

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TENNANT COMPANY,
Petitioner,

v.

OXYGENATOR WATER TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-00625
Patent RE45,415 E

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

KALAN, *Administrative Patent Judge*.

ORDER

Granting-in-Part Patent Owner's Motion for Additional Discovery
37 C.F.R. §§ 42.51(b)(1), 42.51(b)(2)

ORDER

Granting Patent Owner's Motion to Expunge
37 C.F.R. §§ 42.5

Pursuant to our authorization, Oxygenator Water Technologies, Inc. (“Patent Owner”) filed a Motion for Additional Discovery in the instant proceeding, and Tennant Company (“Petitioner”) filed an Opposition.¹ We indicated in our authorization that we expected the parties to address the five Garmin factors that are important in determining whether additional discovery is in the interest of justice. Paper 18, 3 (citing *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential)).

Patent Owner seeks additional discovery related to experiments conducted by Dr. Tremblay, Petitioner’s declarant, who submitted testimony in this proceeding. Mot. 1. Specifically, Patent Owner requests:

- (1) Laboratory notebooks and other documents containing or reflecting the protocols used in connection with the experiments considered by Petitioner’s expert Dr. Tremblay related to his consultation with Petitioner;
- (2) Documents identifying, including, or referring to any instructions, suggestions, or advice provided to Dr. Tremblay concerning the design and/or structure of the purported physical embodiments;
- (3) Documents identifying, including, or referring to any instructions, suggestions, or advice provided to Dr. Tremblay concerning the parameters for operation of the purported physical embodiments; and
- (4) Test reports or other raw data from any experiments conducted by, at the direction of, or for consideration by Dr. Tremblay that analyze the impact of any parameter that is the subject of the claims of the ’415 patent.

Id. Petitioner indicates that it will produce materials relating to Requests 1 and 4 “as they relate to the prior art at issue in this I.P.R. (*i.e.* the Wikey and

¹ See IPR2021-00625, Papers 18 (authorizing filing of the Motion), 21 (“Mot.”), and 25 (“Opp.”).

Davies references).” Opp. 1. Petitioner, however, objects to “discovery regarding Dr. Tremblay’s evaluation of *other* prior art references in connection with the parties’ district court lawsuit that are not part of this I.P.R.” *Id.*

After considering the arguments, evidence, and facts before us, we determine that it is in the interest of justice to grant Patent Owner’s Motion in part. For the reasons that follow, Patent Owner’s Motion is granted, but as to Requests 1 and 4 only.

Petitioner also filed a Motion to Expunge Paper No. 23. Paper 24. Paper 23 is a version of the Opposition that exceeded the 7-page limit set forth in our authorization. Paper 18, 3.

Motion for Additional Discovery

In an *inter partes* review, 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). Patent Owner, as the movant, bears the burden of demonstrating that it is entitled to the additional discovery sought. 37 C.F.R. § 42.20(c). We consider the five *Garmin* factors in determining whether additional discovery is necessary in the interest of justice. *Garmin*, Paper 26 at 6–7. The five *Garmin* factors are: (1) whether there exists more than a possibility and mere allegation that something useful will be discovered; (2) whether the requests seek the other party’s litigation positions and the underlying basis for those positions; (3) whether the moving party has the ability to generate equivalent information by other means; (4) whether the moving party has provided easily

understandable instructions; and (5) whether the requests are overly burdensome. *Id.*

1. Garmin Factor 1: Useful Information

The first *Garmin* factor asks whether the party seeking additional discovery demonstrates more than “[t]he mere possibility of finding something useful, and mere allegation something useful will be found.” *Garmin*, Paper 26 at 6. “The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.* “Useful” in this context means “favorable in substantive value to a contention of the party moving for discovery,” not just “relevant” or “admissible.” *Id.* at 7. A good cause showing requires the moving party to provide a specific factual reason for reasonably expecting that the discovery will be “useful.”

Patent Owner alleges that all of the requested discovery is directed to “the impact of Dr. Tremblay’s selection of unspecified variables on his results.” Mot. 2. Petitioner argues that the requested discovery “will be useful to assessing Petitioner’s inherent anticipation argument” based on Dr. Tremblay’s experiments. *Id.* at 3. Regarding Requests 1 and 4, Patent Owner contends that “there is more than a mere possibility that something useful will be discovered” because “data demonstrating that the unspecified structural and operational parameters of Wikey and Davies impact bubble size will refute inherent anticipation,” and disagrees with Petitioner’s position that “evaluation of uncited prior art is irrelevant.” *Id.* at 4. Regarding Requests 2 and 3, Patent Owner argues that it will be “highly useful” to “show that specific instructions and recommendations were

provided to Dr. Tremblay for his creation of alleged ‘reproductions.’” *Id.* at 6–7.

Regarding Requests 1 and 4, Petitioner responds that Patent Owner’s reliance on *Adobe Inc. v. RAH Color Technologies LLC*, IPR2019-00627, Paper 59 at 4 (PTAB Dec. 12, 2019) is inapposite, because Patent Owner here seeks information regarding the specific content of “other prior art that Dr. Tremblay may have evaluated in the district court litigation and what the conclusions of that analysis were.” *Opp.* 2. According to Petitioner, *Adobe* stands for the proposition that requests for *document* discovery regarding an expert’s substantive analysis of uncited prior art references should be denied. *Id.* at 3. Petitioner further argues that “Patent Owner’s request to seek discovery regarding Dr. Tremblay’s district court litigation evaluation of prior art not cited in the instituted I.P.R. runs afoul of at least *Garmin* factors 1 and 2.” *Id.* at 4–5. Regarding Requests 2 and 3, Petitioner argues that they are “unsupported by the Board’s prior decisions” and “violate Federal Rule of Civil Procedure 26(b)(4).” *Id.* at 5.

As noted above, information is “useful” if it is “favorable in substantive value to a contention of the party moving for discovery,” not just “relevant” or “admissible.” *Garmin*, Paper 26 at 7. Regarding Requests 1 and 4, the facts here are sufficiently similar to those in *Adobe* to allow us to reach the same conclusion as the panel in that case, namely, that “inquiring about the facts (e.g. prior art references) that a declarant considered and reviewed in preparing his testimony” falls “squarely within routine discovery permitted by our rules.” *Adobe*, Paper 59 at 5 (citing 37 C.F.R. § 42.51(b)(1)(ii) (permitting “[c]ross examination of affidavit testimony prepared for the proceeding”)). Even if we were to adopt Petitioner’s

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.