

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOLBE & KOLBE MILLWORK CO., INC.,
Petitioner,

v.

SIERRA PACIFIC INDUSTRIES,
Patent Owner.

Case IPR2019-00933
Patent 8,561,365 B2

Before CARL M. DEFRANCO, TIMOTHY J. GOODSON, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

On December 12, 2019, Patent Owner filed an authorized Motion for Additional Discovery. Paper 26 (“PO Mot.”). On December 20, 2019, Petitioner filed an authorized Opposition to this Motion (corrected). Paper 31 (“Pet. Opp.”). For the reasons discussed below, Patent Owner’s Motion is *granted*.

As described in our Trial Practice Guide, in trials before the Board, “[d]iscovery is a tool to develop a fair record and to aid the Board in assessing the credibility of witnesses” and “discovery before the Board is focused on what the parties reasonably need to respond to the grounds raised by an opponent.” *See* Office Patent Trial Practice Guide, 84 Fed. Reg. 64,280, § I.F (Nov. 21, 2019) (“Trial Practice Guide”). By rule, such discovery is divided into routine and additional discovery, the former category requiring production of a party’s cited exhibits, cross-examination of witnesses, and if not previously served, evidence relevant to information inconsistent with a position advanced by the producing party during the proceeding. 37 C.F.R. § 42.51(b)(1). The latter category, additional discovery, is directed to non-routine discovery that should be allowed in the interests of justice. *Id.* § 42.51(b)(2); *see also* 35 U.S.C. § 316(a)(5).

We conclude the additional discovery sought by Patent Owner should be authorized in the interests of justice, as discussed below. Regarding the authorization of additional discovery, the Board set forth factors for consideration in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential), which are:

Factor 1: Whether there is more than a possibility and mere allegation that something useful will be found and whether the

party requesting discovery is already in possession of evidence tending to show beyond speculation that something useful will be discovered;

Factor 2: Whether the party requesting discovery is seeking its opponent's litigation positions and underlying basis for those positions;

Factor 3: Whether the party requesting discovery has the ability to generate equivalent information by other means;

Factor 4: Whether the party requesting discovery has presented easily understandable instructions and questions; and

Factor 5: Whether the request for discovery is overly burdensome to answer or sensible and reasonably tailored according to a genuine need.

II. DISCUSSION

Patent Owner seeks additional discovery concerning evidence relating to objective indicia of non-obviousness, specifically on the issues of copying and commercial success, in the form of the production of three (3) documents and associated metadata identified by Bates labeling, the production of documents regarding Petitioner's revenue and sales of four (4) specified accused-infringing products,¹ responses to twenty six (26) requests for admission regarding the authenticity and admissibility of the requested documents and related metadata, and a response to one (1) interrogatory regarding an explanation for any response to the requests for admission/denial that is less than an unqualified admission. *See* Ex. 2019;

¹ Patent Owner defines the "Accused Products" to be the following products, sold since 2013: VistaLuxe® Casement Window – Accent Style; VistaLuxe® Casement Window – Flush Style; VistaLuxe® Awning Window – Accent Style; and VistaLuxe® Awning Window – Flush Style. Ex. 2019, 2–3.

Ex. 2020; Ex. 2021. This evidence is also at issue in the U.S. District Court case *Sierra Pacific Industries v. Kolbe & Kolbe Millwork Co., Inc.*, Civil Action No. 18-cv-853 (W.D. Wis.) (herein referred to as the “related district court litigation”), which the parties have each identified as a related matter. Paper 1 at 109; Paper 4 at 2. The related district court litigation was stayed on October 18, 2019, by order of the court. Ex. 2024.

Patent Owner’s proposed discovery requests are reproduced below:

Requests for Production of Documents

RFP No. 1:

The documents and associated metadata produced by Kolbe as: KOLBE_0028207-KOLBE_0028208, KOLBE_003792, KOLBE_0003802.xlsx, and KOLBE_0002997-KOLBE_0003039.

RFP No. 2:

Documents sufficient to show Petitioner’s gross and net revenue derived from sales of the Accused Products, as well as sales in units (as such unit sales may be tracked in the ordinary course of business), by year, throughout the entire period during it has been sold, up to and including the most recent date such information is available.

RFP NO. 3:

For each Request for Admission that Petitioner has not provided an unqualified admission, any and all documents Petitioner claims support its bases to deny said Request for Admission.

Requests for Admissions

REQUEST FOR ADMISSION No. 1: Admit that document KOLBE_0003802.xlsx is a true and authentic copy of the genuine original document.

REQUEST FOR ADMISSION No. 2: Admit that document KOLBE_0003802.xlsx was made at or near March-April 2012 as indicated as created and last modified dates in the metadata.

REQUEST FOR ADMISSION No. 3: Admit that document KOLBE_0003802.xlsx was made at or near the time of the regularly conducted activity to which the document pertains.

REQUEST FOR ADMISSION No. 4: Admit that document KOLBE_0003802.xlsx was made by a person or persons employed by or engaged by Kolbe as part of their duties as a Kolbe employee or their engagement by Kolbe.

REQUEST FOR ADMISSION No. 5: Admit that document KOLBE_0003802.xlsx was prepared and kept in the course of Kolbe's regularly conducted business activity.

REQUEST FOR ADMISSION No. 6: Admit that all foundational requirements for the admission of document KOLBE_0003802.xlsx have been satisfied.

REQUEST FOR ADMISSION No. 7: Admit that document KOLBE_0002997–KOLBE_0003039 (as redacted) is a true and authentic copy of the genuine original document.

REQUEST FOR ADMISSION No. 8: Admit that document KOLBE_0002997–KOLBE_0003039 (as redacted) was made at or near the date on page 2 of the document, January 27, 2012.

REQUEST FOR ADMISSION No. 9: Admit that document KOLBE_0002997–KOLBE_0003039 (as redacted) was made at or near the time of the regularly conducted activity to which the document pertains.

REQUEST FOR ADMISSION No.10: Admit that document KOLBE_0002997–KOLBE_0003039 (as redacted) was made by a person or persons employed by or engaged by Kolbe as part of their duties as a Kolbe employee or their engagement by Kolbe.

REQUEST FOR ADMISSION No. 11: Admit that document KOLBE_0002997–KOLBE_0003039 (as redacted) was

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.