

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLUB CHAMPION LLC,
Petitioner,

v.

TRUE SPEC GOLF LLC,
Patent Owner.

IPR2019-01148
Patent 8,046,899 B2

Before PATRICK R. SCANLON, KEVIN W. CHERRY, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER

Denying Motion to Strike and Contingent Motion for Additional Discovery
Limiting Admissibility of Evidence
37 C.F.R. §§ 42.5(a), 42.7(a), 42.20, 42.51(b)(2)

I. INTRODUCTION

Patent Owner contacted the Board via email on June 1, 2020, requesting authorization to file a motion to strike, or alternatively, for additional discovery. We granted Patent Owner leave to file its motion. Paper 39.

On June 8, 2020, Patent Owner filed its Motion to Strike New Testing Evidence Submitted in Reply and Contingent Motion for Additional Discovery. Paper 40 (“Motion” or “Mot.”). In its Motion, Patent Owner moves to strike “the testimony at paragraphs 32 and 81–114 of the supplemental Vincent Declaration (Ex. 1023), supporting Exhibits 1057– 59, 1061–65, and associated argument on pages 9–10 of Petitioner’s Reply (Paper 35) and page 17 of Petitioner’s Opposition to [Patent Owner’s] Motion to Amend (Paper 36).” Mot. 1. Patent Owner contends that these materials are an “improper attempt to fill in evidentiary gaps in the Petition.” *Id.* at 3.

In the event we decline to strike the above materials, Patent Owner seeks authorization to file an expert declaration with its sur-reply, as well as the following additional discovery:

Patent Owner’s motion seeks production of: (1) the golf clubs and golf club parts depicted in Petitioner’s Exs. 1057–59; (2) underlying testing reports and data considered by Dr. Vincent; and (3) test data or results inconsistent with Ex. 1023. The physical products are to be delivered to Patent Owner’s expert for testing. *See* Ex. 1023 ¶ 96. Patent Owner further seeks an answer to the following single interrogatory: “Has Petitioner or its representatives conducted any tests of the golf clubs and golf club parts depicted in Petitioner’s Exs. 1057–59, the results of which were not provided to Dr. Vincent?”

Mot. 8–9. Patent Owner contends that authorizing this discovery and permitting an expert declaration with the sur-reply will “partially mitigate the prejudice” allegedly resulting from Petitioner’s reliance on the contested materials. *Id.* at 8.

Petitioner subsequently filed an Opposition to the Motion. Paper 44 (“Opposition” or “Opp.”). In its Opposition, Petitioner argues that the contested evidence should not be excluded because it is proper reply evidence, and because it does “‘not raise a new theory of unpatentability . . . ,’ but instead ‘support[s] the initial arguments raised in the Petition and directly respond[s] to Patent Owner’s arguments about reasonable expectation of success.’” Opp. 4–5 (citation omitted). Petitioner also indicates that it served the testing data and results on May 20, and that Patent Owner inspected, photographed, and videotaped the contested golf clubs on June 12, 2020. Petitioner also notes that Patent Owner will cross-examine Dr. Vincent (the author of the contested declaration) before the sur-reply is due. *Id.* at 6–7.

After the Opposition was filed, Patent Owner requested, and was granted, leave to file a short Reply. Paper 46, 1 (“Reply”). In its Reply, Patent Owner asserts that Patent Owner was not permitted to perform tests on the disputed golf clubs, and that Petitioner has refused to produce for inspection “dozens of shafts and heads from Ex. 1057, even though Dr. Vincent relies on them.” *Id.*

II. DISCUSSION

A. Motion to Strike

A petition for *inter partes* review must identify “[t]he exhibit number of the supporting evidence relied upon to support the challenge and the

relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5).

