

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Corning Incorporated
Petitioner

v.

DSM IP Assets B.V.
Patent Owner

Case IPR2013-00043
Patent 7,171,103 B2

Before MICHAEL P. TIERNEY, JENNIFER S. BISK, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Motion for Discovery
37 C.F.R. §§ 42.20 and 42.51

INTRODUCTION

Patent Owner (“DSM”) filed a motion for discovery. Paper 17 (“Mot.”). Petitioner (“Corning”) opposed. Paper 20 (“Opp.”).

As discussed in the Decision to Institute, in its Petition, Corning asserts that the subject matter in the challenged claims is unpatentable over the prior art based on inherent properties not recited explicitly in the prior

art. Paper 14 (“Decision”) at 6. The Petition relies on the testimony of an expert, Inna I. Kouzmina, who prepared several compositions disclosed in the prior art and tested the resulting samples for the properties recited in the claims. *Id.* DSM’s motion requests discovery related to each of the compositions synthesized for this case¹ including:

- (1) Laboratory notebooks and other documents containing the protocols followed in creating and testing the compositions and the underlying data for the test results.
- (2) Samples of the compositions as prepared by Corning.
- (3) Any testing results that are inconsistent with Corning’s position that the alleged prior art composition inherently possess the claimed property values and an associated privilege log.

Ex. 2005 (“Req.”) 1.² We address each of the three categories of request in turn.

REQUEST 1: LABORATORY NOTEBOOKS

DSM’s first request is for the laboratory notebooks and other

¹ The compositions include, four oligomers and four coatings: Oligomer H-I-PPG3025-I-H; Oligomer H-I-PPG4025-I-H; Oligomer HEA-TDI-PPG1025-TDI-HEA; and Oligomer HEA-TDI-PTMG1000-TDI-HEA; Example 10-1 of WO 98/21157 (Ex. 1002) (“Szum ’157”); Example 10-2 of Szum ’157; Example 2 of U.S. Patent 5,664,041 (Ex. 1003) (“Szum ’041”); and Example 4 of Szum ’041. Req. at 1; *see also*, Decision.

² The specific requests for this case can be found on pages 1 and 2 of Ex. 2005 under “IPR Nos. 2013-00043, -00044.” This Exhibit is somewhat confusing because the numbering of the “General Requests to Corning” and the numbering of the specific requests for each case are not consistent. For clarity, DSM’s general requests 1 and 3 and the specific requests for this case labeled 1 and 2 all correspond to our request “(1),” which we refer to generally as the “Laboratory Notebooks request.”

documents and things containing (a) the protocols and procedures followed in preparation of the oligomers and coatings relied on in the petition, and (b) the underlying data obtained during testing those oligomers and coatings. Mot. 1; Req. 1-2. We conclude that DSM sufficiently demonstrates that this request meets the interests of justice standard for additional discovery.

First, we address DSM's argument that this information should have been produced by Corning as "routine discovery" under 37 C.F.R. § 42.51(b)(1)(i). Mot. 5-6. DSM asserts that because the petition and the supporting declarations reference the creation of samples and the results of testing those samples, all the information sought in this request should have been produced as "any exhibit cited in a paper or in testimony" that "must be served with the citing paper or testimony." *Id.* at 5. This proposed interpretation of routine discovery is overbroad. We do not agree that any reference to experiments in a paper requires that all the underlying data and lab notebooks be produced with that paper. We therefore consider this a request for additional discovery under 37 C.F.R. § 42.51(b)(2).

DSM also asserts that this request meets the requirements for additional discovery. *Garmin v. Cuozzo*, IPR2012-00001, Paper No. 26 at 6-7 (PTAB Mar. 5, 2013), set forth a list of factors important in assessing whether a motion for additional discovery meets the standard of "necessary in the interest of justice" under 35 U.S.C. § 316(a)(5). Those factors include: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. DSM states that its request satisfies each of

these factors. Mot. 6-15. Corning disagrees. Opp. 11-15.

Corning argues that DSM has not satisfied the first *Garmin* factor and has not shown that the Laboratory Notebooks request is based on more than a mere possibility of finding something useful. Corning adds that DSM has no need for this information because Corning's two expert declarations provide all the relevant details (in combination with the prior art disclosures) that DSM seeks with this request. *Id.* DSM, on the other hand, asserts that the contents of these same expert declarations show that this *Garmin* factor is satisfied—the information DSM seeks exists and includes information “favorable in substantive value” to DSM's contentions. Mot. 8. DSM explains that the declarations are missing critical information required to confirm that the compositions created by Corning's expert were actually those described in the alleged prior art references and to evaluate the reliability of the tests performed. *Id.* at 10-11.

