

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

LURACO HEALTH & BEAUTY, LLC,  
Petitioner,

v.

LEXOR MANUFACTURING, LLC,  
Patent Owner.

---

Case IPR2019-00204  
Patent RE46,655 E

---

Before RICHARD H. MARSCHALL and ALYSSA A. FINAMORE,  
*Administrative Patent Judges.*

MARSCHALL, *Administrative Patent Judge.*

DECISION  
Granting Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

## BACKGROUND

We previously granted the request of Lexor Manufacturing, LLC (“Patent Owner”) to file a Motion for Additional Discovery. *See* Paper 15. We authorized a Motion seeking documents responsive to Requests 2, 3, 6, and 8 in Patent Owner’s Notice of Deposition to Dr. Hullender. *See id.*; Paper 14, Ex. A. We also encouraged the parties to confer further regarding the disputed requests in an attempt to narrow the scope of the disputes. Paper 15, 3. Following that Order, the parties further conferred and reached agreement as to Requests 2, 3, and 6, but did not resolve the dispute regarding Request 8. *See* Paper 16 (Patent Owner’s Motion for Additional Discovery, “Mot.”), 1. Accordingly, Patent Owner’s Motion only seeks documents responsive to Request 8. *Id.* Petitioner filed an Opposition to Patent Owner’s Motion. *See* Paper 17 (“Opp.”). The sole request at issue in the Motion appears below.

**Request 8.** All documents that specifically discuss anatomy, design or efficiency (fluid flow or head output per energy input) of centrifugal pumps that You reviewed in connection with researching for or preparing Your declaration (Exhibit 1009, Declaration of Dr. David Allan Hullender).

## ANALYSIS

A party moving for additional discovery “must show that such additional discovery is in the interests of justice” in connection with an *inter partes* review proceeding. 37 C.F.R. § 42.51(b)(2). The *Garmin* factors focus on ensuring that the discovery sought is in the interest of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26). Patent Owner asserts that all five *Garmin* factors support its discovery request. Mot. 3–5. Petitioner

largely ignores the *Garmin* factors, and makes several arguments in opposition to Patent Owner's Motion. We address each of Petitioner's arguments in turn.

*Timing of Patent Owner's Filing*

Petitioner argues that we should deny the Motion because Patent Owner failed to file its Motion by June 21, the deadline contained in our authorization to file the Motion. *See* Opp. 1–2; Paper 15, 4. Petitioner correctly notes that Patent Owner did not file its Motion by midnight Eastern on June 21, 2019. Instead, it appears that Patent Owner filed the Motion just under an hour past midnight Eastern, on June 22.

Under our Rules, “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). As we noted in our Order authorizing the Motion, we had to set an extremely tight briefing schedule due to the upcoming deposition of Dr. Hullender, and set the deadline for the Motion the day after we authorized the Motion orally during a call with the parties, and the same day that we issued our Order. Paper 15, 3–4. We also note that Petitioner does not allege any prejudice due to the filing occurring less than an hour after the deadline, nor could it reasonably do so. Under these circumstances, we find that good cause exists to exercise our discretion to excuse the late filing of the Motion. Moreover, as any additional discovery related to Dr. Hullender's upcoming deposition on June 28 should be effectuated prior thereto, our consideration of the merits of the motion would be in the interests of justice.

*Documents Concerning Pump “Efficiency”*

Request 8 seeks documents “that specifically discuss anatomy, design or efficiency . . . of centrifugal pumps.” Paper 14, Ex. A. Petitioner takes issue with the use of the term “efficiency” in Request 8, arguing that Dr. Hullender’s declaration does not use or reference “efficiency.” Opp. 3–4. Petitioner argues that the Request therefore seeks irrelevant documents, or that it is unclear what Patent Owner means by the term. *Id.*

We disagree with Petitioner’s argument that the inclusion of the term “efficiency” in Request 8 supports denial of Patent Owner’s Motion. First, if Dr. Hullender reviewed no documents relating to the “efficiency” of pumps, there is no obligation to produce documents that do not exist. Second, the term appears in a list of terms describing types of centrifugal pump documents, connected by the term “or.” Any ambiguity over the term “efficiency” would not justify denial of Patent Owner’s Motion, removing the need to produce documents falling within the scope of the remaining, clear terms in the Request. Third, Patent Owner already proposed an alternative wording for the Request in its Motion to clarify any potential ambiguity such as that raised by Petitioner with respect to “efficiency.” Mot. 5. Namely, Patent Owner states that “[i]f the specific language of Request No. 8 is considered confusing, Patent Owner would be happy to have it interpreted as referring to documents ‘specifically discussing mechanical or hydraulic aspects of centrifugal pumps.’” *Id.* Accordingly, to the extent that Petitioner remains confused over the scope of the term, it can construe the request in the manner suggested by Patent Owner, which does not employ the term “efficiency.”

For all of the above reasons, we are not persuaded that inclusion of the term “efficiency” in Request 8 supports a denial of Patent Owner’s Motion.

