

NON-PUBLIC VERSION – PROTECTIVE ORDER MATERIAL

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARO PHARMACEUTICALS U.S.A., INC.,
Petitioner,

v.

APOTEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01446
Patent 7,049,328 B2

Before LORA M. GREEN, JEFFREY N. FREDMAN, and
ZHENYU YANG, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2),

I. INTRODUCTION

With authorization of the Board, Paper 18, Taro Pharmaceuticals U.S.A., Inc. (“Petitioner”) filed redacted and public versions of a motion for additional discovery relating to Exhibits 1037–1045 and 1047–1049. Papers 22, 24 (“Mot.”). Apotex Technologies, Inc. (“Patent Owner”) filed redacted and public versions of an opposition to the Motion. Papers 29, 30 (“Opp.”). In the motion, Petitioner explains that these documents were generated during litigation in parallel litigation related to the ’328 patent, *ApoPharma Inc. v. Taro Pharmaceutical Industries, Ltd.*, No. 2:16-cv-00528, currently pending in the District Court for the Eastern District of Texas – Marshall Division.

Petitioner asserts these documents are both relevant to, and inconsistent with, positions advanced by Patent Owner in the Patent Owner Response (Paper 17; “PO Resp.”). Mot. 1. Petitioner seeks to compel Patent Owner to produce these documents in this proceeding because the District Court’s protective order prevents Petitioner from entering the documents into the instant proceeding. For the reasons that follow, we grant Petitioner’s Motion. Mot. 6–7.

II. ANALYSIS

A party seeking discovery beyond what is expressly permitted by our rules must establish that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2) (“The moving party must show that such additional discovery is in the interest of justice.”). Discovery in an *inter partes* review proceeding is more limited than in district court patent litigation, as Congress intended our proceedings to provide a more efficient and cost-effective alternative to such

litigation. H. Rep. No. 112–98 at 45–48 (2011). Thus, we take a conservative approach to granting additional discovery. 154 Cong. Rec. S9988–89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl).

The Board has identified five factors (the “Garmin Factors”) to be considered in determining whether additional discovery is in the interest of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012–00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (“*Garmin*”).

A. Garmin Factor 1 – “More Than A Possibility And Mere Allegation”

The first Garmin Factor requires that the party seeking additional discovery establish that it already is in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered. *Garmin* at 6.

In support of its assertion that the proposed Requests for Additional Discovery will uncover documents favorable to its position, Petitioner asserts that the documents “filed as Exhibits 1037–1045 and 1047–1049[], contain statements inconsistent with positions taken by Apotex during the IPR.” Mot. 6. Patent Owner responds that Petitioner’s proposed discovery request “is not relevant to the issues at hand – namely what is taught by the prior art” and “Exs. 1037–1045 and 1047–1049 are not relevant to this proceeding because, as described above, they are not inconsistent with Apotex’s positions.” Opp. 6–7.

To demonstrate the relevance of the documents, Petitioner first points out that Patent Owner contends there was “significant disagreement in the scientific community” as to whether deferiprone could be safely

administered. Mot. 2 (citing PO Resp. 5). Petitioner points to an asserted inconsistent statement in Exhibit 1040, [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
Ex. 1040, 1.¹ Additionally, Petitioner points to [REDACTED]

[REDACTED] Exhibit 1042 [REDACTED]
[REDACTED]
[REDACTED]

Petitioner next points out that Patent Owner “now contends that the Primary References ‘do not explicitly or inherently disclose administering deferiprone to blood transfusion-dependent patients having iron-induced cardiac disease’ (PO Resp. at 26) because those patients’ cardiac disease may have had a different cause. (*Id.* at 26, 30.)” Mot. 3. Petitioner points to asserted inconsistent statements in Exhibits 1042, 1045, and 1047. Mot. 34.

In Exhibit 1042, Petitioner points to [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

¹ We recognize that, consistent with Patent Owner’s position, a dispute between Dr. Olivieri and other researchers constitutes disagreement in the scientific community (*see* Opp. 3), but Exhibits 1037–1040 and 1042 provide [REDACTED].

[REDACTED]
[REDACTED] Similarly, in Exhibit 1045, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED]
[REDACTED] are
therefore reasonably understood as inconsistent with Patent Owner’s
position that patients undergoing transfusion treated with deferiprone in the
Primary References did not inherently have iron-induced cardiac disease
requiring treatment.

Patent Owner responds

[REDACTED]

Opp. 4.

We are persuaded that requiring Patent Owner to produce evidence as to whether an “inherent result must inevitably result” as required by *In re Montgomery*, 677 F.3d 1375, 1380 (Fed. Cir. 2012) that may be inconsistent with Patent Owner’s position in the instant proceeding is in the interests of justice. We do not find Patent Owner’s argument that the evidence does not directly address the Primary References to be persuasive, because the

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