

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TWI PHARMACEUTICALS, INC.,
Petitioner,

v.

MERCK SERONO SA,
Patent Owner.

IPR2023-00049 (Patent 7,713,947 B2)
IPR2023-00050 (Patent 8,377,903 B2)¹

Before ULRIKE W. JENKS and TINA E. HULSE,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

ORDER
Conduct of proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading for any subsequent papers.

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On May 29, 2024, a conference call was held in the above-referenced proceedings regarding Petitioner's request for authorization to file a motion for additional discovery. *See* IPR2023-00049, Ex. 3002, 3–4; IPR2023-00050, Ex. 3003, 3–4. Present on the call were counsel for the parties and Judges Jenks and Hulse.

Petitioner requested the conference call to seek authorization to file a motion for additional discovery relating to Patent Owner's communications with third party declarants Dr. Nicholas Bodor and Dr. Yogesh Dandiker, and materials underlying their declarations. Petitioner contends Patent Owner has failed to comply with its routine discovery obligations because Patent Owner improperly instructed Dr. Bodor and Dr. Dandiker not to answer certain questions during their depositions, on the basis of privilege. The parties have met and conferred but have not reached agreement as to any discovery requests or Dr. Bodor's and Dr. Dandiker's claims to privilege.

Patent Owner opposes Petitioner's request to file a motion for additional discovery for several reasons. Patent Owner contends Petitioner's request to file a motion for additional discovery relies on mere speculation, and the additional discovery Petitioner seeks is overly broad. Patent Owner also contends the additional discovery Petitioner seeks is protected by attorney-client privilege or constitutes privileged attorney work product because counsel for Patent Owner represents both Dr. Bodor and Dr. Dandiker.² For example, Patent Owner asserts that Petitioner seeks all

² During the conference call with the Board, Patent Owner's counsel was unsure of the exact dates Dr. Bodor and Dr. Dandiker retained Wilmer Cutler Pickering Hale and Dorr LLP as counsel.

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documents reflecting communications between counsel for Patent Owner and Dr. Bodor and Dr. Dandiker, which it contends are protected by attorney-client privilege. Patent Owner also asserts that Petitioner seeks drafts of the declarations of Dr. Bodor and Dr. Dandiker, which it contends are protected by attorney work product privilege. Patent Owner argues that it has satisfied its routine discovery obligations because Dr. Bodor and Dr. Dandiker were cross-examined by Petitioner and the additional information Petitioner sought during the depositions is privileged.

Having heard the parties' respective arguments, we granted Petitioner's request for authorization to file a motion for additional discovery during the conference call. We instructed the parties to focus on the issue of privilege in their briefs, including supporting case law, and cautioned Petitioner that its proposed discovery requests must be narrowly tailored. *See Garmin Int'l, Inc. v. Cuzzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB March 5, 2013) (Paper 26) (precedential).

Petitioner, therefore, is granted authorization to file a motion for additional discovery of no longer than ten (10) pages. Petitioner may include its proposed discovery requests as an appendix attached to its motion. Patent Owner is granted authorization to file an opposition to Petitioner's motion of no longer than ten (10) pages.

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ORDER

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a motion for additional discovery is *granted*;

FURTHER ORDERED that Petitioner shall file its motion no later than June 12, 2024;

FURTHER ORDERED that Patent Owner is authorized to file an opposition to Petitioner's motion no later than two weeks after the filing of the motion;

FURTHER ORDERED that both Petitioner's motion and Patent Owner's opposition shall be no longer than ten (10) pages, excluding Petitioner's proposed discovery requests, which may be placed in an appendix to the motion; and

FURTHER ORDERED that no other briefing is authorized at this time.

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