

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD.,
Petitioner,

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

IPR2024-00101
Patent 10,299,336 B2

Before CHRISTOPHER M. KAISER, KEVIN C. TROCK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. §§ 42.5(a), 42.51(b)(2)

I. INTRODUCTION

After receiving Board authorization, Signify Holdings B.V. (“Patent Owner”) moved for Board approval to seek additional discovery from Luminex International Co., Ltd. (“Petitioner”). Paper 18 (“Mot.”); *see* Ex. 3005. Petitioner opposes Patent Owner’s motion. Paper 23 (“Opp.”).

As additional discovery, Patent Owner proposes eight production requests seeking documents, including “correspondence, written agreements, memoranda, summaries, notes, written communications and electronically stored information,” from Petitioner, including “its predecessors and successors, parents, subsidiaries, divisions, and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.” *See* Paper 19. According to Patent Owner, the documents at issue relate to whether a nonparty is a real party in interest for purposes of applying a statutory bar to institution. *See* Mot. 1–3.

For the reasons explained below, we deny Patent Owner’s motion for additional discovery.

II. BACKGROUND

A. Statutory Bar to Institution Under § 315(b)

The Leahy-Smith America Invents Act (“AIA”) precludes institution of an *inter partes* review under certain circumstances. 35 U.S.C. § 315(a)–(b) (2018); *see* 37 C.F.R. § 42.101(a)–(b) (2024). For instance, § 315(b), titled “Patent Owner’s Action,” bars institution of an *inter partes* review “if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the

petitioner is served with a complaint alleging infringement of the patent.”
35 U.S.C. § 315(b); *see* 37 C.F.R. § 42.101(b).

B. Real Party in Interest

“Congress intended that the term ‘real party in interest’ have its expansive common-law meaning.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1350–51 (Fed. Cir. 2018) (“*AIT*”); *see RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 2, 7 (PTAB Oct. 2, 2020) (precedential). “Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *AIT*, 897 F.3d at 1351; *see Ventex Co. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 at 6 (PTAB Jan. 24, 2019) (precedential); *RPX*, IPR2015-01750, Paper 128 at 6.

The real-party-in-interest analysis should consider the following:

- (1) whether a nonparty “desires review of the patent”;
- (2) “whether a petition has been filed at a nonparty’s ‘behest’”;
- (3) “who, from a ‘practical and equitable’ standpoint, will benefit from the redress that the chosen tribunal might provide”;
- (4) “the extent to which [the nonparty] has an interest in and will benefit from [the petitioner’s] actions”; and
- (5) whether the petitioner “can be said to be representing that interest after examining its relationship with” the nonparty.

AIT, 897 F.3d at 1349, 1351, 1353; *see RPX*, IPR2015-01750, Paper 128 at 5, 7–8, 15, 20. According to the Federal Circuit, “the heart of the inquiry” concerning a real party in interest should focus on “whether a petition has been filed at a [nonparty’s] ‘behest.’” *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027–28 (Fed. Cir. 2021) (quoting *AIT*, 897 F.3d at 1351).

A “common consideration” is whether a nonparty “exercised or could have exercised control over a party’s participation in a proceeding.” PTAB Consolidated Trial Practice Guide¹ at 16 (citing *Taylor v. Sturgell*, 553 U.S. 880, 895 (2008)). For example, a nonparty that “funds and directs and controls” an *inter partes* review constitutes a real party in interest even if that nonparty is not a privy of the petitioner. *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018); *see Uniloc 2017*, 989 F.3d at 1028.

C. Procedural Background

On October 25, 2023, Petitioner filed a Petition requesting an *inter partes* review of claims 1–20 in U.S. Patent No. 10,299,336 B2 (Exhibit 1001, “the ’336 patent”) under 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”).

Petitioner asserts the following challenges to patentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 6–9, 11–13, 15, 17–19	102 or 103	Chaimberg ²

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

² U.S. Patent No. 10,234,091 B1, titled “Ceiling Mountable LED Light Fixture with Accessible CCT Selectable Switch,” filed on April 27, 2018, and issued on March 19, 2019, to Chaimberget al. (“Chaimberg”) (Ex. 1003).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
2, 4, 5, 10, 14, 16, 20	103	Chaimberg, Roberge ³
1–5, 7, 9–13, 15, 16, 19, 20	102 or 103	Halliwel ⁴
13, 15	102 or 103	Reiff ⁵

Pet. 15–89.

To support its challenges, Petitioner relies on the declaration of J. Gary Eden, Ph.D. (Exhibit 1004).

On February 22, 2024, Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). In the Preliminary Response, Patent Owner contended that § 315(b) bars institution because:

- (1) Petitioner filed the Petition on October 25, 2023, more than one year after Patent Owner served Menard, Inc. (“Menard”) with a complaint for patent infringement in *Signify North America Corp. et al. v. Menard, Inc.*, No. 3:22-cv-00706 (W.D. Wis. filed Aug. 12, 2022) (the “Wisconsin case”); and
- (2) Menard is “at least one of” a real party in interest and a privy of Petitioner.

Prelim. Resp. 21; *see id.* at 3–4, 26; 35 U.S.C. § 315(b).

³ U.S. Patent No. 7,178,941 B2, titled “Lighting Methods and Systems,” filed on May 5, 2004, and issued on February 20, 2007, to Roberge et al. (“Roberge”) (Ex. 1011).

⁴ U.S. Patent No. 9,801,250 B1, titled “Light Emitting Diode (LED) Lighting Device or Lamp with Configurable Light Qualities,” filed on September 23, 2016, and issued on October 24, 2017, to Halliwel (“Halliwel”) (Ex. 1012).

⁵ U.S. Patent No. 7,192,160 B2, titled “Light Fixture,” filed on July 12, 2004, and issued on March 20, 2007, to Reiff, Jr. et al. (“Reiff”) (Ex. 1013).

