

## Cain, Brigit

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**From:** Gordon Lindeen <Gordon\_Lindeen@bstz.com>  
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I have just learned that the Interpartes Post Grant Review rules allows for limited discover and possible bigger discovery.

This is a very bad idea.

- 1) It is almost never necessary. Most countries of the world have no discovery even for trials. It is very rare that information obtained in discovery has any impact on the outcome except when calculating damages which the PGR will not do. Discovery did not exist in this country for the first 150 years.
- 2) It cannot be managed. Attorneys accustomed to discovery are accustomed to how it is done in federal district court. Most patent cases are discovery cases with extensive document requests and depositions and no trial. \$100,000's are spent going through boxes, attending depositions and arguing motions. The primary focus of discovery in patent cases is to find information to impugn the motives and intentions of the other side. These attorneys will bring this experience and habit to the PTAB. Notwithstanding the well-intentioned rules, the PTAB will, like federal district courts, be forced by many parties to be consumed with discovery motions, motions to compel and motions for protective orders.
- 3) The intended purpose of discovery can be replaced by hearings and cross-examination. Since the purpose of PGR is to be quick and inexpensive, the best course is to have hearings with cross-examination. If a witness presents something that surprises the other side and the other side is completely unprepared to answer the surprise, then a second hearing can be scheduled in a few weeks when a rebuttal has been prepared. If the parties come prepared, it would be rare to have more than three hearings.

**Gordon Lindeen | Partner**

**BSTZ | 8055 E. Tufts Ave., Suite 1300 | Denver, CO 80237-2835**

**Phone 303.740.1980 | Fax 303.740.6962**

**gordon\_lindeen@bstz.com | [www.bstz.com](http://www.bstz.com)**

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