

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZODIAC POOL SYSTEMS, INC.
Petitioner

v.

AQUA PRODUCTS, INC.
Patent Owner

Case IPR2013-00159
Patent 8,273,183 B2

Before BRIAN J. MCNAMARA, RAMA G. ELLURU, and JAMES B. ARPIN,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

DECISION
Motion for Additional Discovery
37 C.F.R. § 42.51

INTRODUCTION

Patent Owner, Aqua Products, Inc., filed a motion for additional discovery. Paper 23 (“Mot.”). Petitioner, Zodiac Pool Systems, Inc., filed an opposition. Paper 25 (“Opp.”). For the reasons stated below, Patent Owner’s motion is *denied*.

DISCUSSION

Under 35 U.S.C. § 316(a)(5), discovery is available for the deposition of witnesses submitting affidavits or declarations and for “what is otherwise necessary in the interest of justice.” Patent Owner, as the movant, bears the burden to demonstrate that additional discovery is in the interest of justice. *See* 37 C.F.R. §§ 42.20(c) and 42.51(b)(2). To meet its burden, Patent Owner must explain *with specificity* the discovery requested and why each item requested is necessary “in the interests of justice.” *Id.*

Patent Owner seeks additional discovery pertaining to (i) Petitioner’s knowledge of the use of pumped water in a robotic pool cleaner; (ii) the breakthrough nature of the Patent Owner’s development; and (iii) a recognized long felt, but unsatisfied, need for a viable jet drive by Petitioner, as evidence of secondary considerations of nonobviousness. Mot. 1, 5. In particular, Patent Owner requests the authorization to serve a First Set of Interrogatories (Ex. 2001), a First Request for Document Production (Ex. 2002), and Requests for Admission pursuant to Fed. R. of Civ. P. 33, 34, and 36 (Ex. 2003). Mot. 1.

The factors set forth in the “Decision – On Motion for Additional Discovery” entered in IPR2012-00001 guides our analysis in determining whether a discovery request meets the statutory and regulatory necessary “in the interest of justice” standard. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper No. 26 at 6-7 (PTAB, Mar. 5, 2013).

Notably, *Garmin* Factors 1 and 3 provide the following:

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. [In this context, “useful” means “favorable in substantive value to a contention of the party moving for discovery.”]

. . . .

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.

Id. (emphases added; numeration removed). In determining whether we should grant Patent Owner’s motion for additional discovery, we apply these two factors in turn.

1. *Garmin* Factor 1

As noted above, “[t]he party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *See* IPR2012-00001, Paper No. 26 at 6. Patent Owner argues that, by its motion for additional discovery, it seeks information relevant to Petitioner’s “observations about the devices, the technology and [Petitioner’s] evaluation [of either].” Mot. 1. Patent Owner has not established more than the mere possibility of finding something useful, and the mere allegation that something useful will be found is insufficient basis for granting Patent Owner’s motion.

Patent Owner asserts that, on at least two occasions, Patent Owner shared information with Petitioner about the Patent Owner's "jet drive" devices. Mot. 1. Patent Owner argues that "jet drive" devices are the subject of the '183 Patent, and that Patent Owner's "jet drive" devices were provided to Petitioner for evaluation and testing. Mot. 1.

First, Patent Owner argues that Petitioner "*likely* made observations about the technology." *Id.* at 6 (emphasis added). Patent Owner does not define explicitly what it means by "observations." From its Interrogatory No. 1, we understand "observations" to include "any testing, analysis or experimentation" conducted by Petitioner on any robotic pool cleaning products manufactured by Patent Owner "which implemented jet drive technology." Ex. 2001, 4. Patent Owner, however, does not identify which of its robotic pool cleaning products implement "jet drive technology" or that Petitioner conducted "any testing, analysis or experimentation" on such products.

Second, we note that, except for its use in the title of Patent No. US 8,273,183 B2 (the "'183 Patent"), neither the term: "jet drive" nor the term: "jet drive technology" appears in the Specification or in the challenged claims of the '183 Patent. To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter, *as claimed*, and, therefore, Patent Owner must demonstrate that there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). Here, Patent Owner fails to provide the requisite nexus between Petitioner's "likely" observations regarding Patent Owner's "jet drive" or "jet drive technology," and

the challenged claims. *See* Pet. 2 (citing IPR 2012-00026, Paper 32 at 7-8; IPR2012-00001, Paper 26 at 8-9).

Petitioner's individual discovery requests further demonstrate that Patent Owner merely alleges that something useful might be found. For example, Interrogatory No. 1 requests that Petitioner "[i]dentify *any* testing, analysis or experimentation conducted by Zodiac on any robotic pool cleaning products manufactured by Aqua Products which implemented jet drive technology during the period from 1999 through 2008 and identify *all* documents and things in your possession or control relating thereto." Ex. 2001, 4 (emphases added); *see also* Ex. 2001, 3 (definition of "any" and "all"). This request relates to "any" testing, analysis or experimentation of the products regardless of its relationship to the challenged claims. Patent Owner's First Set of Document Requests asks that Petitioner produce "[c]opies of *any and all* documents and things identified in your responses to 'Patent Owner's Interrogatories to Petitioner' served concurrently herewith." Ex. 2002, 3 (emphasis added). To the extent that this request is tied to Interrogatories Nos. 1, 3, and 5, the First Set of Document Requests also does not satisfy the requirements of *Garmin* Factor 1.

