

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., DR REDDY’S LABORATORIES,
INC., DR. REDDY’S LABORATORIES, LTD., SUN PHARMACEUTICAL
INDUSTRIES LTD., AND SUN PHARMACEUTICAL INDUSTRIES, INC.,
Petitioners,

v.

NOVO NORDISK A/S,
Patent Owner.

Case IPR2023-00724
Patent 10,335,462

**REPLY TO JOINED PETITIONERS DRL AND SUN IN SUPPORT OF
PATENT OWNER’S MOTION FOR ADDITIONAL DISCOVERY 37
C.F.R. §42.51(b)(2)¹**

¹ Abbreviations and cites are from Pap.71 (“Br.”), and emphasis/annotations added.

There is no dispute that PO's requests to DRL and Sun (collectively, "Petitioners") will lead to evidence establishing the extent of Mylan's participation in pursuing arguments in violation of Mylan's *Sand Revolution* stipulation, and the harm imposed as a result. Indeed, contrary to DRL's and Sun's assertions, PO explained how such discovery would be useful in light of the extant schedule. Br.3-4, 10. The *Garmin* factors weigh in favor of granting additional discovery.

Factor 1. At no point in Petitioners' analysis do they argue anything relevant to *Garmin* factor 1. "The essence of Factor (1) is unambiguously expressed by its language, *i.e.*, the requester of information should already be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered." *Garmin*, Paper 26, 7. Petitioners argue no useful discovery "resides **uniquely** with DRL and Sun." Opp.3. But Petitioners don't dispute that discoverable information resides with DRL and Sun, and nothing in *Garmin* or the PTAB's November 2019 Consolidated Trial Practice Guide ("TPG") requires discoverable information be **uniquely** in a party's control. *See Garmin*, Pap.26, 7-13; *TPG*, 25-26; Opp.3.

Further, Petitioners incorrectly suggest that additional discovery would not be useful to address the dispute about the scope of Mylan's violation. Opp.3. But in fact, part of the substantive value of the additional discovery is to establish the **relative** participation of the Petitioners and Mylan in pursuing the overlapping

grounds in litigation. *See* Pap.69, 5. The extent of *Mylan*’s participation (including its relative participation compared to DRL and Sun) is relevant to *Mylan*’s and Petitioners’ arguments that the sanctions sought are disproportionate and that there is no harm to PO. Pap.82, 3-5 (arguing proposed sanctions are “draconian” and “Novo has not established harm”); Pap.80, 12-15 (*Mylan* arguing proposed sanctions are “wildly disproportionate” and that “there is no harm” to PO or the Board).

Petitioners also confuse sanctions with discovery, arguing their supposedly “exemplary” conduct (addressed in PO’s sanctions briefing) somehow exempts them from discovery. Opp.3.

Factor 2. Petitioners argue the requested discovery “carries a significant risk of revealing the litigation positions....” Opp.3-4. But PO merely seeks information about the retention, payment, and frequency of communication with experts, not the substance of communications or litigation positions. *See Motorola Mobility LLC v. Largan Precision Co., Ltd.*, IPR2022-01022, Pap.57, 6-7 (Nov. 29, 2023). Moreover, Petitioner can provide a log/redact information that may reflect privileged/work-product information about litigation positions. Thus, factor 2 favors additional discovery.

Factor 3. Next, Petitioners argue the requested information “is either already in Novo’s possession or is otherwise discoverable from *Mylan*.” Opp.4. First, the substantive value of the requested additional discovery is not merely corroborating

that Petitioner Mylan pursued overlapping grounds, so the requested information is not “already in Novo’s possession.” *Id.* The discovery from Petitioners DRL and Sun will provide a more complete picture of the **extent** of Mylan’s participation in the overlapping grounds, such as with respect to relative payment of the experts and involvement in the preparation of the expert reports. And Mylan may not have information about, *e.g.*, DRL and Sun’s payments to experts, the frequency of their communications with experts (unless Mylan was involved), and their respective retention agreements. Even if there is overlap, that two parties might both possess information cannot mean that it is discoverable from neither, and DRL and Sun cite no such case.

