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Paper 23 (IPR2014-00041)  
Paper 25 (IPR2014-00043)  
Paper 22 (IPR2014-00051)  
Paper 19 (IPR2014-00054)  
Paper 15 (IPR2014-00055)  
Entered: April 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GEA PROCESS ENGINEERING, INC.  
Petitioner

v.

STEUBEN FOODS, INC.  
Patent Owner

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Cases<sup>1</sup>

IPR2014-00041 (Patent 6,945,013 B2)  
IPR2014-00043 (Patent 6,475,435 B1)  
IPR2014-00051 (Patent 6,209,591 B1)  
IPR2014-00054 (Patent 6,481,468 B1)  
IPR2014-00055 (Patent 6,536,188 B1)

Before RAMA G. ELLURU, BEVERLY M. BUNTING, and  
CARL M. DEFRANCO, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION  
Patent Owner's Motion for Additional Discovery  
*37 C.F.R. § 42.51*  
*Introduction*

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<sup>1</sup> This order addresses issues raised in all five cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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Patent Owner, Steuben Foods, Inc. (“Steuben Foods”), filed a motion for additional discovery in the instant proceedings, and Petitioner, GEA Process Engineering, Inc. (“GEA”) filed an opposition.<sup>2</sup> For the reasons stated below, Steuben Foods’ motion is *denied*.

### *Background*

Steuben Foods seeks additional discovery relating to the identity of all real parties-in-interest in a potential effort to raise defenses under 35 U.S.C. §§ 312(a)(2) and 315(b). Specifically, Steuben Foods seeks the following discovery from GEA<sup>3</sup>:

1. A copy of the engagement and/or retainer agreement(s) between Pillsbury Winthrop Shaw Pittman LLP and GPNA, Procomac, and/or GEA Group.
2. Legal bills issued by Pillsbury Winthrop Shaw Pittman LLP to GPNA, Procomac, and/or GEA Group for services rendered in connection with the Proceeding, including transmittal letters and documents sufficient to identify the entity that remitted payment for legal services performed in preparation for the Proceeding and paid the filing fee for the Proceeding whether directly or indirectly.
3. Any patents or printed publications provided by Procomac and/or GEA Group to GPNA relating to U.S. Patent Nos. 6,536,188; 6,475,435; 6,481,468; 6,209,591; and 6,945,013 prior to October 10, 2013.
4. Explain with particularity whether, and the extent to which: (a) the Petition was filed at the behest of Procomac and/or GEA Group;

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<sup>2</sup> IPR2014-00041, Papers 19 (“Mot.”), 21 (“Opp.”); IPR2014-00043, Papers 20, 22; IPR2014-00051, Papers 18, 20; IPR2014-00054, Papers 15,17; and IPR2014-00055, Papers 11,13. While the analysis herein applies to each of these proceedings, we refer to the papers filed in Case IPR2014-00041 for convenience.

<sup>3</sup> Steuben Foods refers to GEA as GPNA throughout the Motion.

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(b) Procomac and/or GEA Group, or their respective employees, offered substantive input on the Petition; (c) Procomac and/or GEA Group exercised control or had the opportunity to exercise control with respect to the content of the Petition; (d) Procomac and/or GEA Group participated in funding the preparation and/or filing of the Petition.

5. Identify with particularity each individual and/or entity that participated in the preparation of the petition in the Proceeding, including by identifying each individual's: (a) name; (b) title; (c) employer; and (d) the nature of the input provided with respect to the Proceeding.

Mot. 1-2.

Steuben Foods contends that the requested information is relevant to determining whether GEA's parent, GEA Group AG ("GEA Group") and its affiliate, GEA Procomac S.p.A. ("Procomac"), are real parties-in-interest or privies that should have been named in these proceedings. Mot. 4.

According to Steuben Foods, GEA and Procomac "act in unison for all purposes concerning the aseptic filling technology at issue in these review proceedings and in the co-pending district court litigation as reflected in various court filings and GPNA's website." *Id.* at 2-3. Steuben Foods contends that if any of the co-defendants are real parties-in-interest for purposes of the instant proceedings, GEA did not correctly identify all of the real parties-in-interest in its petitions as required by 35 U.S.C. § 312(a)(2) and the proceeding should be terminated. *Id.* at 6; *see also* Pet. 1 (identifying GEA as the only real party-in-interest). Steuben Foods further submits that if GEA Group or Procomac are real parties-in-interest or privies

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of GEA, GEA would be time-barred under the one-year bar provision of 35 U.S.C. § 315(b) from bringing another petition. Mot. 6.

