IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

QUALICAPS CO., LTD.,
Patent Owner.

Case No. IPR2017-00203
Patent No. 6,649,180

PATENT OWNER'S OPPOSITION TO PETITIONER MYLAN PHARMACEUTICALS INC.'S MOTION FOR ADDITIONAL DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)

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Petitioner requested authorization "to file a motion for additional discovery *in the form of Mr. Tanjoh's deposition* . . ." based on Mr. Tanjoh's prosecution history declaration. *See* Ex. 2061 (emphasis added). Petitioner's motion, however, seeks additional discovery not only in the form of the deposition of Mr. Masaru Tanjoh, but also "production of all documents . . . supporting or refuting Patent Owner's assertion that the invention of the U.S. Patent No. 6,649,180 ("the '180 [P]atent") yielded unexpected results." Paper 31 at 1. Neither Petitioner's request for additional discovery, nor the Board's authorization, addressed the production of documents. *See* Ex. 2061. Petitioner tries to justify this expanded request by stating that the documents in question go to Patent Owner's showing of unexpected results. This rationale is misplaced. Petitioner has already deposed Patent Owner's expert, Dr. McConville, the witness in this proceeding who actually opined on "unexpected results." Moreover, Patent Owner has already consented to filing the March 2017 transcript from Mr. Tanjoh's litigation deposition in the present proceeding (Ex. 2062 at 3-5), which Petitioner concedes is a sufficient alternative to a second deposition (Paper 31 at 1 & 7). Because Petitioner's remaining request for litigation-produced documents was unauthorized, there is effectively nothing left to decide.

I. BACKGROUND

The declaration that formed the basis of Petitioner's request for additional discovery is not one prepared for purposes of this proceeding. Rather, it is a short

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declaration from an inventor, Mr. Tanjoh, submitted during the original prosecution of the '180 patent. ("Tanjoh Declaration"; Ex. 1010 at 105–108). The declaration reports data and test results from Mr. Tanjoh's experiments, the accuracy of which Petitioner's own expert does not contest. Ex. 2029 at 114:7–23. Mr. Tanjoh does not opine on whether the reported data and test results would have been surprising or unexpected to a POSA, and Petitioner cites to no testimony of Mr. Tanjoh to that effect. Rather, it is Dr. McConville who opines on the unexpected and surprising nature of Mr. Tanjoh's test results. *Compare* Paper 31 at 2 (quoting Mr. Tanjoh's test results from Ex. 1010 at 107), *id.* at 4 (no citation to where "the inventor's self-serving testimony that the claim possesses surprising or unexpected import" appears, much less a cite to the Tanjoh Declaration), and *id.* at 5 (no citation to where Mr. Tanjoh "assert[ed] surprising or unexpected results"), *with id.* at 2 ("*He* [Dr. McConville] concludes that 'the POSA would have found this result surprising an[d] unexpected'" (emphasis added), citing to McConville Declaration, Ex. 2028 at ¶¶ 99–100). Petitioner deposed Dr. McConville on August 17, 2017.

As Petitioner acknowledges, in the related district court litigation (Civil Action Nos. 2:15-cv-1471; 2:15-cv-1740 (E.D. Tex.)), Mr. Tanjoh was designated to testify regarding, among other things, unexpected results as an objective indicia of nonobviousness of the '180 Patent. Paper 31 at 4–5; *see also* Ex. 1024 at 6 (Topic 17 includes unexpected results); Ex. 1025 at 2 (confirming Topic 17 for testimony

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by Mr. Tanjoh). Petitioner's back-up counsel in the present proceeding, Mr. Olinger, conducted Mr. Tanjoh's litigation deposition in March of this year, during which a number of deposition exhibit documents were identified as "RESTRICTED—ATTORNEYS' EYES ONLY" ("the AEO Exhibits").

II. ARGUMENT

Each of the five *Garmin* factors, which frame the analysis for determining whether additional discovery is in the interests of justice and should thus be allowed, fails to support either the cross-examination of Mr. Tanjoh, or the requested production of documents. *See Garmin Int'l Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 (PTAB March 5, 2013).

A. *Garmin* factor #1: Petitioner has failed to show that there is more than a possibility or mere allegation that something useful will be uncovered by deposing Mr. Tanjoh for a second time.

Contrary to Petitioner's assertion, the Tanjoh Declaration does not opine on whether the data and results reported therein would be surprising or unexpected to a POSA. *See* Ex. 1010 at 105–108. Petitioner's motion cites to no testimony of Mr. Tanjoh to that effect. *See* Paper 31 at 2, 4, & 5. Therefore, Petitioner has not shown that something "useful" will be obtained from the cross-examination. In addition, Petitioner specifically required Mr. Tanjoh to be prepared to discuss any knowledge he had bearing on "unexpected results" during the March 2017 litigation deposition (Ex. 1024 at 6), by which time Petitioner was in possession of the Patent Owner

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Preliminary Response ("POPR"; Paper 9, February 17, 2017) that laid out the unexpected results arguments from the present proceeding (Paper 9 at 1, 4–11, 13–14, 17).

Patent Owner has already consented to filing in the present proceeding Mr. Tanjoh's *complete* sworn testimony from the March 2017 litigation deposition. Ex. 2062 at 3-5. Thus, any testimony from Mr. Tanjoh regarding unexpected results, and the AEO Exhibits, would be included in the deposition transcript, and the record of Mr. Tanjoh's *testimony* would be complete. Petitioner's "extremely unburdensome request" (Paper 31 at 1) for consent to file the AEO Exhibits from Mr. Tanjoh's March deposition, along with the complete sworn testimony and the non-AEO deposition exhibits, is nothing more than a back-door attempt to obtain documents through additional discovery that were not requested, much less authorized by the Board. *See* Ex. 2061.

Significantly, Petitioner has not asserted or alleged that *any* of the AEO Exhibits is directed to the data and experiments contained in the Tanjoh Declaration, much less directed to why such results are surprising or unexpected, as opposed to any of the other numerous topics on which Mr. Tanjoh was deposed. *See* Exs. 1024, 1025. Petitioner's rationale that a protective order would solve confidentiality concerns about the AEO Exhibits misses the point. Petitioner has not, and cannot, establish that they are independently entitled to production of the AEO Exhibits

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