

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI, INC.,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

Case IPR2015-01164 (Patent 7,554,290 B2)
Case IPR2015-01165 (Patent 7,944,173 B2)
Case IPR2015-01166 (Patent 7,999,510 B2)¹

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

SCANLON, *Administrative Patent Judge*.

ORDER
Additional Discovery
37 C.F.R. § 42.51(b)

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.

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A conference call in the above-captioned proceedings was held on February 8, 2016, including the panel and respective counsel for Petitioner, Hilti, Inc. (“Hilti”), and Patent Owner. Also participating in the conference call were counsel for Chervon North America, Inc. (“Chervon”), counsel for Positec Tool Corporation (“Positec”), and counsel for Snap-On Incorporated (“Snap-On”). Chervon and Positec are petitioners, together with Hilti, in related proceedings IPR2015-00595, IPR2015-00596, and IPR2015-00597. Snap-On is petitioner in related proceedings IPR2015-01242, IPR2015-01243, and IPR2015-01244. Patent Owner requested the call seeking authorization to file one or more motions for additional discovery.

For convenience, we will refer to proceedings IPR2015-00595, IPR2015-00596, and IPR2015-00597 as the first set of proceedings, proceedings IPR2015-01164, IPR2015-01165, and IPR2015-01166 as the second set of proceedings, and proceedings IPR2015-01242, IPR2015-01243, and IPR2015-01244 as the third set of proceedings.

During the call, Patent Owner indicated that, in the first set of proceedings, the Board ordered additional discovery of a limited number of documents from Chervon and Hilti. Patent Owner indicated that it now seeks discovery of the same Chervon documents in the second and third sets of proceedings and the same Hilti documents in the third set of proceedings. Patent Owner indicated that Hilti has agreed to produce its documents in the second set of proceedings, in which it is the petitioner. In addition, Patent Owner indicated that it seeks discovery of a number of Snap-On documents in the second and third sets of proceedings. Patent Owner represented that, based on input from its litigation counsel, these Snap-On documents contain information relevant to the issue of secondary considerations of obviousness.

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Chervon opposed Patent Owner's request, arguing that because it is not a party in the second and third sets of proceedings, it should not be compelled to submit documents in these proceedings absent a subpoena. Hilti confirmed that it has reached agreement with Patent Owner regarding producing its documents in the second set of proceedings, but opposed Patent Owner's request with respect to the third set of proceedings for reasons similar to those raised by Chervon. Snap-On also opposed Patent Owner's request, arguing against the relevancy of its documents.

With respect to the instant proceedings (i.e., the second set of proceedings), the panel authorized Patent Owner to file a 7-page motion for additional discovery. This motion is limited to the Chervon documents produced in the first set of cases and the Snap-On documents described by Patent Owner during the conference call. We also authorized Hilti, Petitioner in the instant proceedings, to file a 7-page opposition. Furthermore, because Patent Owner's request involves their documents, we authorized both Chervon and Snap-On to file 7-page oppositions. In order to file their papers, as non-parties to the instant proceedings, Chervon and Snap-On must send the papers in PDF format by email to trials@uspto.gov, copying all parties in the email and indicating into which proceeding the paper is to be entered.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a 7-page motion for additional discovery within two business days;

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FURTHER ORDERED that Petitioner is authorized to file a 7-page opposition within five business days from the date that Patent Owner files its motion for additional discovery;

FURTHER ORDERED that Chervon is authorized to file a 7-page opposition within five business days from the date that Patent Owner files its motion for additional discovery; and

FURTHER ORDERED that Snap-On is authorized to file a 7-page opposition within five business days from the date that Patent Owner files its motion for additional discovery.

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