Patent Owner's Requests for Admission Nos. 7 and 9 suffer the same deficiencies. In Request No. 8, Patent Owner asks that Petitioner:

8. Admit that prior to January 25, 1999, except for Aqua Products' pool cleaners, Zodiac was unaware of any commercially available robotic pool cleaner that used pumped water for purposes of creating directional movement to the pool cleaner.

Ex. 2003, 3. Patent Owner does not limit Request No. 8 to "jet drives" or to "jet drive technology," but, instead, asks Petitioner to admit that it was unaware of any pool cleaner using pumped water in any manner to create directional movement of

the pool cleaner. Patent Owner fails to demonstrate a nexus between Petitioner's lack of awareness of such systems and the subject matter of the challenged claims.

In sum, Patent Owner has not shown that it is in possession of "evidence tending to show beyond speculation" that, in fact, something useful will be uncovered by the requested discovery. Patent Owner also has not established the requisite nexus between the information sought and the subject matter of the challenged claims. Therefore, we are persuaded that Patent Owner's Interrogatories, First Set of Document Requests, and Requests for Admission fail to satisfy the requirements of *Garmin* Factor 1.

2. *Garmin* Factor 3

Patent Owner acknowledges that it has evidence of its own communications with Petitioner. Mot. 2. Patent Owner alleges, however, that Petitioner is in the *unique* position of having the records of its observations, the reasons for its prior lack of adoption of jet drive technology, and the results of the tests Petitioner may have conducted on Patent Owner's jet drive robotic cleaners. *Id.* Nevertheless, Patent Owner's motion for additional discovery is not limited to the information *uniquely* in the possession of Petitioner. Patent Owner's Interrogatories Nos. 2, 3, 4, and 5 (Ex. 2001, 4-5); First Set of Document Requests (Ex. 2002, 3); Requests for Admission Nos. 1-6 (Ex. 2003, 2) each broadly encompasses materials which, without further explanation, Patent Owner should be able to "reasonably figure out or assemble" by means other than a motion for additional discovery. IPR2012-00001, Paper No. 26 at 7; *see* Opp. 9.

For example, Interrogatory No. 2 requests that Petitioner "[s]tate whether Zodiac has ever met with Aqua Products in Cedar Grove, New Jersey and, if so, state the date, time, place, participants and nature of such meetings." Ex. 2001, 4; *see also* Ex. 2001, 5 (Interrogatory No. 4 requesting similar information

concerning a meeting between Patent Owner and Petitioner in California). Mr. Erlich, President and a primary principal of Patent Owner from 1999-2008, states that representatives of Petitioner toured Patent Owner's facilities and observed products and manufacturing operations. Erlich Declaration, Ex. 2004, ¶ 8. Thus, Patent Owner fails to demonstrate why the requested information could not be obtained from internal sources, including Mr. Erlich. Patent Owner's First Set of Document Requests asks that Petitioner produce "[c]opies of any and all documents and things identified in your responses to 'Patent Owner's Interrogatories to Petitioner' served concurrently herewith." Ex. 2002, 3. To the extent that this request, if granted, would require Petitioner to provide to Patent Owner documents that Patent Owner previously had provided to Petitioner, it too fails to satisfy the requirements of *Garmin* Factor 3. *See* Ex. 2004, ¶ 8.

The Requests for Admission are similarly deficient. For example, with respect to Request for Admission No. 1 (Ex. 2003, 2), Patent Owner requests that Petitioner "admit" that Patent Owner met with Petitioner in New Jersey. For the reasons set forth above, and to the extent that this request for admission is not redundant in view of Interrogatory No. 2, discussed above, Patent Owner fails to demonstrate why the requested information could not be figured out or assembled from internal sources, including Mr. Erlich. *See* Ex. 2004, ¶ 8. Similarly, Request No. 2 requests that Petitioner admit that Patent Owner provided designs, engineering and technical specifications to Petitioner during the meetings between the parties in New Jersey.¹ Ex. 2003, 2. For the reasons set forth above, and to the extent that this request for admission is not redundant in view of Interrogatory No.

¹ Requests for Admission Nos. 3 and 4 are substantially similar to Requests for Admission Nos. 1 and 2, but refer to events that occurred in California. Ex. 2003, 2.

3, discussed above, Patent Owner fails to demonstrate why the requested information could not be figured out or assembled from internal sources, including Mr. Erlich. *See* Ex. 2004, ¶ 8. Finally, with respect to Requests Nos. 5 and 6 (Ex. 2003, 2), Patent Owner requests that Petitioner admit that Patent Owner's own invoices dated July 29 and 31, 2008, are true and correct copies (*id.*). Without further explanation, Patent Owner fails to demonstrate why it would not be able to verify that its Exhibits 1 and 2 to Ex. 2003 are true and correct copies of its own invoices. Thus, the Requests for Admission also fail to satisfy the requirements of *Garmin* Factor 3.

CONCLUSION

For the foregoing reasons, Patent Owner has not met its burden of demonstrating that the additional discovery requested is in the interest of justice. Patent Owner's motion for additional discovery is *denied*.

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