

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARGENTUM PHARMACEUTICALS LLC,  
Petitioner,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2016-00204  
Patent RE38,551 E

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Before FRANCISCO C. PRATS, JACQUELINE WRIGHT BONILLA, and  
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Compel Discovery and File an Exhibit  
*37 C.F.R. § 42.51(b)(1)(iii), § 42.5*

In an Order dated April 6, 2016 (Paper 12), we authorized Petitioner to file a motion to compel discovery in relation to information that Petitioner contends is in Patent Owner's possession and constitutes routine discovery under 37 C.F.R. § 42.51(b)(1)(iii).

As background, in its Preliminary Response, Patent Owner asserts that Petitioner fails to show sufficiently that the LeGall Thesis (Ex. 1008), relied upon in certain challenges in the Petition (Paper 2), is a "printed publication" that qualifies as prior art under 35 U.S.C. § 102. Paper 12, 2 (citing Paper 9, 17–23). Petitioner contends that Patent Owner possesses, but has not filed and/or served, relevant information that is inconsistent with that position.  
*Id.*

On April 11, 2016, Petitioner filed a Motion to Compel Discovery of Inconsistent Information and to File Exhibit 2025. Paper 13 ("Motion"). In the Motion, Petitioner requests authorization to file Exhibit 2025, which is the trial transcript from a district court case involving Patent Owner, other defendants, and the challenged patent. Motion 5 (citing Ex. 1044, 73–75). In addition, Petitioner asks us to compel discovery from Patent Owner of a transcript from a deposition that took place in the district court case, as well as certain "University documents." Motion 1–2, 5 (citing Ex. 1028, 13; 1027, 9–11). On the same day it filed its Motion, Petitioner also filed Exhibit 2025 itself. By e-mail correspondence dated April 13, 2016, we indicated to both parties that Petitioner did not have permission to file Exhibit 2025 until authorized by the Board, which had not occurred at that point, and we would expunge Exhibit 2025.

In its Motion, Petitioner provides substantive arguments as to why the LeGall thesis (Ex. 1008) was sufficiently publicly accessible in the relevant

time frame, and therefore qualifies as prior art under 35 U.S.C. § 102. Motion 1–3, 5. Petitioner also argues: “While a petition cannot be saved by supplementation, the statutes do not mandate the Board to turn a blind eye to information that contradicts factual assertions in a [Patent Owner Preliminary Response].” *Id.* at 3.

In relation to the latter point, Petitioner contends that Exhibit 2025 is “inconsistent with Patent Owner’s contention that the trial stipulation concerning LeGall is ‘not probative’ of whether LeGall was publicly accessible.” *Id.* at 4 (citing Patent Owner’s Preliminary Response (Paper 9 (“Prelim. Resp.”), 20). Petitioner then asserts, relying on Ex. 2025 in support, that “[t]rial counsel” in the district court case “mentioned actual ‘proof’ that caused Patent Owner’s admission,” and that “two witnesses confirmed LeGall’s public accessibility.” *Id.* at 4–5 (citing Ex. 2025).

Petitioner also argues that other documents it requests are not publicly accessible, and states that “the PACER docket shows redacted filings and a redaction transcript release date of March 14, 2016, suggesting the trial transcript [Ex. 2025] would be unavailable until that date.” *Id.* at 5 (citing Ex. 1044, 73–75).

Patent Owner filed an Opposition to Petitioner’s Motion. Paper 15 (“Opp.”). In its Opposition, Patent Owner asserts that its Preliminary Response challenges only the sufficiency of evidence cited by Petitioner in its Petition, as needed to meet its burden to show that LeGall Thesis qualifies as a printed publication. For example, according to Patent Owner, the Preliminary Response discusses why a district court trial stipulation (Ex. 1004, a “Joint Statement of Uncontested Facts” in the district court case) is not probative on the issue. *Opp.* 1–2 (citing *Prelim. Resp.* 20). Patent

Owner also argues why certain articles cited in the Petition “provide no evidence’ ‘of how the LeGall Thesis was in fact indexed, cataloged or shelved.’” Opp. 2 (quoting Prelim. Resp. 22).

After multiple conference calls on the issue, and upon considering the Motion and Opposition, it appears to us that Petitioner is attempting to use its request for “routine discovery” as a vehicle to bolster its Petition with substantive argument and evidence. Indeed, this is evidenced by the fact that Petitioner is already in possession of a copy of the district court trial transcript (Ex. 2025), and thus need not seek discovery of that document from Patent Owner.

As Patent Owner notes, Petitioner has the burden to make a threshold showing that the LeGall thesis qualifies as “printed publication” prior art under 35 U.S.C. §§ 102 and 311(b). Prelim. Resp. 19; *Apple Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 14, slip op. at 5 (PTAB Aug. 12, 2015). In its Preliminary Response, Patent Owner argues that Petitioner fails to provide that threshold showing in the Petition. Prelim. Resp. 19–22. Such arguments do not impose an obligation on Patent Owner to provide evidence that supports Petitioner’s position, i.e., provide the very evidence Petitioner may need to meet that threshold. *See Hughes Network Sys., LLC v. Calif. Inst. of Tech.*, IPR2015-00059, Paper 34, slip op. at 7 (PTAB Dec. 30, 2015) (“Arguments pointing to a deficiency in petitioner’s case do not impose an obligation on the part of [Patent Owner] to provide evidence supplementing that provided by [Petitioner].”).

We are not, therefore, persuaded that Petitioner is entitled to the requested discovery because it is “routine” under 37 C.F.R. § 42.51(b)(1). We also are not persuaded to allow Petitioner to file supplemental evidence

into the record now, in an attempt to overcome any failings that may exist in its Petition. Petitioner could have filed additional evidence along with its Petition, if it so wished.

For example, neither party indicates that Petitioner was, or is now, subject to a time bar under 35 U.S.C. § 315(b). Thus, even assuming the district court trial transcript (Ex. 2025) was unavailable until March 14, 2016, as Petitioner contends (Motion 5), Petitioner could have waited until such information was available before filing its Petition. We also are not inclined to exercise our discretion to compel Patent Owner to provide information here that Petitioner or others have been unable to obtain through a prior district court subpoena or the Texas Public Information Act. Motion 1–2; Ex. 1027; Ex. 1028.

In consideration of the foregoing, it is:

ORDERED that Petitioner’s Motion to Compel Discovery of Inconsistent Information and to File Exhibit 2025 is *denied*; and

FURTHER ORDERED that Exhibit 2025 filed with Petitioner’s Motion is expunged.

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