

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOLFSPEED, INC. AND
IDEAL INDUSTRIES LIGHTING, LLC d/b/a CREE LIGHTING,
Petitioner,

v.

CAO LIGHTING, INC.,
Patent Owner.

IPR2022-00847 (Patent 6,465,961 C2)
IPR2022-00848 (Patent 6,634,770 C3)¹

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and BRIAN D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)(i)

¹ These proceedings have not been consolidated. The parties are not authorized to use a combined caption unless an identical paper is being entered into each proceeding, and the paper contains a footnote indicating the same.

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

These matters are an *inter partes* review of claims 21, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 71–73, 77, 78, 81, 82, 85, 86, and 88–91 of U.S. Patent No. 6,465,961 C2 (“the ’961 patent”) and claims 18, 22, 25, 26, 28–30, 32–36, 40–44, 47–49, 52, 53, 56–59, 62, 63, 65–68, 70–73, 77, 78, 81, 82, 85, 86, and 88–91 of U.S. Patent No. 6,634,770 C3 (“the ’770 patent”). IPR2022-00847, Paper 10, 45–46; IPR2022-00848, Paper 10, 33. With pre-authorization², Patent Owner filed a Motion for Additional Discovery in each of these matters (IPR2022-00847, Paper 21; IPR2022-00848, Paper 20), and Petitioner filed an Opposition (IPR2022-00847, Paper 23; IPR2022-00848, Paper 22)³.

The applicable standard for this motion is set forth in 37 C.F.R. § 42.51(b)(2)(i) as follows:

Additional Discovery. The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice

An important Congressional objective in passing the Leahy-Smith America Invents Act was to provide a quick and cost-effective alternative to federal district court patent litigation. *See* H. Rep. No. 112-98, at 45–48 (2011). With that goal in mind, the statute passed by Congress and the rules implementing the statute provide for limited discovery. *See* 35 U.S.C. § 316(a)(5)(A); 37 C.F.R. § 42.51(b). In an *inter partes* review, the Board may authorize additional discovery, but only what is necessary in the interest

² The panel provided pre-authorization via e-mail.

³ The papers are substantively identical in each matter. Through the remainder of this decision, we refer to the papers in IPR2022-00847 for brevity.

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

of justice. *See* 35 U.S.C. § 316(a)(5)(B); 37 C.F.R. § 42.51(b)(2). The legislative history makes plain that additional discovery in the interest of justice should be limited to minor discovery and special circumstances. 154 CONG. REC. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl).

Given the time deadlines imposed by Congress, the Board is conservative in granting additional discovery requests in *inter partes* review proceedings. *See id.* We assess the interest of justice in view of factors set forth in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (Mar. 5, 2013) (precedential) (“*Garmin*”):

1. Whether requests are based on more than a possibility and mere allegation;
2. Whether the requests seek litigation positions and underlying basis;
3. Whether the requestor has the ability to generate equivalent information by other means;
4. Whether the requests instructions are easily understandable; and
5. Whether the requests are overly burdensome to answer.

Patent Owner’s motion (Paper 21) advances four document requests. We address each request in view of the *Garmin* factors.

Document Request No. 1

Patent Owner first requests “Documents sufficient to show the structure and operation of each of the products identified in paragraphs 27-35 of Exhibit 1017 and in Exhibit 1018 (each referred to below as an ‘Accused Product’).” Paper 21, 1. Patent Owner argues that this request, as well as its other requests, are relevant to objective evidence of non-obviousness: “long-felt need, failure of others, unexpected results, copying,

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

commercial success, awards, and industry recognition.” *Id.* at 2. In particular, Patent Owner argues that it already possesses “a threshold amount of evidence” tending to show that “the Accused Products” embody and are co-extensive with claimed features such that evidence of Petitioner’s “commercial success, awards, and industry recognition” has a nexus with the claims. *Id.* at 2–4.

With regard to *Garmin* factor 5, we agree with Petitioner (Paper 23) that Patent Owner’s requests, including this first request, are ambiguous and overly broad. In particular, the request defines “Accused Products” by referring to paragraphs 27–35 of its district court complaint (Exhibit 1017) and the entirety of a twenty-four page claim chart (Exhibit 1018). The complaint, in turn, identifies an large and indeterminate number of products as “Accused” including, for example, “a variety of LED lighting sources” (paragraph 27), three “A-line lamps” (paragraph 28), “XLamp XT E-high-voltage LEDs” (paragraph 29), about 30 distinct *series* of products from a 2015 catalog (paragraphs 30–31), and about nineteen different *categories* of lighting products “offered by IDEAL” (paragraph 34). Ex. 1017. Petitioner characterizes the Accused Products as including “hundreds of disparate lighting products, designed for various indoor or outdoor applications” (Paper 22, 6–7), and, based on the complaint, Petitioner’s characterization appears correct.

We further note that the request is overbroad in that it seeks documents regarding structure and operation of the Accused Products rather than only seeking such documents to the extent they relate to a claimed feature of a patent now at issue. The breadth and lack of clarity regarding

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

what Patent Owner considers “accused products” weighs heavily against allowing this request pursuant to *Garmin* factors four and five.

