

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOEHRINGER INGELHEIM ANIMAL HEALTH USA INC.,  
Petitioner,

v.

KANSAS STATE UNIVERSITY RESEARCH FOUNDATION,  
Patent Owner.

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PGR2020-00076  
Patent 10,450,351 B2

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Before ERICA A. FRANKLIN, SHERIDAN K. SNEDDEN, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

ORDER  
Denying Petitioner's Motion for Additional Discovery  
*37 C.F.R. §§ 42.51(b)(2), 42.224*

## I. INTRODUCTION

With authorization of the Board, Paper 11, Petitioner filed a motion for additional discovery, Paper 13 (“Mot.”). Petitioner asserts that the additional discovery requested is relevant to issues concerning claim construction and unpatentability under 35 U.S.C. §§ 101 and 112. Mot. 1. In particular, Petitioner seeks to serve two requests for production of documents covering all non-public patent application file histories in the same family as the challenged patent in this proceeding, i.e., U.S. Patent No. 10, 450, 351 (Ex. 1001, “the ’351 patent”). *Id.*; Appendix A. Patent Owner opposes the motion. Paper 15 (“Opp.”). For the reasons that follow, we deny Petitioner’s motion.

## II. DISCUSSION

A party seeking discovery in a post-grant review (“PGR”) beyond what is expressly permitted by rule must show that such additional discovery is “limited to evidence directly related to factual assertions advanced by either party in the proceeding.” 35 U.S.C. § 326(a)(5); *see also* 37 C.F.R. §§ 42.51(b)(2), 42.224. Discovery in Board trial proceedings is more 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).

In furtherance of that goal, the Board has identified five factors (the “*Garmin* factors”) important in determining whether additional discovery sought in an *inter partes* review (“IPR”) is in the interests of justice. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26

(PTAB Mar. 5, 2013) (precedential) (“*Garmin*”). Those same factors are helpful in determining whether discovery requests may be granted in a PGR.

However, unlike in an IPR, where an “interests of justice” standard applies, a request for additional discovery in a PGR is reviewed based upon a slightly more liberal “good cause” standard. 37 C.F.R. § 42.224(a) (“Requests for additional discovery may be granted upon a showing of good cause as to why the discovery is needed.”). The application of that different standard recognizes the scope of a PGR may be broader than an IPR, as a PGR may additionally involve patentability challenges based upon 35 U.S.C. §§101 and 112. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“CTPG”), 24 (available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>) (citing 37 C.F.R. § 42.224). Also, as explained in the CTPG,

because a petition for a PGR must be filed no later than nine months after the date of the grant of a patent or of the issuance of a reissue patent (35 U.S.C. § 321(c)), information regarding the patentability of claims subject to PGR review may be more readily available than information regarding the patentability of claims subject to other forms of review that could take place many years after the challenged patent issued, and therefore discovery in a PGR is likely to be obtained from the patent owner in a less burdensome manner.

*Id.* at 24–25.

Thus, when we review a request for additional discovery in a PGR, we will be guided by the same factors set forth in *Garmin*, as modified to reflect the “good cause” standard in *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32, 5 (PTAB May 29, 2013) (precedential). We set forth those modified discovery factors below, in the context of a PGR.

### Discovery Factors for Post-Grant Review

1. *More Than A Possibility And Mere Allegation—*  
The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing. “Useful” means favorable in substantive value to a contention of the party moving for discovery. A good cause showing requires the moving party to provide a specific factual reason for expecting reasonably that the discovery will be “useful.”
2. *Litigation Positions And Underlying Basis—*  
Asking for the other party’s litigation positions and the underlying basis for those positions is insufficient to demonstrate that the additional discovery is necessary for good cause. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.
3. *Ability To Generate Equivalent Information By Other Means—*  
A party should not seek information that reasonably can be generated without a discovery request.
4. *Easily Understandable Instructions—*  
Instructions and questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder’s ability to answer efficiently, accurately, and confidently.
5. *Requests Not Overly Burdensome To Answer—*  
Requests must not be overly burdensome to answer, given the expedited nature of a post-grant review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of the trial. Requests should be sensible and responsibly tailored according to a genuine need.

*Petitioner's Requests for Production of Documents*

Petitioner's two requests for production of documents seek the production of "all non-public prosecution files histories for all patents and patent applications filed in the United States that are related to the '351 Patent or the '369 PCT,"<sup>1</sup> as well as "all non-public prosecution files histories for all patents and patent applications filed outside the United States that are national stage entries of the '369 PCT or are otherwise related to the '351 patent or '369 PCT." Mot. 1, *see* App'x A. Petitioner and Patent Owner address each of the five discovery factors discussed above. *See* Mot. 5–13; Opp. 6–14. We have considered those arguments and determine that Petitioner has not shown persuasively "good cause as to why the discovery is needed." 37 C.F.R. § 42.224(a).

