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Paper 24
Entered: February 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUV N' CARE, LTD.,
Petitioner,

v.

MUNCHKIN, INC.,
Patent Owner.

Case IPR2015-00872
Patent 8,739,993 B2

Before SHERIDAN K. SNEDDEN, MITCHELL G. WEATHERLY, and JAMES A. TARTAL, *Administrative Patent Judges.*

SNEDDEN, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion for Authorization to Compel Testimony and Production of Documents
37 C.F.R. § 42.52(a)

INTRODUCTION

Luv N' Care, Ltd. ("Petitioner") filed a motion for authorization to compel third-party testimony and production of documents by seeking authorization to serve a subpoena upon a third party, Edgewell Personal Brands, LLC ("Edgewell"). Paper 18 ("Motion"). Petitioner also filed a supplement to its Motion. Paper 19. Patent Owner filed an opposition to Petitioner's Motion. Paper 21

For the reasons set forth below, we grant Petitioner's Motion.

DISCUSSION

A party seeking to compel testimony or the production of documents via a subpoena must first file a motion for authorization or the compelled evidence will not be admitted in this proceeding. *See* 37 C.F.R. § 42.52(a); *see also* 35 U.S.C. § 24 (clerks of the United States district courts shall issue subpoenas in contested cases before the Patent and Trademark Office). U.S.C. Section 316(a)(5) of Title 35 discovery in these proceedings is obtained via procedures to ensure that discovery is limited to "what is otherwise necessary in the interest of justice." We generally consider several factors ("the *Garmin* factors") in determining whether discovery is in the interest of justice. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative) ("*Garmin*").

A. Testimony and Production of Documents Sought by Petitioner

Petitioner provides further information regarding the discovery that it seeks. In particular, Petitioner directs our attention to photographs

submitted by Patent Owner as part of a complaint in a federal lawsuit filed against Playtex on May 13, 2011. Paper 18, 1 (citing Ex. 1016, 14–25). The photographs purportedly show sippy cups manufactured by Playtex in packaging advertising a "Twist and Click" feature. *Id.* Petitioner contends that establishing foundation for the photographs is necessary to demonstrate the unpatentability of substitute claims set forth in Patent Owner's Motion to Amend. *Id.* at 4.

Petitioner contends that Edgewell is the owner of the PLAYTEX brand of personal care products, including the sippy cups about which Petitioner seeks discovery. *Id.* Petitioner seeks to compel the testimony of Edgewell regarding the dates on which it offered to sell the PLAYTEX sippy cups with the "Twist and Click" feature. *Id.* at 3. Petitioner intends to use the testimony and photographs of the PLAYTEX cups in support of Petitioner's Opposition to Patent Owner's Motion to Amend. *Id.* Petitioner also seeks production at the deposition of the cups depicted in the photographs. *Id.*

Patent Owner's proposed subpoena, provided as Ex. 1015, sets forth topics for the deposition as follows:

> 1.) The packaged cup as shown in the photographs labeled as Exhibit 1, Figures 1-11, attached hereto, of a Playtex Twist n' Click cup in packaging with the barcode 7830005661 and bearing the trademark THE 1st SIPSTER.
>
> 2.) The packaged cup as shown in the photographs labeled as Exhibit 2, Figures 1-6, attached hereto, of a Playtex Twist n' Click cup in packaging with the barcode 7830005670 and bearing the trademark THE INSULATOR.
>
> 3.) The package cup as shown in the photographs labeled as Exhibit 3, Figures 1-8, attached hereto, of a Playtex Twist n'

> Click cup in packaging with the barcode 7830005854 and bearing the trademark LIL' GRIPPER.

Ex. 1015, 4.

B. Analysis

We view Petitioner's Exhibit 1015 and its representations, discussed above, as providing sufficient specificity regarding the testimony and objects sought. Petitioner only seeks testimony to establish that each sippy cup, as depicted in respective photographs, exemplifies products offered for sale, on sale and in public use prior to June 2, 2010. Petitioner has shown sufficiently why the information sought in discovery is relevant and needed at this stage in the proceeding.

Regarding the other efforts made by Petitioner to obtain the information that it seeks, Petitioner represents that it contacted Edgewell's counsel, who indicated that a subpoena would be necessary to compel Edgewell to submit to the request for the information sought by Petitioner. Paper 18, 5.

Regarding whether Petitioner has established more than a possibility that it will obtain that evidence that it seeks, Petitioner has made a sufficient showing that the products depicted in respective photographs are owned by Edgewell and that, as the owner, Edgewell is likely able to answer the question of whether their products were offered for sale, on sale and in public use prior to June 2, 2010. We, therefore, determine that Petitioner has established more than a possibility that it will obtain the evidence that it seeks.

Regarding, Patent Owner's opposition, Patent Owner contends that "Petitioner has no evidence that additional discovery will actually produce

'useful' information." Paper 21, 4. We disagree and are persuaded by Petitioner that the information sought will be useful in determining the prior art status of the products depicted in the photographs.

Patent Owner contends that "Petitioner here has failed to offer any evidence or explanation tending to show that the alleged Playtex prior art cups *actually* anticipate or render obvious Munchkin's proposed amended claims as a prerequisite to obtaining additional discovery relating to that alleged prior art." *Id.* at 6. We are not persuaded that it is necessary for Petitioner to prove their arguments now in order for us to grant authorization to seek information potentially useful for their case.

Patent Owner contends that "equivalent information" may be found in US 2009/0242562 to Valderrama, which was assigned to Playtex and appears in the record at Ex. 1014. *Id.* at 10–11. Here, we note that the information set forth in Ex. 1014 may not be the same as the information now sought by Petitioner, and we decline to opine at this stage of the proceeding on the respective merits of the evidence of record.

Patent Owner contends that granting Petitioner's Motion will adversely impact the schedule of this case because the deadline for Petitioner's Opposition to Patent Owner's Motion to Amend has passed. *Id.* at 13. We are not persuaded. Petitioner filed its Opposition to Patent Owner's Motion to Amend on February 16, 2016. The information sought by Petitioner concerns Petitioner's ability to serve supplemental evidence under 37 C.F.R. § 42.64(b)(2) to provide evidentiary foundation for information already of record, which relates to Due Dates 4 to 6 set forth in our scheduling order, which have not yet passed. We determine that, at this time, the schedule of this case would not be adversely impacted.

C. Conclusion

For the foregoing reasons, we authorize Patent Owner to seek a subpoena directed to Edgewell pursuant to 35 U.S.C. § 24. The scope of the subpoena shall be limited to the deposition topics and requests for objects listed in Exhibit 1015. Additionally, Patent Owner is permitted to attend any deposition taken pursuant to the subpoena and cross-examine the witness, but only regarding the subject matter of the direct testimony of the witness.

ORDER

For the reasons given, it is

ORDERED that Petitioner is authorized pursuant to 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States District Court for the district where the testimony of Edgewell Personal Brands, LLC is to be taken;

FURTHER ORDERED that the scope of the subpoena shall be limited to the deposition topics submitted in this proceeding as Exhibit 1015; and

FURTHER ORDERED that Patent Owner is permitted to attend the deposition and cross-examine the witness, but only regarding the subject matter of the direct testimony of the witness.

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