

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

BIOGEN MA INC.,
Patent Owner.

Case IPR2018-01403
Patent No. 8,399,514

Before SHERIDAN K. SNEDDEN and JACQUELINE T. HARLOW,
Administrative Patent Judges.

SNEDDEN, *Administrative Patent Judge.*

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

With its Petition, Petitioner submitted a declaration of Robert Mihail. Ex. 1054. The Mihail Declaration is an identical copy of the declaration previously submitted in IPR2015-01993. Petitioner also served on Patent Owner supplemental evidence in the form of a declaration from Emily Greb, not yet entered into this proceeding. A conference call in the above proceeding was held on April 12, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Snedden and Harlow. During the call, we discussed whether the declarations are subject to the provisions of 37 C.F.R. § 42.51(b)(1) (“routine discovery”) or § 42.51(b)(2) (“additional discovery”). A transcript of the conference call will be entered by Patent Owner.

During the call, it was preliminarily determined that those declarations were not prepared for the purposes of this *inter partes* review, and thus, that the routine-discovery provisions of § 42.51(b)(1) do not apply. *See Mexichem Amanco Holdings S.A. de C.V. v. Honeywell Int’l, Inc.*, Case IPR2013–00576, Paper 29 (PTAB Aug. 15, 2014) (“if the declaration was not prepared for purposes of the instant *inter partes* review—such as preexisting documentary evidence filed previously in another proceeding—cross-examination of the witness would not be provided as routine discovery.”). We further explained that, although cross-examination of the declarants is not provided as routine discovery under § 42.51(b)(1), several factors remain relevant in assessing the weight to be accorded to their testimony, including whether the declarants were cross-examined. Additionally, we will evaluate whether evidence cited in a paper sufficiently supports a contention made by a party in the paper. *See Mexichem* at 3.

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During the call, Patent Owner requested authorization to file a motion for additional discovery to compel testimony in the form of deposition testimony from Mr. Mihail and Ms. Greb. Based on our consideration of the parties' position, we agreed to authorize Patent Owner to file a motion for additional discovery. The parties are reminded that additional discovery is permitted in an *inter partes* review only in the interests 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) (providing factors important to deciding a motion for additional discovery). 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. *Id.* at 6. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered. *Id.*

Accordingly, Patent Owner is granted permission to file its motion, limited to 7 pages, no later than April 22, 2019. Petitioner may file an opposition by April 30, 2019, also limited to 7 pages.

It is

SO ORDERED

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