*Consideration of the Garmin Factors*

Further consideration of the *Garmin* factors supports Patent Owner’s Motion, and with the exception of the fifth factor, Petitioner has largely ignored the factors in its Opposition.

The first *Garmin* factor requires more than a mere possibility or mere allegation that the discovery will reveal useful information. Patent Owner argues that Dr. Hullender likely reviewed “authority concerning the main issues at play in the matter—namely anatomy and design of centrifugal pumps, and its [e]ffects on pump hydraulic performance, including efficiency.” Mot. 4. Patent Owner bases the argument on the scope of the opinions in Dr. Hullender’s Declaration that encompass centrifugal pump redesign, and the inclusion of *Marks’ Handbook* in connection electric motors, not centrifugal pumps, in the list of reviewed materials. *Id.* at 2–4 (citing Ex. 1009, 3). Petitioner does not address this factor directly in its Opposition. Notably, Petitioner does not argue that Dr. Hullender’s list of materials reviewed in his Declaration is complete, and that no other responsive documents exist. *See* Ex. 1009, 3 (list of materials reviewed). Based on the Patent Owner’s un rebutted arguments, we find that more than a mere possibility exists that Dr. Hullender reviewed additional materials “in connection with researching for or preparing” his Declaration beyond those listed in the Declaration, such that there is more than a possibility that documents responsive to the Request exist and are in Dr. Hullender’s possession.

The second *Garmin* factor addresses whether the requested discovery concerns litigation positions or the underlying basis for those positions. Patent Owner contends that Request 8 does not seek those positions. Mot. 4. Petitioner does not address this factor. We agree with Patent Owner that Request 8 does not seek Petitioner’s litigation positions or the underlying basis for the positions.

The third *Garmin* factor focuses on the ability of Patent Owner to discover the requested information by other means. Patent Owner argues that Dr. Hullender possesses the authority he reviewed in connection with the preparation of his Declaration. Mot. 4. Petitioner does not address this issue. We agree with Patent Owner that it cannot discover what information Dr. Hullender reviewed in connection with the preparation of his Declaration by means other than requesting this information from Dr. Hullender.

The fourth *Garmin* factor focuses on whether the request is easily understood. Patent Owner argues that Request 8 and the related instructions are “fairly standard, and are not difficult to understand.” Mot. 4. Petitioner argues that the term “efficiency” is unclear, but does not otherwise address this factor. *See* Opp. 4. We addressed Petitioner’s argument regarding “efficiency” above. We do not view Request 8 or the related instructions as unclear or difficult to understand.

The fifth *Garmin* factor precludes discovery requests that place an undue burden on the producing party. Patent Owner argues that Request 8 does not place an undue burden on Dr. Hullender because the Request seeks only those documents “reviewed in connection with researching for or preparing” his Declaration regarding centrifugal pumps. Mot. 4. Patent Owner stresses that responsive documents “would be limited to the finite

period between when Dr. Hullender was retained and when his Declaration was completed.” *Id.* at 5. Petitioner argues that the request is overly broad and unduly burdensome because “[i]t is not unreasonable to conclude that an individual such as Dr. Hullender would consider such a request to apply to all the text books and articles on the shelves in his office.” *Opp.* 5.

According to Petitioner, the Request’s use of the term “in connection” calls for production of any document Dr. Hullender may have reviewed “over the years that allow him to analyze any centrifugal pump matter.” *Id.* We disagree with Petitioner’s interpretation of Request 8, which ignores the points made by Patent Owner in the Motion. Request 8 seeks documents “reviewed in connection with researching for or preparing” the Declaration, which is limited to specific documents reviewed since Petitioner retained Dr. Hullender in this matter. *See* Mot. 5. The Request does not seek, and Dr. Hullender need not produce, documents he may have reviewed over his entire career that relate to “any centrifugal pump subject matter.” Given the limits on the scope of the Request, we do not find the Request unduly broad or overly burdensome.

In summary, Patent Owner has established that the *Garmin* factors weigh in favor of granting Patent Owner’s Motion for Additional Discovery as to Request 8. Based on our review of the parties’ arguments and our review the discovery sought by Patent Owner, we conclude that it is in the interests of justice to grant the Motion.

### III. CONCLUSION

Based on the foregoing, we grant Patent Owner’s Motion for Additional Discovery with respect to Request 8 (Paper 14, Ex. A).

IV. ORDER

It is ORDERED that Patent Owner's Motion for Additional Discovery  
(Paper 16) is *granted*.

For PETITIONER:

Gregory Howison  
Keith Harden  
John Arnott  
MUNCK WILSON MANDALA, LLP  
ghowison@munckwilson.com  
kharden@munckwilson.com  
jarnott@munckwilson.com

For PATENT OWNER:

Glen Nuttall  
Tom Dao  
KLEIN, O'NEILL & SINGH, LLP  
gnuttall@koslaw.com  
tdao@koslaw.com