

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNAPTIVE MEDICAL INC.,
Petitioner,

v.

KARL STORZ ENDOSCOPY-AMERICA, INC.,
Patent Owner.

Case IPR2018-00462
Patent 9,468,360 B2

Before BARRY L. GROSSMAN, MICHELLE N. WORMMEESTER, and
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Motion to Compel Routine Discovery
37 C.F.R. §§ 42.52(a); 42.51(b)(1)(iii)

A conference call was conducted between counsel for the parties and Judges Grossman, Wormmeester, and Khan on September 28, 2018. A transcript of that call was filed with the court on October 4, 2018. *See* Paper 11 (“Tr.”). Patent Owner requested the call to compel production of information regarding objective indicia of non-obviousness, and in particular copying, that Patent Owner alleges is inconsistent with Petitioner’s position that it is unaware of any secondary considerations. Patent Owner bases its contention on a number of publicly available published papers authored by Dr. Kassam, which discuss or cite to Patent Owner’s publications regarding Patent Owner’s patented invention. According to Patent Owner, Dr. Kassam worked as a consultant to Patent Owner for a number of years and then subsequently moved to work with Petitioner. Because of Dr. Kassam’s prior work for Patent Owner, citations in Dr. Kassam’s papers to Patent Owner’s patented invention, and apparent similarities between Patent Owner’s invention and Petitioner’s competing product, Patent Owner contends that it “find[s] it hard to believe” that Petitioner is not aware of information inconsistent with Petitioner’s position on secondary considerations. Tr. 10:19–21.

Petitioner, on the other hand, maintains that it is unaware of “anything inconsistent” with its positions. Tr. 11:25–12:3. Petitioner also alleges that Patent Owner’s requests are overly broad (Tr. 14:8–16:3) and that photographs of Patent Owner and Petitioner’s respective products show, at best, only superficial similarities that are unrelated to any specific claimed limitations (Tr. 12:11–12:23). Moreover, Petitioner adds that any such similarities, even if they exist, would not be sufficient to show copying under the correct standard. Tr. 12:24–13:17.

We are unpersuaded that the information being sought by Patent Owner falls under routine discovery pursuant to Rule 42.51(b)(iii). “Routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) is narrowly directed to specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 slip op. at 4 (PTAB Mar. 5, 2013) (Paper 26) (precedential). On the call, Patent Owner did not articulate any reasons sufficient to show that there exists any specific information known to Petitioner regarding copying, or any other secondary considerations. Patent Owner’s position is largely speculative, believing that Petitioner must have some information of copying because of Dr. Kassam’s knowledge of the patented invention. *See* Tr. 17:22–24 (“But we don’t know what Synaptive’s counsel or what Synaptive has or who Dr. Kassam was communicating with.”). We do not find such speculation sufficient in demonstrating that Petitioner knows of any specific information regarding secondary considerations inconsistent with its position.

ORDER

For the reasons given, it is:

ORDERED that Patent Owner’s Request to Compel Routine Discovery is *denied*.

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