



## **Prior Art That Was Considered but Not Relied Upon by an Expert is Fair Game for Discovery in IPRs**

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By: Matthew George Hartman, Rubén H. Muñoz

Petitioner Adobe Inc. initiated IPR proceedings against Patent Owner RAH Color Technologies LLC over four patents claiming a “system for distributing and controlling color reproduction at multiple sites.” On October 24, 2019, Patent Owner deposed Petitioner’s expert and asked three questions about the expert’s review of prior art: (1) whether the expert performed any prior art search, (2) whether the expert considered claim charts comparing the patents at issue to the prior art and (3) whether the expert determined that any prior art references rendered the patents at issue obvious. Petitioner instructed its expert not to answer these questions, invoking attorney work product protections and Rule 26 of the Federal Rules of Civil Procedure. On October 25, after a telephonic conference with the parties, the three-judge PTAB panel authorized the parties to submit briefing on the issue.

In support of its motion to compel testimony, Patent Owner argued that facts and data underlying an expert opinion are not only relevant to IPR proceedings, but necessary to assess the expert’s independence, reliability and credibility. Patent Owner further argued that Rule 26 does not apply to IPR proceedings, but even if it did, the rule would, nonetheless, compel disclosure of the facts and data that an expert considered. The Board agreed that the Patent Owner’s questions concerned underlying factual bases, not attorney communications or the content of prior art, and thus were within the scope of permissible discovery. The panel also credited the argument that Rule 26 would compel disclosure of underlying facts and data, even if the Federal Rules applied to IPR proceedings.

Turning to Petitioner’s assertions, the PTAB rejected the argument that prior art on which the Board had not instituted review was outside the scope of discovery. On the contrary, according to the Board, if expert testimony is to be given any weight, a party must disclose all art considered and reviewed in preparation of the testimony. The Board also disagreed that Patent Owner’s line of questioning would reveal the analysis and strategy of Petitioner’s attorneys, because Patent Owner asked for only the identities of the documents that Petitioner’s expert reviewed. The Board distinguished this inquiry from questions about attorney communications and suggestions for editing and drafting an expert opinion.

The PTAB ultimately granted Patent Owner’s motion, but—in the interest of efficiency—treated the questions as interrogatories and ordered Petitioner’s expert to provide certified written responses to be filed within a week of the order.

### Practice tip

Though the scope of allowable discovery is more limited for IPR proceedings than for district court litigation, a party to an IPR may seek and obtain discovery related to the underlying facts and data informing the opinion of an opposing party’s expert. This includes prior art considered, but not relied upon by the expert in forming his or her opinions.

*Adobe Inc. v. RAH Color Technologies LLC*, IPR2019-00627, IPR2019-00628, IPR2019-00629, IPR2019-00646 (PTAB December 12, 2019)

## Categories

Patent Trial & Appeal Board

Prior Art

Inter Partes Review

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