

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHERVON NORTH AMERICA, INC., POSITEC TOOL
CORPORATION, POSITEC USA, INC., and HILTI, INC.,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

Case IPR2015-00595 (Patent 7,944,173 B2)
Case IPR2015-00596 (Patent 7,554,290 B2)
Case IPR2015-00597 (Patent 7,999,510 B2)¹

Before GRACE KARAFFA OBERMANN, PATRICK R. SCANLON, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Motion for Additional Discovery
37 C.F.R. §§ 42.20 and 42.51(b)(2)

¹ This Decision addresses issues pertaining to all three cases. Thus, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

IPR2015-00595 (Patent 7,944,173 B2)
IPR2015-00596 (Patent 7,554,290 B2)
IPR2015-00597 (Patent 7,999,510 B2)

In each of the instant proceedings, pursuant to authorization from the Board, Patent Owner filed a motion for additional discovery on October 19, 2015. Paper 29² (“Mot.”). On October 26, 2015, Petitioner filed its opposition to each motion. Paper 30 (“Opp.”). We address the parties’ arguments below.

Patent Owner is requesting from Petitioner twelve documents that Patent Owner contends relate to secondary considerations of non-obviousness. Mot. 1. Patent Owner asserts that these documents were previously produced in related district court actions, and its litigation counsel have “analyzed these documents and would have used them to support its secondary considerations position in the concurrent litigations.” *Id.*

Additional discovery may be ordered if the party moving for the discovery shows “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2). The Board has identified five factors (“the *Garmin* factors”) important in determining whether additional discovery is in the interests of justice. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative). These factors are: (1) more than a possibility and mere allegation that something useful will be discovered; (2) requests that do not seek other party’s litigation positions and the underlying basis for those positions; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Id.*

² As the pertinent papers in all three proceedings are substantially similar, we refer herein to the papers filed in IPR2015-00595 for convenience.

IPR2015-00595 (Patent 7,944,173 B2)

IPR2015-00596 (Patent 7,554,290 B2)

IPR2015-00597 (Patent 7,999,510 B2)

Regarding the first *Garmin* factor, Patent Owner argues that its litigation counsel already have identified the twelve documents from the thousands of documents produced by Petitioner as relating to secondary considerations, and this identification establishes more than “a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.” Mot. 3 (citing *Garmin*, slip op. at 7).

Petitioner asserts that, other than asserting its litigation counsel has determined the documents relate to secondary considerations, Patent Owner has not identified any nexus between the documents sought and the claims at issue. Opp. 2. Petitioner argues that Patent Owner fails to “provide any test data or other evidence that their own V28 product, much less any of Petitioners’ products, actually embodies the challenged claims.” *Id.* at 2–3. Petitioner adds that there have been no concessions or findings that its products infringe the challenged claims, and we “should reject Patent Owners’ invitation to hold a trial within the IPRs on issues of infringement.” *Id.* at 3.

Patent Owner has made a narrow request for documents it asserts will have a bearing on the issue of secondary considerations. In this case, Patent Owner’s assertion is not based on mere speculation, but on direct input from its litigation counsel. Although Patent Owner has not identified at this time a definite nexus between the desired documents and the claims at issue, it has provided sufficient reasoning tending to show that the documents will have substantive value with respect to the issue of secondary considerations.

Regarding the second *Garmin* factor, we are persuaded that Patent Owner does not seek Petitioner’s litigation positions because the documents sought already have been produced to Patent Owner’s litigation counsel.

IPR2015-00595 (Patent 7,944,173 B2)

IPR2015-00596 (Patent 7,554,290 B2)

IPR2015-00597 (Patent 7,999,510 B2)

See Mot. 3. With respect to the third *Garmin* factor, Patent Owner contends that it cannot generate the requested information independently because the documents relate to Petitioner’s “internal analysis and perceptions.” *Id.* at 4. Petitioner argues that Patent Owner had more than three years to identify evidence supporting its representations of secondary considerations and is ultimately in the best position to identify such evidence. Opp. 4. We have considered both parties’ arguments and determine that the third *Garmin* factor favors neither party.

The remaining *Garmin* factors favor Patent Owner. We are persuaded that Patent Owner’s request for twelve specifically identified documents, which have been previously produced in the related district court litigation, is focused, easily understandable, and not overly burdensome to Petitioner. *See* Mot. 3. Petitioner argues that the requested discovery would create undue burdens and risk business harm resulting from the disclosure of confidential information. The fact that the information may be confidential, however, does not shield it from discovery. Instead, if any confidential material is made of record in these proceedings, the relevant party may file a motion to seal that material along with a proposed protective order pursuant to § 42.54.

Upon consideration of each of the *Garmin* factors, and for the foregoing reasons, we grant Patent Owner’s motion to produce the twelve identified documents.

In addition, in an email dated October 28, 2015, Patent Owner requested a conference call with the Board to request an extension of time to file its Responses in these proceedings. Under the circumstances, Patent Owner is granted an extension to November 9, 2015, to file its Response in

IPR2015-00595 (Patent 7,944,173 B2)
IPR2015-00596 (Patent 7,554,290 B2)
IPR2015-00597 (Patent 7,999,510 B2)

each of these proceedings. *See* 37 C.F.R. § 42.5(c)(1). In the future, we encourage the parties to first confer with each other in a good-faith effort to resolve any scheduling issues between themselves before contacting the Board.

Accordingly, it is

ORDERED that Patent Owner's motion for additional discovery is *granted*; and

FURTHER ORDERED that Patent Owner is granted an extension to November 9, 2015 to file its Response in each of these proceedings.

IPR2015-00595 (Patent 7,944,173 B2)
IPR2015-00596 (Patent 7,554,290 B2)
IPR2015-00597 (Patent 7,999,510 B2)

PETITIONER:

Russell Levine
Hari Santhanam
KIRKLAND & ELLIS LLP
relevine@kirkland.com
hsanthanam@kirkland.com

Robert Eichenberger
MIDDLETON REUTLINGER
rhe@middletonlaw.com

Jonathan Lindsay
CROWELL & MORING LLP
jlindsay@crowell.com

PATENT OWNER:

Dion M. Bregman
Charles C. Huse
MORGAN, LEWIS & BOCKIUS LLP
dbregman@morganlewis.com
chuse@morganlewis.com
milwaukee_ipr@morganlewis.com