

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION,
Petitioner.

v.

FELLOWES, INC.,
Patent Owner.

Case IPR2013-00566
Patent 8,464,767

Before JOSIAH C. COCKS, BENJAMIN D. M. WOOD, and RICHARD E. RICE,
Administrative Patent Judges.

COCKS, *Administrative Patent Judge.*

DECISION

Patent Owner Motion to Compel Additional Discovery
37 C.F.R. § 42.51(b)(2)

1. Introduction

Patent Owner, ACCO Brands Corporation (“ACCO”), has filed a motion to compel additional discovery. Paper 13 (“Mot.”). Petitioner, Fellowes Inc. (“Fellowes”), has filed an opposition to the motion. Paper 15 (“Opp.”). Both the motion and the opposition were authorized by the panel in the initial conference call that was conducted on March 20, 2014. *See* Paper 12.

According to Fellowes, it “seeks four categories of discovery from ACCO.” Mot., 4. Those categories are expressed by Fellowes as follows:¹

1. Documents ~~and things~~ sufficient to show the different approaches ACCO has conceived or developed to address the effect of fluttering articles during shredding on a thickness detector in a shredder, and the reasons for adopting or not adopting each in marketed ACCO shredders. Examples of such approaches include the use of intermediate and maximum thresholds or mechanical means for suppressing fluttering as described in US 7,624,938, the “sense and ignore” approach, and the later approach marketed as “Non-Stop Jam Free.”
2. Reports on ~~Documents and things related to any~~ customer or industry praise, feedback or reviews relating to the approaches in Request 1.
3. Documents ~~and things~~ relating to ACCO’s knowledge or consideration during the development of ACCO’s “Non-Stop Jam Free” feature of (a) Fellowes’ U.S. Patent No. 8,464,767 involved [in] this proceeding, its published application, or any patents/published applications related thereto by priority, and (b) any Fellowes shredder that use at least one criterion in addition to the violation of a maximum thickness threshold.

¹ The categories that are reproduced show “red-lining” provided by Fellowes to narrow the categories that were initially presented and discussed in connection with the initial conference call. Paper 13, 4.

4. Documents ~~and things relating to~~ sufficient to show the reasons for ACCO's decision to adopt the use of its "Non-Stop Jam Free" feature [to] address the effect of fluttering articles during shredding on a thickness detector in a shredder in favor of the "sense and ignore" approach used in its prior shredders.

Id. at 4-5.

For the reasons stated below, Fellowes's motion is *denied*.

2. Analysis

In connection with the initial conference call, the panel observed:

Pursuant to the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 stat. 284 (2011) ("AIA"), certain discovery, in some circumstances, is available in *inter partes* review proceedings. 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. §§ 51-53. The legislative history of the AIA makes clear that additional discovery should be confined to "particular limited situations, such as minor discovery that PTO finds to be routinely useful, or to discovery that is justified by the special circumstances of the case." 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). The statutory standard for permitting additional discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5). There is a one-year statutory deadline for completion of *inter partes* review, subject to limited exceptions. 35 U.S.C. § 316(a)(11); *see also* 37 C.F.R. § 42.100(c). Given the statutory deadlines imposed by Congress and with the limited nature of additional discovery in *inter partes* review proceedings, the Board will be conservative in authorizing additional discovery. *See* 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) ("Given the time deadlines imposed on these proceedings, it is anticipated that, regardless of the standards imposed in [sections 316 and 326], PTO will be conservative in its grants of discovery.")

Paper 12, 4-5.

The panel also referred the parties to *Garmin International, Inc. et al. v. Cuozzo Speed Technologies LLC.*, IPR2012-00001, Paper 26 (March 5, 2013)

(“*Garmin*”), as setting forth important factors that the panel will consider in deciding Fellowes’s Motion to Compel Additional Discovery. *Id.* at 5. We make particular reference to the following factors articulated in the *Garmin* case:

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.

Ability To Generate Equivalent Information By Other Means -- Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.

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.

Garmin, Paper 26, 6-7.

