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# PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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## Benefits of Showing Discovery as “Routine” Instead of “Additional”

By H. Wayne Porter

April 14, 2015 — The PTAB issued an order granting in part a request for discovery by an IPR petitioner.

[IPR2014-00727 - C&D Zodiac, Inc. v. B/E Aerospace, Inc. \(Paper 37\)](#)

Certain types of “routine” discovery are available in a trial proceeding before the PTAB. Under 37 C.F.R. § 42.51(b)(1), routine discovery includes (i) any paper or exhibit cited in a paper or in testimony, (ii) cross-examination (deposition) of witnesses providing affidavits, and (iii) relevant information that is inconsistent with a position advanced by a party. Routine discovery is intended to be self-executing, and all parties have the burden to provide such discovery.<sup>i</sup> The rules provide that a party may move for “additional discovery” that includes other types of materials. In practice, however, it is very difficult to meet the high burden<sup>ii</sup> that the PTAB sets for obtaining additional discovery.

The petitioner in IPR2014-00727 was able to obtain substantial discovery — that the patent owner did not want to provide — by showing the discovery qualified as “routine.”<sup>iii</sup> The patent at issue in the IPR relates to aircraft enclosures for lavatories, closets, etc. having walls that are shaped to provide space for seats outside the enclosure.<sup>iv</sup>

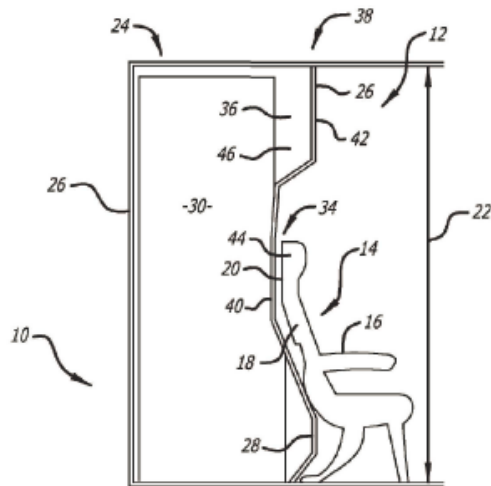


FIG. 2

In its [motion to compel discovery](#), the petitioner argued that the requested materials were inconsistent with a position the patent owner had advanced. In particular, the petitioner pointed to statements by the patent owner asserting that a person of ordinary skill in the art would not have applied previously-known recessed aircraft enclosure designs to the design of other enclosures.<sup>v</sup> With its motion to compel, the petitioner submitted evidence that a “KLM crew rest” design was based on a previous design of a recessed enclosure, together with evidence that the patent owner was aware of that KLM crew rest design.<sup>vi</sup>

The PTAB ordered the patent owner to produce, as [routine discovery](#), documents that concerned development of the KLM crew rest.<sup>vii</sup> The PTAB also ordered production of documents that concerned development of the invention and that referenced other enclosures having relevant features (e.g., a recessed wall). Because the petitioner was able to show the requested materials were inconsistent with a position advanced by the patent owner, and show that the patent owner knew of and likely had those materials, the petitioner was able to obtain discovery without meeting the substantially higher burden necessary to obtain “additional discovery.”

*The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.*



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<sup>i</sup> See “Message From Administrative Patent Judges Jacqueline Bonilla and Sheridan Snedden: Routine and Additional Discovery in AIA Trial Proceedings: What Is the Difference?” AIA Blog post, dated September 30, 2014 ([http://www.uspto.gov/blog/aia/entry/message\\_from\\_administrative\\_patent\\_judges](http://www.uspto.gov/blog/aia/entry/message_from_administrative_patent_judges)).

<sup>ii</sup> *Id.* See also IPR2012-00001, *Garmin Int'l Inc. et al. v. Cuozzo Speed Techs. LLC*, Paper 26, pages 3-7, including five factors when considering whether additional discovery in an IPR is “necessary in the interest of justice.”

<sup>iii</sup> Case IPR2014-00727, *C&D Zodiac, Inc. v. B/E Aerospace, Inc.* (IPR2014-00727), Paper 37.

<sup>iv</sup> IPR2014-00727, Decision Institution of *Inter Partes* Review, Paper 15, page 4.

<sup>v</sup> IPR2014-00727, Paper 34, pages 4-5.

<sup>vi</sup> *Id.*, pages 2-4; IPR2014-00727, Exhibits [1011](#) (Declaration of assigned project engineer for development of the KLM crew rest) and [1012](#) (rendering of the KLM crew rest).

<sup>vii</sup> IPR2014-00727, Paper 37, page 3.