

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC, and BRYCER MANAGEMENT, INC.,

Petitioner,

v.

TEGRIS, INC.,

Patent Owner.

IPR2023-01196
Patent 11,126,966 B2

Before HUBERT C. LORIN, MEREDITH C. PETRAVICK,¹ and
BRENT M. DOUGAL, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ Judge Petravick joins in this Order after reviewing the transcript of the March 12, 2024 conference call.

Patent Owner’s counsel contacted the Board on March 7, 2024 seeking authorization to file a motion for additional discovery to obtain certain documents listed in a document entitled “Patent Owner Requests for Production Nos. 1-4” (Ex. 3001, 5) (“RFP No(s).”). Ex. 3001.

A conference call was held on March 12, 2024, among respective counsel for Patent Owner and Petitioner, and Judges Lorin and Dougal. A transcript of the call has been entered into the record. *See* Paper 13.

For the reasons stated below, we deny Patent Owner’s request to file a motion for additional discovery.

Patent Owner contends RFP Nos. 1–3 are relevant to commercial success and RFP No. 4 is relevant to copying. Paper 13, 4:10–13. According to Patent Owner, the RFPs are related to patentability because “the commercial success of the [Petitioner’s] product is directly related its implementation of the claimed invention that’s recited in claim 8, and that commercial success is an indicia of non[obviousness].” *Id.* at 10:11–16. According to Patent Owner, the parties conferred to discuss Patent Owner’s RFPs and Petitioner objected to each of them. *Id.* at 3:24–4:5.

Petitioner opposes Patent Owner’s request and contends Patent Owner cannot show that any of its RFPs are in the interest of justice under *Garmin Int’l, Inc. v. Cuozzo Speed Tech. LLC*, IPR2012-00001 (Paper 26) (PTAB Mar. 5, 2013) because there is nothing in Patent Owner’s RFPs that “ties to the specific issues in this proceeding and it’s simply a fishing expedition in the hopes that something may be uncovered.” Paper 13, 10:22–11:12. Petitioner also contends Patent Owner’s request should be denied because there is not any evidence that would tie the RFPs to commercial success or

copying, RFP Nos. 1–3 do not seek information about a particular feature, and RFP No. 4 is unreasonably broad. *Id.* at 11:13–12:13.

“[I]n *inter partes* review, discovery is limited as compared to that available in district court litigation.” *Garmin*, IPR2012-00001, slip op. at 5 (Paper 26). Additional discovery is permitted when the moving party shows it “is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). We consider several factors in determining whether additional discovery is in the interests of justice. *Garmin*, IPR2012-00001, slip op. at 6–7 (Paper 26). Those factors include whether the requested discovery: 1) is based on more than a mere possibility of finding something useful; 2) seeks the other party’s litigation positions or the basis for those positions; 3) seeks information that reasonably can be generated without the discovery requests; 4) is easily understandable; and 5) is overly burdensome to answer (the “*Garmin* factors”). *Id.*

The party requesting discovery should already be in possession of a threshold amount of evidence tending to show beyond speculation that something useful will be discovered. *See Garmin*, IPR2012-00001, slip op. at 6 (Paper 26). Patent Owner has not demonstrated a *prima facie* showing that there is more than a mere possibility that the documents it anticipates Petitioner will provide will be useful to our determination of the patentability of the challenged claims. Patent Owner states that RFP Nos. 1–3 seek Petitioner’s “annual revenues [and] annual subscriptions to show that with their entry to the market they achieved enormous success.” Paper 13, 7:12–15. Patent Owner contends it will “prove that there’s a nexus between that success and the proactive notification, and standardized form, and web registry that’s recited in claim 8” of Patent Owner’s patent using materials

from Petitioner’s website, testimony from declarants that Petitioner’s system works in almost precisely the same manner as Patent Owner’s system as it relates to the features that are recited in the challenged claims, and claim charts from the co-pending litigation. *Id.* at 7:15–8:6; *see also id.* at 13:25–14:19. Thus, Patent Owner takes the position that the RFPs will uncover evidence of copying because Petitioner’s products include aspects that correspond to the steps or features of claim 8. *Id.* at 7:12–8:6, 13:25–14:19. Without any additional evidence, we determine Patent Owner’s allegations of infringement are insufficient to support its request in this proceeding.

We are also unpersuaded that Patent Owner’s RFPs are not overly burdensome. For example, RFP No. 2 broadly requests information about “the number and type of devices under management or otherwise monitored by the Accused Products,” such as fire hydrants and related life-saving systems, but Patent Owner’s claims are directed to computer-implemented methods for using a fire hydrant management software and a web-based registry to track requisite inspection of an owned asset, not the fire hydrants themselves. Ex. 3001, 5; *see also* Paper 13, 4:23–5:4. Additionally, RFP No. 4 broadly requests “[d]ocuments that contain statements of fact or opinion about Tegriss, Tegriss Fire, Compliance Model, or U.S. Patent No. 11,126,966.” Ex. 3001, 5. Although Patent Owner offered to limit RFP No. 4 to documents that refer to Tegriss, Compliance Engine (i.e., Petitioner’s product), or the challenged patent (*see* Paper 13, 8:21–9:7, 13:13–25), we still find that this is overly burdensome because the request could include any document mentioning Petitioner’s product or any discussion of Patent Owner, without any relationship to copying.

For the above reasons, we are not persuaded Patent Owner will show that the *Garmin* factors favor the additional discovery it seeks.²

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to file a motion for additional discovery is *denied*.

² During the conference call, Patent Owner likened the circumstances of its request to a decision on a motion for additional discovery the Board granted in *Brunswick Corporation v. Volvo Penta of the Americas, LLC* (“*Volvo Penta*”). Paper 13, 9:8–10:3 (citing *Brunswick Corporation v. Volvo Penta of the Americas, LLC*, Case IPR2020-01512 (Paper 25) (PTAB May 12, 2021)). According to Patent Owner, its RFPs are similar to those at issue in *Volvo Penta* in which “under very similar circumstances, the board allowed discovery regarding the revenues annual number showing the commercial success of the Petitioner, and also allowed similar discovery showing copies.” *Id.* at 9:8–15. We do not find Patent Owner's discussion of *Volvo Penta* persuasive because the Board's decision in that proceeding is not precedential, and the moving party's request to file a motion for additional discovery in that proceeding was not opposed. *See Volvo Penta*, Case IPR2020-01512, slip op. at 2 (Paper 21) (PTAB Apr. 29, 2021).

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