On May 9, 2024, the panel issued a decision denying institution based on § 315(b) because the panel determined that (1) Menard is a real party in interest in this proceeding and (2) Petitioner filed the Petition more than one year after the date on which Menard was served with a complaint alleging infringement of the '336 patent. *See* Paper 10, 35–42.

On June 6, 2024, Petitioner requested Director review of the panel's decision denying institution. *See* Paper 11. Among other things, Petitioner asserted that the panel erred in determining that Menard is a real party in interest in this proceeding. *See id.* at 4–15.

On August 20, 2024, the Director granted Petitioner's request and vacated the panel's decision denying institution. Paper 12, 6. Among other things, the Director determined that Menard is not a real party in interest in this proceeding. *Id.* at 5. Further, the Director remanded the case to the panel and instructed the panel "to determine whether the Petition presents a reasonable likelihood of prevailing with respect to at least one of the challenged claims under 35 U.S.C. § 314(a), and to determine whether to institute *inter partes* review accordingly." *Id.* at 5–6.

On September 9, 2024, the panel instituted an *inter partes* review of claims 1–20 in the '336 patent on all challenges included in the Petition because the panel determined that the Petition presents a reasonable likelihood of prevailing with respect to at least one of the challenged claims. *See* Paper 14 ("Inst. Dec.").

On September 23, 2024, Menard filed a petition substantively identical to the Petition in this proceeding and a motion for joinder seeking joinder as a party in this proceeding. *Menard, Inc. v. Signify Holdings B.V.*, IPR2024-01469, Papers 1–2 (PTAB Sept. 23, 2024). To support its

challenges, Menard submitted an identical copy of Dr. Eden’s declaration from this proceeding. *Compare* Ex. 1004, *with* IPR2024-01469, Ex. 1004.

On November 21, 2024, the Director issued a supplemental opinion setting forth the analysis and reasons for granting Director review. *See* Paper 20 (“Suppl. Op.”). Among other things, the Director determined that:

- (A) “there is no evidence on this record of control, funding, or substantial coordination between Petitioner and Menard to file the Petition”;
- (B) “the fact that Menard desires to be free from infringement liability does not establish that the Petition was filed at Menard’s behest”;
- (C) “Petitioner’s filing of the Petition after Menard’s requests for indemnification likewise does not establish that the Petition was filed at Menard’s behest”;
- (D) “Petitioner and Menard understood the Agreement to, at most, create obligations to indemnify and defend in the district court litigation (without mention of any proceedings before the Office)”;
- (E) “the overlap of asserted challenges in the IPR and the joint invalidity contentions in district court do not show that Menard desires review of the ’336 patent.”

Suppl. Op. 15–16.

The Director also determined that “there is no evidence that Petitioner filed the IPR *because of* or *in response to* any request by Menard to do so.” Suppl. Op. 16 (emphases in original). The Director explained that “the evidence at most shows that Menard requested indemnification in district court.” *Id.*

D. The Wisconsin Case

On August 12, 2022, Patent Owner filed a complaint alleging that Menard infringed the ’336 patent and five other patents by importing,

offering to sell, and selling numerous products. *See* Ex. 2003 ¶¶ 1, 4, 21–54, 85–166.

On October 14, 2022, Menard filed an answer to Patent Owner’s complaint. *See* Ex. 3002. In the answer, Menard denied Patent Owner’s infringement allegations and asserted affirmative defenses. *See id.* at 8–14 (¶¶ 85–166), 15–16 (¶¶ 1–17). In an affirmative defense, Menard asserted that “Menard’s suppliers will indemnify and defend Menard in this action.” *Id.* at 15 (¶ 11). Menard did not assert invalidity as an affirmative defense for any patent in suit. *Id.* at 15–16 (¶¶ 1–17).

On October 27, 2022, Menard filed a third-party complaint identifying Petitioner and twelve other entities as third-party defendants. *See* Ex. 2001 ¶¶ 1–22. Among other things, Menard asserted that “if held liable, Menard is entitled to indemnification” from the third-party defendants. *Id.* ¶ 3. Regarding Petitioner, Menard alleged that a “Menards Customer Returns, Defective Goods Policy and Conditions of Order Agreement” requires Petitioner “to defend, indemnify and hold Menard harmless from and against all claims of any actual or alleged violation or infringement of any intellectual property right, including patent infringement arising from Menard’s use, sale or offering for sale of any goods provided by” Petitioner. *Id.* ¶¶ 24–26.

On February 27, 2023, Petitioner answered Menard’s third-party complaint and, among other things, acknowledged that it and Menard are “parties to a Menards Customer Returns, Defective Goods Policy and Conditions of Order Agreement” and that Petitioner supplies accused products to Menard under that agreement. *See* Ex. 2002, 5, 8–9 (¶¶ 21, 24–25, 32–33, 35). Further, Petitioner asserted (1) affirmative defenses to

Patent Owner’s complaint against Menard, e.g., that each patent in suit is invalid, and (2) crossclaims “directly against” Patent Owner, i.e., seeking declaratory judgments of noninfringement and invalidity for each patent in suit. *Id.* at 94–102 (¶¶ 1–49); Ex. 2007, 7–8.⁶

On August 31, 2023, the district court decided various motions, including Patent Owner’s motion to sever Menard’s claims against the third-party defendants. *See* Ex. 2008. In denying Patent Owner’s motion to sever, the district court noted that “the court expects Menard and the third-party defendants to coordinate a litigation strategy, acting as a united front whenever possible.” *Id.* at 5.

On September 26, 2023, the parties filed an Updated Joint Preliminary Pretrial Conference Report and Discovery Plan. *See* Ex. 1020. In that joint report, Menard and the third-party defendants stated that they “fully intend to, and have taken various steps to, comply with the Court’s request that Menard and the third-party defendants act as a united front when possible.” *Id.* at 3, 20. Among other things, Menard and the third-party defendants proposed to “collectively serve a single consolidated set of invalidity and unenforceability contentions.” *Id.* at 16.

