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Paper 23
Date: December 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUASAR SCIENCE LLC,
Petitioner,

v.

COLT INTERNATIONAL CLOTHING, INC. d/b/a COLT LED,
Patent Owner.

IPR2023-00611 (Patent 10,197,224 B1)
IPR2023-00613 (Patent 10,411,582 B1)
IPR2023-00614 (Patent 10,566,895 B1)[1]

Before GEORGIANNA W. BRADEN and ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Granting In Part Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

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[1] This Order pertains to all of these cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

Colt International Clothing, Inc. d/b/a Colt LED ("Patent Owner"). filed a motion for additional discovery on November 17, 2023. Paper 16 ("Motion" or "Mot.").[2] Quasar Science LLC ("Petitioner") filed an opposition to the Motion on December 1, 2023. Paper 21 ("Opposition" or "Opp."). For the following reasons, the Motion is *granted in part*.

II. ANALYSIS

Patent Owner requests additional discovery regarding an objective indicia of nonobviousness, namely, commercial success. Mot. 1. We may order additional discovery if the moving party shows "that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). We consider several factors ("the *Garmin* factors") in determining whether additional discovery is in the interests of justice. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential). Those factors include: 1) whether the requesting party possesses evidence tending to show beyond speculation that something useful will be found; 2) whether the requesting party seeks the other party's litigation positions and the underlying basis for those positions; 3) the requesting party's ability to generate the requested information without discovery; 4) whether the instructions are easily understandable; and 5) whether the requested discovery is overly burdensome. *Id*

Here, Patent Owner seeks to serve the following interrogatories:

1) For each of the years 2021, 2022 and 2023 (year to date) please state, on a product-by-product basis Petitioner

[2] We cite to the record of IPR2023-00613, unless otherwise noted.

Quasar's annual revenues from sales of Petitioner Quasar's S-Switch Lights;

2) For each of the years 2021, 2022 and 2023 (year to date) please state, on a product-by-product basis Petitioner Quasar's annual revenues from rentals of Petitioner Quasar's S-Switch Lights;

3) Please state any overall share or percentage of the market for Competitive White LED Tube Lights (based on revenue) of Petitioner Quasar's S-Switch Lights as estimated or determined by Petitioner Quasar for each of the years 2021, 2022 and 2023;

4) For each of the years 2017 to 2021, please state, on a product-by-product basis Old Quasar's annual revenues from sales of Old Quasar's S-Switch Lights;

5) For each of the years 2017 to 2021 please state, on a product-by-product basis Old Quasar's annual revenues of rentals of Old Quasar's S-Switch Lights; and

6) Please state any overall share or percentage of the market for Competitive White LED Tube Lights (based on revenue) of Old Quasar's S-Switch Lights, which overall share or percentage of the market is as estimated or determined by Petitioner Quasar and/or Old Quasar for each of the years 2017 to 2021.

Ex. 2022, 5–6 (emphases omitted). Petitioner already agreed to provide answers to Interrogatory Nos. 1–3, and Patent Owner agreed to withdraw Interrogatory No. 6. Opp. 2. Thus, we only discuss Interrogatory Nos. 4 and 5 below.

Interrogatory Nos. 4 and 5 seek revenue information relating to "Old Quasar's S-Switch Lights." Ex. 2022, 5–6. In April 2021, the Vitec Group plc "acquired the trade and net assets of Quasar Science LLC." Ex. 2037, 34. We understand Patent Owner's use of the term "Old Quasar" and Petitioner's use of the term "Q-California" to refer to the same entity from

which the Vitec Group plc acquired assets in April 2021. Mot. 2 ("Petitioner QUASAR (and/or its predecessor Quasar Science LLC (a California LLC, 'Old Quasar')"); Opp. 1 ("Quasar Science LLC (a still existing California LLC) (hereinafter, 'Q-California')—from whom Petitioner purchased limited assets in 2021"). The parties' use of different terms appears to reflect different views on the scope of the acquisition. Mot. 10 ("acquiring Old Quasar"); Opp. 1 ("purchased limited assets"). We use the term Old Quasar in this Order simply to maintain consistency with Patent Owner's proposed discovery requests. We do not make any determination about the scope of the aforementioned acquisition.

A. Garmin Factor 1 – More than a possibility and mere allegation

Patent Owner argues that there is more than a mere possibility that something useful will be found regarding the objective indicia of commercial success. Mot. 3–8. Specifically, Patent Owner points to claim charts showing that certain of Old Quasar's products "practice claims" of the challenged patents. *Id.* at 3–4 (citing Ex. 2028, 4–27). Patent Owner also identifies portions of Old Quasar's marketing materials that promote features of the challenged claims. *Id.* at 5 (citing Ex. 2029, 2–3, 8).

Petitioner responds that Patent Owner "fails to establish the necessary nexus." Opp. 3. Specifically, Petitioner argues that Patent Owner "fails to address and does not account for the presence of other potentially desirable features implemented on the same units." *Id.* at 4. According to Petitioner, "even a cursory review" of Old Quasar's marketing materials shows that its products "embody features *not* recited in Patent Owner's claims which may be significant and desirable." *Id.* at 4–5 (citing Ex. 2029, 11–12, 17–18).

Petitioner also responds that Patent Owner "offers no evidence or sufficient reasoning tending to show beyond speculation that Petitioner has the requested information" relating to Old Quasar's revenues. *Id.* at 7. According to Petitioner, Patent Owner "asserts without any support, that the information sought by the proposed additional discovery as related to [Old Quasar] is 'within the control of Petitioner and readily accessible by Petitioner.'" *Id.* Petitioner asserts that "[w]hile limited information related to [Old Quasar] may have been represented to Petitioner at the time of the asset purchase in 2021, Petitioner does not have information in its possession, custody, or control necessary to answer the requests of ROGs 4 and 5 with any level of reliability or certifiable accuracy." *Id.* at 7–8.

