

PTAB okays expanded expert testimony with reply, but denies request for responsive discovery and surreply expert testimony

SEPTEMBER 25, 2020

Club Champion LLC v. True Spec Golf LLC, Case IPR2019-01148, Paper 49 (July 2, 2020), Before: Patrick R. Scanlon, Kevin W. Cherry, and Scott C. Moore.

Patent Owner filed a motion to strike 30+ paragraphs of new expert testimony submitted with the Petitioner's reply. The new testimony related to product testing that supported the discussion in the original expert declaration as to how a prior art combination would result in a secure product with the same performance. Patent Owner also requested additional discovery, and to submit an expert declaration with its sur-reply, if the motion to strike was denied.

With respect to the motion to strike: the panel stated that "it would be improper to permit Petitioner to supplement the single paragraph of testimony [in the original expert declaration] with 34 new paragraphs of testimony and 8 new exhibits that were not disclosed until the Reply." The panel reasoned that 37 C.F.R. § 42.104(b)(5) requires "Petitioner to identify with specificity and in the Petition all evidence that supports its arguments of unpatentability." Thus, the panel barred Petitioner from relying upon the new testimony and exhibits "as affirmative evidence in support of the contentions set forth in the Petition."

However, the panel allowed Petitioner to rely upon the additional testimony and evidence for other purposes. Reliance was permitted for the limited purpose of rebutting Patent Owner's arguments against the prior art combination. Additionally, reliance was permitted in response to Patent Owner's motion to amend.

With respect to Patent Owner's contingent request for discovery and sur-reply expert testimony: the panel denied the requests as moot. The panel reasoned that there is no need for additional discovery or testimony given the limitation to how Petitioner can rely on the new materials.

Furthermore, the PTAB found that the *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) factors did not weigh in favor of finding that additional discovery should be allowed in the interest of judgment. Here, *Garmin* Factor 1 (whether there is more than a mere possibility or allegation that something useful will be found) and Factor 3 (the requesting party's ability to generate equivalent information by other means) weighed against discovery because the Patent Owner had the ability to inspect the products tested and described in the new exhibits and had not otherwise "demonstrated more than a mere possibility that [additional] testing would uncover useful evidence." *Garmin* Factor 5 (whether the requested

discovery is overly burdensome) also weighed against the requested discovery because Petitioner would have to incur the expense of creating additional prototypes for Patent Owner to test. Also, Patent Owner's request for information through interrogatory discovery could be obtained through the less burdensome process of cross-examining Petitioner's expert. The panel did not address *Garmin* Factors (whether the requesting party seeks the other party's litigation positions and the underlying basis for those positions) or Factor 4 (whether the instructions are easily understandable).

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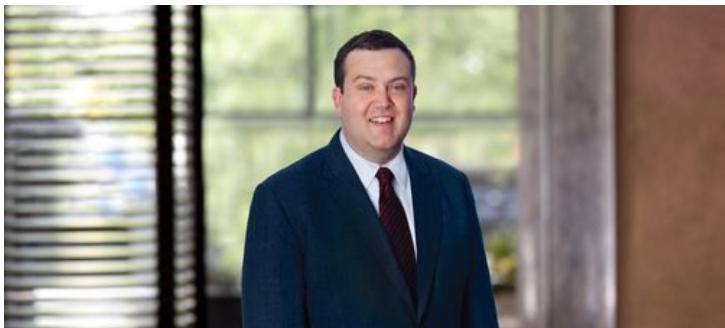
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