

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

RED.COM, LLC,  
Patent Owner.

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Case IPR2019-01064 (Patent 9,230,299 B2)  
Case IPR2019-01065 (Patent 9,245,314 B2)

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Before BRIAN J McNAMARA, J. JOHN LEE, and JASON M. REPKO,  
*Administrative Patent Judges.*

REPKO, *Administrative Patent Judge.*

ORDER

Denying Petitioner's Motion for Pre-Institution Discovery  
Granting Petitioner's Request for a Reply to Patent Owner's Preliminary  
Response

37 C.F.R. §§ 42.5 and 42.51(b)

## SUMMARY

Petitioner seeks to address Patent Owner's argument and evidence about actual reduction to practice with pre-institution discovery and a reply to Patent Owner's preliminary response. In a conference call on August 27, 2019, Judges Lee and Repko authorized Petitioner to file a motion for pre-institution discovery in both IPR2019-01064 and IPR2019-01065. *See* Paper 9<sup>1</sup>; Ex. 3001 (email dated Aug. 26, 2019). Patent Owner was authorized to file an opposition. Paper 9. Authorization for Petitioner's reply was held in abeyance. *Id.*

Petitioner filed the motion. Paper 10 ("Mot."). Patent Owner filed its opposition. Paper 12 ("Opp.").

This order addresses Petitioner's request for a reply and its motion for pre-institution discovery. As discussed below, we grant the request for a reply but deny the motion for discovery. We authorize Patent Owner to file a sur-reply of equal length to Petitioner's reply.

### PETITIONER'S MOTION FOR PRE-INSTITUTION DISCOVERY

To determine whether to allow additional discovery, the Board applies several factors on a case-by-case basis. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential) (listing factors). Here, Petitioner requests

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

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<sup>1</sup> For brevity, we refer to the documents from IPR2019-01064. The filings in IPR2019-01065 are substantially similar in all respects relevant to this order.

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.

Motion 1.

Petitioner argues that *Garmin* factor one strongly favors production.

*Id.* at 2–4. *Garmin* factor one is as follows:

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.

*Garmin*, slip op. at 6.

Petitioner argues that “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.”

Motion 2 (citing Ex. 1011, 21–64). Petitioner argues that “[t]his delay calls into question Patent Owner’s alleged reduction to practice date.” *Id.*

In Petitioner’s view, Patent Owner relies on the testimony of interested parties to fill this nine-month gap. *Id.* at 2–3. Petitioner argues that the testimony will “better enable” the Board to evaluate credibility and the technical merit of the claims. *Id.* at 3.

Petitioner also argues that the requested documentation and access to the cameras “is necessary to assess whether the ‘Boris’ and ‘Natasha’ cameras support RED’s actual reduction to practice claim.” *Id.* at 4. In Petitioner’s view, Patent Owner cites “generalized statements” with “no other supporting evidence” to show actual reduction to practice. *Id.*

In Patent Owner’s view, “Petitioner’s supposed need for discovery is no more than its stated need to confirm the testimony that sensor, processor, and compression components existed in the cameras.” Opp. 3. According to Patent Owner, “if granted, the pre-institution phase would essentially become a de facto trial phase, turning the entire decision on whether to institute a trial on its head.” *Id.* at 1.

Considering the time remaining until we must issue a decision on institution, Petitioner’s discovery request and corresponding briefing places a burden on this proceeding’s schedule. As Patent Owner points out, “Petitioner seeks pre-institution discovery encompassing three unrestricted depositions, multiple categories of documents and data files from over 12 years ago, and two physical inspections.” *Id.* The scope of this request and the time remaining until we must issue our decision leads us to deny Petitioner’s request under the *Garmin* factors, as discussed below.

As for *Garmin* factor one, Petitioner’s request for a physical inspection of the camera may help in assessing whether the sensor, processor, and compression components existed in the cameras and whether their performance met the limitations of the challenged claims. Motion 1. So there is some merit to Petitioner’s contention that *Garmin* factor one weighs in favor of the requests. *Id.* at 2–3.

In Petitioner’s view, the documents and data files are relevant to “technical aspects and performance.” *See id.* at 4. But the request lacks an explanation of what specific “technical documentation,” “data files,” and “metadata” would be useful here in assessing whether Patent Owner reduced to practice the invention claimed in the patents at issue. *Id.* at 1. Given the breadth of the request, Petitioner’s contention that the documents and data would be useful is somewhat speculative. On balance, *Garmin* factor one is neutral or, at best, only slightly favors Petitioner’s request.

We determine that *Garmin* factors two and three tend to favor Petitioner’s request. For instance, under *Garmin* factor two, there is nothing in the record indicating that Petitioner is seeking litigation positions or their basis. *Garmin*, slip op. at 6. Indeed, the parties have not identified any related litigation on the record at this time. *See* Pet. 1; Paper. 4. Under *Garmin* factor three, Petitioner has shown that it is not able to generate equivalent information by other means. *Garmin*, slip op. at 6. In particular, Petitioner requests information from declarants, data and documents from Patent Owner, and physical access to two cameras. Motion 1, 5. Although factors two and three tend to favor production, the breadth of the discovery request and the limited time available, given the constraints of the pre-institution period, weigh against granting the request.

Under *Garmin* factor five, we consider whether the discovery request is overly burdensome to answer:

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.

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