

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.
Petitioner,

v.

UNITED THERAPEUTICS, CORP.
Patent Owner.

Case IPR2017-01621 and IPR2017-01622
Patents 9,358,240 B2 and 9,339,507 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and DAVID
COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Motions for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

With authorization of the Board, Paper 22,¹ Watson Laboratories, Inc. (“Petitioner”) filed a motion for additional discovery in each captioned proceeding. Petitioner asserts that the additional discovery relates to the “the contribution of the named inventors to the challenged claims,” and thus bears on the issue of whether Ghofrani (Ex. 1005), a prior art reference relied upon in the instituted ground, is the work of “another” under 35 U.S.C. § 102(a). Paper 26 (“Mot.”), 1, 6. Specifically, Petitioner seeks an unredacted copy of the November 30, 2007 Declaration of Rachel Turow (“the Turow Declaration,” Ex. 1172) submitted to the Patent Office during prosecution of a parent application to each of the challenged patents. United Therapeutics, Corp. (“Patent Owner”) opposes the Motion. Paper 30 (“Opp.” or “Opposition”). For the reasons that follow, we deny Petitioner’s Motion.

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

¹ There are slight differences in the numbering of Papers and Exhibits in IPR2017-01621 and IPR2017-01622. Notwithstanding these differences, the papers relating to the motions addressed herein are substantively identical. Unless otherwise noted, for the convenience of the Board, citations to Papers and Exhibits referenced herein are only to IPR2017-01621, with the understanding that there exists a corresponding, substantively identical, Paper or Exhibit in IPR2017-01622.

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

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*”). In particular, the first *Garmin* factor requires essentially 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 7.

A redacted version of the Turow Declaration was submitted in U.S. Application No. 11/748,205 (“the ’205 application”), a parent of the applications that ultimately issued as the patents at issue in these proceedings. Ex. 1172. It was submitted under 37 C.F.R. § 1.47(a) to request that the Patent Office accept inventors’ oaths without the signatures of Horst Olschewski, Thomas Schmehl, Werner Seeger, and Robert Voswinckel, all four of whom are identified as inventors on the patents at issue. Opp. 6; Ex. 1001.

The Turow Declaration attaches a number of exhibits, including email correspondence with the non-signing inventors. Ex. 1172. Some of this correspondence has been redacted. Petitioner seeks to discover unredacted copies of the correspondence.

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

We agree with the Petitioner that the redacted correspondence would be relevant if it reflected “the contribution of the named inventors to the challenged claims” (Mot. 6), or otherwise speaks to the identity of the inventorship entity for the patent claims at issue. However, on the record before us, we find it unlikely that discovery of the redacted material would yield such information.

Petitioner speculates that the redacted subject matter speaks to the inventorship of claims similar to those at issue and asserts that, in the redacted email correspondence, Dr. Seeger (a named inventor) and Mr. Mahon (Executive Vice President and General Counsel of UTC) appear to be discussing “the contributions of the Giessen team to the inventions disclosed in the pending application.” Mot. 8. But, the focus of the email correspondence accompanying the Turow Declaration is a difference of opinion between the non-signing inventors and UTC as to whether the work of the non-signing inventors related to the ’205 application was covered by a previously executed agreement. There does not appear to be any dispute about, or substantive discussion of, what any of the non-signing inventors, individually or collectively, contributed to the claimed subject matter. Indeed, inventorship appears tangential to the focus of the correspondence – i.e., whether the subject matter invented was covered by a pre-existing contract.

That the correspondence at issue does not speak to inventorship is reinforced by the testimony of Ms. Turow in her Declaration, which unequivocally states that none of the inventors have “indicated that some other entity besides Inventor (1) Olschewski; Inventor (2) Roscigno, Inventor (3) Rubin, Inventor (4) Schmehl, Inventor (5) Seeger; Inventor (6)

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

Steritt and Inventor (7) Voswinckel invented the subject matter of the present invention.” Ex. 1172, 6; *see also, id.* at 28 (email from UTC representative stating that “all inventors have to be named for the patent to be valid and enforceable . . . [s]o it seems that the four of you need to be included. . .”).

We agree with Patent Owner that Petitioner’s evidence and argument in support of its motion for additional discovery fail to demonstrate more than a mere possibility or mere allegation that something useful will be found. Thus, the first *Garmin* factor weighs heavily against granting Petitioner’s request for additional discovery. We note that Petitioner also addresses the remaining factors set forth in *Garmin*. Mot. 8–10. Even if we considered those factors to weigh in favor of Petitioner, however, Petitioner still has not met its burden to show that the additional discovery would serve the interest of justice, for the reasons provided above.

Having considered the evidence and arguments proffered in support of the Petitioner’s motion, we are not persuaded that granting the requested discovery would uncover something useful in support of Petitioner’s contention that Ghofrani is the work of another.

III. CONCLUSION

For the reasons discussed above, and in consideration of our conservative approach to granting additional discovery, we conclude that Petitioner has not met its burden to show that the additional discovery sought is necessary in the interest of justice.

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