

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES, LTD. AND DR. REDDY'S
LABORATORIES, INC.,

Petitioner,

v.

INVIDIOR UK LIMITED,

Patent Owner.

Case IPR2016-01113
Patent 8,475,832 B2

Before TONI R. SCHEINER and ZHENYU YANG,
Administrative Patent Judges.

SCHEINER, *Administrative Patent Judge.*

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

On August 1, 2016, a conference call was conducted between respective counsel for the parties and Judges Franklin, Hulse, Paulraj, Scheiner, and Yang.¹ The purpose of the call was to discuss Patent Owner Invidior UK Limited's ("Invidior") request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) concerning real parties-in-interest and parties in privity with Petitioner, Dr. Reddy's Laboratories, Ltd. and Dr. Reddy's Laboratories, Inc. The conference call also covered a similar request in Cases IPR2016-01111 and IPR2016-01112, which involve a different Patent Owner and are assigned to a different panel than the above-captioned proceeding. The remainder of this order addresses the above-captioned proceeding only. A similar order will issue in IPR2016-01111 and IPR2016-01112.

During the call, counsel for Patent Owner in IPR2016-01111 and IPR2016-01112, Monosol RX, LLC ("Monosol"), speaking for both Patent Owners, represented that Patent Owners had reason to believe that Teva Pharmaceuticals ("Teva") is a real party-in-interest and is in privity with Petitioner based on the recent press announcement of an agreement with Teva concerning the acquisition of a portfolio of eight Abbreviated New Drug Applications ("ANDAs") as well as a related notice by the Federal Trade Commission ("FTC"). In view of those public announcements, Patent Owners assert that the agreement with Teva covered Suboxone®, the drug at issue in the underlying patent infringement litigation between the parties.

¹ Patent Owner in IPR2016-01111 and IPR2016-01112 arranged for a court reporter to be present on the call. We instructed the Patent Owners to file a copy of the transcript as an exhibit in their respective proceedings.

As a result, Patent Owner Invidior seeks authorization to serve requests for production relating to that agreement.

Petitioner's counsel asserted that Patent Owner's basis for the requested discovery is speculative and, in any event, the agreement had not been finalized during the relevant time period with respect to establishing privity. Petitioner also raised confidentiality concerns about the production of such agreement and related documents.

After considering the general statements regarding the respective positions of Patent Owner and Petitioner, we authorize Patent Owner to file a Motion for Additional Discovery, limited to the requests for production of documents described by Patent Owner during the call. Patent Owner shall include the specific requests for production as an Appendix to its Motion. The Motion should be no more than 15 pages, exclusive of any supporting declarations or other evidence, and filed within one week of the entry of this Order. We authorize Petitioner to file an Opposition to the Motion for Additional Discovery, also within a 15-page limit exclusive of any supporting declarations or other evidence, and due within one week of Patent Owner's filing of the Motion for Additional Discovery. Petitioner shall clarify in its Opposition which of the requested documents, if any, it is willing to produce without contest. No further briefing is authorized at this point.

Patent Owner's Motion and Petitioner's Opposition should each reflect consideration and exemplification of the five "*Garmin*" factors when discussing whether the additional discovery at issue is "necessary in the interest of justice." 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2); *Garmin*

IPR2016-01113
Patent 8,475,832 B2

Int'l, Inc. v. Cuozzo Speed Techs. LLC, Case IPR2012-00001, slip op. at 5–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

In view of the confidentiality concerns raised by Petitioner during the call, the parties shall meet and confer regarding an appropriate protective order to be entered in this proceeding that would cover the requested discovery, if necessary. The entry of a protective order is necessary if either party seeks to file a motion to seal. In such case, we recommend the default protective order in the Office Trial Practice Guide. 77 Fed. Reg. 48,756, Appendix B (Aug. 14, 2012). If the parties choose to deviate from the default protective order, a conference with the Board shall be requested for such guidance. Any proposed protective order may be filed separately from the authorized Motion and Opposition papers, at a time prior to or along with any motion to seal.

ORDER

In accordance with the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) in IPR2016-01113 within one week of entry of this Order, limited to 15 pages;

FURTHER ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's Motion for Additional Discovery within one week after Patent Owner's Motion is filed, limited to 15 pages;

FURTHER ORDERED that, in its Motion, Patent Owner should identify specifically the scope of each request for production of documents that Patent Owner proposes;

IPR2016-01113
Patent 8,475,832 B2

FURTHER ORDERED that, the parties shall address specifically each of the *Garmin* factors with respect to each item of additional discovery requested;

FURTHER ORDERED that, in its Opposition, Petitioner should identify specifically whether and to what extent Petitioner opposes Patent Owner's requested additional discovery;

FURTHER ORDERED that Patent Owner is instructed to file a copy of the transcript provided by the court reporter.

PETITIONER:

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