Here, the Petition alleges that one of ordinary skill in the art “would have been motivated to modify or combine Burrows ’269 to implement a shaft-head interface design in which the shaft is axially spaced from the golf club head hosel.” Paper 1 (“Petition” or “Pet.”), 62. In particular, the Petition alleges that the connection between the golf club head and shaft in such an embodiment would remain secure, and that performance would remain the same or improve. *Id.* at 64–65 (citing Ex. 1002 ¶ 133). The cited portion of Dr. Vincent’s initial declaration explains that one of ordinary skill in the art would have understood that the connection between the club head and shaft could remain secure in such a modified embodiment, that implementing such a secure connection would have been a “routine design task,” and that this type of modification would have improved performance by reducing the weight of the “unnecessary portion of the shaft.” Ex. 1002 ¶ 133. Dr. Vincent relies solely on the knowledge that would have been had by one of ordinary skill in the art. He cites no publications, empirical evidence, or test results to support his opinions that a modified embodiment would retain a secure connection between the club head and shaft, and would perform better than an unmodified club. *See id.*

The objected-to portions of the second Vincent declaration (Ex. 1023, ¶¶ 32 and 81–114) contain extensive additional support for Petitioner’s assertion that a modified Burrows ’269 embodiment would retain a secure club head to shaft connection, and would have similar or improved performance. These 34 paragraphs contain descriptions of several tests that

were performed on modified embodiments of Burrows '269, and detailed explanations of why these test results allegedly support Petitioner's assertion. *See* Ex. 1023, ¶¶ 32, 81–114. The objected-to exhibits depict modified and unmodified clubs and shafts (Exs. 1057–59) and test results (Ex. 1065), and also include several articles relevant to golf club performance (Exs. 1061–64).

We agree with Patent Owner that it would be improper to permit Petitioner to supplement the single paragraph of testimony that was cited for a particular purpose in the Petition, with 34 new paragraphs of testimony and 8 new exhibits that were not disclosed until the Reply. To permit this type of conduct would effectively eviscerate 37 C.F.R. § 42.104(b)(5), which requires Petitioner to identify with specificity and in the Petition all evidence that supports its arguments of unpatentability. Accordingly, Petitioner will not be permitted to rely on paragraphs 32 and 81–114 of Exhibit 1023, or Exhibits 1057–59 and 1061–65, as affirmative evidence in support of the contentions set forth in the Petition.

As Petitioner notes, however, the objected-to materials also are responsive to two declarations that Patent Owner submitted with its Response. Opp. 2–3 (citing Exs. 2018, 2024). Patent Owner does not offer any persuasive argument regarding why Petitioner should not be permitted to rely on these materials for the limited purpose of rebutting the opinions set forth in the two declarations submitted with the Response. Accordingly, we are not persuaded that Petitioner should be precluded from relying on these materials to rebut the opinions set forth in Exhibits 2018 and 2024.

In addition, Patent Owner has not offered any persuasive argument as to why Petitioner should be precluded from relying on these materials in

opposition to the Motion to Amend. When a Patent Owner files a motion to amend, a Petitioner is permitted to raise new evidence and arguments to challenge the patentability of the proposed amended claims. Patent Owner will have an adequate opportunity to respond to these arguments by submitting any desired rebuttal evidence in its reply brief. We are not persuaded on this record that Petitioner should be precluded from relying on the objected-to materials in its opposition to the Motion to Amend.

For the foregoing reasons, we limit the admissibility of paragraphs 32 and 81–114 of Exhibit 1023, and Exhibits 1057–59 and 1061–65, but decline to strike these materials, or corresponding portions of Petitioner’s Reply and Petitioner’s opposition to the Motion to Amend. Petitioner may rely on paragraphs 32 and 81–114 of Exhibit 1023, and Exhibits 1057–59 and 1061–65 in opposition to the Motion to Amend (including a revised Motion to Amend), and to rebut opinions set forth in Exhibits 2018 and 2024. Petitioner, however, may not rely on these materials as additional evidentiary support for the arguments for unpatentability set forth in its Petition.

B. Motion for Additional Discovery

We may order additional discovery if the moving party shows “that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). The Board has identified several factors (“the *Garmin* factors”) that are important in determining whether additional discovery is in the interests of justice. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative). Those factors include: 1) whether there is more than a mere possibility or allegation that something useful will be found; 2) whether the

requesting party seeks the other party's litigation positions and the underlying basis for those positions; 3) the requesting party's ability to generate equivalent information by other means; 4) whether the instructions are easily understandable; and 5) whether the requested discovery is overly burdensome. *Id.*

Patent Owner's contingent request for additional discovery is premised on the prejudice allegedly resulting from Petitioner's alleged use of its Reply to improperly bolster its Petition and fill gaps in the evidence cited in the Petition. *See* Mot. 4, 8–9. As discussed above, we are precluding Petitioner from using the objected-to testimony and exhibits for this allegedly improper purpose. This ruling alleviates the prejudice upon which Patent Owner's request for discovery is premised. In addition, for the reasons discussed below, the *Garmin* factors and the interests of justice do not justify granting Patent Owner's request for additional discovery.