We determine that Patent Owner possesses evidence tending to show beyond speculation that something useful will be found regarding the objective indicia of commercial success. Patent Owner's evidence indicates beyond a mere possibility that Old Quasar sold products embodying the challenged claims and also promoted features recited in the challenged claims. Ex. 2028, 4–27; Ex. 2029, 2–3, 8. Petitioner's opposition focuses on whether Patent Owner ultimately will prevail in showing commercial success. Opp. 3–5. But Patent Owner need not demonstrate that it will succeed on the merits in order to obtain additional discovery.

We also determine that Patent Owner possesses evidence tending to show beyond speculation that Petitioner has the requested information. Specifically, Patent Owner's evidence indicates beyond a mere possibility that Petitioner received information regarding Old Quasar's revenues. Ex. 2019, 2; Ex. 2037, 35. Nonetheless, to the extent Petitioner does not

have some (or any) of the information requested in Interrogatory Nos. 4 and 5, Petitioner may indicate that in its responses. Similarly, to the extent Petitioner has the requested information but cannot certify its reliability or accuracy, Petitioner may provide the requested information and indicate Petitioner's inability to certify its reliability or accuracy.

B. Garmin Factor 2 – Litigation positions and underlying basis

Patent Owner argues that the "discovery requested does not seek a litigation basis for any position taken by Petitioner." Mot. 8. Petitioner responds that "ROGs 4 and 5 extend far beyond the limited discovery normally permitted in [an] IPR[]." Opp. 8. We determine that Interrogatory Nos. 4 and 5 only seek revenue information, not Petitioner's litigation positions or the underlying basis for those positions.

C. Garmin Factor 3 – Ability to generate equivalent information by other means

Patent Owner argues that "[t]here is no publicly available data with a breakdown by type of product to show sales of S-Switch models." Mot. 8. Petitioner responds that Patent Owner "could present evidence of the commercial success of its own products (if such success exists) or request the information directly from [Old Quasar]." Opp. 8. We determine that Patent Owner cannot generate equivalent information without discovery. Even if Patent Owner has revenue information for its own products, we are not persuaded that Patent Owner can generate the requested revenue information for Old Quasar's products without discovery.

D. Garmin Factor 4 – Easily understandable instructions

Patent Owner argues that "the ROGs are short, simple and clear." Mot. 8. Petitioner responds that "ROGs 4 and 5 are unintelligible where

Patent Owner defines 'S-Switch Lights' as including **both** '[Petitioner's] and [Old Quasar's] product line'" because Petitioner "has never manufactured or sold any S-Switch lights." Opp. 9. We determine that Petitioner's concern about the definition of "S-Switch Lights" does not warrant denying Patent Owner's proposed discovery. The parties can meet and confer to resolve any ambiguity in the identified definition.

E. Garmin Factor 5 – Requests not overly burdensome to answer

Patent Owner argues that "[t]he ROGS are short and focus[] upon information that should be easily locatable by Petitioner." Mot. 9. Petitioner responds that "Patent Owner's requests are overly burdensome, because the only way Petitioner can answer the requests of ROGs 4 and 5 with any level of reliability or certifiable accuracy is to seek to obtain information from non-party [Old Quasar]." Opp. 10. We determine that Interrogatory Nos. 4 and 5 are not overly burdensome. We are not persuaded that Interrogatory Nos. 4 and 5 require Petitioner to seek information outside its possession. As discussed above, to the extent Petitioner does not have some (or any) of the information requested in Interrogatory Nos. 4 and 5, Petitioner may indicate that in its responses. Similarly, to the extent Petitioner has the requested information but cannot certify its reliability or accuracy, Petitioner may provide the requested information and indicate Petitioner's inability to certify its reliability or accuracy.

F. Conclusion

After considering the *Garmin* factors, we determine that Patent Owner shows sufficiently that it is entitled to serve Interrogatory Nos. 4 and 5.

And, as discussed above, Petitioner already agreed to answer Interrogatory Nos. 1–3. Thus, we authorize Patent Owner to serve Interrogatory Nos. 1–5 within three (3) days of this Order.[3] Petitioner must respond within thirty (30) days of service of the discovery requests. To accommodate this additional discovery, we extend the deadline for Patent Owner's response to February 1, 2024, the deadline for Petitioner's reply to April 23, 2024; and the deadline for Patent Owner's sur-reply to June 4, 2024.

III. ORDER

It is hereby

ORDERED that Patent Owner's Motion is *granted in part*;

FURTHER ORDERED that Patent Owner's request to serve Interrogatory Nos. 1–5 is granted;

FURTHER ORDERED that Patent Owner's request to serve Interrogatory No. 6 is denied as moot;

FURTHER ORDERED that Patent Owner must serve the authorized discovery requests within three (3) days of this Order, and Petitioner must respond within thirty (30) days of service of the discovery requests;

FURTHER ORDERED that the deadline for Patent Owner's response is extended to February 1, 2024;

FURTHER ORDERED that the deadline for Petitioner's reply is extended to April 23, 2024; and

FURTHER ORDERED that the deadline for Patent Owner's sur-reply is extended to June 4, 2024.

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[3] If Patent Owner did not already serve Interrogatory Nos. 1–3 pursuant to the parties' agreement, Patent Owner may do so now.

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