

## **Atlanta Gas Light Company v. Bennett Regulator Guards, Inc.: Granting and Denying in Part Motion for Additional Discovery IPR2013-00453**

Article By:

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*Takeaway: Depositions of any witnesses submitting affidavits or declarations are considered routine discovery under 35 U.S.C. § 316(a)(5).*

In its [Order](#), the Board granted in part and denied in part Patent Owner's Motion for Additional Discovery. Before the depositions of two of Patent Owner's witnesses, Patent Owner objected to the qualifications of the videotape operator and court reporter based upon the assertion that there is a contractual relationship between them and Petitioner's counsel that calls into question their objectivity. Patent Owner then filed a motion to exclude the deposition testimony of both witnesses asserting that the court reporter was not authorized by law to take the depositions in violation of 35 U.S.C. § 23, 37 C.F.R. § 42.53(f), and Federal Rule of Civil Procedure 30(b)(5), asserting specifically that Petitioner's counsel's law firm has a contract with the reporting firm that employed the court reporter. Patent Owner argued that the contractual relationship calls into question the impartiality of the reporter rendering the deposition testimony inadmissible. In opposition to the motion to exclude, Petitioner denied the existence of the contract and supported its opposition with the declaration of the general manager of the reporting firm that employed the reporter. Patent Owner's Motion for Additional Discovery requested document production and the deposition of Petitioner's declarant to support its motion to exclude.

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." Therefore, the Board authorized cross-examination of the declarant concerning her declaration as routine discovery. The Board noted that document production is outside of the scope of routine discovery, and referenced the *Garmin* factors for whether additional discovery is in the interests of justice. The Board found that Patent Owner did not demonstrate that the authorized cross-examination of the declarant is insufficient to gain the information that it seeks. Therefore, the Board denied authorization for the document production sought by Patent Owner.

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Paper 80: Order on Motion to Exclude

Dated: October 6, 2014

Patent 5,810,029

Before: Jennifer S. Bisk, James B. Arpin, and Patrick M. Boucher  
Written by: Boucher

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National Law Review, Volume IV, Number 282

Source URL: <https://natlawreview.com/article/atlanta-gas-light-company-v-bennett-regulator-guards-inc-granting-and-denying-part-m>