

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD.,
Petitioner,

v.

REGENERON PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2023-00884

U.S. Patent No. 11,253,572

**PETITIONER'S MOTION FOR DISCOVERY
PURSUANT TO 37 C.F.R. § 42.51(b)**

TABLE OF EXHIBITS

Exhibit(s)	Description
1001-1068	<i>Previously presented</i>
1069	Email Correspondence Between Petitioner Samsung Bioepis and Third Party Mylan Pharmaceuticals, Inc. Regarding Discovery
1070	Email Correspondence Between Petitioner Samsung Bioepis and Patent Owner Regeneron Regarding Discovery
1071	Transcript of Bench Trial (June 12, 2023) in <i>Regeneron Pharms., Inc. v. Mylan Pharms. Inc.</i> , No. 22-cv-00061-TSK (N.D.W. Va. January 31, 2024) (ECF No. 558)
1072	Transcript of Bench Trial (June 20, 2023) in <i>Regeneron Pharms., Inc. v. Mylan Pharms. Inc.</i> , No. 22-cv-00061-TSK (N.D.W. Va. January 31, 2024) (ECF No. 564)
1073	Transcript of Bench Trial (June 21, 2023) in <i>Regeneron Pharms., Inc. v. Mylan Pharms. Inc.</i> , No. 22-cv-00061-TSK (N.D.W. Va. January 31, 2024) (ECF No. 566)
1074	Partial Transcript of Yancopoulos Deposition in <i>Regeneron Pharms., Inc. v. Mylan Pharms. Inc.</i> , No. 22-cv-00061-TSK (N.D.W. Va. January 31, 2024) (ECF No. 624) (REDACTED)
1075	Transcript of Karen Chu Deposition in <i>Regeneron Pharms., Inc. v. Mylan Pharms. Inc.</i> , No. 22-cv-00061-TSK (N.D.W. Va. January 31, 2024) (ECF No. 432-12)

Pursuant to 37 C.F.R. § 42.51(b) and the Board’s May 7 email authorizing this motion, Petitioner Samsung Bioepis Co., Ltd. (“Petitioner”) respectfully requests that the Board order Patent Owner Regeneron Pharmaceuticals, Inc. (“Patent Owner”) to produce certain materials from a parallel district court litigation, *Regeneron Pharmaceuticals, Inc. v. Mylan Pharmaceuticals, Inc.*, Case No. 22-cv-61-TSK (N.D.W. Va.) (the “Mylan Litigation”) involving the same patent, U.S. Patent No. 11,253,572, as this proceeding. Specifically, Petitioner requests that Patent Owner produce transcripts and underlying exhibits of prior testimony from Karen Chu and George Yancopoulos and exhibits cited in the District Court’s decision invalidating the ’572 patent (collectively, “Requested Materials” and more specifically listed in Ex. 3003 at 2).

Ms. Chu and Dr. Yancopoulos have both submitted declarations here attempting to antedate certain prior art references. Exs. 2063; 2064. Ms. Chu and Dr. Yancopoulos also testified relating to the same or similar subject matter relating to the patentability of the ’572 patent in the Mylan Litigation. *See* Exs. 1071 at 87-250; 1072 at 3-44; 1073 at 44-130; 1074; 1075. The district court considered this testimony in reaching its decision, citing Ms. Chu’s personal testimony on “the history of Eylea’s clinical development as well as Dr. Yancopoulos’s involvement” and Rule 30(b)(6) testimony on “Patent Owner’s clinical trials, secondary considerations and reduction to practice of the claimed

inventions,” and similar testimony from Dr. Yancopoulos regarding “his work leading to the methods of treatment claimed in the [’572 patent].” Ex. 2093 at 64-65. This is useful information in evaluating the patentability of the ’572 patent in this proceeding, especially given that Patent Owner relies on declarations from the same witnesses regarding the same patent. As explained below, the Requested Materials are required routine discovery and meet the five factors set forth in *Garmin Int’l, Inc. v. Cuozzo Speed Tech. L.L.C.*, IPR2012-00001, Paper 26 (P.T.A.B. Mar. 5, 2013) for additional discovery.

I. FACTUAL BACKGROUND

The Mylan Litigation. In the Mylan Litigation, the district court invalidated claims 6 and 25 of the ’572 patent. *See generally* Paper 55 (Joint Summary of Related Proceedings). Dr. Yancopoulos and Ms. Chu testified live at trial, and excerpts of Ms. Chu’s deposition were also played at trial. Neither witness’s complete deposition testimony, including any of their deposition exhibits, are publicly available, nor are the exhibits cited by the district court in the portion of its opinion on the ’572 patent.

Correspondence with Regeneron Regarding Requested Materials. Petitioner deposed Ms. Chu on April 11, and Dr. Yancopoulos the next day. One business day after Dr. Yancopoulos’s deposition, Petitioner requested that Patent Owner produce, *inter alia*, the Requested Materials. Ex. 1070 at 11-12.

Following Petitioner diligently pushing the meet and confer process forward, the parties reached an impasse on May 3, and Petitioner emailed the Board that same day to request authorization to file this motion. Ex. 3003. The Board authorized Petitioner's motion on May 7. *Id.* Petitioner's Reply is not due until June 10, 2024, over four weeks after briefing on this motion will be complete. Paper 54.

During the meet and confer, Patent Owner made numerous requests of Petitioner. Ex. 1070 at 7. Petitioner agreed to the following conditions on production: (1) amend the protective order to allow for production on an "Outside Counsel's Eyes Only" basis for materials produced on that basis in the Mylan Litigation and (2) agree not to seek additional depositions of Ms. Chu or Dr. Yancopoulos unless Patent Owner submits additional declarations. *Id.* at 8. Petitioner did not agree to Patent Owner's proposal to redact the Requested Materials of non-relevant information. As Petitioner explained, "it's not clear how Patent Owner would be able to determine what is relevant versus what is not, and performing the redactions only requires more burden and delay in producing the materials." *Id.* at 8. Finally, Mylan has confirmed that it does not oppose production of these materials. Ex. 1069.

II. PETITIONER'S REQUEST SHOULD BE GRANTED

Routine Discovery Petitioner's request is routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). The District Court found that the requested testimony and

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