Furthermore, the patent claims at issue relate to the external and internal structure of LED lightbulbs that Patent Owner alleges are publicly sold. Paper 20, 4 (admitting that Patent Owner analyzed retail samples of Accused Products). Patent Owner alleges that it seeks internal documents regarding “further detail on the structure and operation of the Accused Products to confirm Patent Owner’s analysis (that the Accused Products embody the claimed inventions)” (*id.*), but the documents appear unnecessary if Patent Owner can obtain actual samples of the products commercially. Patent Owner does not identify features of the patent claims at issue that could not be observed by inspecting commercial products (visually or by testing). Moreover, Patent Owner’s assertion that documents will provide information that is not publicly available by inspection of products lacks factual underpinning and, as such, are based on speculation or mere possibility. Thus, availability of public information regarding the products’ operation weighs against this request pursuant to *Garmin* factors one and three.

For these reasons, taking account of the information presented by the parties, we deny this request.

Document Request No. 2

Patent Owner’s second request seeks “[a]ll documents concerning the development of each Accused Product.” Paper 20, 1. Patent Owner argues that these documents are relevant to Petitioner’s alleged copying of the claimed inventions. *Id.* at 4–5.

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

The request is overly broad and unclear for the reasons we explain above with regard to the first request. Also, the request is overly broad because it seeks *all* documents concerning development of Accused Products, but many of those documents may not relate to any feature claimed by a patent at issue. Also, any documents relating to Petitioner's independent development of products cannot possibly relate to copying. *Garmin* factors four and five weigh against this request.

The request also is speculative and based on a mere possibility of returning relevant evidence. When considering a request for additional discovery, we look for more than “speculation that something useful will be uncovered. ‘Useful’ in th[is] context does not mean merely ‘relevant’ and/or ‘admissible.’” *Garmin*, Paper 26, 7. On the contrary, “‘useful’ means favorable in substantive value to a contention of the party moving for discovery.” *Id.*

Here, Patent Owner raises no “more than a possibility” or “mere allegation” that production of the requested documents would return anything of substantive value. *Id.* Patent Owner cites as evidence of Petitioner's copying Petitioner's “access” to Patent Owner's products (meaning that Petitioner, just like anyone, *could* have bought those products on the open market or *could* have obtained Patent Owner's catalog), patent number markings on products, and Petitioner keeping development of its products confidential. Paper 20, 4–6. But none of these facts suggest copying. Thus, *Garmin* factor one also weighs against this request.

For these reasons, taking account of the information presented by the parties, we deny this request.

Document Request No. 3

Patent Owner’s third request seeks “Documents sufficient to show the number of units sold and the amount of revenue collected for each Accused Product.” Paper 20, 1. Patent Owner argues that this request is relevant to commercial success. *Id.* at 4.

The request is overly broad and unclear for the reasons we explain above with regard to the first request. Thus, *Garmin* factors four and five weigh against this request.

Also, as Petitioner argues, raw sales numbers have little value in determining “commercial success.” Paper 22, 4 (*citing In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (“numbers of units sold is insufficient to establish commercial success”)). As such, the request is based on a mere possibility of obtaining relevant evidence, and *Garmin* factor one weighs against the request.

For these reasons, taking account of the information presented by the parties, we deny this request.

Document Request No. 4

Patent Owner’s fourth request seeks “Documents sufficient to show industry praise for the Accused Products.” Paper 20, 1. Patent Owner argues that this request is relevant to industry praise as an objective indicator of patentability. *Id.* at 4.

The request is overly broad and unclear for the reasons we explain above with regard to the first request. Also, Patent Owner states that some documents encompassed by this request “may be also publicly available.” *Id.* at 6. To the extent the request encompasses publicly available

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

documents, the request is overbroad. Thus, *Garmin* factors three, four, and five weigh against this request.

Patent Owner also argues that it “believes there is likely industry praise that was not publicized (e.g., customer feedback).” *Id.* at 6. Patent Owner does not provide a factual basis for this belief and does not establish that such documents would be significant relative to similar publicly available documents. As such, the request is based on speculation and mere possibility, and *Garmin* factor one weighs against the request.

For these reasons, taking account of the information presented by the parties, we deny this request.

It is

ORDERED that, pursuant to 37 U.S.C. § 42.51(b)(2)(i), Patent Owner’s Motion for Additional Discovery (IPR2022-00847, Paper 21; IPR2022-00848, Paper 20) is *denied*.

IPR2022-00847 (Patent 6,465,961 C2)

IPR2022-00848 (Patent 6,634,770 C3)

For PETITIONER:

John C. Alemanni

Matias Ferrario

KILPATRICK TOWNSEND & STOCKTON LLP

jalemanni@kilpatricktownsend.com

mferrario@kilpatricktownsend.com

For PATENT OWNER:

Joshua P. Larsen

Paul B. Hunt

Adam M. Kaufmann

BARNES & THORNBURG LLP

joshua.larsen@btlaw.com

paul.hunt@btlaw.com

adam.kaufmann@btlaw.com