In this case, Fellowes seeks additional discovery relating to certain “secondary considerations” of non-obviousness, including “long-felt but unmet need for the claimed invention, adoption of the claimed invention by a competitor, and adulation and praise of the claimed invention by others,” as well as “whether ACCO copied or derived its technology from Fellowes patents/application or products.” Mot. 9. Fellowes fails, however, to show that ACCO is in possession of evidence concerning such secondary considerations. Fellowes simply

speculates, for example, that products generated by ACCO may have been derived in some context from features of Fellowes's involved Patent No. 8,464,767 ("the '767 patent"). Fellowes also offers little more than speculation that ACCO may have "attempt[ed] and fail[ed]" to arrive at the invention of the '767 patent. Indeed, Fellowes's proffered support for that speculative possibility is simply an observation that an employee of ACCO, Mr. Aries, has at least three patents that Fellowes contends solves the problem of "paper fluttering" in a manner distinguished from solutions presented in the '767 patent. Mot. 5-6. Yet, Fellowes does not demonstrate that the particular "solutions" developed by Mr. Aries are tantamount to "failures" to arrive at the invention of the '767 patent.

A motion to compel additional discovery from a party is not an opportunity to enter into a "fishing expedition" in the hopes that something will emerge that will aid a party's case. In that regard, a party requesting additional information must already be in possession of a threshold amount of evidence or reasoning beyond speculation that useful material will be uncovered. *See Garmin*, Paper 26, 7. Here, Fellowes has not demonstrated that it possesses the requisite threshold evidence or offers reasoning beyond mere allegation that ACCO and its employees tried and failed to solve paper fluttering in a manner set forth in the '767 patent and necessarily copied or derived an approach that was laid out in the patent. Fellowes also does not offer any credible basis for its postulation that ACCO's "Non-Stop Jam Free" approach may have received praise or adulation as compared to possible criticism for other ACCO approaches. Mot. 9.

Furthermore, as admitted by Fellowes, material concerning the additional information that Fellowes seeks is already available as public records in the form of published patent documents. Mot. 6-8. Although Fellowes urges that it is "looking for further documentation to understand the rest of the story that went on

‘behind the scenes’,” it is apparent that the crux of what Fellowes seeks is information concerning Mr. Aries’s work on shredder products in which the issue of paper fluttering arose. We agree with ACCO that Fellowes can question Mr. Aries adequately about his opinions and work at ACCO during the deposition that is scheduled, evidently, for May 15, 2014, without additional discovery. *See* Opp. 7.

In addition, we agree with ACCO that certain of Fellowes’s requests for additional discovery are not narrowly tailored and would be overly burdensome for ACCO to comply with. *See* Opp. 8-10. For instance, in Request #1, approaches that “ACCO” has “conceived” of in the process of developing products addressing fluttering articles during shredding is vague and seemingly of such breadth as to encompass a virtually indeterminate number and type of documents. Similarly in Request #3, the production of documents “relating to ACCO’s knowledge or consideration” in developing ACCO’s “Non-Stop Jam Free” feature is insufficiently specific. That request would be overly burdensome because ACCO would need to scour indeterminately for documents generally “relating” to the collective knowledge of the company and its employees.

Furthermore, with respect to Request #4, we agree with ACCO that intrinsic to the request is the assumption that ACCO actively opted to favor a “Non-Stop Jam Free” shredder feature over a “sense and ignore” shredder feature. *See* Opp. 6. Fellowes has not explained adequately the underlying foundation for the assumption. As such, it is not apparent that Fellowes would be able to comply with the production of documents “sufficient to show” the assumption.

We also share ACCO’s view that in Request #2 the requested production of “[r]eports” is vague. Opp. 7-8. Although “reports” are seemingly a subcategory of “documents and things,” Fellowes does not explain adequately what material

constitutes a “report” or what characteristics of a document or item establishes it as a report.

3. Conclusion

For the reasons given above, we conclude that Fellowes’s motion has not met the “necessary in the interest of justice” standard for any of the requested items of discovery set forth its Motion.

4. Order

It is ORDERED that Fellowes’s motion to compel additional discovery is *denied*.

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Patent 8,464,767

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