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Paper 58
Entered: January 31, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

ACHATES REFERENCE PUBLISHING, INC.
Patent Owner

Case IPR2013-00080 (Patent 6,173,403)
Case IPR2013-00081 (Patent 5,982,889)[1]

Before HOWARD B. BLANKENSHIP, JUSTIN T. ARBES, and GREGG I. ANDERSON, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

DECISION
Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

[1] This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Introduction

Petitioner filed a motion for additional discovery in the instant proceedings and Patent Owner filed an opposition.[2] For the reasons stated below, Petitioner's motion is *granted*.

Patent Owner filed with its response in each proceeding a declaration from Mr. Dmitry Radbel (Exhibit 2013) and a declaration from Dr. Xin Wang (Exhibit 2014). In their declarations, Mr. Radbel and Dr. Wang stated that they relied on the other individual's declaration with respect to two prior art references at issue in these proceedings: U.S. Patent No. 5,933,497 ("Beetcher") and U.S. Patent No. 5,949,876 ("Ginter"). Mr. Radbel stated that he "rel[ied] upon the descriptions regarding Beetcher given in the declaration of Mr. Wang." Ex. 2013 ¶ 93. Dr. Wang stated that he "relied upon the descriptions of Ginter that Mr. Radbel set forth," and also relied on Mr. Radbel's testimony regarding the "legal standards for validity," level of ordinary skill in the art, and "design approach" of a person of ordinary skill in the art. Ex. 2014 ¶¶ 7-10, 51, 62.

Petitioner cross-examined both witnesses, and transcripts of their depositions have been entered into the record. *See* Exs. 2031, 2032, 2034, 2035. According to Petitioner, Mr. Radbel and Dr. Wang testified during their depositions that, in addition to the other individual's declaration, they also relied on email communications with the other individual as a basis for their opinions. Mot. 1-3. Petitioner, therefore, seeks discovery of "email communications exchanged directly between [Patent Owner's] two experts

[2] IPR2013-00080, Papers 51 ("Mot."), 57 ("Opp."); IPR2013-00081, Papers 45, 48. While the analysis herein applies to both proceedings, we refer to the papers filed in Case IPR2013-00080 for convenience.

during preparation of their declarations which concern any topic addressed in either witness' declaration." *Id*. at 1.

Analysis

Pursuant to the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), certain discovery is available in *inter partes* review proceedings. 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. §§ 42.51-53. Discovery in an *inter partes* review proceeding, however, is less than what is normally available in district court patent litigation, as Congress intended *inter partes* review to be a quick and cost effective alternative to litigation. *See* H. Rep. No. 112-98 at 45-48 (2011). A party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2)(i). The legislative history of the AIA makes clear that additional discovery should be confined 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. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). In light of this, and given the statutory deadlines required by Congress for *inter partes* review proceedings, the Board will be conservative in authorizing additional discovery. *See id*.

The Board considers various factors in determining whether additional discovery in an *inter partes* review proceeding is necessary in the interest of justice, including the following:

> 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.

Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC, IPR2012-00001, Paper 26 at 6-7 (Mar. 5, 2013). "Useful" in the context of this factor means "favorable in substantive value to a contention of the party moving for discovery," not just "relevant" or "admissible." *Id*. at 7.

Petitioner cites portions of the depositions of Mr. Radbel and Dr. Wang where the witnesses testified that they had direct email communications with each other regarding the prior art at issue in these proceedings. Mot. 2-3. For example, Dr. Wang testified as follows regarding his communications with Mr. Radbel, particularly with respect to Ginter:

> Q. So the question was, did you speak directly to Mr. Radbel before you prepared your declaration?
>
> A. Yes. We had a conversation.
>
> Q. And was that by email or by a telephone call?
>
> A. Email and telephone calls.
>
> Q. And can you tell me what topics you discussed with Mr. Radbel?
>
> A. The few things. One is which part we're going to cover. And he has more knowledge than I do, Ginter, and so we kind of talk about given the time we have and how we're going to divide the work. And so then we – and we have some references, mutual references, cross-references, and we talk about how do we deal with that.
>
> . . .

> Q. So what I wanted to know is whether you discussed in those emails the technical analysis you were performing of the prior art or the claims that you address in your report?
>
> A. Yeah, we had exchange on those.
>
> *Q. So if I looked in those emails, I would see you and Mr. Radbel discussing what is being described, for example, in one of the patents that was prior art?*
>
> *A. Basically that's the nature of it.*

Ex. 2034 at 21:1-22:21 (emphasis added). Mr. Radbel confirmed the discussions regarding Ginter, and stated that the two individuals discussed the challenged patents and used each other as "sounding boards":

> Q. . . . And what did you discuss with Dr. Wang?
>
> A. We discussed the patents, the issues. Sometimes he would use me as a sounding board; sometimes I would use him.
>
> . . .
>
> Q. Okay. And yet you used Dr. Wang as a sounding board for some of your views on the Ginter '876 patent; is that fair?
>
> A. Yeah. I guess.

Ex. 2031 at 17:18-18:5. Similarly, Mr. Radbel testified that he relied on Dr. Wang's communications regarding Beetcher:

> Q. . . . Did you read Bee[t]cher?
>
> A. I did a quick review. Mr. – Dr. Wang focused on analyzing Bee[t]cher, so *I relied in part on his statements*.
>
> . . .
>
> Q. . . . Were there email statements he made to you that you relied on?
>
> A. With regard specifically to Bee[t]cher, I'm not sure.
>
> Q. How about for anything else?
>
> A. We had email exchanges, yeah.
>
> *Q. You had email exchanges about Bee[t]cher?*

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