

International Securities Exchange, LLC v. Chicago Board Options Exchange, Incorporated, Decision Granting Additional Discovery IPR2014-00097, 98

Article By:

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Takeaway: Potentially inconsistent statements made in patent applications that are not publicly available could provide the basis for a successful motion for additional discovery.

In its [Decision](#), the Board granted Patent Owner's Motion for Additional Discovery. In particular, the Board ordered Petitioner to provide a copy of the complete file history of one of Petitioner's patent applications that had gone abandoned.

Patent Owner contended that during prosecution of the now abandoned application, Petitioner had made statements about one of the prior art references asserted in the instant proceedings that are inconsistent with positions taken in the Petitions. Portions of the file history of the application were produced, and the complete file history is not available publicly. Patent Owner argued that the complete history is needed in order to place the inconsistent statements into context. Petitioner did not oppose the requested discovery or indicate any confidentiality issues with the file history.

The Board stated that a party seeking discovery beyond what is expressly permitted by rule "must show that such additional discovery is 'necessary in the interest of justice.'" The Board was persuaded that the requested discovery met this standard and satisfied the factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26). In particular, Patent Owner's request was "narrow, easily understandable, and not unduly burdensome, and demonstrates more than a mere possibility of uncovering something useful." The requested discovery could not be reasonably obtained without a discovery request and was not related to Petitioner's litigation positions.

International Securities Exchange, LLC v. Chicago Board Options Exchange, Incorporated, IPR2014-00097; IPR2014-00098

Paper 20: Decision on Patent Owner's Motion for Additional Discovery

Dated: July 14, 2014

Patents: 7,356,498 B2 (IPR2014-00097); 7,980,457 B2 (IPR2014-00098)

Before: Justin T. Arbes and James B. Arpin

Written by: Arbes

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