

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS II LLC,
Petitioner,

v.

NPS PHARMACEUTICALS, INC.,
Patent Owner.

Cases IPR2015-00990 and IPR2015-01093
(Patent 7,056,886 B2)¹

Before LORA M. GREEN, JACQUELINE WRIGHT BONILLA, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

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

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading when filing a single paper in each proceeding, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

On May 29, 2015, Judges Snedden, Green, and Bonilla conducted a conference call with respective counsel for Petitioner and Patent Owner.

Patent Owner requested the call to seek authorization to file a motion for additional discovery. During the call, Patent Owner contended that the Petitioner failed to name all relevant investors and identify them as real parties-in-interest (RPI). Patent Owner contended that Petitioner's undisclosed investors are real parties-in-interest because those undisclosed investors provided the funds for the Petitions and stand to gain or lose depending on an outcome in the cases.

During the call, Petitioner responded that the Petitions identify a number of RPIs, and that no other entity has the authority to control the proceedings or is obligated to fund expenses associated with the Petitions.

After hearing the respective positions of the parties, the panel conferred and concluded that additional briefing was warranted. The panel authorized Patent Owner to file a motion for additional discovery of no more than 15 pages due by June 3, 2015. The panel also authorized Petitioner to file an opposition to the motion, also of no more than 15 pages due by June 10, 2015. Patent Owner was authorized to file a reply to the opposition of no more than 5 pages due by June 15, 2015.

In authorizing the filing of the motion, the panel cautioned Patent Owner that a motion for additional discovery is unlikely to be granted if it is unduly broad and encompasses numerous documents that are irrelevant to the RPI issue. We refer the parties to *Garmin International, Inc. v. Cuozzo Speed Technologies LLC.*, Case No. IPR2012-00001 (PTAB March 5, 2013) (Paper 26), as laying out factors that we will consider in deciding whether to grant Patent Owner's motion for additional discovery. We also point the parties to

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additional guidance in the following cases: *Dr. Farmwald and RPX Corp. v. Parkervision, Inc.*, Case No. IPR2014-00946 (PTAB Feb. 20, 2015) (Paper 25); *VMware, Inc. v. Good Technology Software, Inc.*, Case No. IPR2014-01324 (PTAB Dec. 5, 2014) (Paper 25); *Zerto, Inc. v. EMC Corp.*, Case No. IPR2014-01254 (PTAB Nov. 25, 2014) (Paper 15); *Unified Patents Inc. v. Dragon Intellectual Property, LLC*, Case No. IPR2014-01252 (PTAB Feb. 17, 2015) (Paper 39). For additional guidance on real party-in-interest generally, *see, e.g., Aruze Gaming Macau, LTD v. MGT Gaming, Inc.*, Case No. IPR2014-01288, slip op. at 5–20 (PTAB Feb. 20, 2015) (Paper 13); *TRW Automotive US LLC v. Magna Electronics Inc.*, Case No. IPR2014-01497, slip op. at 6–11 (PTAB Mar. 19, 2015) (Paper 7); *Shopkick Inc. v. Novitaz, Inc.*, Case IPR2015-00279, slip op. at 10–15 (PTAB May 29, 2015) (Paper 7).

Patent Owner, in its motion, should identify *specifically* what discovery it requests and include a showing as to why the discovery of each item is in the interest of justice. Moreover, a party requesting discovery should already be in possession of some evidence to show beyond mere speculation that something useful will be uncovered. A request for additional discovery should not encompass publicly available information that the party has the ability to obtain without the need for discovery.

It is:

ORDERED, that Patent Owner is authorized to file a motion for additional discovery. The motion is to be no more than 15 pages, and is due no later than June 3, 2015;

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FURTHER ORDERD, that Petitioner may file an opposition to the motion for additional discovery. The opposition is to be no more than 15 pages, and is due no later than June 10, 2015; and

FURTHER ORDERED, that Patent Owner is authorized to file a reply to the opposition. The reply is to be no more than 5 pages, and is due no later than June 15, 2015.

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