On October 19, 2023, Menard filed an amended answer to Patent Owner’s complaint. *See* Ex. 2027. In the amended answer, Menard denied Patent Owner’s infringement allegations and asserted affirmative defenses. *See id.* at 8–15 (¶¶ 85–166), 16–17 (¶¶ 1–10). In an affirmative defense,

⁶ For Exhibit 2007 (Third-Party Defendant Luminex International Company, Ltd.’s Opposition to Signify’s Motion to Dismiss Luminex’s Amended Crossclaims and Amended Affirmative Defenses Against Signify), we cite to the page numbers of the brief rather than the page numbers in the header.

Menard asserted that each patent in suit is “invalid for failure to meet the ‘Conditions for patentability’ of 35 U.S.C. §§ 102 and 103.” *Id.* at 16 (¶ 1).

On October 19, 2023, Menard also filed an amended third-party complaint. *See* Ex. 3003. The amended third-party complaint included essentially the same allegations against Petitioner as the initial third-party complaint. *Compare id.* ¶¶ 21, 23–35, *with* Ex. 2001 ¶¶ 21, 23–35.

On November 16, 2023, Petitioner answered Menard’s amended third-party complaint in essentially the same way Petitioner answered Menard’s initial third-party complaint. *Compare* Ex. 2013, 1–9, *with* Ex. 2002, 1–9.

On November 22, 2023, Menard and the third-party defendants served joint invalidity contentions on Patent Owner. Ex. 2011, 1, 21.⁷ For the ’336 patent, the joint invalidity contentions included contentions about anticipation under § 102 and obviousness under § 103 based on the references asserted in this proceeding (Chaimberg, Roberge, Halliwell, and Reiff) as well as other references. *Id.* at 26–27.

On April 29, 2024, Dr. Eden submitted an opening expert report regarding the invalidity of the ’336 patent and another patent in suit. *See* Ex. 2024. Dr. Eden stated that he submitted his opening expert report “at the request of counsel for Defendant Menard, Inc. (‘Menard’), and the Third-Party Defendants,” including Petitioner. *Id.* ¶ 1. For the ’336 patent, Dr. Eden’s opening expert report includes his opinions about anticipation under § 102 and obviousness under § 103 based on the references asserted in

⁷ For Exhibit 2011 (Defendant’s and the Third-Party Defendants’ Joint Initial Invalidity Contentions), we cite to the page numbers that Patent Owner applied to the exhibit.

this proceeding (Chaimberg, Roberge, Halliwell, and Reiff) as well as another reference. *Id.* ¶¶ 137–615.

On June 13, 2024, Dr. Eden submitted a rebuttal expert report regarding the noninfringement of the ’336 patent and another patent in suit. *See* Ex. 2025. Dr. Eden stated that he submitted his rebuttal expert report “at the request of counsel for Defendant Menard, Inc. (‘Menard’), and the Third-Party Defendants,” including Petitioner. *Id.* ¶ 2.

III. ANALYSIS

A. Standard for Additional Discovery

Under the Board’s rules, the moving party “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). When seeking additional discovery, the moving party must show that the 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). Moreover, the moving party must satisfy that standard for each proposed discovery request. *See* 37 C.F.R. § 42.20(c); *Chi Mei Innolux Corp. v. Semiconductor Energy Lab’y Co.*, IPR2013-00028, Paper 25 at 4 (PTAB Apr. 26, 2013).

Because Congress intended *inter partes* reviews to serve as a faster and more cost-effective alternative to infringement actions in district courts, discovery in *inter partes* reviews is limited compared to discovery in infringement actions in district courts. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5 (PTAB Mar. 5, 2013) (precedential); 154 Cong. Rec. S9982, S9988–89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). “Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution.” *Garmin*, IPR2012-00001, Paper 26 at 5.

B. The Garmin Factors

In *Garmin*, the Board identified the following factors as “important” when considering whether additional discovery is “necessary in the interest of justice”:

1. More than a Possibility and Mere Allegation – The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.
2. Litigation Positions and Underlying Basis – Asking for the other party’s litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.
3. Ability to Generate Equivalent Information by Other Means – 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. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.
4. Easily Understandable Instructions – The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is *prima facie* unclear. Such instructions are counter-productive and tend to undermine the responder’s ability to answer efficiently, accurately, and confidently.
5. Requests Not Overly Burdensome to Answer – The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the

time schedule of *Inter Partes* Review. Requests should be sensible and responsibly tailored according to a genuine need.

Garmin, IPR2012-00001, Paper 26 at 6–7.

*C. Applying the Garmin Factors to
Patent Owner’s Proposed Discovery Requests*

1. GARMIN FACTOR 1:
MORE THAN A POSSIBILITY AND MERE ALLEGATION

(a) Patent Owner’s Contentions

Regarding proposed production request no. 1 seeking communications between Petitioner and Menard before Menard’s third-party complaint against Petitioner (October 27, 2022) and proposed production request no. 2 seeking “common interest agreements” between Petitioner and Menard before Menard’s third-party complaint against Petitioner, Patent Owner contends that it possesses evidence of communications between Petitioner and Menard before Patent Owner brought suit against Menard (August 12, 2022). Mot. 4; *see* Paper 19, 4–5. Patent Owner provides the following documents as evidence of pre-suit communications between Petitioner and Menard:

- (1) a February 24, 2021, letter from Menard’s counsel to Patent Owner’s counsel (Exhibit 2018); and
- (2) a March 15, 2021, letter from Petitioner’s counsel to Patent Owner’s counsel (Exhibit 2016).

Mot. 4.

Patent Owner contends that it “knows of other pre-suit communications between Menard and [Petitioner], based on a privilege log served by Menard” in the Wisconsin case where “Menard asserted an alleged common interest privilege.” Mot. 4. Patent Owner explains that “Menard has refused to allow [Patent Owner] to submit a copy of that

privilege log” in this proceeding. *Id.* Further, Patent Owner asserts that “[t]hese pre-suit communications are not subject to a common interest privilege.” *Id.*; *see id.* at 4–6.

