

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKER BIOMARINE AS
Petitioner

v.

NEPTUNE TECHNOLOGIES AND BIORESSOURCES, INC.
Patent Owner

Case IPR2014-00003
Patent 8,278,351 B1

MOTION FOR ADDITIONAL DISCOVERY

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. 42.51(b)(1)(iii) and 37 C.F.R. 42.51(b)(2), Petitioner Aker BioMarine AS (“AKBM”) respectfully requests that the Board order Patent Owner Neptune Technologies and Bioresources, Inc. (“Neptune”) to produce:

- August 9, 2010 email to Tina Sampalis regarding CaPre (RX-0456C);
- Transcript of the deposition of Tina Sampalis, Volumes I–III;
- Report on NKO (RX-0398C);
- Transcript of the deposition of Pierre St-Jean;
- Exhibit 4 to the St-Jean deposition; and
- Exhibit 5 to the St-Jean deposition.¹

Far from “speculating” or “hoping,” AKBM *knows* these documents are within Neptune’s possession and contain information inconsistent with Neptune’s principal arguments attempting to distinguish the prior art Beaudoin I reference at the heart of this proceeding from the claims at issue. Neptune already produced these documents to AKBM and Enzymotec in a prior ITC Investigation, and its refusal to produce them here is a tacit acknowledgement that they hurt Neptune’s positions. The existence and damaging contents of the documents is not surprising, as the evidence already of record also shows Neptune’s arguments are wrong.

¹ Authorization for this motion was granted on August 26, 2014. *See* Order Conduct of Proceeding, Paper 79 (Sep. 3, 2014).

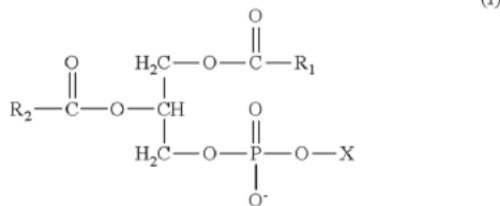
Neptune refuses to re-produce the documents in this proceeding (and thereby permit AKBM to submit them to the Board without running afoul of the protective order in the ITC Investigation), because Neptune claims (i) the Protective Order in this proceeding is insufficient to protect their confidentiality, and (ii) the documents are not relevant. Neptune, however, drafted and moved for entry of the Protective Order knowing full well it could govern the very documents AKBM seeks. Neptune shouldn't be allowed to use "deficiencies" of its own design, in an order to which it agreed, as a discovery escape hatch. Neptune's claim that its bad documents are not relevant also should not shield those documents from discovery, particularly where Neptune has blocked AKBM from addressing Neptune's relevance arguments by refusing to allow AKBM to discuss the documents' contents with the Board.

I. BACKGROUND

A. '351 Patent Claims

All of the '351 patent claims at issue in this proceeding² are directed to a "krill extract comprising" a phospholipid molecule as follows:

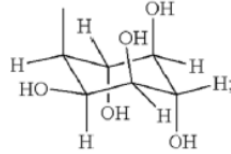
a phospholipid of the general formula (I)



² The claims at issue are Claims 1–6, 9, 12, 13, 19–29, 32, 35, 36, and 42–46 of U.S.

Patent No. 8,278,351 (the "351 patent") (Ex. 1001).

wherein R1 and R2, each together with the respective carboxyl groups to which each is attached, each independently represents a docosahexaenoic acid (DHA) or an eicosapentaenoic acid (EPA) residue, and X is —CH₂CH₂NH₃, —CH₂CH₂N(CH₃)₃, or



and wherein the extract is suitable for human consumption.

(the “Claimed Phospholipid(s)”). Ex. 1001 at claims 1, 24. The Claimed Phospholipid has an EPA and/or DHA attached at the sn-1 and sn-2 positions of the phospholipid backbone. It is undisputed that the claimed krill extracts need contain only one molecule of the Claimed Phospholipid in order to anticipate the independent claims at issue.³

B. Beaudoin I

One of the grounds for which the Board instituted trial in this IPR proceeding is that the claims at issue are anticipated by WO 00/23546 (“Beaudoin I” or “Beaudoin”). Beaudoin I describes krill extracts and discloses multiple processes for making krill extracts. *See* Decision Institution of *Inter Partes Review*, Paper 22 (Mar. 24, 2014) (“Dec. Inst.”) at 10. For example, Beaudoin I discloses a process for making an extract referred to as “Fraction I” that comprises the steps of subjecting krill to

³ *See id.*; *see generally* Patent Owner’s Resp. to Petition for *Inter Partes Review*, Paper 66 (Jul. 1, 2014) (“Resp.”) (proffering no claim construction or other argument regarding quantity of Claimed Phospholipid).

acetone extraction then separating the solubilized lipid fraction from the solid starting material. Ex. 1002 at 5:22–6:13. Beaudoin discloses another process for making an extract referred to as “Fraction II” that comprises taking the solid starting material left over from the production of Fraction I and subjecting that solid starting material to another solvent extraction. *Id.* at 6:15–18. Beaudoin I specifically discloses using *E. pacifica* krill as the starting material for creation of Fraction I and Fraction II. *See, e.g., id.* at Tables 1, 2. Beaudoin I further discloses other species may be used in the alternative. *Id.* at Tables 3, 4.

C. Neptune's Inconsistent Positions Regarding Beaudoin I And The Claimed Phospholipids

Neptune contends that the '351 Patent claims are distinguishable over Beaudoin I because the claims require a Claimed Phospholipid. In other words, Neptune seeks to persuade the Board that none of the extracts produced by the methods of Beaudoin I contain even a single Claimed Phospholipid molecule. As exemplified below, Neptune's positions on this point are inconsistent with its and its expert's own statements, and all of the experimental evidence, including the additional discovery sought by this motion.

1. Neptune's Position that Beaudoin I Does Not Result in a Claimed Phospholipid Is Inconsistent with Statements in its Own Patent

When Neptune filed the application that resulted in the '351 Patent, it was obligated, as part of the *quid pro quo* for obtaining a patent, to “descri[be] ...the

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