

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACUETICALS, LLC. and
PAR PHARMACEUTICAL, INC.
Petitioner

v.

JAZZ PHARMACEUTICALS, INC.
Patent Owner

Case IPR2015-00554
Patent 7,668,730

**PETITIONER PAR PHARMACEUTICAL, INC.'S OPPOSITION TO PATENT
OWNER'S MOTION FOR ADDITIONAL DISCOVERY
PURSUANT TO 37 C.F.R. § 42.51**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. BACKGROUND

Petitioner Par Pharmaceutical, Inc. (“Par Pharm. Inc.”) submits this opposition to Patent Owner Jazz Pharmaceutical, Inc.’s (“Jazz”) motion for additional discovery (Paper No. 27). Jazz seeks discovery of billing records regarding the preparation and filing of the Petitions in IPR2015-00545, -00546, -00547, -00548, -00551, and -00554 (the “Petitions”), and any employment agreements for Par Pharm. Inc.’s in-house counsel, Dr. Lawrence Brown and Mr. David Silverstein. The Board should reject Jazz’s motion, however, as it fails to demonstrate why the interests of justice require production of these documents.

II. LEGAL STANDARDS

Under 35 U.S.C. § 316(a)(1)(5), discovery in *inter partes* review proceedings is limited to the deposition of witnesses submitting affidavits or declarations and “what is otherwise necessary in the interests of justice.” The party requesting additional discovery must show that they meet the five *Garmin* factors, which include showing that there is “more than a possibility and mere allegation” of finding useful information, and no “ability to generate equivalent information by other means.” See *Garmin Int’l. v. Cuozzo Speed Techs.*, No. IPR2012-00001, 2013 WL 2023626, at *4 (P.T.A.B., Mar. 5, 2013).

III. ARGUMENT

Jazz seeks discovery that is allegedly relevant only to the issue of whether

Par Pharmaceutical Companies, Inc., Sky Growth Holdings I Corp., Sky Growth Holdings II Corp., and Par Pharmaceutical Holdings, Inc. (collectively, the “Par Parents”) are real-parties-in-interest to the Petitions in addition to Par Pharm. Inc. (Paper No. 27 at 3–4). Specifically, Jazz seeks (1) billing records submitted by Par Pharm. Inc.’s attorneys or Dr. Valuck to any Par Pharm. Inc. or the Par Parents to the extent they relate to the Petitions; and (2) employment agreements between David Silverstein/Lawrence Brown and Par Pharm. Inc. or the Par Parents. (*See* Ex. 2039). But Jazz cannot demonstrate that the requested discovery meets all five *Garmin* factors.

A. Production of Billing Records is not in the Interests of Justice.

1. Jazz Had the Ability to Generate Equivalent Information.

Jazz offers no new evidence showing that any billing records they receive in discovery will not be duplicative of the testimony of Barry Gilman, Par Pharm. Inc.’s deputy general counsel and secretary. Mr. Gilman declared that “[Par Pharm. Inc.] was the only Par entity that paid any filing or legal fees associated with the preparation of the [Petitions].... None of the Par Parents... [provided] or other compensation for the preparation and filing of the [Petitions].” (Ex. 1040, ¶ 7). That directly answers the *one* question to which billing records would be relevant.

Jazz had the opportunity to depose Mr. Gilman regarding the basis of this statement on June 4, 2015. During that deposition, Jazz’s attorney spent a great

deal of time asking Mr. Gilman about irrelevant matters outside of the scope of his declaration, including which Par entity issues his paycheck (Ex. 2033., 17, 22–23, 26–30), his personal LinkedIn account (*Id.*, 17–18, 49–50), and abstract questions regarding whether Par Pharm. Inc.’s legal department had ever been authorized to act on behalf of the Par Parents. (*Id.*, 58–63). Mr. Gilman was neither “unwilling or unable” to provide further evidence at his deposition, as Jazz claims; rather, the Board had ordered that his deposition was to be limited to the subject matter of his Declaration. (*See* Paper No. 10 at 4–5). Jazz’s attorney never asked about his basis for stating that Par Pharm. Inc. paid for the Petitions or whether he had reviewed billing records, despite having more than an hour of unused deposition time remaining when Jazz closed the deposition. (*See* Ex. 2033, 68).

2. *Jazz’s Request is Based on a Mere Allegation.*

Jazz has no basis for stating that the information sought will be inconsistent with Mr. Gilman’s testimony, other than making “the logical inference” that Par’s refusal to produce the records is that they “do not support Petitioner’s positions.” But the opposite is true: if Par Pharm. Inc. or its attorneys had submitted bills to any of the Par Parents, those would be inconsistent with positions Par took, and Par would have been obligated to produce them with its Reply of May 26, 2015. (*See* 37 C.F.R. §42.51(b)(1)(iii)). Additionally, Par Pharm. Inc. and its attorneys have a duty of candor to the Board to identify real-parties-in-interest; Jazz’s

unsubstantiated “inference” also infers that Par Pharm. Inc.’s attorneys violated that duty. (*See* 37 C.F.R. §42.11). Other reasons exist for not wanting to produce billing records: they contain sensitive yet irrelevant material and privileged information that Par Pharm. Inc. does not wish to waste money on reviewing, redacting, and producing to Jazz. Further, the engagement letter for Dr. Valuck could reveal work product or privileged information, e.g., whether Par Pharm. Inc. is working with him as a non-testifying consultant in the related litigation.

B. Production of David Silverstein or Lawrence Brown’s Employment Agreements is not in the Interests of Justice.

1. Jazz Already Generated Equivalent Information.

Mr. Silverstein and Dr. Brown’s employment agreements would be relevant and not duplicative only if agreements with any of the Par Parents exist. Jazz has no basis to believe that is true. Mr. Gilman testified that both Dr. Brown and Mr. Silverstein were employed on behalf of Par Pharm. Inc. by a subsidiary called “Par, Inc.,” which renders corporate services to Par Pharm. Inc. (*See* Ex. 2033, 43–48). Mr. Gilman also declared that the Par Parents do not employ Dr. Brown and Mr. Silverstein (*See* Ex. 1040, ¶ 6) based on knowledge that they “generally do not have employees.” (Ex. 2033 at 44). Jazz thus has equivalent information.

2. Jazz’s Request is Based on Inadmissible Evidence and Mere Allegations.

Jazz has no basis for stating that the information sought will be inconsistent with Mr. Gilman’s testimony, other than evidence already raised: [REDACTED]

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.