

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)

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

**APPENDIX A TO PETITIONER'S MOTION
FOR ADDITIONAL DISCOVERY**

[PROPOSED] DISCOVERY REQUESTS

1. All Documents that are or reflect Communications between (i) Dr. Bodor and/or Dr. Dandiker and (ii) Patent Owner and/or counsel for Patent Owner between October 1, 2023 and February 29, 2024.

2. All Documents in the possession, custody, or control of Dr. Bodor and/or Dr. Dandiker concerning the factual disclosures described in the *Declaration of NICHOLAS BODOR, Ph.D., D.Sc., d.h.c. (multi), HoF (multi)* ¶ 20 (Ex. 2054) and/or the *Declaration of Yogesh Dandiker, Ph.D.* ¶ 24 (Ex. 2055) filed in IPR2023-00049 and IPR2023-00050.

4. All Documents provided by or shown by Patent Owner or counsel for Patent Owner to Dr. Bodor and/or Dr. Dandiker in conjunction with the preparation of the declarations filed as Ex. 2054 and Ex. 2055 in IPR2023-00049, IPR2023-00050, IPR2023-00480, and/or IPR2023-00481.

4. All Documents that are or reflect drafts of the declarations of Dr. Bodor and/or Dr. Dandiker filed as Ex. 2054 and Ex. 2055 in IPR2023-00049, IPR2023-00050, IPR2023-00480, and/or IPR2023-00481.

INSTRUCTIONS AND DEFINITIONS

In the above requests the following terms have the following stated meaning:

- a. The term “Patent Owner” means Merck Serono S.A. including its officers, agents, assigns, and attorneys (including its attorneys in IPR2023-00049 and IPR2023-00050 and the attorneys relating to the family of the patents-in-suit), its parents, subsidiaries, and affiliates (including IVAX and Ares Trading, S.A.).
- b. The term “Communication” means the transmittal of information (in the form of facts, ideas, inquiries, or otherwise).
- c. The term “Document” means is defined to be synonymous in meaning and equal in scope to the usage of this term in Fed. R. Civ. P. 34(a)(1)(A)), which states “any designated documents or electronically stored information—including writings, drawings, graphs, charts, photographs, sound recordings, images, and other data or data compilations—stored in any medium from which information can be obtained either directly or, if necessary, after translation by the responding party into a reasonably usable form.” The term “document” includes but is not limited to all tangible

things, all typed, written, printed, photocopies, photographic, graphic, or recorded matter of any kind, any recorded material however produced or reproduced, including books, agreements, calendars, charts, memory media, computer printouts, correspondence, desk pads, diaries, drafts, drawings, entries in books of account, electronic mail, facsimile transmissions, files, folders, graphs, guidelines, instructions, lists, manuals, memoranda, minutes, notes, operation procedures, pamphlets, reports, rules, studies, telegrams, teletypes, and all other written or tangible things that can be derived from the computer database, microfilm, microfiche, or other storage medium. The term “document” includes Electronically Stored Information (“ESI”), which includes individual documents and records (including associated metadata) whether as discrete files stored electronically, optically, or magnetically, or as a record within a database, archive, or container file, including emails, messages, word processed documents, recordings of videoconferences or conference calls, digital presentations, spreadsheets, database content, text messages, data recorded by Internet of Things (IoT) devices, and messages in workplace collaboration tools (including, without limitation, Slack, Microsoft Teams, and Google Hangouts) or ephemeral messaging applications. It refers to any document now or at any time in Duplo’s possession, custody, or control. A person is deemed in control of a document if the person has any ownership, possession, or custody of the document, or the right to secure the document or a copy thereof from any person or public or private entity having physical possession thereof. A draft or non-identical copy is a separate document within the meaning of this term.

- d. The term “Family of the Patents-in-Suit” means all patents, applications, and disclosures claiming priority to the same disclosures as the patent-in-suit, including but not limited to US 8,377,903; US 7,713,947; U.S. Ser No. 11/722,018; U.S. Ser. No. 12/766,173; China 200580043514.4; Australia 2005318190; Canada 2588966; India 4469/DELNP/2007; Israel 183930; European Patent Office 2005823474; Japan 2007547486; Mexico MX/a/2007/007610; Eurasian Patent Organization 200701221; Republic of Korea 1020077016508; Ukraine a200708371; Norway 20073813; Israel 212421; Serbia P-2012/0161; European Patent Office 2014001970; European Patent Office 2010182676; European Patent Office 2010182632; PCT/EP2005/056954 (published as WO 2006/067141); U.S. Ser. No. 60/638,669.
- e. The terms “all,” “any,” and “each” shall each be construed as encompassing any and all.

- f. The conjunction “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope.
- g. The term “including” means including, but not limited to.
- h. The use of the singular form of any word includes the plural and vice versa.
- i. The use of present tense includes past tense and vice versa.

June 12, 2024

Respectfully submitted,

/Philip D. Segrest, Jr./

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