Regarding proposed production request no. 3 seeking agreements between Petitioner and Menard concerning “any indemnification or defense obligation owed by” Petitioner, Patent Owner asserts that a “pre-existing indemnification agreement” between Petitioner and Menard “was produced in the [Wisconsin case] subject to a protective order.” Mot. 2, 6; *see* Paper 19, 5; Ex. 2026 (Stipulated Protective Order). Patent Owner further asserts that Petitioner “refuses to make the same production here.” Mot. 6.

Regarding proposed production request no. 4 seeking communications between Petitioner and Menard before Petition filing (October 25, 2023) that concern *inter partes* reviews in general and this proceeding in particular, Patent Owner asserts that Petitioner “has never denied that it communicated with Menard regarding the IPR Petition before it was filed.” Mot. 6; *see* Paper 19, 5. Patent Owner quotes Petitioner’s statement that it “never communicated with Menard regarding the substance of the IPR petition and never told Menard why the IPR petition would be filed.” Mot. 6 (emphases omitted) (quoting Paper 8, 3–4). Petitioner then contends that “this carefully crafted language does not negate the fact that communications between Menard and [Petitioner] regarding the Petition are highly relevant in ascertaining whether Menard” is a real party in interest. *Id.*

Regarding proposed production request no. 5 seeking documents concerning “the discovery of and/or reliance on” Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity/unpatentability purposes, Patent Owner asserts that Petitioner and Menard “cannot dispute that they worked together

on invalidity in the litigation, given the Court ordered them to do so.” Mot. 7 (citing Ex. 2008 (Opinion and Order), 5); *see* Paper 19, 6. Patent Owner makes the same assertion for proposed production request no. 8 seeking documents concerning the “steps” referenced in the following statement to the district court in the Wisconsin case: “Menard and the Third-Party Defendants fully intend to, and have taken various steps to, comply with the Court’s request that Menard and the third-party defendants act as a united front when possible.” Mot. 7 (quoting Ex. 1020 (Updated Joint Preliminary Pretrial Conference Report and Discovery Plan), 3, 20); *see* Paper 19, 6–7; Ex. 2008 (Opinion and Order), 5).

Regarding proposed production request no. 6 seeking documents concerning Menard’s contributions to “the costs in preparing and filing” the Petition (including Dr. Eden’s compensation for analyzing the ’336 patent’s validity) and proposed production request no. 7 seeking documents stating that Dr. Eden “was being retained by and/or on behalf of Menard” for either the Wisconsin case or this proceeding, Patent Owner asserts that both Dr. Eden’s opening expert report regarding invalidity and Dr. Eden’s rebuttal expert report regarding noninfringement state that he submitted the report “at the request of counsel for Defendant Menard, Inc. (‘Menard’), and the Third-Party Defendants,” including Petitioner. Mot. 7 (emphasis omitted) (quoting Ex. 2024 (Opening Expert Report) ¶ 1; Ex. 2025 (Rebuttal Expert Report) ¶ 2); *see* Paper 19, 6. According to Patent Owner, the “source of the payments to Dr. Eden and the nature of his arrangement with Menard and [Petitioner] are important in determining whether Menard was involved in aspects tied to” this proceeding. *Id.*

(b) Petitioner's Contentions

Petitioner contends that “useful” information under the circumstances here is information “tending to show beyond speculation that Menard had a role in the filing of this IPR, or that Menard is funding or controlling this IPR.” Opp. 3 (citing *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1027–28 (Fed. Cir. 2021)). Petitioner also contends that Patent Owner “fails to meet this burden” for any proposed production request because Patent Owner “presents no evidence suggesting that Menard had any involvement in this IPR.” *Id.*

Regarding proposed production request no. 1 seeking communications between Petitioner and Menard before Menard’s third-party complaint against Petitioner (October 27, 2022) and proposed production request no. 2 seeking “common interest agreements” between Petitioner and Menard before Menard’s third-party complaint against Petitioner, Petitioner asserts that the “pre-suit communications show that [Patent Owner] first emailed Menard almost three years before this IPR was filed, asserting 19 different patents against 12 products.” Opp. 3 (citing Ex. 2015); *see* Paper 19, 4–5. Petitioner explains that because it “supplied some of these accused products, Menard relayed [Patent Owner’s] allegations to [Petitioner], reminding [Petitioner] of its indemnification obligation, and [Petitioner] responded to [Patent Owner], seeking to understand the allegations.” Opp. 3 (citing Ex. 2016; Ex. 2017; Ex. 2018).

Petitioner asserts that the pre-suit communications:

- (1) “do not show Menard’s involvement in this IPR”;
- (2) “do not specifically discuss the ’336 Patent or plans to file an IPR against this Patent”; and

- (3) “show routine customer-supplier communications in response to infringement allegations.”

Opp. 3–4.

Regarding proposed production request no. 3 seeking agreements between Petitioner and Menard concerning “any indemnification or defense obligation owed by” Petitioner, Petitioner asserts that the indemnification agreement with Menard is “a standard, boilerplate agreement, identical to the ones that Menard has with the 14 other suppliers involved in the [Wisconsin case], that neither contemplates an IPR, nor gives Menard the ability to control, direct, or fund any IPR.” Opp. 4; *see* Paper 19, 5.

Regarding proposed production request no. 4 seeking communications between Petitioner and Menard before Petition filing (October 25, 2023) that concern *inter partes* reviews in general and this proceeding in particular, Petitioner asserts that Patent Owner’s “bare assertion that ‘communications between Menard and [Petitioner] regarding the Petition are highly relevant’” ignores Petitioner’s certification under its duty of candor that “Menard had no role in filing this IPR, and is not controlling or funding this IPR.” Opp. 4–5 (citing Paper 8, 3–4; Mot. 6); *see id.* at 7 (citing Suppl. Op. 16); Paper 19, 5. Petitioner also asserts that “Menard has made the same certification.” Opp. 5 (citing Ex. 2023).

