

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ATLANTA GAS LIGHT COMPANY  
Petitioner

v.

BENNETT REGULATOR GUARDS, INC.  
Patent Owner

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Case IPR2013-00453  
US Patent No. 5,810,029

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Before JENNIFER S. BISK, JAMES B. ARPIN and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*

ORDER  
Authorizing Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

On March 25, 2014, a telephone conference call was held between respective counsel for the parties and Judges Bisk, Arpin, and Boucher. The conference call was initiated by the Board in response to a communication received from Patent Owner's counsel.

Patent Owner requests, and Petitioner opposes, authorization to file a motion for additional discovery. Specifically, Patent Owner seeks discovery regarding the exact relationship between Petitioner ("AGLC") and other entities, including MRC Global Inc. ("MRCG"), McJunkin Redman Corporation, AGL Resources, Inc., and AGLC Affiliates. According to Patent Owner, the requested information is relevant because MRCG was served a complaint more than a year before the petition in this case was filed and Patent Owner alleges the relationship between the entities is such that this proceeding is barred by 35 U.S.C. § 315(b). Petitioner disagrees with Patent Owner's allegation and argues that Patent Owner's requests are based solely on speculation.

After hearing the respective positions of the parties, the panel conferred and concluded that additional briefing is warranted. The panel authorized Patent Owner to file a Motion for Additional Discovery of no more than 15 pages due no later than Tuesday, April 1, 2014. The panel also authorized Petitioner to file an Opposition to the Motion, also of no more than 15 pages, due no later than Tuesday, April 8, 2014. In authorizing the filing of the Motion, the panel cautioned Patent Owner that a motion for additional discovery is unlikely to be granted if it is unduly broad or is

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written in the style of a district court litigation request for “all documents in the possession, custody, or control of AGLC that discuss, refer to or relate to . . . .” Such a request is unlikely to be found sufficiently narrowly tailored under the factors considered in deciding whether discovery is “necessary in the interest of justice.” *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). For guidance regarding such motions, we direct the parties to the following cases: *Garmin Int’l, Inc. et. al. v. Cuozzo Speed Techs. LLS*, IPR2012-00001 (“Decision on Motion for Additional Discovery”) (Paper 26); *Apple v. Achates Reference Publishing, Inc.*, IPR2013-00080 (Paper 17); *Broadcom Corp. v. Telefonaktiebolaget LM Ericsson*, IPR2013-00601 (Paper 23); *Nichia Corp. v. Emcore Corp.*, IPR2012-00005 (Paper 19); *RPX Corp. v. Virnetx Inc.*, IPR2014-00171 (Paper 33).

In particular, Patent Owner’s motion should address what evidence shows that Petitioner has discoverable documents that are relevant to determining whether any of the listed entities are real parties-in-interest or privies of Petitioner such that a § 315(b) bar would apply in this case.

It is

ORDERED that Patent Owner’s authorized motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is due by April 1, 2014, and is limited to 15 pages;

FURTHER ORDERED that Petitioner’s authorized opposition is due by April 8, 2014, and is also limited to 15 pages;

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FURTHER ORDERED that no reply is authorized;

FURTHER ORDERED that, in its motion, Patent Owner identify the discovery being requested and why the discovery is necessary in the interest of justice, specifically addressing Petitioner's alleged agreements, evidence of their existence, and why the sought-after discovery will establish the required privity or real party relationship.

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