

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TENNANT COMPANY,  
Petitioner,

v.

OXYGENATOR WATER TECHNOLOGIES, INC.,  
Patent Owner.

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IPR2021-00625  
Patent RE45,415 E

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Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER, and  
WESLEY B. DERRICK, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

On September 20, 2021, Patent Owner's counsel contacted the Board via email (Exhibit A), copying Petitioner's counsel, and requesting "leave to file a motion seeking 'routine' and/or 'additional' discovery" for certain listed documents.

A conference call was held on September 22, 2021, among respective counsel for Patent Owner and Petitioner, and Judges Kalan, Kaiser, and Derrick. For the reasons stated below, we authorize Patent Owner to file a motion for additional discovery and authorize Petitioner to file an opposition thereto.

Patent Owner seeks authorization to file a motion "seeking 'routine' and/or 'additional' discovery." Ex. A. Patent Owner submits that it will make four requests to obtain certain documents in connection with experiments conducted by Dr. Tremblay, Petitioner's declarant, who submitted testimony in this proceeding. Patent Owner represents that "Petitioner opposes at least some aspect of each of these four requests."

Petitioner responds that Patent Owner's four requests are not in the nature of routine discovery, but are an additional obligation for Petitioner. Petitioner indicated that it did not oppose a reasonable examination of Dr. Tremblay's lab notebooks, test results, and data, but that Patent Owner's second and third requests, in particular, are not the type of expert discovery that would be allowed under the Federal Rules of Civil Procedure.

37 C.F.R. § 42.51(b)(2) states that a party may move for additional discovery when appropriate. A party seeking additional discovery in an *inter partes* proceeding must demonstrate that the additional discovery is in the interest of justice. *See* 35 U.S.C. § 316(a)(5).

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After considering the arguments of the parties, we authorized Patent Owner to file a motion for additional discovery, limited to 7 pages, to be filed by close of business on October 4, 2021. We authorized Petitioner to file an opposition, also limited to 7 pages, to be filed by close of business on October 11, 2021. No other briefing was authorized. We expect the parties to address the five Garmin factors that are important in determining whether additional discovery is in the interest of justice. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential). We gave the parties additional time before the due date for Patent Owner's motion, instructing the parties to meet and confer to determine if Petitioner could agree to provide any of the discovery requested in Patent Owner's email (Ex. A), and if any of Patent Owner's four requests could be narrowed or eliminated to streamline the motions practice.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2), and Petitioner is authorized to file an opposition;

FURTHER ORDERED that Patent Owner's motion is due October 4, 2021, and Petitioner's opposition is due October 11, 2021; and

FURTHER ORDERED that Patent Owner's motion and Petitioner's opposition are limited to no more than 7 pages each.

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PETITIONER:

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# EXHIBIT A

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