Patent Owner's request for production of the golf clubs and parts depicted in Exhibits 1057–1059 was partially addressed by Petitioner's offer to make these clubs available for inspection. Though Petitioner did not allow Patent Owner to test the clubs, nothing precludes Patent Owner from creating and testing its own prototypes to confirm or refute Dr. Vincent's results, and Patent Owner has not demonstrated more than a mere possibility that testing would uncover useful evidence. Thus, *Garmin* factors 1 and 3 weigh against compelled discovery. Factor 5 also weighs against production because Patent Owner has offered no persuasive argument regarding why Petitioner should be required to bear the burden and expense of creating prototypes for Patent Owner to test. Patent Owner has offered no persuasive evidence that it could not create and test its own prototypes.

Regarding the shafts and heads depicted in Exhibit 1057, we observe that it is unclear that these materials were relied upon by Dr. Vincent. The shafts and clubs depicted in Exhibit 1057 appear to be unmodified, commercially available products that Patent Owner could easily obtain. They do not appear to be the modified prototypes that Dr. Vincent tested. Thus, at least *Garmin* factors 1, 3, and 5 also weigh against compelled production of these materials.

Patent Owner's request for the test reports and data considered by Dr. Vincent seeks material that Dr. Vincent was required to disclose in or with his declaration. *See* 37 C.F.R. § 42.65; *see also* Fed. R. Evid. 702 (requiring the proponent of expert testimony to demonstrate, *inter alia*, that the testimony is based on sufficient facts or data, and is the product of reliable principles and methods). Accordingly, these materials are not "additional discovery" under our rules. *See* 37 C.F.R. § 42.51(b). To the extent these materials were not disclosed in the required manner, Patent Owner may challenge the admissibility of Dr. Vincent's opinions in a motion to exclude.

Petitioner also was required by our rules to disclose any test data or results inconsistent with Exhibit 1023, to the extent such materials are not covered by the attorney-client privilege or work product doctrine. *See* 37 C.F.R. § 42.51(b)(1)(iii). Accordingly, these materials also are not "additional discovery" under our rules. *See* 37 C.F.R. § 42.51(b). Patent Owner also does not offer any evidence that Petitioner has failed to comply with this obligation.

Finally, Patent Owner has not demonstrated more than a mere possibility that its interrogatory would yield useful information, and it

appears that Patent Owner could obtain the requested information by other, less-burdensome means, such as by through questions during Dr. Vincent's cross-examination. Accordingly, at least *Garmin* factors 1, 3, and 5 weigh against compelling Petitioner to answer Patent Owner's interrogatory.

C. Request to Submit Declaration with Sur-Reply

Patent Owner seeks to submit a declaration with its sur-reply in order to address the new evidence that Petitioner has allegedly used to improperly bolster and backfill the Petition. *See* Mot. 1, 8. Our decision limiting the admissibility of the objected-to testimony and exhibits addresses Patent Owner's concerns regarding the potential improper use of this evidence. Accordingly, we are not persuaded at this time that Patent Owner should be permitted to file new evidence with its sur-reply.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Motion to Strike New Testing Evidence Submitted in Reply and Contingent Motion for Additional Discovery (Paper 40) is *denied*; and

FURTHER ORDERED that Petitioner may rely on paragraphs 32 and 81–114 of the supplemental Vincent Declaration (Ex. 1023), and supporting Exhibits 1057–59, 1061–65, in opposition to a Motion to Amend (including a revised Motion to Amend), and to rebut opinions set forth in Exhibits 2018 and 2024, but Petitioner may not rely on these materials as additional evidentiary support for the arguments for unpatentability set forth in its Petition.

IPR2019-01148
Patent 8,046,899 B2

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