

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

reasoning that *Adobe* applies only to depositions and not written discovery, it makes no sense to us to deny the document discovery requested here and then permit it in Dr. Tremblay's deposition as in *Adobe*. We note that Patent Owner has noticed Dr. Tremblay's deposition (Paper 26), and having the documents Dr. Tremblay relied upon in constructing his reproductions would typically be useful in conducting such a cross-examination. *See Mylan Pharm. Inc. v. Allergan, Inc.*, IPR2016-01127, Paper 28 at 3 (“[W]e agree with Petitioner that the underlying data is necessary to evaluate figures fully, will aid Petitioner's rebuttal to Patent Owner's arguments and evidence, and will afford Petitioner a fair cross-examination of Patent Owner's witnesses.”).

Regarding Requests 2 and 3, Petitioner argues that *Apple Inc. v. Singapore Asahi Chem. & Solder Indus.*, IPR2019-00377, Paper 22 at 3–4, 16 (PTAB Oct. 21, 2019) does not apply, because the requests in this case “dramatically exceed the discovery authorized” in *Apple*. Opp. 5. Although the facts of every case are different, and although the discovery authorized in *Apple* was different than the discovery requested here, we agree that *Apple* is helpful to delineate some boundaries of our rules as they apply to the discovery requested here.

Even if we were to assume FRCP 26(b)(4) applies to our proceedings (*cf. Adobe*, Paper 59 at 8 (“although the Federal Rules of Civil Procedure do not govern these proceedings, we note that FRCP Rule 26 is consistent with our determination”)), we are not persuaded that we would permit the discovery that Patent Owner seeks under Requests 2 and 3. As a threshold matter, even if Dr. Tremblay's receipt of an instruction from counsel to use a particular parameter in his reproductions were discoverable under

FRCP 26(b)(4)(C), as Patent Owner alleges, Patent Owner has provided no basis for its belief that such an instruction exists. Moreover, Patent Owner's requests appear to go beyond what would be permitted under FRCP 26(b)(4)(C), which "protects communications between a party's counsel and its expert unless those communications are necessary to identify facts, data, or assumptions 'that the party's attorney provided and that the expert considered' or 'relied on' in forming their opinions." Opp. 5. Requests 2 and 3 seek not only documents that "identify" the material discoverable under FRCP 26(b)(4)(C), but also documents that "includ[e]" or "refer[]" to that material, as well as documents that identify, include, or refer to other material, such as suggestions and advice to Dr. Tremblay. We find Requests 2 and 3 too broad to be justified either under our rules, which do not expressly provide for discovery into communications between an attorney and an expert, or under FRCP 26, which only permits very limited discovery into such communications.

We are persuaded by Patent Owner's assertions that Requests 1 and 4 will help Patent Owner evaluate Dr. Tremblay's reproductions, which are the basis for Petitioner's inherent anticipation arguments. For the reasons given above, we find that *Garmin* factor 1 weighs in favor of granting Patent Owner's Motion as to Requests 1 and 4. We are not persuaded, however, that Patent Owner has demonstrated that granting Requests 2 and 3 would be in the interest of justice.

2. *Garmin* Factor 2: *Litigation Positions*

Garmin factor 2 asks whether the requests seek the other party's litigation positions and the underlying basis for those positions. *Garmin*, Paper 26 at 6 ("Asking for the other party's litigation positions and the

underlying basis for those positions is not necessary in the interests of justice.”). Patent Owner argues that Requests 1 and 4 seek “seek only factual information related to electrolysis not litigation theories.” Mot. 5. Patent Owner argues that Requests 2 and 3 “only seek instructions and suggestions for creating reproductions that Dr. Tremblay considered and relied upon in this proceeding” and “seek information relating to the scientific process, not Petitioner’s litigation theories.” Mot. 7.

Regarding Requests 1 and 4, Petitioner responds that “Patent Owner’s attempt to obtain discovery regarding Dr. Tremblay’s evaluation of *other* prior art references in connection with the parties’ district court lawsuit” is improper. Opp. 1. 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 invokes Federal Rule of Civil Procedure 26(b)(4), and argues: “Attempts to invade work product are the epitome of violating Garmin Factor 2.” *Id.* at 7.

Patent Owner’s requests do not appear to be delving into Petitioner’s litigation position, notwithstanding Petitioner’s characterization of questions into prior art other than Wikey and Davies as “outside the scope of the instituted I.P.R.” Opp. 4. Requests 1 and 4, which ask for information (in addition to Wikey and Davies) that Dr. Tremblay considered in constructing and testing his reproductions for this *inter partes* review, appear to be fair. Petitioner submitted Dr. Tremblay’s reconstruction as part of its case-in-chief in this proceeding, and Patent Owner is not overreaching in its requests to obtain the documents supporting Dr. Tremblay’s reproduction in connection with this proceeding. As discussed above, however, Requests 2

and 3, which ask for information provided to Dr. Tremblay in connection with preparing the reproduction in this proceeding, appear to exceed the scope of our rules.

