testimony of interested parties for support. *See* POPR, pp.3-4; Exs. 2001, 2011, 2017. Notwithstanding the fact that “a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an inter partes review” (37 C.F.R. § 42.108(c)), Petitioner, as authorized by Paper 9, respectfully requests discovery of the following so that the Board can consider a more complete record:¹

1. Deposition of Messrs. Jannard, Nattress, and Land, pursuant to 37 C.F.R. § 42.53, each of whom submitted declarations in each proceeding to support RED’s claim of actual reduction to practice of the “Boris” and “Natasha” cameras (*see* Exs. 2001, 2011, and 2017);
2. Technical documentation in RED’s possession dated prior to April 13, 2007 regarding the “Mysterium CMOS image sensor” (*see* POPR at 36);
3. Physical access to inspect the “Boris” and “Natasha” cameras by Petitioner’s counsel and expert; and
4. Electronic copies of data files in RED’s possession generated by either the “Boris” or “Natasha” cameras prior to April 13, 2007, with metadata.

¹ Petitioner is filing a near identical motion in IPR2019-01064, but both motions constitute a single request for discovery for the combined proceedings.

For discovery requests, the Board considers (1) where there is more than a “mere allegation” something useful will be uncovered; (2) the request does not attempt to alter the Board’s trial procedure by seeking litigation positions; (3) equivalent information is not easily obtainable by other means; (4) instructions are easy to understand; and (5) requests are not overly burdensome. *Garmin Int’l Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, at 6-16 (precedential). Discovery here is in the “interests of justice” because evidence on the threshold issue of actual reduction to practice is “uniquely in the possession of the party that raised it.” 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012).

A. *Garmin* Factor One Strongly Favors Production

Petitioner seeks discovery that is “more than a possibility and mere allegation” because RED alleges actual reduction to practice of two cameras, neither of which was fully disclosed in a patent application until over 9 months later when the ’406 provisional application was filed. *See* Ex. 1011, pp.21-64. This delay calls into question Patent Owner’s alleged reduction to practice date. *DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1126 (Fed. Cir. 1991) (“events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred.”).

To fill this 9-month gap, RED relies on testimony of interested parties. But this testimony fails at a minimum to describe a key claimed element—the “image

sensor.” Tellingly, RED relies solely on its declarants that the “Boris” and “Natasha” cameras “employed a Mysterium CMOS image sensor, which implemented a Bayer pixel pattern.” POPR, pp.35-36. RED offers nothing else—no photographs, no data sheets, no development contracts with third-parties, etc.—showing an image sensor “comprising first, second and third pluralities of light sensitive devices” that was “configured to convert ... raw mosaiced image data” and “output ... resolution of at least 2k and at a frame rate of at least about 23 frames per second....” Ex.1001, 15:47-63. Cross-examination of RED’s declarants will therefore produce probative evidence, as each declarant implies specific knowledge of the Mysterium image sensor. *See* Ex. 2001, p.4; Ex. 2017, p.8; Ex. 1017, p.2 (comment by declarant Jannard that he “found” the Mysterium image sensor), *available at* <http://www.reduser.net/forum/showthread.php?53370-RED-A-Look-Back&p=997323&viewfull=1#post997323>.

Consequently, cross-examination of RED’s declarants is “necessary in the interest of justice” because it will better enable the Board to assess if testimony by interested parties technically and credibly support RED’s alleged actual reduction to practice. *See* IPR2013-00576, Paper 36 (stating that as a result of not making declarant available “we will give that Declaration little to no weight as Patent Owner has not been offered a fair opportunity to challenge his testimony”); *see also* Fed. R. Evid. 801, 802. Moreover, this request only seeks evidence based on

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