

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Case IPR2017-00126
Patent 7,161,319 B2

Before JONI Y. CHANG, JUSTIN T. ARBES and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

ORDER
Granting Motion for Additional Discovery
37 C.F.R. § 42.51

INTRODUCTION

On November 29, 2017, The Chamberlain Group, Inc., (“Patent Owner”) filed a motion seeking additional discovery in this proceeding. Paper 18 (“Mot.”). In particular, Patent Owner requests discovery of ten documents that are referenced in the International Trade Commission’s (“ITC’s”) Initial Determination (“ID”) *In the Matter of Certain Access Control Systems and Components Thereof*, ITC Investigation No. 337-TA-1016, involving U.S. Patent No. 7,161,319 (“the ’319 patent”), in a discussion of copying as a secondary consideration of nonobviousness. Mot. 1; *see also* Ex. 2013, 4; Ex. 2014, 212–222. On December 6, 2017, One World Technologies, Inc. (“Petitioner”) filed an opposition to the motion. Paper 19 (“Opp.”). For the reasons discussed below, we grant Patent Owner’s motion seeking additional discovery.

DISCUSSION

A party seeking additional discovery must do so by motion, and must show that the requested discovery is necessary “in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *see also* 35 U.S.C. § 316(a)(5)(b). As the moving party, Patent Owner bears the burden of establishing it is entitled to the requested discovery. 37 C.F.R. § 42.20(c). The Board has identified various factors to be considered in determining whether requested discovery is necessary in the interests of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, slip op. at 6–7 (PTAB March 5, 2013) (Paper 26) (precedential). These factors include whether the requested discovery: (1) is based on more than a mere possibility of finding something useful; (2) seeks the other party’s litigation positions or the basis for those positions; (3) seeks information that reasonably can be generated

without the discovery requests; (4) is easily understandable; and (5) is overly burdensome to answer. *Id.*

FIRST GARMIN FACTOR

The first *Garmin* factor considers whether the requested discovery is based on more than a mere possibility of finding something useful. Patent Owner argues this factor weighs in favor of granting discovery because the ITC's Initial Determination confirmed the existence and relevance of the requested documents, and found "the secondary consideration of copying has been shown to have meaningful weight." Mot. 1 (quoting Ex. 2014, 222). Petitioner argues this factor weighs against discovery because the ITC's administrative law judge ("ALJ") did not cite eight of the ten requested documents in his analysis of copying. Opp. 3 (citing Ex. 2014, 227–229). Petitioner further argues that two of the ten requested documents are written direct examinations of Patent Owner's expert, rather than Petitioner's own documents. *Id.* at 3–4. Petitioner further argues the ALJ's copying analysis failed to show a nexus to the invention claimed in the '319 patent. *Id.*

Although Petitioner is correct that the ALJ cited, in the portion of the ID analyzing secondary considerations of nonobviousness, only two of the ten requested documents that were introduced as evidence of copying in the ITC investigation, we nonetheless agree with Patent Owner that the first *Garmin* factor favors granting discovery of all ten documents because they are known to exist, and were at the very least submitted to and part of the record considered by the ALJ when considering the validity of the claims of the '319 patent. *See* Ex. 2014, 219 ("I find that the Record shows some level of copying of [Patent Owner's] technology by [Petitioner] in their

development of their own products; technology that has a nexus to the invention of the '319 patent.”). The ALJ rendered a decision on the validity of the challenged claims based on much of the same prior art that is being asserted by Petitioner in this proceeding, and found evidence of copying as a secondary consideration of nonobviousness to have “meaningful weight” in that determination. We likewise will determine in this proceeding whether Petitioner has shown the challenged claims to be unpatentable for obviousness. Under the particular factual circumstances of this case, we are persuaded that the requested discovery—the evidence of alleged copying submitted by Patent Owner and considered by the ALJ—to be based on more than a mere possibility of finding something useful.

