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Paper No. 18
Entered: August 12, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCIENTIFIC DESIGN COMPANY, INC.,
Petitioner,

v.

SHELL OIL COMPANY,
Patent Owner.

IPR2021-01537 (Patent 8,084,390 B2)
IPR2022-00158 (Patent 8,357,813 B2)
IPR2022-00159 (Patent 8,357,825 B2)[1]

Before KRISTINA M. KALAN, JULIA HEANEY, and AVELYN M. ROSS, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

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[1] This Order addresses issues that are identical in the above-identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in any subsequent papers.

Pursuant to our authorization, Scientific Design Company, Inc. ("Petitioner") filed a Motion for Additional Discovery in the instant proceedings, and Shell Oil Company ("Patent Owner") filed an Opposition.[2] 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 13, 3 (citing *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential)).

Petitioner seeks additional discovery related to test data for Carrier C of the Lockemeyer reference, Exhibit 1003. Mot. 1. Specifically, Petitioner argues that Lockemeyer, which Petitioner relies upon in each captioned proceeding, provides some data on its three example Carriers A-C, "including the percentage of pores in the carrier having diameters of 0.2-10 μm, relative to total pore volume." *Id.* (citing Ex. 1003 ¶¶ 95–110, Table I). Petitioner argues that Patent Owner compares Lockemeyer's Carrier A to the claimed carrier to argue that there is "substantially improved catalyst performance," but equivalent data regarding Carrier C is not provided in Lockemeyer. *Id.* at 2. Thus, Petitioner seeks "equivalent data for Lockemeyer Carrier C." *Id.* at 3. In its Request for Production (Ex. 1023), Petitioner requests:

> All documents and data relating to Carrier C of Lockemeyer (Ex. 1003) and any analysis for and/or characterizations of such documents and data, particularly including documents and data

[2] *See* IPR2021-01537, Papers 13 (authorizing filing of the Motion), 14 ("Mot."), and 16 ("Opp."). We refer herein to the papers filed in IPR2021-01537; the papers filed in IPR2022-00158 and IPR2022-00159 were substantially similar.

> that set forth (or could be used to determine) information substantially equivalent to the information identified for Lockemeyer's Carrier A (designated as Carrier D in U.S. Patent No. 8,084,390) in Ex. 1001, Tables I-III and Ex. 2018, ¶ 23.

Id.

Patent Owner argues that Petitioner "mischaracterizes the POR to speculate that requested information ***might*** exist that ***might*** be useful to refute ***phantom*** arguments" that Patent Owner never made. Opp. 1.

After considering the arguments, evidence, and facts before us, we determine that it is not in the interest of justice to grant Petitioner's Motion, for the reasons that follow.

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). Petitioner, 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 the "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.

Petitioner asserts that "how structurally similar Carrier C is to the claimed carrier (along with performance data) goes to, at least, whether the claimed subject matter provided any improvements and whether any alleged improvements can be tied to the claimed [pore size distribution]." Mot. 3. Petitioner also argues that the "assertion of unexpected results would make Lockemeyer Carrier C highly relevant." *Id*. at 4 ("Petitioner established the usefulness of test data for Lockemeyer Carrier C in the Facts section, above. *See also* Pet., 43-45, 39."). Petitioner further argues that it is "indisputable" that Patent Owner "tested one or more of Lockemeyer's carriers and possesses corresponding test data." *Id*. Thus, Petitioner alleges that Patent Owner's "possession of test data for Lockemeyer Carrier C is beyond speculation and entirely likely." *Id*. at 5.

Patent Owner argues that Petitioner "has no idea whether Carrier C falls inside or outside any challenged claims or how it performs," characterizing the request as a "fishing expedition." Opp. 1–2. Patent Owner argues that Petitioner's request for "performance data" of Carrier C

"is not in the scope of the prior art and irrelevant in this IPR" because the Response "made no secondary consideration showing." *Id.* at 2–3. Because "there is no dispute in this IPR about secondary considerations based on unexpected results," there is "no legitimate reason for [Petitioner] to seek discovery on Carrier C's performance when it is not at issue in this IPR." *Id.* at 2. Patent Owner also argues that Petitioner's request for "structural data" (e.g. detailed pore size distribution) which Petitioner alleges would be relevant to "arguments concerning, e.g., the ability to achieve what was claimed and 'discovery timing.' POR, 34, 14, 58" fails for three reasons: (1) Carrier C does not necessarily fall within the claims; (2) Patent Owner never argued a claimed carrier could not be achieved; and (3) Carrier C structural data that cannot be gleaned from Lockemeyer is "not in the prior art and is irrelevant to ***when*** the inventors made their inventive discovery." *Id.* at 5–6

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.

