

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRONTIER THERAPEUTICS, LLC,
Petitioner,

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE
SPEZIALPRÄPARATE MBH,
Patent Owner.

Case IPR2016-00649
Patent 8,664,231 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

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

A conference call was held on September 28, 2016, between James Haley and J. Steven Baughman for medac Gesellschaft für klinische Spezialpräparate mbH (“Patent Owner” or “Medac”); Gregory Gonsalves for Frontier Therapeutics LLC (“Petitioner” or “Frontier”); and Administrative Patent Judges Bonilla, Franklin, and Scheiner. Patent Owner requested the call to seek authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.52(a) regarding real parties-in-interest.

(1)

Patent Owner seeks to compel the testimony of Mr. Jason Greer—identified by Patent Owner as Frontier’s Executive Manager—regarding the identity of entities referred to as “industry relationships” and “development partners” in Mr. Greer’s letter to Medac of January 8, 2016 (Ex. 2001), as well as the relationship of these entities to Frontier and their level of involvement in IPR2016-00649. Patent Owner maintains that Mr. Greer is in a position to shed light on whether these entities are as yet unidentified real parties-in-interest. In support of its request, Patent Owner points to Mr. Greer’s representations to Medac that “Frontier has uniquely positioned itself to achieve its strategic objectives through its industry relationships,” and “Frontier intends to approach its development partners to prepare and file an ANDA for Rasuvo®” (the subject matter of Patent 8,664,231 (“the ’231 patent”)), should the PTAB “institute an IPR of the ’231 Patent.” *See* Ex. 2001, 1.

The Board has identified several factors relevant to determining whether a discovery request is “necessary in the interest of justice,” the applicable standard under the AIA. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013)

(Paper 26). The first of these factors weighs decisively in our consideration of Patent Owner's request:

More Than a Possibility and Mere Allegation—The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be discovered. [In this context, “useful” means “favorable in substantive value to a contention of the party moving for discovery.”]

Id.

Here, Patent Owner has identified insufficient evidence already in its possession that tends to show beyond speculation that something useful would be uncovered were we to grant Patent Owner's request to compel Mr. Greer's testimony with respect to real parties-in-interest. Factors relevant to whether an unnamed party is a real party-in-interest of Frontier include whether that unnamed party has or could have exerted control over the filing of the Petition in this case. The mere mention of unidentified “development partners” or “industry relationships” in the context of filing an ANDA—which purportedly would occur, if at all, after institution of an *inter partes* review in this case—is insufficient to show beyond speculation that the relief requested would uncover something useful in support of Patent Owner's assertions that unnamed entities have or could have exerted control over Frontier's Petition in this case. Thus, even if we considered the remaining *Garmin* factors in favor of Patent Owner, for the reasons set forth above, Patent Owner still would be unable to meet its burden of showing that the requested additional discovery is necessary in the interest of justice.

Accordingly, we decline to authorize Patent Owner's request for authorization to compel the testimony of Mr. Greer on this matter.

(2)

Patent Owner also seeks authorization to move for additional discovery on the issue of whether Mr. Jason Greer, Jason Paul Group LLC, and Jason Paul Greer Enterprises LLC are unnamed real parties-in-interest of Frontier. Patent Owner asserts, among other things, that Frontier, Jason Paul Group LLC, and Jason Paul Greer Enterprises LLC share Mr. Greer's personal address, and are all alter egos of Mr. Greer.

During the conference call, the parties confirmed the absence of a statutory bar under 35 U.S.C. § 315(a) or (b). Following further discussion of the matter, counsel for Petitioner agreed to confer with his client as to whether it would be appropriate for Petitioner to file an updated mandatory notice naming Mr. Greer, Jason Paul Group LLC, and Jason Paul Greer Enterprises LLC as additional real parties-in-interest. We indicated that in the event Petitioner determines that such a filing is appropriate and thereafter files the notice, we would exercise our discretion under 35 U.S.C. § 316 and 37 C.F.R. §§ 42.5 and 42.71 to reset the filing date of the Petition and the Decision to Institute to the date of the updated mandatory notice, without otherwise modifying the Scheduling Order already in place. Patent Owner explained that such action would satisfy its concerns and obviate its interest in filing a motion for additional discovery relating to those entities.

Accordingly, Petitioner agreed to a time period for filing an updated mandatory notice naming additional real parties-in-interest, should Petitioner elect to file such, of no later than close of business on Friday, October 7, 2016. In addition, should Petitioner elect not to file such a notice, it shall

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inform us of that decision by close of business on October 7, 2016. Finally, as indicated during the conference call, we will revisit Patent Owner's request for authorization to file a motion for additional discovery regarding whether Mr. Jason Greer, Jason Paul Group LLC, and Jason Paul Greer Enterprises LLC are real parties-in-interest of Frontier in the event that Petitioner elects not to file the proposed updated mandatory notice.

It is:

ORDERED, that Patent Owner's request for authorization to file a motion to compel the testimony of Mr. Jason Greer is *denied*;

FURTHER ORDERED that Petitioner's Updated Mandatory Notice, should Petitioner elect to file one as indicated above, is due not later than close of business on October 7, 2016; and

FURTHER ORDERED that Petitioner shall inform the Board, by email, if it elects not to file an updated mandatory notice, by close of business on October 7, 2016.

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