SECOND GARMIN FACTOR

The second *Garmin* factor considers whether the requested discovery seeks the other party’s litigation positions or the basis for those positions. Patent Owner argues this factor weighs in favor of granting discovery because the requested documents are not sought for the purpose of identifying Petitioner’s litigation positions, and are not likely to reveal those positions. Mot. 1–2. Petitioner does not contend otherwise. Opp. 1–8. Accordingly, we find the second *Garmin* factor weighs in favor of granting the requested discovery.

THIRD GARMIN FACTOR

The third *Garmin* factor considers whether the requested discovery seeks information that reasonably can be generated without the discovery requests. Patent Owner argues this factor weighs in favor of granting discovery because the requested documents are Petitioner’s, and Patent Owner cannot obtain them from the ITC because they are subject to an ITC

protective order. Mot. 2. Petitioner argues this factor weighs in favor of denying discovery because Patent Owner has known about these documents for months, and could have timely sought permission from the ITC to obtain them. Opp. 4–5 (citing *Duncan Parking Techs., Inc. v. IPS Group Inc.*, IPR2016-00067, slip op. at 3–4 (PTAB Sept. 27, 2016) (Paper 18)).

We agree with Petitioner that Patent Owner could have earlier sought relief from the ITC (e.g., authorization to submit the requested documents in this proceeding). We also note, however, Patent Owner’s statement that it requested Petitioner’s production of documents related to copying when Patent Owner first learned of such documents, but Petitioner denied the request as lacking specificity, relevance, and merit. *See* Mot. 3–4. Petitioner does not dispute this statement. *See* Opp. 1–8. Consequently, although we find both parties bear some fault for the late date of this request, the late date favors Petitioner’s prompt production of the requested documents. Accordingly, we find the third *Garmin* factor weighs in favor of granting the requested discovery.

FOURTH GARMIN FACTOR

The fourth *Garmin* factor considers whether the requested discovery is easily understandable. Patent Owner argues this factor weighs in favor of granting discovery because the request identifies a list of ten ITC exhibits identified by exhibit number. Mot. 2; *see also* Ex. 2013, 4. Petitioner does not contend otherwise. Opp. 1–8. Accordingly, we find the fourth *Garmin* factor weighs in favor of granting the requested discovery.

FIFTH GARMIN FACTOR

The fifth *Garmin* factor considers whether the requested discovery is overly burdensome to answer. Patent Owner argues this factor weighs in

favor of granting discovery because the requested documents are easily identifiable, are in Petitioner's possession, and can be easily produced electronically. Mot. 3. Patent Owner further argues that with nearly five months remaining in this proceeding, ample time exists to produce and consider the requested documents. *Id.* at 6. Petitioner argues this factor weighs against granting discovery because the impact on the scheduling of this proceeding is a factor to consider in whether the discovery is overly burdensome to answer. Opp. 5–6 (quoting *Garmin*, IPR2012-00001, Paper 26 at 14). Petitioner argues the hearing for this proceeding is less than two months away, and in addition to needing time to prepare for the hearing, Petitioner needs time to prepare various motions and oppositions that are contemplated by the current Scheduling Order. *Id.* at 7.

We acknowledge Petitioner's concerns with the timing of Patent Owner's request, but nonetheless find that the requested documents are clearly identified, easily located, and constitute a small number of documents, and there is ample time to produce the requested documents for Patent Owner's consideration. Accordingly, we find the fifth *Garmin* factor weighs in favor of granting the requested discovery.

CONCLUSION

As discussed above, we find the *Garmin* factors favor Patent Owner's request for the production of the requested documents identified on page 4 of Exhibit 2013. Petitioner is to produce the requested documents to Patent Owner by December 22, 2017.

ORDER

It is

ORDERED that Patent Owner's motion for additional discovery is *granted*; and

FURTHER ORDERED that Petitioner is to produce to Patent Owner the documents identified on page 4 of Exhibit 2013 by December 22, 2017.

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