

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEYER PRODUCTS, LLC,
Petitioner,

v.

DOUGLAS DYNAMICS, L.L.C.,
Patent Owner.

Case IPR2015-01247
Patent 6,928,757 B2

Before MICHAEL W. KIM, JAMES A. TARTAL, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

A conference call in the above-referenced proceeding was held on September 11, 2015, among respective counsel for the parties, and Judges Kim, Tartal, and Worth. Patent Owner requested the call (1) to inquire as to the status of Petitioner's request for rehearing (Paper 10) and (2) for authorization to file a motion for additional discovery, specifically seeking

the following. Patent Owner stated that it had in its possession eight (8) documents which Petitioner had produced in December as part of discovery in a co-pending matter in the U.S. District Court for the District of Wisconsin. *Douglas Dynamics, LLC vs. Meyer Products, LLC*, Case No. 3:14-cv-00886 (W.D. Wis.).

Patent Owner acknowledged that the documents Patent Owner possessed as a result of the District Court proceeding were governed by a Protective Order issued by the District Court in that proceeding, that the Protective Order was already in effect at the time it received the documents from Petitioner, and that the Protective Order prohibited the use of the documents for any purpose outside of the District Court proceeding without the permission of Petitioner. In response to a question from the panel, Patent Owner stated that there are no other exceptions to the Protective Order. Patent Owner argued that the use of the documents in this proceeding would satisfy the factors for discovery enumerated by the Board in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative), and additionally cited *Brunswick Corp. v. Cobalt Boats, LLC*, Case IPR2015-01060 (PTAB Dec. 28, 2015) (Paper 15). Patent Owner suggested that the panel could protect the information subject to a Board protective order.

Petitioner disagreed that the *Garmin* factors would be satisfied, in particular, because of the risk of disclosure of sensitive information, and additionally cited the Board's implementation of discovery rules at 77 Fed. Reg. 48611.

In view of the facts of this case, the panel cannot entertain a request for discovery of the information Patent Owner has obtained from the District

Court proceeding, governed by the District Court's Protective Order, unless and until Patent Owner has obtained permission from Petitioner or authorization from the District Court. Although a Board Protective Order might protect submitted exhibits, the relevant question here, based on the representations of the parties, is whether Patent Owner is complying with the District Court's own Protective Order. That is a question that only the District Court can answer. If Patent Owner wishes to pursue this matter, it must first seek such guidance from the District Court for relief in the first instance. The parties may update the panel if there is a change in the status of this matter.

As to Petitioner's request for rehearing of the Decision on Institution, the panel advised the parties that a decision thereon will be forthcoming. The panel advised Patent Owner to proceed according to the schedule set forth in the Scheduling Order. Paper 9.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the request for authorization to file a motion for additional discovery is denied; and

FURTHER ORDERED that no further motions are authorized at this time.

IPR2015-01247
Patent 6,928,757 B2

PETITIONER:

John M. Skeriotis
Sergey Vernyuk
EMERSON THOMSON BENNETT, LLC
jms@etblaw.com
sv@etblaw.com
iplaw@etblaw.com

PATENT OWNER:

Aaron T. Olejniczak
Christopher R. Liro
Edward R. Williams
ANDRUS INTELLECTUAL PROPERTY LAW, LLP
aarono@andruslaw.com
chris.liro@andruslaw.com
ewilliams@andruslaw.com