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Paper 20
Entered: February 14, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC. ET AL.
Petitioner

v.

CUOZZO SPEED TECHNOLOGIES LLC
Patent Owner

Case IPR-2012-00001
Patent 6,778,074

Before MICHAEL P. TIERNEY, *Lead Administrative Patent Judge*, JAMESON LEE, and JOSIAH C. COCKS, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Authorizing Motion For Additional Discovery
37 C.F.R. § 42.51(b)(2)

A conference call was held this morning between respective counsel of petitioner (Garmin) and patent owner (Cuozzo), and Judges Tierney, Lee, and Cocks, to discuss whether to authorize Cuozzo's request to file a motion for additional discovery. Prior to the presentation by Cuozzo, we articulated a general

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guideline and certain factors we regard as important for evaluating discovery requests.

Under the Leahy-Smith America Invents Act, discovery is available for the deposition of witnesses submitting affidavits or declarations and for "what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5); see also 37 C.F.R. § 42.51(b)(2)("The moving party must show that such additional discovery is in the interest of justice …."). That is significantly different from the scope of discovery generally available under the Federal Rules of Civil Procedure.

From the legislative history of the Leahy-Smith America Invents Act, we know that discovery is limited as compared to that available in district court patent litigation. Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution. Given the one-year statutory deadline for completion of Inter Partes Review, the Board will be conservative in granting additional discovery.

The statutory standard is "necessary in the interest of justice." That standard is not a mathematical formula, but these factors are important:

> 1. More Than A Possibility And Mere Allegation -- The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.
>
> 2. Litigation Positions And Underlying Basis -- Asking for the other party's litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has

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> established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board's trial procedures under the pretext of discovery.
>
> 3. Ability To Generate Equivalent Information By Other Means – Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.
>
> 4. Easily Understandable Instructions -- The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder's ability to answer efficiently, accurately, and confidently.
>
> 5. Requests Not Overly Burdensome To Answer -- The requests must not be overly burdensome to answer, given the expedited nature of Inter Partes Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of Inter Partes Review. Requests should be sensible and responsibly tailored according to a genuine need.

Cuozzo's original requests are attached to this communication. During the conference call, after being advised of the above-noted factors of consideration, Cuozzo voluntarily withdrew many of the listed items. However, many remain. The only secondary consideration of unobviousness mentioned by Cuozzo during the conference call was long-felt and unresolved need in the industry. We stated that any reference to "market" should be specific as to which "market" and that

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with regard to secondary considerations and objective evidence of unobviousness, Cuozzo must address the issue of nexus in a motion for additional discovery.

Cuozzo indicated that it disputes the Board's claim interpretation with regard to the requirements of claim 10. We indicated that a motion for additional discovery is not the place to argue about and resolve disputes in claim interpretation. Cuozzo should reserve those arguments for its patent owner response. In a motion for additional discovery, for any claim interpretation issues that matter, Cuozzo need only indicate its own claim construction and how its discovery request is necessary in light of that construction. Similarly, in an opposition to additional discovery, Garmin should not argue and present evidence on claim interpretation; Garmin's simply indicating its position on claim construction would be sufficient.

It is

ORDERED that Cuozzo is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) by February 21, 2013, limited to 15 pages; Garmin is authorized to file an opposition by February 28, 2013, also limited to 15 pages; and no reply is authorized;

FURTHER ORDERED that in its motion, Cuozzo should specifically address each of the above-noted factors and apply them to each item of requested discovery;

FURTHER ORDERED that Cuozzo's motion should note, for each item of requested discovery, the purpose for seeking the item and how the information sought, in the best of circumstances, would assist in the presentation of patent owner's response;

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FURTHER ORDERED that in particular Cuozzo should explain in its motion why with respect to objective evidence of nonobvious such as long-felt but unresolved need Cuozzo has to ask Garmin for any information and is otherwise unable to ascertain the state of the art including general conditions in the art otherwise;

FURTHER ORDERED that in its motion Cuozzo should provide an explanation of why it has submitted such an extensive set of discovery request at this late date with just twenty-five (25) days remaining until the due date for the patent owner's response; note that during the initial conference call conducted on January 23, 2013, Cuozzo had no problem with the March 11, 2013 due date set for Time Period 1; and

FURTHER ORDERED that Garmin in its opposition to the motion should indicate with particularity the burden the discovery request imposes on Garmin, including financial burden, burden on human resources, and burden to meet deadlines in this proceeding.

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