

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

REM HOLDINGS 3, LLC,
Patent Owner.

Case IPR2014-00312
Patent 8,584,946

Before DENISE M. POTHIER, JENNIFER S. BISK, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Motion for Additional Discovery
37 C.F.R. § 42.51

Patent Owner moves for additional discovery relating to evidence of secondary considerations to overcome obviousness challenges. Paper 19. Counsel for the parties and Judges Pothier, Bisk, and Scanlon participated in a conference call on August 13, 2014, to discuss the motion.

We have reviewed Patent Owner's requests and find that we cannot grant them in their current form and given the expedited nature of these proceedings. The document requests in particular are unduly broad and burdensome to Petitioner. In addition, the motion includes requests for information that is publicly available. As explained in the call, given the evidence previously submitted in this and related proceedings, we believe that Patent Owner may be entitled to a limited amount of discovery from Petitioner. Although Petitioner asserts that Patent Owner has not established the nexus required to show commercial success, we are persuaded that, at this point in the proceeding, Patent Owner has made sufficient showing to entitle them to some information from Petitioner regarding sales figures. *Garmin* requires that before a discovery request will be granted, Patent Owner must show more than a possibility or mere allegation that something useful will be found. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at * 6 (PTAB Mar. 5, 2013) (Paper 26). However, this does not mean that the requester must prove conclusively that they will win on the merits before any discovery will be granted.

During the call, we directed the parties to meet and confer on the issue of discovery and attempt to agree on a reasonable amount of information to

produce. In the alternative, Petitioner may offer to stipulate to certain facts, such as sales figures, in order to avoid producing sensitive documents.¹

If the parties cannot come to an agreement, they may contact the Board for further guidance and to give Patent Owner an opportunity to seek authorization to renew its motion for additional discovery in accordance with this order and the cases listed in the original order authorizing the motion (Paper 17). The parties should be prepared to discuss why they were unable to reach an agreement at least as to sales information.

Accordingly, it is

ORDERED that Patent Owner's Motion for Additional Discovery (Paper 19) is *dismissed without prejudice*;

FURTHER ORDERED that the parties are directed to meet and confer on the issue of discovery;

FURTHER ORDERED that Petitioner is authorized to file a motion to seal any stipulations that contain business confidential material.

¹ Petitioner may file a motion to seal any stipulations that contain business confidential material. 37 C.F.R. § 42.54.

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