

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEARCH AMERICA, INC.
Petitioner

v.

TRANSUNION INTELLIGENCE, LLC
Patent Owner

Case CBM2013-00037 (Patent 7,333,937)
Case CBM2013-00038 (Patent 8,185,408)¹

Before THOMAS L. GIANNETTI and PATRICK M. BOUCHER,
Administrative Patent Judges.

BOUCHER, *Administrative Patent Judge.*

ORDER
Authorization for Motion for Additional Discovery
37 C.F.R. §§ 42.51(b)(2) and 42.224

¹ This caption is not authorized for use by the parties.

Case CBM2013-00037 (Patent 7,333,937)
Case CBM2013-00038 (Patent 8,185,408)

On April 21, 2014, a conference call was held in these cases. Present on the call were respective counsel for the parties and Administrative Patent Judges Thomas Giannetti and Patrick Boucher. Counsel for Patent Owner indicated that the call was being transcribed. The Patent Owner is requested to file the transcript as an exhibit as soon as it is available.

During the call, Patent Owner requested authorization to file a motion for additional discovery directed at documents concerning (1) alleged copying by Petitioner of a commercial product identified by Patent Owner as “Revenue Manager” and released by Patent Owner’s predecessor-in-interest and (2) commercial success of Petitioner’s product alleged to infringe the patents at issue in these proceedings. Petitioner opposes.

The requested documents are subject to a district court protective order that precludes their use in this proceeding. Petitioner declines to waive its claim that the documents are subject to the provisions of the protective order.

The Board has identified factors important in evaluating requests for additional discovery in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013). Although articulated for *inter partes* reviews, the *Garmin* factors apply also to covered business method patent reviews, modified to reflect the slightly lower good-cause standard applied in covered business method patent reviews. *See* 37 C.F.R. § 42.224; *see Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 at 2–5 (PTAB May 29, 2013). One of the

Case CBM2013-00037 (Patent 7,333,937)
Case CBM2013-00038 (Patent 8,185,408)

factors considered is the ability to generate equivalent information sought by the request for additional discovery by other means.

Patent Owner acknowledges that, thus far, it has made no effort to seek a modification of the protective order by the district court so that the documents may be used in these proceedings. In addition, it became clear from the discussions that equivalent marketing and sales information related to the technology of the patents at issue can reasonably be generated by Patent Owner on its own, without a discovery request directed to Petitioner's documents.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery is *denied*.

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Case CBM2013-00037 (Patent 7,333,937)
Case CBM2013-00038 (Patent 8,185,408)

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