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Paper No. 26
Entered March 5, 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 IPR2012-00001
Patent 6,778,074

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

LEE, *Administrative Patent Judge*.

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

INTRODUCTION

The patent owner ("Cuozzo") has filed a motion for additional discovery. (Paper 21). Petitioner ("Garmin") has opposed. (Paper 22). Cuozzo has replied. (Paper 25).

Prior to filing of the discovery motion, a conference call was held on February 14, 2013, during which time Cuozzo presented a proposed set of discovery requests and was advised by the Board of five (5) factors which are important in determining what constitutes discovery satisfying the "necessary in the interest of justice" standard under 35 U.S.C. § 316(a)(5). (Paper 20). The Board appreciates the effort expended by Cuozzo in:

1. reducing the number of interrogatories from nineteen to nine;

2. reducing the number of document requests from twenty to ten;

3. shortening instructions for answering interrogatories from nine pages in length to two pages; and

4. shortening the instructions for producing documents from eight pages to two.

Cuozzo's motion also requests what amounts to the equivalent of a district court litigation deposition of a corporate entity under Fed. R. Civ. P. 30(b)(6) on topics covered by the interrogatories and document requests, for information "that may not be recorded in documents or revealed in interrogatory responses." (Paper 21, 8:14 to 9:2).

We have considered every item of the discovery request. In its request, Cuozzo disagrees with the Board's non-final interpretation of the term "integrally attached" in instituting this *inter partes* review. For purposes of this decision on Cuozzo's motion for discovery, we employ Cuozzo's interpretation, recognizing that all discussions below apply under either our non-final interpretation or Cuozzo's proposed interpretation and that the outcome would be no different.

For reasons discussed below, Cuozzo's motion for additional discovery is *denied*.

DISCUSSION

A. Routine Discovery

First, we address Cuozzo's attempt to label all of its document requests and interrogatories as "Routine Discovery" under 37 C.F.R. §§ 41.51(b)(1)(i) and 41.51(b)(1)(iii). In that regard, it is noted that the Board's authorization is not required for Cuozzo to conduct routine discovery. *Office Patent Trial Practice Guide*, 77 *Fed. Reg.* 48756, 48761 (Aug. 14, 2012).

Under 37 C.F.R. § 41.51(b)(1)(i), "[u]nless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony." Under 37 C.F.R. § 41.51(b)(1)(iii), "[u]nless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency" [privileged information excepted].

Cuozzo construes 37 C.F.R. § 41.51(b)(1)(i) as including the file histories of prior art patents relied on by Garmin in its petition for review. That interpretation is unreasonably broad. It is sufficient that Garmin provides copies of the patents relied on in its petition since Garmin did not rely on the file histories of those patents. Cuozzo may independently obtain the file histories of the cited prior art patents if it so desires, through the Patent Application Information Retrieval (PAIR) System available on the USPTO Web site (www.uspto.gov/patents/ebc) or other commercial services.

Cuozzo construes 37 C.F.R. § 41.51(b)(1)(iii) as including discovery requests "tailored to target information inconsistent with positions Garmin has taken in its Petition." (Paper 21, 7:5-6). The language appears to be in line with the applicable rule by use of narrow terms such as "tailored," "target," and "inconsistent with positions Garmin has taken." In actuality, however, Cuozzo is not referencing information known to Garmin to be inconsistent with positions taken in the petition. Rather, Cuozzo casts a wide net directed to broad classes of information which may not include anything inconsistent with positions taken by Garmin.

Routine discovery under 37 C.F.R. § 41.51(b)(1)(iii) is narrowly directed to specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information. Cuozzo's attempt to label very broad discovery requests as narrowly tailored routine discovery is misplaced.

Also, under 37 C.F.R. § 41.51(b)(1)(iii), the time for serving such routinely discoverable inconsistent information is concurrent with the filing of documents or things that contains the inconsistency. Nothing in Cuozzo's motion persuades us that Garmin has failed to comply with "routine discovery" under 37 C.F.R. § 41.51(b)(1)(iii), under our construction of the rule provision as discussed above. However, to assist in alleviating any concern, we will in the order section of this decision ask each party to confirm that up to now in this *inter partes* review it has produced all information covered by 37 C.F.R. § 41.51(b)(1)(iii) as routine discovery.

B. Additional Discovery

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 interests of justice …."). That is significantly different from the scope of discovery generally available under the Federal Rules of Civil Procedure.

Congressional debate for the Leahy-Smith America Invents Act indicates that discovery standards under that legislation for *inter partes* review are identical to the standards in the original patent reform bill introduced by Senator Kyl in 2008. 157 Cong. Rec S1375-76 (daily ed. Mar. 8, 2011). During introduction of the 2008 bill, Senator Kyl commented on the discovery standard for *inter partes* review, noting that it "restricts additional discovery to particular limited situations, such as minor discovery that PTO finds to be routinely useful, or to discovery that is justified by the special circumstances of the case." 154 Cong. Rec. S9988 (daily ed. Sept. 27, 2008)(statement of Sen. Kyl). Senator Kyl further commented that "[g]iven the time deadlines imposed on these proceedings, it is anticipated that, regardless of the standards imposed in [sections 316 and 326], PTO will be conservative in its grants of discovery." *Id*. at 9988-89.

Thus, in *inter partes* review, discovery is limited as compared to that available in district court litigation. Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution. There is a one-year statutory deadline for completion of *inter partes* review, subject to

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