

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 B2

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

COCKS, *Administrative Patent Judge.*

INITIAL CONFERENCE SUMMARY AND ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

1. Introduction

An initial conference in IPR2013-00566, which involves U.S. Patent 8,464,767 B2 (the “’767 patent”), was conducted on March 20, 2014. Petitioner, ACCO Brands Corporation (“ACCO”) was represented by lead counsel, Richard Kaiser and Steve Trybus. Patent Owner, Fellowes, Inc. (“Fellowes”) was represented by lead counsel, Bryan Collins. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Paper 9), and to discuss any motions contemplated by the parties. Prior to the call, ACCO filed a paper indicating that it does not contemplate filing any motions at this time. Paper 10. Fellowes filed a paper seeking authorization to file a Motion to Compel Additional Discovery and indicating that it may file a Motion to Exclude Evidence in connection with evidence submitted by ACCO in its Petition. Paper 11.

2. Related Matters

No reexaminations or reissue applications of the ’767 patent have been identified by the parties. The following litigation in the United State District Court for the Northern District of Illinois, Eastern Division has been identified: Civil Action Nos. 1:10-CV07587 (CONSOLIDATED) and 1:11-CV-081487 (RELATED). During the call, the parties indicated that the litigation has been stayed.

3. Scheduling Order

Neither party indicated any issues with respect to the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3 by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

4. Protective Order

The parties have not discussed a protective order at this time and do not anticipate needing a protective order. No protective order has been entered. Should circumstances change, the parties are reminded of the requirement for a protective order when filing a Motion to Seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than, or departing from, the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48769.

5. Discovery - Generally

The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Trial Practice Guide. *See* 77 Fed. Reg. at 48761-2. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 37.64; Office Trial Practice Guide, 77 Fed. Reg. at 48767.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48772, App. D.

As discussed below, during the conference call, the parties conveyed that there is a discovery issue pending at this time in the proceeding in connection with Fellowes's proposed Motion to Compel Additional Discovery.

6. *Motions*

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference call to obtain authorization to file the motion.

a. Motion to Exclude

Board authorization is not required for a party to file a Motion to Exclude Evidence. 37 C.F.R. § 42.64(c). Should either party file a Motion to Exclude Evidence, the motion is due no later than DUE DATE 4 (*see* Paper 9, 5).

b. Motion to Compel Additional Discovery

The parties may agree to additional discovery between themselves. 37 C.F.R. § 51(b)(2). During the conference call, the parties informed the Board that they were unable to reach agreement in connection with Fellowes's request for additional discovery.

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.”)

In its list of proposed motions, Fellowes outlines four “categories” of documents that it seeks leave to obtain as a part of a Motion to Compel Additional Discovery. Paper 11, 1-2. During the conference call, counsel for Fellowes informed the panel that those categories of documents relate to the development of shredders by ACCO. In particular, Fellowes represented that it seeks information related to statements made by Mr. Aries, a person associated with ACCO, in connection with the development of such shredders. Counsel for ACCO expressed to the panel that it believes the requested additional discovery is beyond the scope of permitted additional discovery and would be overly burdensome for ACCO to produce in this proceeding.

After hearing the respective positions of the parties, the panel conferred and concluded that additional briefing was warranted. The panel authorized Fellowes to file a Motion to Compel Additional Discovery of no more than 15 pages due by Close of Business (“COB”) Thursday, March 27, 2014. The panel also authorized ACCO to file an Opposition to the Motion, also of no more than 15 pages, due by COB Thursday, April 3, 2014. In authorizing the filing of the Motion, the panel cautioned Fellowes that a motion for additional discovery is unlikely to be granted if it is unduly broad and encompasses numerous documents that are irrelevant to the instituted grounds of unpatentability. The panel indicated that the motion should be tailored narrowly to specific documents that Fellowes seeks to assist in

the presentation of a Patent Owner's Response, including any documents necessary for Fellowes to depose Mr. Aries. The panel referred both parties to *Garmin International, Inc. et al. v. Cuozzo Speed Technologies LLC.*, IPR2012-00001, Paper 26 (March 5, 2013), as laying out important factors that the panel will consider in deciding whether to grant Fellowes's Motion to Compel Additional Discovery.

c. Motion to Amend

Fellowes indicated in the conference call that, at this time, it does not contemplate filing a motion to amend. Should circumstances change, Fellowes may file one motion to amend the patent by cancelling or substituting claims without Board authorization. However, we remind Fellowes of the requirement to request a conference with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). The Board also takes this opportunity to remind Fellowes that a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, explain how any substitute claim is patentable generally over the prior art known to Fellowes, and clearly identify where the corresponding written description support in the original disclosure can be found for each substitute claim. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary.

For further guidance regarding these requirements, Fellowes is directed to the Board's prior decisions concerning motions to amend, including *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper No. 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper No. 26 (June 11, 2013), Paper No. 66 (January 7, 2014); *ZTE Corp. v. ContentGuard*

Holdings, IPR2013-00136, Paper 33 (November 7, 2013); and *Invensense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper No. 21, (January 9, 2014).

7. Settlement

The parties stated that there is no immediate prospect of settlement that will affect the conduct of this proceeding.

8. Orders

It is

ORDERED that Fellowes is authorized to file a single Motion to Compel Additional Discovery of no more than 15 pages by COB Thursday, March 27, 2014;

FURTHER ORDERED that Fellowes should note, for each item of requested discovery, the purpose of seeking the item and how the information sought would assist in the presentation of its Patent Owner's Response; and

FURTHER ORDERED that ACCO is authorized to file a single Opposition to the Motion of no more than 15 pages by COB Thursday, April 3, 2014.

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