Regarding proposed production request no. 5 seeking documents concerning “the discovery of and/or reliance on” Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity/unpatentability purposes, Petitioner asserts that Patent Owner fails to explain how the district court’s order requiring Petitioner and Menard “to coordinate a litigation strategy whenever possible” shows “beyond speculation that information regarding

Menard’s role in this IPR will be found.” Opp. 5 (citing Ex. 2008 (Opinion and Order), 5); *see* Paper 19, 6.

Further, Petitioner asserts that proposed production request nos. 6, 7, and 8 fail for similar reasons. Opp. 5. According to Petitioner, both Petitioner and Menard “have already certified that Menard did not fund this IPR in any way, which includes payments to Dr. Eden for work on this IPR.” *Id.* (citing Paper 8, 4; Ex. 2023).

(c) Analysis

For *Garmin* factor 1, Patent Owner does not identify evidence or provide sufficient reasoning “tending to show beyond speculation that in fact something useful will be uncovered,” e.g., showing that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. Mot. 4–7; *see* Suppl. Op. 8, 15–16. In the context of a motion for additional discovery, “useful” means “favorable in substantive value to a contention of the party moving for discovery,” not merely “relevant” or “admissible.” *Garmin*, IPR2012-00001, Paper 26 at 7–8. “The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Id.* at 6, 8. Patent Owner’s evidence and reasoning do not exceed the “mere possibility”/“mere allegation” threshold. Mot. 4–7.

The February 24, 2021, letter from Menard’s counsel to Patent Owner’s counsel (Exhibit 2018) and the March 15, 2021, letter from Petitioner’s counsel to Patent Owner’s counsel (Exhibit 2016) do not amount to evidence tending to show beyond speculation that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that

Menard is “controlling, funding, or directing” this proceeding. *See* Ex. 2016; Ex. 2018. Those letters relate to infringement allegations that Patent Owner made in a February 8, 2021, letter to Menard and predate the Petition by more than thirty months. *See* Ex. 2015; Ex. 2016; Ex. 2018.

As for pre-suit communications between Petitioner and Menard listed on a Menard privilege log, Patent Owner speculates that they may show that Petitioner “filed the IPR *because of or in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. *See* Mot. 4–6. Those pre-suit communications predate the Petition by more than fourteen months. *See, e.g.,* Ex. 2016; Ex. 2017; Ex. 2018. Hence, even if those pre-suit communications are not privileged, which the parties dispute, the timing of those pre-suit communications lessens the likelihood that they have any relation to the preparation or filing of the Petition. *See* Mot. 4–6; Opp. 3–4, 10 & n.4; Ex. 3004, 2.

As for the “pre-existing indemnification agreement” that was produced in the Wisconsin case, based on excerpts of that agreement in the record, the Director described that agreement as “a standard, non-exclusive, manufacturer-customer indemnification agreement relating to patent infringement.” Suppl. Op. 11, 23. Additionally, the Director determined that “standard indemnification language” does not “support an inference that the Agreement gives Menard the opportunity or ability to control this IPR proceeding or Petitioner’s filing of the Petition.” *Id.* at 12 (citing Ex. 2002 ¶¶ 26–27, 29; Ex. 2013 ¶¶ 26–27, 29). Patent Owner does not explain how the “pre-existing indemnification agreement” that was produced in the Wisconsin case includes anything other than “standard indemnification

language.” Mot. 2, 6; *see* Ex. 2001 ¶¶ 24–29; Ex. 2002 ¶¶ 24–29; Ex. 2013 ¶¶ 24–29; Ex. 3003 ¶¶ 24–29.

Regarding proposed production request no. 4 seeking communications between Petitioner and Menard before Petition filing (October 25, 2023) that concern *inter partes* reviews in general and this proceeding in particular, we agree with Petitioner that Patent Owner’s “bare assertion that ‘communications between Menard and [Petitioner] regarding the Petition are highly relevant’” ignores Petitioner’s certification under its duty of candor that “Menard had no role in filing this IPR, and is not controlling or funding this IPR.” Opp. 4–5; *see id.* at 7; Paper 8, 3–4; Paper 19, 5. For instance, Petitioner certifies under its duty of candor that:

Menard had no role whatsoever in Petitioner’s IPR; Petitioner never communicated with Menard regarding the substance of the IPR petition and never told Menard why the IPR petition would be filed; Petitioner did not file its IPR petition at Menard’s behest; Menard never requested that Petitioner file an IPR petition challenging the ’336 patent; Menard had no control or say whatsoever in Petitioner’s IPR petition; and Petitioner did not ask for or receive input from Menard on the petition.

Paper 8, 3–4.

Regarding proposed production request nos. 5, 6, 7, and 8, Petitioner and Menard taking “steps” in the Wisconsin case as directed by district court to coordinate and act “as a united front whenever possible,” e.g., when working with Dr. Eden, does not tend to show beyond speculation that Petitioner “filed the IPR *because of* or *in response to* any request by Menard to do so” or that Menard is “controlling, funding, or directing” this proceeding. Mot. 7; *see* Suppl. Op. 8, 15–16; Paper 19, 6–7.

For example, Dr. Eden’s expert reports in the Wisconsin case submitted “at the request of counsel for Defendant Menard, Inc. (‘Menard’), and the Third-Party Defendants,” including Petitioner, show nothing more than coordination in the Wisconsin case and overlapping invalidity/unpatentability theories for the ’336 patent based on Chaimberg, Roberge, Halliwell, and Reiff. *See* Ex. 2024; Ex. 2025. Coordination as part of a joint defense group “does not indicate control.” *See AMX, LLC v. Chrimar Sys., Inc.*, IPR2016-00569, Paper 18 at 6 (PTAB May 19, 2016). Additionally, the overlapping invalidity/unpatentability theories resulting from court-ordered collaboration in the Wisconsin case do not show a “volitional coordination” by Petitioner and Menard with respect to this proceeding. Suppl. Op. 20.