The details of the procedures used to synthesize and test the oligomers and coatings involved in this case are per se useful as Corning has proffered the expert testimony, which relies upon those details, to demonstrate the unpatentability of DSM's claims. Thus, we conclude that the first factor weighs in favor of DSM.

Corning does not explicitly address any of the other *Garmin* factors with respect to the Laboratory Notebooks request. *See* Opp. 11-15. Indeed, DSM's Laboratory Notebooks request does not seek to uncover an opponent's litigation position (*Garmin* Factor 2), seek information that could be obtained through other means (*Garmin* Factor 3), or place an undue burden on an opponent (*Garmin* Factor 5). In fact, when the Board explicitly enquired about *Garmin* Factor 5 on a conference call shortly after

briefing of this motion was completed, Corning's counsel did not assert that Corning would be prejudiced by this particular request.³

REQUEST 2: SAMPLES

DSM also requests samples of each of the compositions involved in this case. Mot. 1; Req. 1. Similar to the Laboratory Notebooks request, DSM argues that the samples requested are routine discovery. Mot. 5-6. We do not agree. For the reasons described above, we classify this as a request for additional discovery.

DSM asserts that it requires samples from Corning in order to independently evaluate the compositions synthesized by Corning's expert. Mot. 8. According to DSM, some of the samples take weeks to synthesize, time that DSM does not have because of the expedited nature of an *inter partes* review. Mot. 9-10 (citing Ex. 2006, ¶ 25⁴). Corning responds that DSM has not satisfied the *Garmin* factors for this request. Opp. 8-11.

First, Corning argues that DSM has not shown that the Samples request is based on more than a mere possibility of finding something useful because DSM has not revealed why or how it would use the samples. Opp. 8-9. Second, Corning argues that DSM has not shown that it could not generate the samples itself because DSM has not even alleged that it has tried creating its own samples. *Id.* at 10. Third, Corning argues that DSM has not specified sufficiently how much of each composition it needs and Corning has only small amounts of each composition remaining after its own

³ This conference call took place on June 13, 2013.

⁴ Corning argues that the declaration of Christopher Bowman, Ph.D. filed with DSM's motion, should be rejected as speculative, conclusory, and containing inadmissible hearsay. Opp. 1. Because we do not rely on the declaration, we do not address Corning's objections.

testing, which is destructive by nature. *Id.*

We agree that DSM has not shown sufficiently that the Samples request meets the standard of “necessary in the interest of justice.” Although DSM states generally that *some* of the samples will take several weeks to create, DSM does not specify which of the samples it will have trouble creating in the time allotted and instead requests samples of every composition. Mot. 9. Nor does DSM specify the quantity required of each sample. To the extent that a quantity of a sample sufficient to do extensive testing is required, DSM has not shown that such a request would not unduly burden Corning. Finally, other than stating that the requested samples “are important and useful for DSM to independently evaluate,” (Mot. 9) DSM does not explain sufficiently why it cannot gather the information it is seeking with this request through cross-examination and inspection of the documents produced through the Laboratory Notebooks request.

REQUEST 3: INCONSISTENT POSITIONS

DSM’s last category of request is for information and testing results that are inconsistent with the purported inherency of certain claim limitations. Mot. 1; Req. 1. Routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) requires specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding to be served concurrently with the filing of documents or things that contains the inconsistency. *Garmin* at 4. Corning confirms that it has produced all information covered by routine discovery. Opp. 7. Since DSM repeats that the information it seeks with this request is routine discovery (Mot. 6), it appears that this request has been fulfilled.

DSM also requests that “to the extent Corning is withholding

information under any applicable privilege, a privilege log with sufficient factual information such that DSM can assess the propriety of Corning's privilege claim." Req. 1. DSM does not provide any further explanation for why it requires this information. DSM provides no indication that it is in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered by such a request. Moreover, DSM does not explain why such a request would not be overly burdensome to Corning. We therefore conclude that DSM has not shown sufficiently that this request meets the standard of "necessary in the interest of justice."

Accordingly, it is hereby:

ORDERED that DSM's motion for additional discovery is *granted* as to the request for Laboratory Notebooks request as specified on pages 1 and 2 of Ex. 2005 under "IPR Nos. 2013-00043, -00044" requests numbered 1 and 2;

FURTHER ORDERED that Corning must serve DSM the additional discovery by June 28, 2013;

FURTHER ORDERED that DSM's motion is *denied* as to all other requests for additional discovery.

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