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Paper 13
Date: May 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

CANON KABUSHIKI KAISHA,
Patent Owner.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)[1]

Before BART A. GERSTENBLITH, JOHN D. HAMANN, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

[1] This Order addresses issues that are identical in each of the above-identified proceedings. The parties are not authorized to use this caption without prior authorization.

DISCUSSION

We determined that the panel would benefit from additional briefing regarding the factors for discretionary denial under § 314(a), as identified in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Paper 7.[2] Thus, we authorized a Preliminary Reply and Preliminary Sur-Reply. *Id.* at 4.

Under *Fintiv*, we consider certain factors when a patent owner argues for discretionary denial in light of a district-court trial scheduled earlier than the projected deadline for the Board's final written decision in a particular case. *Fintiv*, Paper 11 at 4–16. Patent Owner requested, and we granted, authorization for a motion seeking additional discovery regarding Petitioner's relationship with parties in a related litigation, collectively identified as TCL or the TCL entities. Paper 8. Also, we granted Petitioner a response to Patent Owner's motion. *Id.*

Patent Owner's Motion for Additional Discovery asserts that it seeks discovery relevant to *Fintiv* Factors 4 and 5. Paper 9, 1 ("Mot."). Factors 4 and 5 consider "overlap between issues raised in the petition and in the parallel proceeding" and "whether the petitioner and the defendant in the parallel proceeding are the same party," respectively. *Fintiv*, Paper 11 at 12–14. Patent Owner argues that although Petitioner admits the TCL entities are Petitioner's privies, it "does not reveal the full extent of that relationship." Mot. 1–2. Thus, Patent Owner proposes five interrogatories. Mot. App'x A,

[2] Citations to the present proceedings are to IPR2020-00341. Corresponding papers appear in the record of each above-captioned proceeding.

3–4. Proposed Interrogatory 1 seeks information about "the full nature of the privity relationship" between Petitioner and TCL. *Id.* at 3. Proposed Interrogatory 2 seeks information about "direction, control, participation, and/or involvement" Petitioner has had regarding TCL's litigation positions. *Id.* Proposed Interrogatory 3 seeks identification of agreements between Petitioner and TCL concerning the litigation. *Id.* at 4. Proposed Interrogatory 4 seeks identification and description in detail of all discovery responses in the litigation that Petitioner contends relates to "direction, control, funding, participation, and/or involvement" by Petitioner in the litigation. *Id.* Proposed Interrogatory 5 seeks identification and description in detail of all discovery responses in the litigation that Petitioner contends relates to the same topics as Proposed Interrogatory 4. *Id.*

Patent Owner addresses factors identified in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential). According to Patent Owner, Petitioner's statements in the Petition and the related litigation "suggest[] a close relationship exists between TCL and Roku." Mot. 2–3. Patent Owner reasons that evidence supports that there is more than a possibility and mere allegation of the additional discovery uncovering something useful. *Id.* Petitioner contests such a conclusion, arguing that the "requested discovery is neither useful nor relevant to the *Fintiv* analysis." Paper 11 ("Opp."), 2.

Petitioner argues that *Fintiv* Factor 4 involves comparing IPR issues with litigation issues and therefore does not relate to any relationship between the parties. *Id.* We agree. Patent Owner has made no showing that

the discovery it seeks would have any bearing on the degree of "overlap between issues raised in the petition and in the parallel proceeding." *See Fintiv*, Paper 11 at 12–13.

As to *Fintiv* Factor 5, Petitioner argues that "TCL and Roku are plainly not the 'same party.'" Opp. 3. Rather, according to Petitioner, "Roku and TCL are admitted privies, and discovery into the precise contours of that relationship will never transform Roku into one of its customers." *Id.* Petitioner's analysis, however, is insufficient. Although *Fintiv* uses "same party" in the heading of Factor 5, the discussion of that factor repeatedly considers whether an IPR petitioner and a litigation party are "unrelated." *Fintiv*, Paper 11 at 13–14. Thus, our analysis considers more than the simple identities of the parties. We determine that the relationship between Petitioner and TCL likely impacts our analysis of *Fintiv* Factor 5. We further determine that Patent Owner has sufficiently supported that the discovery sought will produce something useful. *See* Mot. 2–3.

Patent Owner asserts that none of the proposed interrogatories seeks a litigation position because each relates only to the relationship between Petitioner and the litigation defendants, not the positions taken in litigation. *Id.* at 3. Patent Owner asserts that it could not generate the requested discovery itself, as Patent Owner's counsel in this proceeding does not have access to material already produced in the related litigation. *Id.* at 4. And Patent Owner asserts that the instructions are easily understandable. *Id.* at 5. Petitioner does not contest any of those assertions.

Patent Owner asserts that the proposed interrogatories are not overly burdensome, "especially since Roku's counsel has already acknowledged Roku has collected materials relevant to the requests." *Id.* Petitioner challenges that assertion, arguing that the proposed interrogatories are too broad because they seek a full range of possible information, without limiting the scope to a genuine need. Opp. 4–5. We determine that Proposed Interrogatories 1 and 2 sufficiently explore the relevant issue. Additionally granting Proposed Interrogatories 3, 4, or 5 would unnecessarily burden Petitioner with duplicative and vague requests unlikely to benefit our analysis. In particular, Proposed Interrogatory 1 focuses on the "nature of the privity relationship" and will allow us to evaluate the degree to which Petitioner and TCL are "unrelated" for *Fintiv* Factor 5. Proposed Interrogatory 2, while largely overlapping Proposed Interrogatory 1, ensures a more full understanding of the relationship, by including Petitioner's actual involvement in the relevant litigation. But the existence of agreements between Petitioner and the TCL entities (Proposed Interrogatory 3) is already captured in the nature of the privity relationship, and would unnecessarily extend the discovery into details only marginally relevant to our current inquiry. Proposed Interrogatories 4 and 5, by seeking identification of relevant discovery responses and document production from the related litigation, would impose a large burden on Petitioner while not expanding the relevant area of substance. Moreover, given the short timeline here for discovery before our analysis of the *Fintiv* factors, we determine Proposed Interrogatories 3, 4, and 5 are overly burdensome.

DOCKET ALARM

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