Moreover, Menard’s submission of an identical copy of Dr. Eden’s declaration from this proceeding in IPR2024-01469 does not indicate that Menard is “controlling, funding, or directing” this proceeding. *See* IPR2024-01469, Ex. 1004. Instead, Menard’s decision to file its own IPR challenging claims in the ’336 patent undermines an inference that Menard is “controlling, funding, or directing” this proceeding.

For these reasons, Patent Owner fails to identify evidence or provide sufficient reasoning tending to show beyond speculation that in fact something useful will be uncovered with any of the proposed production requests. Due to that failure, *Garmin* factor 1 weighs against granting Patent Owner’s motion.

2. GARMIN FACTOR 2:
LITIGATION POSITIONS AND UNDERLYING BASIS

(a) Patent Owner's Contentions

Patent Owner contends that “litigation positions are not being sought” because expert reports “concerning the same prior art and same validity arguments have already been served and filed” in the Wisconsin case. Mot. 7 (citing Ex. 2024 (Opening Expert Report); Ex. 2025 (Rebuttal Expert Report)); *see id.* at 9.

Regarding proposed production request no. 1 seeking communications between Petitioner and Menard before Menard’s third-party complaint against Petitioner (October 27, 2022) and proposed production request no. 2 seeking “common interest agreements” between Petitioner and Menard before Menard’s third-party complaint against Petitioner, Patent Owner asserts that these requests do not encompass documents after Menard’s third-party complaint against Petitioner, i.e., after litigation against Petitioner commenced. Mot. 8; *see* Paper 19, 4–5.

Regarding proposed production request no. 5 seeking documents concerning “the discovery of and/or reliance on” Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity/unpatentability purposes, Patent Owner asserts that this request is “limited to the references that Luminex relies on in the IPR.” Mot. 8; *see* Paper 19, 6. Patent Owner also asserts that “how Menard or [Petitioner] discovered the references is not a ‘litigation position.’” *Id.* at 8–9.

Additionally, Patent Owner contends that the other proposed production requests do not seek litigation positions. *See* Mot. 9.

(b) Petitioner's Contentions

Regarding proposed production request no. 1 seeking communications between Petitioner and Menard before Menard's third-party complaint against Petitioner (October 27, 2022), Petitioner asserts that "any communications during this period about [Patent Owner's] infringement allegations would touch on [Petitioner's] litigation positions and bases" because Petitioner is "defending Menard in the district court litigation as part of the joint defense group." Opp. 5–6; *see* Paper 19, 4.

Regarding proposed production request no. 5 seeking documents concerning "the discovery of and/or reliance on" Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity/unpatentability purposes, Petitioner asserts that this request "directly implicates [Petitioner's] litigation strategy because the prior art applied in this Petition has also been applied in the district court invalidity contentions." Opp. 6; *see* Paper 19, 6. Petitioner asserts that "any documents and communications about this prior art would inevitably include [Petitioner's] litigation strategy." *Id.*

Further, Petitioner asserts that the submission of invalidity expert reports in the Wisconsin case "does not eliminate the threat of [Patent Owner] prying into [Petitioner's] litigation positions." Opp. 6. Petitioner explains that the requested documents "would encompass [Petitioner's] litigation positions that are not already memorialized in its expert reports, such as discussions on the relative strength of the prior art references, which references are to be used at trial, and the relationship of the invalidity arguments to non-infringement arguments." *Id.*

(c) Analysis

Garmin factor 2 weighs against granting Patent Owner’s motion because the proposed production requests seek litigation positions and the underlying bases for those positions. *See* Paper 19, 4–7. The proposed production requests define “Petitioner” broadly as including “its predecessors and successors, parents, subsidiaries, divisions, and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.” *Id.* at 2.

Proposed production request no. 1 seeks communications between Petitioner and Menard before Menard’s third-party complaint against Petitioner (October 27, 2022) and likely encompasses communications concerning litigation positions and the underlying bases for those positions because:

- (1) the proposed production requests extend to Petitioner’s attorneys;
- (2) this request expressly seeks communications concerning Patent Owner’s “infringement allegations”;
- (3) Petitioner agreed to indemnify and defend Menard against infringement claims; and
- (4) Petitioner participates in a joint defense group defending Menard against Patent Owner’s infringement claims.

See Opp. 5–6; Paper 19, 4; Ex. 2002 ¶¶ 24–29; Ex. 2013 ¶¶ 24–29.

Proposed production request no. 5 seeks documents concerning “the discovery of and/or reliance on” Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity/unpatentability purposes and likely encompasses documents concerning litigation positions and the underlying bases for those positions because:

- (1) the proposed production requests extend to Petitioner's attorneys;
- (2) this request expressly seeks documents concerning "reliance on" Chaimberg, Roberge, Halliwell, and/or Reiff for invalidity purposes; and
- (3) Petitioner relies on Chaimberg, Roberge, Halliwell, and Reiff for invalidity purposes in the Wisconsin case.

See Opp. 6; Paper 19, 6; Ex. 2011, 25–26; Ex. 2024 ¶¶ 137–519.

Further, we agree with Petitioner that the submission of invalidity expert reports in the Wisconsin case "does not eliminate the threat of [Patent Owner] prying into [Petitioner's] litigation positions" because the requested documents "would encompass [Petitioner's] litigation positions that are not already memorialized in its expert reports, such as discussions on the relative strength of the prior art references, which references are to be used at trial, and the relationship of the invalidity arguments to non-infringement arguments." *See* Opp. 6.

Proposed production request no. 8 seeks documents concerning the "steps" that Menard and the third-party defendants have taken to "comply with the Court's request that Menard and the third-party defendants act as a united front when possible" and likely encompasses documents concerning litigation positions and the underlying bases for those positions because:

- (1) the proposed production requests extend to Petitioner's attorneys;
- (2) Petitioner agreed to indemnify and defend Menard against infringement claims;
- (3) Petitioner participates in a joint defense group defending Menard against Patent Owner's infringement claims; and

- (4) Petitioner has collaborated with the other third-party defendants and Menard at least with respect to invalidity theories in the Wisconsin case.

