Trials@uspto.gov
571-272-7822

Paper 17
Entered: July 2, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAIFUKU CO., LTD. AND DAIFUKU AMERICA CORP.,
Petitioner,

v.

MURATA MACHINERY, LTD.,
Patent Owner.

Case IPR2015-00083 (Patent 8,197,172 B2)
Case IPR2015-00085 (Patent 7,771,153 B2)
Case IPR2015-00088 (Patent 7,165,927 B2)1[1]

Before KEN B. BARRETT, BARRY L. GROSSMAN, and BRIAN P. MURPHY, *Administrative Patent Judges.*

MURPHY, *Administrative Patent Judge*.

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

[1] This Order will be entered in each case. The parties are not authorized to use the caption style of this Order.

On June 18, 2015, Murata Machinery, Ltd. ("Patent Owner") filed a Motion for Additional Discovery of documents regarding alleged (i) secondary considerations of nonobviousness of the challenged claims in U.S. Patent No. 7,771,153 B2 ("the '153 patent"), and (ii) real parties in interest not identified by Petitioner. Paper 14 ("Mot.").[2] Daifuku Co., Ltd. and Daifuku America Corp. (together, "Petitioner") filed an Opposition to Patent Owner's motion. Paper 15 ("Opp."). Having considered the arguments of the parties we make the following rulings.

Patent Owner's motion seeks production from Petitioner of 25-50 documents produced as confidential information in a co-pending district court action. Mot. 1. Patent Owner asserts, based on hearsay statements of Patent Owner's un-named district court litigation counsel,[3] that such documents will provide evidence of copying, praise, and commercial success of the patented technology relevant to secondary considerations of nonobviousness (hereafter the "secondary considerations documents"). *Id.* at 2–3 (citing Ex. 2008, 11). Patent Owner also asserts that some of the confidential documents relate to "the activities and interrelationships of various Daifuku corporate entities involved in the AMHS business," which are asserted to bear on the question of Petitioner's identification of all real parties in interest. *Id.* at 5 (citing Ex. 2008, 12). Patent Owner advises

[2] Citations to the paper numbers are identical in each proceeding.
[3] We note that Patent Owner's district court litigation counsel is not admitted *pro hac vice* in this proceeding. Patent Owner's district court litigation counsel also has not submitted an affidavit or sworn declaration in support of Patent Owner's motion.

that it is unable to provide further information because of constraints imposed by a protective order entered in the co-pending district court litigation. *Id.* at 1, 6.

In the absence of reliable, specific evidence and information sufficient to establish that the requested additional discovery is "necessary in the interest of justice," we cannot grant Patent Owner's motion. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB March 5, 2013) (Paper No. 26)(setting forth five factors for consideration by the Board). First, Patent Owner's argument regarding the need for evidence asserted to show that Petitioner has not identified all real parties in interest in this proceeding, is vague and speculative. Patent Owner has not provided any evidence, information or persuasive argument tending to show that a real party in interest has not been identified by Petitioner. Opp. 5–6. Second, with regard to the asserted secondary considerations documents, although we understand the District Court Protective Order constrains access to confidential documents, the power to ease those constraints is with the District Court, not the Board. We do, however, have the authority to issue a protective order in the present proceeding to protect confidential information of the parties, and we will do so upon request of either party. 37 C.F.R. § 42.54; *see also* Trial Practice Guide, 77 Fed. Reg. No. 157, 48756, 48769-71 (August 14, 2012, App. B). Based on the present record, Patent Owner has not made a sufficient showing to support its request for production of the secondary considerations documents from Petitioner.

In conclusion, if the District Court protective order issue is resolved prior to Patent Owner's August 11, 2015 Response date in the present proceedings, Patent Owner may refile its motion for additional discovery of a limited number of documents asserted to be evidence of secondary considerations of nonobviousness, and the Board will decide that motion as expeditiously as possible.

Accordingly, it is:

ORDERED that Patent Owner's Motion for Additional Discovery of documents related to asserted real parties in interest not identified by Petitioner is *denied*;

FURTHER ORDERED that Patent Owner's Motion for Additional Discovery of the asserted secondary considerations documents is *denied without prejudice*;

FURTHER ORDERED that the parties shall meet and confer in good faith in an effort to submit a joint motion for a protective order, in accordance with 37 C.F.R. § 42.54 (Trial Practice Guide, 77 Fed. Reg. No. 157, 48756, 48769-71 (August 14, 2012, App. B));

FURTHER ORDERED that if the parties fail to agree on a joint motion for a protective order, either party is authorized to file a motion for entry of our default protective order, not later than July 10, 2015.

FOR PETITIONER:

Mark Thronson
Dipu Doshi
DICKSTEIN SHAPIRO LLP
thronsonm@dicksteinshapiro.com
Daifuku.IPR@dicksteinshapiro.com

FOR PATENT OWNER:

David L. McCombs
Thomas B. King
Greg J. Michelson
HAYNES AND BOONE, LLP
david.mccombs.ipr@haynesboone.com
ipr.thomas.king@haynesboone.com
greg.michelson.ipr@haynesboone.com