### *Analysis*

Discovery in an *inter partes* review proceeding is “limited” and less than what is normally available in district court patent litigation. 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. §§ 42.51-53. A party seeking discovery beyond what is expressly permitted by rule “must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i); *see also* 35 U.S.C. § 316(a)(5). An important factor in determining whether additional discovery is in the interests of justice is whether there exists more than a “mere possibility” or “mere allegation that something useful [to the proceeding] will be found.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs*, IPR2012-00001, Paper 20 at 2-3 (identifying factors to be considered in determining whether additional discovery is warranted). This requires the party seeking discovery to come forward with some factual evidence or support for its request.

In support of its request for additional discovery, Steuben Foods asserts that GEA Group is in control of the review proceedings and participated in the development of legal positions because GEA Group’s 2013 Annual Report states GEA and Procomac are each wholly owned by GEA Group, and GEA Group manages legal and financial matters for both GEA and Procomac. Mot. 6-7. With respect to the co-pending district court litigation, Steuben Foods notes that GEA and Procomac share the same litigation counsel; GEA and Procomac identified GEA’s in-house counsel as

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one of three in-house attorneys able to access confidential information under a protective order; two in-house attorneys at GEA Group were identified as assisting with the development of GEA's and Procomac's defenses; and the Deputy Chief Legal Counsel of GEA Group was identified as an "individual that is likely to have discoverable information that would support their defenses." *Id.* at 6-7, 10. Steuben Foods further notes that, in joint motions to stay the district court proceedings in view of the present review proceedings, GEA admitted that Procomac is a real party in interest or a privy; GEA and Procomac are collectively referred to as GEA in the proceeding; and both GEA and Procomac would be subject to statutory estoppel. *Id.* at 7-8. Lastly, Steuben Foods asserts there is a principal-agent relationship between GEA and Procomac based on sales of Procomac systems by GEA in the United States. Mot. 9-10. In further support of its allegation of a principal-agent relationship, Steuben Foods points to GEA's website and the physical address of GEA and Procomac in Hudson Wisconsin. *Id.*

Whether a non-party is a "real party-in-interest" or "privy" for purposes of an *inter partes* review proceeding is a "highly fact-dependent question" that takes into account how courts generally have used the terms to "describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion." *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012). Whether parties are in privity, for instance, depends on whether the relationship

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between a party and its alleged privy is “sufficiently close such that both should be bound by the trial outcome and related estoppels.” *Id.*

In seeking authorization to move for additional discovery, Steuben Foods represented during a conference call with the Board that Procomac is potentially a real party in interest because it may have funded and controlled the filing of the instant petitions through a purported indemnification agreement with GEA. Paper 18 at 4. Steuben Foods’ motion for additional discovery, however, Steuben is silent on the issue of indemnification. Mot. 1-2. Moreover, the evidence and arguments presented by Steuben Foods in its motion amount to mere allegation and speculation that Procomac and/or GEA Group are real parties-in-interest or privies of GEA.

Steuben Foods has not explained how the proffered evidence tends to show that something useful will be uncovered by the requested additional discovery. For instance, Steuben Foods argues that, because GEA, GEA Group, and Procomac share the same counsel in the related district court proceeding, the co-defendants GEA Group and Procomac had an opportunity to exercise control over the instant Petition. Mot. 10-11. Steuben Foods, however, has not directed us to any evidence tending to show that GEA has sought or accepted advice, input, or monetary compensation from either Procomac or GEA Group in support of GEA’s participation in this proceeding. Rather, Steuben Foods’ assertions are based on mere speculation and conjecture.

Also, we are not persuaded by Steuben Foods’ arguments that certain statements by GEA and Procomac in the co-pending litigation support

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Steuben Foods' contentions that GEA Group and Procomac are real-parties-in-interest. Steuben Foods has not demonstrated that these statements tend to show that Steuben Foods will uncover something useful that supports its theory that GEA is not the sole real party-in-interest. The statements are ambiguous and do not establish that others exercised control and/or funding of this proceeding.

#### *Conclusion*

Based on the record before us, the evidence and arguments presented by Steuben Foods do not specifically convince us that the requested additional discovery either exists or is likely to uncover information useful to the instant proceedings. Therefore, Steuben Foods has not met its burden to demonstrate that additional discovery is in the interests of justice.

#### ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Steuben Foods' motion for additional discovery is *denied*.

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