



PTAB: Discovery Requests Targeting Objective Evidence of Nonobviousness Denied Under Garmin Framework

Apr 26, 2021

Reading Time : **3 min**

By: Anthony David Sierra, Rubén H. Muñoz

Patent owner requested documents relating to a marketing video, U.S. and worldwide sales of a petitioner's purportedly infringing systems, and first release dates of those systems. Patent owner also requested technical documents that had been largely produced by other petitioners, real parties-in-interest, and third parties in a co-pending district court litigation.

In support of the first *Garmin* factor, patent owner argued that it had viewed public documents that indicated petitioners' use of its systems in an infringing manner, and that petitioners had experienced commercial success as a result of selling the systems. Furthermore, patent owner argued that the requested documents would confirm the extent of commercial success attributable to patent owner's invention. Patent owner also argued that its counsel had firsthand knowledge that the evidence was highly relevant to commercial success and to copying of the claimed invention, and that this knowledge was based on review of the requested documents in a co-pending district court litigation.

Petitioners responded by arguing that patent owner did not show how the requested documents showed infringement, commercial success, or a nexus between the claims and commercial success. Instead, petitioners argued that the products in question were not infringing, that the alleged commercial success related to a feature that was within the scope of claims previously invalidated by the PTAB and found in the prior art, and that patent owner failed to show how dates of first release would help establish commercial success. As for the technical documents subject to the discovery requests, petitioners stated that a mere review by patent owner's counsel, a general description of the documents, and a statement that the

documents were relevant was insufficient, particularly because the description indicated that some of the documents were technical in nature and thus not helpful in assessing commercial success.

For the second *Garmin* factor, patent owner argued that the documents had already been produced in co-pending district court litigation, and those that had not related to secondary considerations of nonobviousness, not the parties' litigation positions or the basis for any litigation position.

Regarding the third *Garmin* factor, patent owner emphasized that it could not independently obtain the information because it related to information internal to petitioners. In response to the request for the technical documents, petitioners noted that patent owner could have obtained the requested information without discovery by asking the district court for permission to use the documents or using procedures in the court's protective order to use the requested documents in the current proceedings.

For the fourth factor, patent owner argued that its requests identified document types in sufficient detail to explain the scope of discovery. Patent owner added that, for certain documents, it had provided specific Bates numbers as well. For their part, petitioners argued that the requests were unclear because certain terms were vague in what they required.

Finally, patent owner argued that it met the fifth factor because its requests included only information that petitioners necessarily possessed and that was necessary to support patent owner's commercial success arguments, and that patent owner would work to keep all confidential information protected. Petitioners responded that the requests were unduly burdensome because patent owner agreed that the products did not themselves infringe, petitioners did not have the requested documents, and that in any event, the requested documents would be voluminous.

The PTAB concluded that patent owner had not met its burden of showing that the additional discovery was in the interests of justice, focusing primarily on the first, third and fifth *Garmin* factors. The video touting the benefits of one of petitioners' products did not provide any technical details that could be compared to the challenged claims nor suggested a nexus between the challenged claims and the systems discussed in the video. In the same vein, sales figures for some of petitioners' systems or dates of first release did not support a showing of required nexus or that petitioner copied the claimed invention. Regarding technical documents, the PTAB agreed that patent owner's own description of the

documents indicated that they related to technical information, and so would not be likely to support a showing of nexus, commercial success, or copying. It was also unconvinced that patent owner could not generate equivalent information by other means, and emphasized that the number of documents it was requesting was overly burdensome in light of the expedited nature of the proceedings. Therefore, the motion was denied.

Practice Tip: To establish “beyond speculation” that useful objective indicia evidence will be uncovered from discovery, the moving party should demonstrate with specificity how the requested documents and information are relevant to the ultimate question of nonobviousness. Mere assertions that the documents are relevant or short descriptions of the contents will not meet this threshold, particularly where the requested documents do not clearly align with the elements supporting nonobviousness (e.g., technical documents that would not at first glance establish commercial success).

Case: *Atlas Copco Tools and Assembly Systems LLC v. Wildcat Licensing WI LLC*; IPR2020-00891/IPR2020-00892, Paper 37 (PTAB Mar. 18, 2021)

Categories

Patent Trial & Appeal Board

Non-Obviousness

Inter Partes Review

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.