

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING CO., INC.,
Petitioner,

v.

MHL CUSTOM, INC.,
Patent Owner.

IPR2024-00085 (Patent 9,586,659 B2)
IPR2024-00086 (Patent 9,359,044 B2)

Before BART A. GERSTENBLITH, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Unopposed Motion for Additional Discovery
37 C.F.R. § 42.51

I. INTRODUCTION AND BACKGROUND

With our authorization, MHL Custom, Inc. (“Patent Owner”) filed an “Unopposed Motion for Additional Discovery Regarding Deposition of Dr. Kутtenkeuler.” Paper 15 (“Motion” or “Mot.”).¹ Patent Owner seeks five hours of cross-examination via deposition from declarant Dr. Jakob Kутtenkeuler. *Id.* at 1. Foil Boarding Company, Inc. (“Petitioner”) does not oppose Patent Owner’s request. *Id.*

Petitioner submitted the Declaration of Jakob Kутtenkeuler (Ex. 1018) as evidence in these proceedings. *See* Pet. 87 (Table of Exhibits). Dr. Kутtenkeuler is a professor in the Department of Technical Mechanics at the Kungliga Tekniska högskolan (KTH) in Stockholm, Sweden. Ex. 1018 ¶ 1. Petitioner relies on Dr. Kутtenkeuler’s declaration to support its contentions that the two primary references—the “Evolvo Report” (Ex. 1003) and “Evolvo Videos” (Exs. 1006–1010)—were publicly accessible before the priority date of the challenged claims. *See* Pet. 13–20. As Patent Owner explains, Dr. Kутtenkeuler’s declaration (Ex. 1018) was prepared for a prior litigation, not the current proceeding.² Mot. 1. Thus, under our rules, Dr. Kутtenkeuler is not subject to cross-examination as part of “routine discovery,” but, as Patent Owner notes, cross-examination may be obtained under “additional discovery” upon a showing that such discovery would be in the interests of justice. *Id.* (citing *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00126, Paper 77 at 4 (PTAB Dec. 8, 2020) (“For

¹ Patent Owner filed substantially identical papers and exhibits in IPR2024-00086. For simplicity, we cite to the papers filed in IPR2024-00085.

² *MHL Custom, Inc. v. Waydoo USA, Inc.*, No. 1:21-cv-00091 (D. Del.).

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testimony not prepared for the proceeding, ‘additional discovery’ is available if the party seeking additional discovery can show ‘that such additional discovery is in the interests of justice.’ 37 C.F.R. § 42.51(b)(2)(i).”). For the reasons that follow, we determine that such testimony is in the interests of justice, and therefore, *grant* Patent Owner’s motion.

II. ANALYSIS

Discovery in an *inter partes* review proceeding is more limited than in district court patent litigation, as Congress intended our proceedings to provide a more efficient and cost-effective alternative to such litigation. H. Rep. No. 112-98 at 45–48 (2011). Thus, we take a conservative approach to granting additional discovery. 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). Accordingly, a party seeking discovery beyond what is expressly permitted by our rules must establish that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2) (“The moving party must show that such additional discovery is in the interests of justice.”).

The Board has identified five factors (the “*Garmin* Factors”) to be considered in determining whether additional discovery is in the interest of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (“*Garmin*”). In assessing Patent Owner’s motion, we address those factors below.

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Factor 1 – There must be more than a possibility and mere allegation that something useful will be discovered.

Pursuant to factor 1, we consider whether Patent Owner is already in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered via the requested discovery. *Garmin*, at 7. “Useful” in this context does not mean merely “relevant” and/or “admissible.” *Id.* Rather, it means favorable in substantive value to a contention of the party moving for discovery. *Id.*

Patent Owner submits that “[a] key issue in the proceeding is whether the Evolo Report and/or Evolo Videos qualify as prior art. Petitioner relies on Dr. Kутtenkeuler’s Declaration—specifically, paragraphs 18, 24, 27, and 29-31—in an attempt to establish the public accessibility of the Evolo Report and/or Evolo Videos prior to the critical date (October 10, 2013).” Mot. 3. Patent Owner argues that “[c]ross-examination of Dr. Kутtenkeuler’s statements regarding how, when, and where these documents/videos were allegedly uploaded to the internet, their accessibility, and the Båtnytt Article [(Ex. 1019)] is relevant and highly likely to yield information useful to the proceedings.” *Id.* at 3–4. Patent Owner contends that Dr. Kутtenkeuler, as the person having allegedly uploaded the Evolo Report and at least one of the Evolo Videos, is highly likely to have additional information specific to these events.” *Id.* at 4.

We agree with Patent Owner that Dr. Kутtenkeuler is highly likely to have relevant information. As evidenced by his declaration, he possesses important first-hand knowledge about the events surrounding the alleged public dissemination of the Evolo Report and the Evolo Videos.

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Accordingly, we find that *Garmin* Factor 1 weighs in favor of granting Patent Owner's request.

Factor 2 – A party may not seek another's litigation positions or the underlying basis for those positions.

Patent Owner asserts that it does not seek litigation positions or the underlying basis for those positions. Mot. 4. We see no reason to disagree with that contention. As such, *Garmin* Factor 2 weighs in favor of granting Patent Owner's request.

Factor 3 – A party should not seek information that reasonably can be generated without a discovery request.

Patent Owner notes that “Dr. Kутtenkeuler was a faculty advisor to the students involved in the Evolo Project and has testified in his declaration regarding the Evolo Report and Evolo Videos being allegedly uploaded to the internet.” Mot. 4–5. And Patent Owner contends that it cannot otherwise obtain this information because “it is exclusively available through Dr. Kутtenkeuler, the person who allegedly uploaded the Evolo Report and at least one of the Evolo Videos.” *Id.* at 5. We agree with Patent Owner that Dr. Kутtenkeuler is uniquely situated and able to provide the information Patent Owner seeks. Accordingly, we find that *Garmin* Factor 3 weighs in favor of granting Patent Owner's request.

Factor 4 – Instructions and questions should be easily understandable.

Patent Owner contends that “[t]he requested discovery is easily understandable, as the requested discovery is limited to the cross-examination of the portions of Dr. Kутtenkeuler's declaration relied on by Petitioner, the specific issues of which are provided herein.” Mot. 5. We agree with Patent Owner that its request is easily understandable.

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Accordingly, we agree that *Garmin* Factor 4 weighs in favor of granting Patent Owner's request.

Factor 5 – The discovery requests must not be overly burdensome to answer.

Patent Owner argues that the requested discovery is narrow and limited to the cross examination of the portions of Dr. Kutteneuler's declaration relied on by Petitioner. Mot. 5. Patent Owner notes that "since Dr. Kutteneuler is located abroad, [Patent Owner] is willing to take the deposition via video-conference; so, Petitioner's compliance with the requested discovery will not require significant expenditure of resources." *Id.* at 5–6. We agree with Patent Owner that the request is "sensible and responsibly tailored according to a genuine need" and does not appear overly burdensome. *See Garmin*, at 14–16. Accordingly, we find that *Garmin* Factor 5 weighs in favor of granting Patent Owner's request.

III. CONCLUSION

Upon review of Patent Owner's arguments and supporting evidence in view of the *Garmin* factors, we conclude that it is in the interests of justice to grant Patent Owner's unopposed motion for additional discovery.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Unopposed Motion for Additional Discovery is *granted*.

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