We are not persuaded by Petitioner's assertion that the requested information is "favorable in substantive value to a contention of the party moving for discovery." Patent Owner notes that "the Petition alleged that because the '390 Patent did not test Lockemeyer's Carrier C, Shell could not establish 'secondary considerations' based on 'unexpected results'" and Patent Owner confirms that it "did not challenge that assertion." Opp. 2. Patent Owner further confirms that Patent Owner "made no secondary consideration showing" and that there is "no dispute in this IPR about secondary considerations based on unexpected results and no dispute about

Carrier C's performance." *Id.* Given Patent Owner's representation that it has made no secondary consideration showing in this proceeding, essentially waiving any secondary considerations argument Patent Owner might have been able to make, we are unable to discern a reason for Petitioner to obtain the requested discovery regarding Lockemeyer's Carrier C. We also find unclear Petitioner's asserted basis for requesting structural data, i.e., pore size distribution, for the reasons given by Patent Owner, and because Petitioner fails to demonstrate persuasively how the requested data would aid Petitioner's arguments.

For the reasons given above, we find that *Garmin* factor 1 weighs strongly against granting Petitioner's Motion.

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 interest of justice.").

Petitioner represents that there is no parallel litigation involving the challenged patent, which weighs in favor of granting additional discovery. Mot. 5. Patent Owner does not address Factor 2. *See generally* Opp. Thus, *Garmin* factor 2 is neutral.

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 interest of justice to have produced by the other party." *Garmin*, Paper 26 at 6.

Petitioner argues that it "cannot reasonably assemble equivalent information without the discovery request," because even if time permitted Petitioner to conduct testing before the Reply due date, "there would be no guarantee that the testing would be precisely 'equivalent' to the testing conducted by" Patent Owner. Mot. 5–6.

Patent Owner responds that the specific details of its testing, such as preparation techniques, moisture content, and geometry of the samples, "are in Lockemeyer and the '390 Patent." Opp. 6.

Disclosure of certain reaction conditions in Lockemeyer and the '390 patent notwithstanding, we agree that Petitioner 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 Petitioner'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.

Petitioner argues that its request for production is only two pages long and only contains a single targeted request focusing on test data for Lockemeyer Carrier C (Ex. 1023). Mot. 6. Patent Owner does not appear to specifically address *Garmin* factor 4. *See generally* Opp. On this record, Petitioner's request for additional information appears to be easily understandable. *See* Ex. 1023. We find that *Garmin* factor 4 weighs in favor of granting Petitioner's Motion.

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

Garmin factor 5 requires that the "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.

Petitioner argues that Patent Owner "already retrieved similar data to prepare the specification of the '390 patent and the POR" for Carrier A, and "only *de minimis* expenditure of additional resources would be necessary to identify and produce remaining test data on related Lockemeyer Carrier C." Mot. 7.

Patent Owner argues that it would be "highly burdensome" to "comb through ***19+ years*** of records to find '***all*** documents and data ***relating*** to' Carrier C and **'*any analysis for and/or characterizations*'** thereof." Opp. 7. According to Patent Owner, it "would take significant time and expense to search hundreds of thousands of pages of engineering documents and emails to comply with the Request and its 'Instructions' requiring a 'privilege log' and identifying materials 'no longer' in Shell's possession." *Id.*

We have reviewed Petitioner's request (Ex. 1023), which on its face is brief but which could be burdensome given the time period between the testing and the present day, and the open-ended nature of the requests for documents and data relating to Lockemeyer's Carrier C. We determine that *Garmin* Factor 5 weighs against granting Petitioner's Motion.

6. Conclusion

Having considered the *Garmin* factors with respect to the request presented by Petitioner, we find that they do not support granting Petitioner's Motion.

Accordingly, it is

ORDERED that Petitioner's Motion for Additional Discovery is *denied*.

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