

US: PATENTS



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considered before determining whether the claimed invention would have been obvious” (*Apple v ITC* (Fed Cir 2013)(emphasis added); see also *Leo v Rea* (Fed Cir 2013)), it has yet to opine on the PTAB’s use of the first *Garmin* factor to deny objective indicia discovery. At least until the Federal Circuit considers the issue, patent owners defending their patents in IPR proceedings may need to rely on public evidence of objective indicia wherever possible.

High bar for additional discovery in IPRs

Inter partes review (IPR) proceedings provide a faster and cheaper alternative to litigation on the issues of anticipation and obviousness. To increase speed and reduce cost, the IPR rules significantly limit one of the most time-consuming and costly aspects of litigation: fact discovery.

Unfortunately for patent owners, evidence required to show objective indicia of non-obviousness such as copying and commercial success often resides in the patent challenger’s corporate documents, which must be obtained through discovery. In IPRs, such evidence may be sought via a motion for “additional discovery” under Rule 42.51(b)(2), which requires the movant to establish that the discovery sought is “necessary in the interest of justice”. The “interest of justice” analysis involves a five-factor test set forth by the PTAB in *Garmin*.

The PTAB has denied almost every motion for additional discovery that has been filed, and motions seeking evidence of copying and commercial success have uniformly been denied based on the first *Garmin* factor, namely that the movant “should already be in possession of a threshold amount of evidence tending to show beyond speculation that something useful will be uncovered”. Because such evidence is unlikely to be in a patent owner’s possession before any discovery has taken place, this standard will not often be met.

If a patent owner is involved in a co-pending district court litigation, it may be possible to import litigation discovery into the IPR. Patent owners can also leverage objective indicia such as long-felt need, scepticism and praise, which can often be supported by publicly available evidence such as other patents and peer-reviewed literature.

While the Federal Circuit has recently held that objective indicia “must be