See Opp. 5–6; Paper 19, 6–7; Ex. 2002 ¶¶ 24–29; Ex. 2011, 24–268; Ex. 2013 ¶¶ 24–29; Ex. 2024 ¶¶ 137–519.

3. GARMIN FACTOR 3:
ABILITY TO GENERATE EQUIVALENT
INFORMATION BY OTHER MEANS

(a) Patent Owner’s Contentions

Patent Owner contends that it “has no other means to generate this information as the requested information is in the possession or control of only [Petitioner] and Menard.” Mot. 9. Regarding documents encompassed by the proposed production requests and produced in the Wisconsin case, Patent Owner contends that “such documents contain a confidentiality designation that prevents [Patent Owner] from using the documents in the IPR without [Petitioner’s] permission (which it has refused).” *Id.* (citing Ex. 2021).

(b) Petitioner’s Contentions

Petitioner contends that Patent Owner propounded “similar” production requests in the Wisconsin case and that “relevant documents” were produced in the Wisconsin case. Opp. 8 (citing Ex. 1026 (Plaintiff’s First Set of Requests for Production to Third-Party Defendant Luminex International Company, Ltd. (Nos. 1–24))). Regarding the documents that were produced in the Wisconsin case, Petitioner asserts that Patent Owner “did not ask for permission to use” those documents in this proceeding. *Id.* at 7 n.3. Petitioner contends that the documents Patent Owner already has do not support its arguments. *Id.* at 7.

Regarding “the indemnification agreement between [Petitioner] and Menard,” Petitioner asserts that:

- (1) “the exact indemnification provision from this agreement is on the record here”; and
- (2) Patent Owner cited that indemnification provision “verbatim” in the Preliminary Response.

Opp. 7 (citing Prelim. Resp. 2; Ex. 3003, 4–5).

Further, Petitioner asserts that Patent Owner fails to explain why it “delayed seeking discovery for over eight months” after raising the real-party-in-interest issue in the Preliminary Response. Opp. 9.

(c) Analysis

Garmin factor 3 weighs against granting Patent Owner’s motion because (1) the proposed production requests largely overlap Patent Owner’s production requests in the Wisconsin case, (2) the proposed production requests seek many of the documents already sought by Patent Owner’s production requests in the Wisconsin case, and (3) Patent Owner identifies only five responsive documents produced in the Wisconsin case. *See* Mot. 2, 6; Paper 19, 4–7; Ex. 1026, 10–15.

For example, Patent Owner’s production request nos. 4, 5, 10, and 11 in the Wisconsin case read as follows:

4. All Documents and Things referring or relating to Luminex’s obligations and/or agreements to supply Luminex Relevant Products to Menard, including without limitation all contracts and agreements between Menard and Luminex, all Documents describing the terms of any manufacture and/or supply agreements between Menard and Luminex (and any supplementations, amendments and/or modifications thereto), all Documents setting forth the identity, number of units and price of any Luminex Relevant Products that Luminex has supplied to Menard, and any correspondence relating thereto.

5. All Documents and Things considered, referred to or relied upon in preparing Your Answer to Menard's Third Party Complaint and/or Your Affirmative Defenses and Cross-Claims Against Plaintiffs (ECF No. 159), or any amendments or supplementations thereto, or other pleading later filed by You, including but not limited to, all documents and things on which You base Your allegations, contentions, and any Affirmative Defenses and Cross-Claims against Signify, and any documents which tend to support or undermine any of the Affirmative Defenses and Cross-Claims against Signify identified in Your Answer.

10. All Documents and Things concerning, referring or relating to each of the Asserted Patents.

11. All Documents and Things concerning any communications or agreements between Menard and You regarding Signify, this Action, any Asserted Patents, any Menards Accused Product and/or any Luminex Relevant Product.

Ex. 1026, 10–12. These production requests in the Wisconsin case encompass or largely overlap proposed production request nos. 1–5. *See* Paper 19, 4–6.

Although the proposed production requests seek many of the documents already sought by Patent Owner's production requests in the Wisconsin case, Patent Owner identifies only five responsive documents produced in the Wisconsin case, in particular, the "pre-existing indemnification agreement" between Petitioner and Menard, SIGNIFYMDRD0015968–69, MEN008627–30, MEN008675–78, and MEN008684–88. *See* Mot. 2, 6; Paper 19, 4. Hence, Patent Owner had the ability to obtain the many of the requested documents without needing discovery in this proceeding and obtained only a handful of documents despite that ability.

As for the five responsive documents produced in the Wisconsin case, the parties dispute whether Patent Owner requested permission to use those documents in this proceeding. Patent Owner asserts that Petitioner refused permission to use those documents in this proceeding. Mot. 9. Petitioner asserts that Patent Owner “did not ask for permission to use” those documents in this proceeding. Opp. 7 n.3. Petitioner does not indicate whether it would or would not give Patent Owner permission to use those documents in this proceeding. *See id.* at 6–9, 7 n.3. The Board encourages the parties to resolve this question without Board intervention.

Insofar as the proposed production requests seek documents not already sought by Patent Owner’s production requests in the Wisconsin case, Patent Owner speculates that the proposed production requests will yield something “favorable in substantive value” to the real-party-in-interest issue. *See* Mot. 4–7. Patent Owner’s speculation does not exceed the “mere possibility”/“mere allegation” threshold. *See supra* § III.C.1(c).

4. GARMIN FACTOR 4: EASILY UNDERSTANDABLE INSTRUCTIONS

(a) Patent Owner’s Contentions

Patent Owner contends that the proposed production requests “include a list of instructions that are easily understandable.” Mot. 9. Patent Owner also contends that (1) some production requests include date ranges and (2) some production requests “identify exemplary responsive documents by Bates ranges, making them even more easily understandable.” *Id.*

(b) Petitioner’s Contentions

Petitioner does not address the understandability of the instructions for the proposed production requests. *See* Opp. 9–10; Paper 19, 1–4.