We find that *Garmin* factor 2 weighs in favor of granting Patent Owner's Motion as to Requests 1 and 4.

3. Garmin Factor 3: Ability to Generate Equivalent Information

"Information a party can reasonably figure out or assemble without a discovery request would not be in the interests of justice to have produced by the other party." *Garmin*, Paper 26 at 6. Patent Owner argues that, regarding Requests 1 and 4, it "cannot generate this information by other means" and it "does not know what additional experiments Dr. Tremblay considered that Petitioner appears to be withholding." Mot. 5. Patent Owner argues that, regarding Requests 2 and 3, it "cannot generate this nonpublic information by other means." *Id.* at 7.

Petitioner does not appear to specifically address *Garmin* factor 3. *See generally* Opp. We agree that Patent Owner would have a difficult time generating the information it seeks, or its equivalent, by other means. Accordingly, we find that *Garmin* factor 3 weighs in favor of granting Patent Owner's Motion.

4. Garmin Factor 4: Easily Understandable Instructions

Garmin factor 4 requires that the additional information sought "should be easily understandable." *Garmin*, Paper 26 at 6.

Patent Owner argues that Requests 1 and 4 "are easily understandable" because "they are limited to the protocols and data Dr. Tremblay considered." Mot. 5. Patent Owner argues that Requests 2 and 3 "are easily understandable" because "they are limited to the instructions and

suggestions Dr. Tremblay considered in designing his alleged ‘reproductions.’” *Id.* at 7.

Petitioner does not appear to specifically address *Garmin* factor 4. *See generally* Opp. On this record, the Patent Owner’s requests for additional information appear to be easily understandable. *See* Mot. 1. We find that *Garmin* factor 4 weighs in favor of granting Patent Owner’s Motion.

5. *Garmin* Factor 5: Whether the Requests are Overly Burdensome

Garmin factor 5 requires that “[t]he requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review[,] . . . includ[ing] financial burden, burden on human resources, and burden on meeting the time schedule.” *Garmin*, Paper 26 at 7.

Patent Owner argues that Requests 1 and 4 are “not burdensome” because “they are limited to the protocols and data Dr. Tremblay considered.” Mot. 5. Patent Owner argues that Requests 2 and 3 are “not burdensome” because “they are limited to the instructions and suggestions Dr. Tremblay considered in designing his alleged ‘reproductions.’” *Id.* at 7.

Petitioner does not appear to specifically address *Garmin* factor 5. *See generally* Opp. We have reviewed the requests, which appear to be limited in scope and do not appear to be overly burdensome for Petitioner to answer as to Requests 1 and 4. Regarding Requests 2 and 3, however, we believe that attempting to provide answers that would simultaneously comply with the requests and protect privileged information would be overly burdensome to Petitioner. We determine that *Garmin* Factor 5 weighs in favor of granting Patent Owner’s Motion with respect to Requests 1 and 4 only.

6. *Conclusion*

Having considered the *Garmin* factors with respect to the four requests presented by Patent Owner, we find that they support granting Patent Owner's Motion as to Requests 1 and 4, but that they do not support granting Patent Owner's Motion as to Requests 2 and 3.

Motion to Expunge

Petitioner's Motion to Expunge requests that the Board "expunge the originally-filed version of its Opposition to Patent Owner's Motion for Additional Discovery (Paper No. 23)" which "inadvertently exceeded the page limit set by the Board's September 23 Order." Paper 24, 1. Petitioner concurrently filed a corrected Opposition (Paper 25).

We may determine a proper course of conduct in a proceeding for any situation not specifically covered by our rules. 37 C.F.R. § 42.5(a). We may also waive or suspend requirements of certain parts of our rules. 37 C.F.R. § 42.5(b). Although typically, a "motion will not be entered without Board authorization" (37 C.F.R. § 42.20(b)), we invoke our ability to waive this requirement, and we grant Petitioner's Motion to Expunge in view of the readily identifiable error and readily identifiable solution.

Accordingly, it is

ORDERED that Patent Owner's Motion for Additional Discovery is *granted* as to Requests 1 and 4 and *denied* as to Requests 2 and 3; and

FURTHER ORDERED that Patent Owner's Motion to Expunge is *granted* and Paper 23 is *expunged*.

IPR2021-00625
Patent RE45,415 E

PETITIONER:

Robert Johnson
FREDRIKSON & BYRON, P.A.
rsjohnson@fredlaw.com

PATENT OWNER:

Derek Vandenburg
Aaron Pederson
Nathan Louwagie
CARLSON, CASPERS, VANDENBURGH, & LINDQUIST, P.A.
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com