

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRAXAIR DISTRIBUTION, INC.,
Petitioner,
v.
INO THERAPEUTICS LLC,
Patent Owner.

Case IPR2015-00529
Patent 8,846,112 B2

Before LORA M. GREEN, TINA E. HULSE,
and ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On December 22, 2015, the panel held a conference call with respective counsel for Petitioner and Patent Owner to discuss Petitioner's request for authorization to file a Motion for Additional Discovery pursuant to 37 C.F.R. § 42.51(b)(2) to depose Drs. James S. Baldassarre, Douglas A. Greene, and David L. Wessel regarding their declarations submitted during the prosecution of U.S. Patent No. 8,846,112 B2 ("the '112 patent"), at issue in this proceeding. For the reasons set forth below, the request is denied.

Petitioner, represented by Mr. Benjamin Weed, argued that short depositions of Drs. Baldassarre, Greene, and Wessel are warranted because Patent Owner substantively relies on their declarations submitted during prosecution of the '112 patent. Opposing the request, Patent Owner's representative, Mr. Bob Steinberg, argued that these declarations were not prepared for the instant proceeding, but are part of the prosecution history of record in this case. Alluding to the burden and timeliness of Petitioner's request, Mr. Steinberg further noted that none of the declarants is presently employed by Patent Owner, and that any such depositions would need to be completed prior to the January 15, 2016 due date of Petitioner's Reply brief.

Where the parties do not agree to additional discovery between themselves, the Board may grant additional discovery upon a showing that such discovery "is in the interests of justice." 37 C.F.R. § 42.51(b) (2). Having heard the parties' oral arguments, we are not persuaded that Petitioner can make this showing.

Mr. Steinberg emphasized that the declarations at issue are part of the prosecution history of record in this case. Nevertheless, depending on the context in which Patent Owner relies on those declarations, the panel may accord the testimony little or no weight as Petitioner has not been offered a fair opportunity to challenge the testimony. *See Mexichem Amanco Holdings v. Honeywell Int'l*, Case IPR2013-00576, slip op. at 3 (PTAB : September 5, 2014) (Paper 36). Thus, while we deny Petitioner's Motion for Additional Discovery, Patent Owner may wish to reconsider its position regarding the cross-examination of Drs. Baldassarre, Greene, and Wessel.

It is, therefore,

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ORDERED that Petitioner's Motion for Additional Discovery pursuant to 37 C.F.R. § 42.51(b)(2) is denied.

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