UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKER BIOMARINE AS and ENZYMOTEC LTD.
Petitioners

v.

NEPTUNE TECHNOLOGIES AND BIORESSOURCES INC.
Patent Owner

CASE IPR2014-00003[1]
U.S. Patent No. 8,278,351 B2

PATENT OWNER'S OPPOSITION TO PETITIONER AKBM'S MOTION FOR ADDITIONAL DISCOVERY

[1] Case IPR2014-00556 has been joined with this proceeding.

Aker's expansive requests are not routine discovery and are not favored by the interests of justice. The requested materials are not relevant, let alone useful, and Aker could present analogous information through other means. In fact, Aker itself characterizes the requested discovery as cumulative of a "wealth" of allegedly similar evidence already of record. (*E.g.,* Mot. at 8-10.)

Unable to satisfy the requirements for routine or additional discovery under 37 C.F.R. 42.51(b), Aker resorts to casting unfounded aspersions at Neptune and injecting arguments about the merits issues in these proceedings. The requested documents ***must*** be relevant, Aker insists, because Neptune did not agree to produce them. This notion is baseless and hypocritical. Neptune did not agree to Aker's requests because they seek irrelevant and highly confidential materials, previously produced only pursuant to a stringent ITC protective order. There is nothing nefarious about Neptune's desire to protect its proprietary information. Indeed, Aker itself refused to produce its confidential ITC documents because it did not want to "waive" the protections of the ITC's order.

Neptune should not be forced to put a thousand-plus pages of highly sensitive and irrelevant information into the hands of its competitors' prosecuting attorneys and, potentially, the public domain. The Board should deny Aker's Motion. In addition, the Board should expunge the portions of Aker's Motion that are, as detailed below, unauthorized arguments on the merits and wholly unrelated to Aker's discovery requests, which Aker included in an effort to circumvent the page limits for Petitioners' Reply.

I. THE REQUESTED DISCOVERY IS HIGHLY CONFIDENTIAL AND SUBJECT TO AN ITC PROTECTIVE ORDER

The materials Aker requests are confidential documents Neptune produced in prior litigation between the parties before the U.S. International Trade Commission ("ITC"). Neptune, without challenge from Aker, designated all of the requested documents as "Confidential Business Information" (CBI) pursuant to the ITC Protective Order. All parties are bound under the ITC protective order to use CBI solely for purposes of the ITC Investigation, which is now terminated.

Neptune attempted to reach a mutual agreement with Petitioners to use certain CBI documents in this proceeding, but Petitioners refused to enter into such an agreement. Petitioners would not even negotiate the issue in good faith. Accordingly, during the May 28, 2014 conference call with the Board, Neptune proposed a procedure for requesting and/or objecting to the use of CBI documents. *See* NEPN Ex. 2027, 31:12-36:2. Aker opposed Neptune's request and argued that use of Aker CBI documents would mean "waiving our [Aker's] confidentiality concerns." *Id.* at 36:22-37:1. Aker's counsel further stressed that any agreement to use CBI documents "***needs to be reciprocal*** and the parties still need to agree on that." *Id.* at 36:13-17 (emphasis added).

A reciprocal agreement was never reached. As a result, Neptune was barred from using Petitioners' relevant CBI documents in depositions and in its Patent Owner Response.

Now speaking out of the other side of its mouth, Aker urges the Board to ignore Neptune's confidentiality interests and order a voluminous, indiscriminate production of Neptune CBI. Aker's arguments ring hollow in light of its refusal to produce its CBI absent a "reciprocal" agreement. The documents Aker requests are also far more sensitive than the small number of documents Neptune requested from Aker. The requested Neptune documents disclose, for example, details regarding Neptune's commercial manufacturing processes, business plans, and proprietary research and development activities.

While Neptune agreed to a separate protective order for this IPR, the IPR protective order was drafted to cover the limited scope of discovery available in IPR, not the broad discovery available in the ITC. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, Paper No. 26 at 5 (P.T.A.B. Mar. 5, 2013) ("in *inter partes* review, discovery is limited as compared to that available in district court litigation."). Given the limited scope of discovery, IPR protective orders are logically more limited than protective orders that the ITC or district courts may issue. For example, Neptune's understanding is that the Board must retain the right to declassify confidential information, and that prosecution bars are not permitted. *See* U.S.P.T.O. Trial Practice Guide, App'x B; *CRS Adv. Techns., Inc. v. Frontline Techs., Inc.*, Case No. CBM2012-00005, Paper 43 at 3 (P.T.A.B. May 28, 2013) ("A protective order that deviates from the Board's default protective order must nonetheless include [mandatory] terms as outlined in the Office Practice Guide").

Accordingly, the parties agreed that this IPR protective order would cover CBI documents only by mutual agreement. NEPN Ex. 2033. ¶ 6. Aker itself argued that producing CBI under an IPR protective order would "waiv[e]" the protections ordered by the ITC. This does not mean this IPR protective order is "deficient," as Aker claims, but simply that it does not and cannot sufficiently cover the Neptune CBI Aker demands. The problem is not with the IPR protective order, but with Aker's requests for highly confidential information that is, as detailed below, wholly irrelevant to this proceeding.

II. AKER'S REQUESTS ARE NOT ROUTINE DISCOVERY

Aker's requests do not call for routine discovery. "Routine discovery under 37 C.F.R. § 41.51(b)(1)(iii) is narrowly directed to specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding, and not broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information." *Garmin* at 4. Neptune has produced all information covered by routine discovery, and knows of no information in its possession that is inconsistent with positions it has advanced in this proceeding.

III. AKER'S REQUESTS FAIL THE *GARMIN* TEST FOR ADDITIONAL DISCOVERY

To obtain something more than routine discovery, Aker must prove that its requests meet the demanding five-factor "interest of justice" test set forth in *Garmin*. Aker fails to meet this burden. Its requests fail under at least *Garmin* factors 1 and 3 because the

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