Petitioner contends that discovery factor one favors the proposed additional discovery. Mot. 5–10. According to Petitioner, "recently published patent applications show the likelihood—much more than the 'mere possibility' recited in the good cause standard—that the requested files histories contain statements that are useful to assess the scope of the challenged claims of the '351 Patent." Mot. 6. Specifically, Petitioner asserts that the publicly available file history for the child of the '351 patent, i.e., U.S. Patent Application No. 16/600,067 (Ex. 1028, "the '067 Application") includes numerous admissions by the inventor during prosecution concerning the scope of some of the same claims challenged in this proceeding. *Id.* (citing Ex. 1029, File history for the '067 Application).

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<sup>1</sup> PCT/US2016/057369 (Exhibit 1031, "the '369 PCT"). Petitioner notes that the '351 patent issued from the U.S. national stage entry of the '369 PCT. Mot. 3.

As an example, Petitioner asserts that during prosecution, Patent Owner “defined and attempted to distinguish the term ‘sequence homology’ from the term ‘sequence identity,’ and described “percent identity” as being “more stringent than homology.” *Id.* Petitioner contends that because “sequence homology” is also recited in each of the challenged independent claims, “the ’067 Application’s file history and its commentary on the shared specification between the ’351 Patent and ’067 Application is useful.” *Id.* at 7.

Additionally, Petitioner notes that the examiner for the ’067 Application rejected originally filed claim 1 in the application for lack of written description because it failed to distinguish the recited “PCV3 proteins and PCV3 ORF1, ORF2, and/or ORF3” from the proteins disclosed in the prior art and determined that the specification lacked a sufficient description of the identifying characteristics of those proteins. *Id.*

Petitioner asserts also that the published prosecution file history of the related European Patent, EP3362467, includes statements by Patent Owner that are “useful to this proceeding and show the usefulness of related non-public file histories.” *Id.* at 8. Specifically, Petitioner contends that Patent Owner’s statements in response to the examiner’s rejection of an amended version of claim 1 in the application based upon a determination that the amended claim introduced new matter that did not have adequate support in the specification would be useful to the written description issues raised by Petitioner in this proceeding. *Id.* at 9.

Based on those examples, Petitioner asserts that “it is likely—not just merely possible—that [Patent Owner] has made similar useful statements during the prosecution of other non-public patent applications in the ’351 Patent family.” *Id.* Petitioner is aware of at least one non-public U.S. patent

application that is related to the '351 patent, i.e., U.S. Application No. 17/249,100 (“the '100 Application”). *Id.* at 5. According to Petitioner, because examination of the '100 Application must consider requirements including written description, enablement, and patentable subject matter, “it is a near certainty that the file histories will contain further views of examiners and the Patent Owner with regard to issues germane to this proceeding.” *Id.* at 10.

Patent Owner argues that Petitioner “has not shown more than a mere possibility of finding the statements and arguments it seeks or that such information would be useful.” Opp. 7. Patent Owner asserts that Petitioner does not know what claims are being examined in the non-public applications that its requests are directed to, or whether those claims are similar in any meaningful way to the claims at issue in this proceeding. *Id.* Patent Owner notes that the '100 Application was filed only a month ago and would not yet contain any arguments or statements by applicant, much less useful ones. *Id.* Patent Owner contends that Petitioner “has not even put forward a contention it believes the non-public file histories would support, let alone an explanation of how they would do so.” *Id.* at 10. According to Patent Owner, Petitioner’s argument amounts to a fishing expedition. *Id.*

Having considered the arguments and evidence, we agree with Patent Owner that Petitioner has not met its burden for discovery factor one because it has failed to provide sufficient evidence or reasoning tending to establish beyond speculation that something useful will be uncovered from the production of the non-public file histories that its proposed discovery requests seek. In particular, we find that Petitioner has described no more than a mere possibility and allegation that those file histories contain any

statements regarding the construction of terms in the challenged claims or insight regarding whether the challenged claims satisfy the written description requirement. Also, as Patent Owner has argued, Petitioner has not offered a sufficient explanation of how such information would be useful, i.e., favorable in substantive value to a contention by Petitioner in this proceeding. At most, Petitioner has demonstrated only that it is already in possession of statements from other file histories that *may* be relevant to this proceeding. That showing, however, is insufficient to demonstrate more than mere speculation that it might discover useful information from the non-public file histories that it seeks. Based on the vague assertions of Petitioner regarding what those non-public file histories may contain, we agree with Patent Owner that Petitioner's discovery requests resemble a fishing expedition.

Moreover, as Petitioner acknowledges, Mot. 12, routine discovery in our trial proceedings requires a party to “serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency.” 37 C.F.R. 42.51(b)(1)(iii). Thus, to the extent that Petitioner seeks the additional discovery to gain such information, our routine discovery rule already requires production of that material.

Petitioner and Patent Owner also address the remaining four discovery factors. Mot. 6–8; Opp. 11–14. However, even if we considered those factors in favor of Petitioner, for the reasons provided above, Petitioner has not met its burden of showing good cause as to why the additional discovery is needed.



### 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 good cause for needing the additional discovery requested.

### IV. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion for Additional Discovery is *denied*.

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