(c) Analysis

Garmin factor 4 does not favor granting Patent Owner’s motion because the proposed production requests include broad definitions that make the requests “less clear than desirable” in an *inter partes* review. *See* Paper 19, 2–4; *New World Med., Inc. v. MicroSurgical Tech., Inc.*, IPR2020-01573, Paper 13 at 11 (PTAB Dec. 10, 2020).

As an example, the proposed production requests define “Petitioner” broadly as including “its predecessors and successors, parents, subsidiaries, divisions, and affiliated companies, and all past and present directors, officers, employees, agents, representatives, consultants and attorneys of the foregoing.” Paper 19, 2.

As another example, the proposed production requests define “document” broadly as including “‘originals’ and ‘duplicates’ and has the same meaning as the term ‘writings and recordings’ and ‘photographs’ as defined in Fed. R. Evid. 1001, whether or not claimed to be privileged or otherwise exempted from discovery, including without limitation correspondence, written agreements, memoranda, summaries, notes, written communications and electronically stored information, whether a draft, or a copy, however reproduced.” Paper 19, 3.

5. GARMIN FACTOR 5:
REQUESTS NOT OVERLY BURDENSOME TO ANSWER

(a) Patent Owner’s Contentions

Patent Owner contends that the proposed production requests “will not require a significant expenditure of human and financial resources because, at least, many of the documents have already been gathered in connection with” the *Wisconsin* case. Mot. 9–10. Patent Owner also

contends that (1) some production requests define “specific date ranges, a specific issue, and/or specific parties” and (2) some production requests identify “certain specific responsive documents already known to exist.” *Id.* at 10.

Regarding proposed production request no. 3 seeking agreements between Petitioner and Menard concerning “any indemnification or defense obligation owed by” Petitioner, Patent Owner asserts the number of responsive agreement documents” is “expected to be limited, and copies are expected to be accessible by [Petitioner]—in fact, one responsive agreement has already been produced in the litigation.” Mot. 10.

Regarding proposed production request no. 6 seeking documents concerning Menard’s contributions to “the costs in preparing and filing” the Petition (including Dr. Eden’s compensation for analyzing the ’336 patent’s validity) and proposed production request no. 7 seeking documents stating that Dr. Eden “was being retained by and/or on behalf of Menard” for either the Wisconsin case or this proceeding, Patent Owner asserts that they are “directed to focused topics” and relate to “payments/costs” or a “specific expert” used by Petitioner for both the Wisconsin case and this proceeding. Mot. 10.

Regarding proposed production request no. 8 seeking documents concerning the “steps” that Menard and the third-party defendants have taken to “comply with the Court’s request that Menard and the third-party defendants act as a united front when possible,” Patent Owner asserts that the request “relates to recent communications and documents in the litigation following the Court’s August 31, 2023 Order requiring Menard and Luminex to operate as a ‘united front.’” Mot. 10. Patent Owner also

asserts that “it should not be burdensome for [Petitioner’s] counsel to simply search its existing electronic correspondence files for these communications.” *Id.*

(b) Petitioner’s Contentions

Petitioner contends that the proposed production requests are “overly burdensome” because they are litigation-style requests “seeking ‘*All* Communications,’ ‘*All* documents,’ and ‘*All* agreements,’ relating not only to this IPR, but also to infringement allegations made by [Patent Owner] for 19 different patents, and agreements predating [Petitioner’s] participation in the district court.” Opp. 9 (emphases by Petitioner). Petitioner also contends that the requested documents “very likely encompass communications subject to common interest and/or joint defense privileges that would require an extensive privilege review, placing a burden not only on [Petitioner’s] finances and human resources, but also on the time schedule” for this proceeding. *Id.* at 10.

Further, Petitioner asserts that Patent Owner “fails to explain how this expansive range of documents, some predating this IPR by almost three years, could uncover information ‘useful’ to” the real-party-in-interest issue in this IPR. Opp. 10.

(c) Analysis

Garmin factor 5 weighs against granting Patent Owner’s motion because the proposed production requests are litigation-style requests seeking broad categories of documents from numerous custodians. *See* Paper 19, 1–7.

As an example of their breadth, the proposed production requests purport to impose a continuing obligation to respond by including the following instruction:

These Requests are deemed to be continuing in nature so as to require amended and supplemented responses to the extent called for by Rule 26(e) of the Federal Rules of Civil Procedure. If Petitioner acquires additional knowledge or information with respect to any of these requests after service of your responses, Petitioner shall serve a supplemental and/or amended response to each such discovery no later than thirty (30) days after acquiring the additional knowledge or information.

Paper 19, 1–2.

As another example of their breadth, the proposed production requests define “document” broadly as including “electronically stored information.” Paper 19, 3. But the proposed production requests do not limit the custodians whose files would be searched for the requested “electronically stored information.” *See id.* at 1–4. Additionally, the proposed production requests compound the burden to search for “electronically stored information” by defining “Petitioner” broadly as including “all past and present directors, officers, employees, agents, representatives, consultants and attorneys.” *Id.* at 2.

Responding to the proposed production requests would likely require significant time and effort to (1) locate responsive documents, (2) segregate responsive privileged documents from responsive nonprivileged documents, (3) log responsive privileged documents, and (4) produce responsive nonprivileged documents. Even if a particular request may not result in many, if any, responsive documents, Petitioner would be obligated to make a diligent search to adequately comply with the request. Thus, the proposed

production requests would impose a burden on at least human resources and the time schedule for this proceeding. *See* Paper 15 (Scheduling Order), 12; *Garmin*, IPR2012-00001, Paper 26 at 14.

In view of the one-year statutory deadline for an *inter partes* review, *Garmin* cautions that proposed discovery requests “should be sensible and responsibly tailored according to a genuine need.” *See Garmin*, IPR2012-00001, Paper 26 at 7, 14. Patent Owner failed to heed that caution.

6. CONCLUSION

For the reasons discussed above, the *Garmin* factors do not indicate that the proposed additional discovery is “necessary in the interest of justice.”

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner’s motion for additional discovery is denied.

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