

# Additional Discovery In Inter Partes Reviews—Absolutely No Fishing Allowed

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When **Congress** first announced the ***Leahy-Smith America Invents Act***, it was well-publicized that the new Post-Grant proceedings, including ***Inter Partes Reviews*** (IPR), would allow discovery. In keeping with its goal of providing quicker and more cost-effective alternatives to conventional litigation, however, Congress made clear that it wanted the discovery to be limited in scope. Not surprisingly, the Patent Trial and Appeal Board (PTAB) has followed the directive of Congress to keep the scope of discovery very narrow. In addition to avoiding the fishing expeditions, harassment and bitter discovery disputes traditionally associated with discovery in district court litigation, the PTAB reigns in the scope of IPR discovery for an even more selfish reason—the need to meet the one-year statutory deadline for issuing final written decisions.

The Rules provide for two types of discovery: (1) routine discovery, and (2) additional discovery. Routine discovery is limited to the production of “any exhibit cited in a paper or testimony” and “relevant information that is inconsistent with a position advanced during the proceeding.” The most common use of routine discovery is the cross-examination through deposition of declarants. Often, both the petitioner and the patent owner rely on declaration testimony to establish and support their respective positions. Using routine discovery, the opponent is entitled to depose the declarant in relation to the content of the declaration.

All requests that fall outside the purview of routine discovery are considered to be requests for additional discovery, and in IPR, must be made in the form of a motion asserting that the discovery is “in the interest of justice.” Over the first two years of AIA trials, the PTAB has established strict criteria for determining what qualifies as appropriate additional discovery. Only if the PTAB decides

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that all of these criteria are met will it allow the limited additional discovery. Known as the Garmin factors, the criteria are:

1. Requester is in possession of evidence tending to show beyond speculation that the requested discovery seeks existing, useful documents.
2. Requester is not asking for litigation positions.
3. Requester cannot obtain the information by other means.
4. The discovery requests are easy to understand.
5. The discovery requests are not overly burdensome.

The first factor has been an important mechanism used by the PTAB to prevent fishing expeditions. PTAB Chief Judge James Smith expounded on this factor in a PTAB “boardside chat” webinar on February 3, 2015, stating:

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.

The PTAB frequently cautions parties seeking additional discovery to tailor their motions narrowly to *specific documents* being sought. The first criteria has been used effectively to keep the scope of additional discovery focused and narrow. A requester cannot engage in a fishing expedition in the hopes of uncovering some damaging evidence, but instead, must already have evidence that specific documents exist in order to convince the PTAB that the requested discovery is in the interest of justice.

The remaining Garmin factors work in conjunction with the first factor to further limit the boundaries of additional discovery. No litigation positions can be sought, nor can a requester seek information through discovery that it could obtain through other means. The fourth factor ensures that the requests are clearly written, which in conjunction with the PTAB’s directive to tailor the motion to specific documents, requires direct and succinct “asks” for the additional discovery documents. Finally, the last factor is intended to prevent requests that would impose burdens on the parties or the Board that would jeopardize the PTAB’s ability to meet the one-year statutory deadline, such as excessive cost or time to locate documents.

Requests for additional discovery are most often made seeking information relevant to objective evidence of nonobviousness. Examples include evidence tending to prove or disprove the secondary considerations of commercial success, copying, and long-felt need. Next in frequency are requests for information relevant to who is a real party-in-interest. This second category is likely to remain prevalent given recent decisions refusing to institute trial and dismissing a trial that had been instituted for failing to properly identify the real parties-in-interest.

While additional discovery is available, it is important to understand the limited circumstances under which it will be granted. Having some evidence that specific, relevant documents exist, and then being able to clearly and succinctly identify those documents, without posing an undue production

burden, is the threshold for any motion to request additional discovery. Although these criteria have become well established, and presumably are addressed in every request to seek additional discovery, a majority of the requests for additional discovery continue to be denied by the PTAB as not meeting the Garmin factors.

### Practice Tips

- Provide sufficient information to show that the information requested actually exists.
- Limit the requests to the minimum amount of information that might be sufficient to establish or refute a claim or defense.
- Provide brief and clear instructions regarding the requests. In other words, do not use instructions typically found in document requests in district court litigation.

### Trends at the Board

During the first six months of the current fiscal year, more than 1,000 AIA petitions have been filed. At this rate, the total number of AIA petitions is projected to exceed by more than 500 AIA petitions the total number of petitions filed during the last fiscal year.

#### **IPR Trends at the Board Sept. 2012 — April 2015**

Petitions Filed	3,176
Petitions Denied	493 (25%)
Trials Instituted	1,360 (75%)
Trials Dismissed/Settled	671
Final Written Decisions	386

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