CQV Co. Ltd. v. Merck Patent GmbH is clearly inapposite because the movant’s discovery requests there were directed to a **nonparty** (whereas DRL and Sun are both joined as Petitioners here), and the *CQV* movant’s purpose for seeking additional discovery was “to corroborate information that it contends is already within its possession” (whereas here PO seeks additional information it does not possess). PGR2021-00054, Paper 36, 2, 10 (Mar. 2, 2022).

Factor 4. Petitioners argue that the requests “are not easily understandable because they include vague phrases....” Opp.5. But these are plain and ordinary English phrases, and Petitioners’ boilerplate objections do not identify what they actually contend is vague about them. On the contrary, RFP Nos. 1, 2, and 3 each

minimize the burden on Petitioner Mylan by seeking only “[d]ocuments *sufficient to show*” and by narrowing the requests to information related to the three experts on three *specific overlapping grounds* asserted for one patent (the ’462). Br.4-5. Similarly, the Interrogatories (an alternative to the RFPs) are limited in that they are directed to just three experts’ work on three invalidity arguments regarding ’462, and only as to their retention, direction, and compensation over a period of time limited to that retention. Br.5-6. Tellingly, Mylan (while making other complaints), has not objected to the same discovery requests for being vague. See Pap.79.

Factor 5. Petitioners argue the requests “require parsing through months of invoices,” that privilege issues are implicated, and that they should be immune from discovery because there are “no allegations of misconduct against DRL and Sun.” Opp.5. Setting aside that Petitioners’ fault is not part of factor 5, Petitioners DRL and Sun (as further addressed in PO’s sanctions briefing) were aware of Mylan’s *Sand Revolution* stipulation, stood by while Mylan violated it, and benefited from Mylan’s violation. *E.g.*, Pap.70, 4-5 n.5; IPR2024-00009, Pap.18, 1-2 (DRL); (“in violation of the stipulation Mylan promised”); IPR2024-00107, Pap.14, 1-2 (Sun).

Petitioner’s complaints overstate the burden of the requests. For example, DRL and Sun need only review a limited number of months of expert bills—at most back to the time they retained the three experts in question (which, according to DRL’s and Sun’s own statements, is after Mylan’s institution decision (Pap.70, 4-

5))—assuming they paid the experts (or reimbursed Mylan) at all. EX2552, 65:1-7, 74:19-75:3 (Bantle testifying he received payment only from Mylan’s counsel). Further, the requests do not seek communications between co-defendants, but rather communications with any of Mylan’s IPR experts. Br.4-6. Nor do the requests seek *privileged or work product protected information*. PO merely seeks information about the retention, payment, and **frequency** of communication with experts—not the **substance** of the communications with the experts. Work product does not protect communications between counsel and experts as to factual information, such as the bases for an opinion, or compensation. *See, e.g., Apple Inc. v. Singapore Asahi Chem. & Solder Indus. PTE Ltd.*, IPR2019-00377, Paper 22, 10 (Oct. 21, 2019); *see also* Fed. R. Civ. P. 26(b)(4)(C) (excluding from work product protection expert witness communications “relat[ing] to compensation for the expert’s study or testimony,” factual information and assumptions); EX2552, 65:1-67:20; EX2553, 52:9-54:6. DRL and Sun cite **no case** suggesting the frequency or times of counsel-expert interactions are privileged. *Cf.*, EX1140, 8:22-9:17 (Mylan asking similar questions). In any case, DRL and Sun may provide privilege logs as necessary. Br.4; *Cavium, LLC v. Alacritech, Inc.*, IPR2018-00401, Paper 24, 12-13 (Nov. 20, 2018) (“the request explicitly contemplates... a privilege log ..., and we, accordingly, do not understand the request to require production of... work-product”).

Respectfully submitted: /Megan Raymond/

August 23, 2024

CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing REPLY IN SUPPORT OF PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY 37 C.F.R. §42.51(b)(2) FROM PETITIONERS DR. REDDY'S LABORATORIES, INC. AND SUN PHARMACEUTICAL INDUSTRIES LTD. complies with the Board's July 26, 2024 (Pap.69) limiting this motion to 5 pages.

Dated: August 23, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of REPLY IN SUPPORT OF PATENT OWNER’S MOTION FOR ADDITIONAL DISCOVERY 37 C.F.R. §42.51(b)(2) FROM PETITIONERS DR. REDDY’S LABORATORIES, INC. AND SUN PHARMACEUTICAL INDUSTRIES LTD. has been served in its entirety by causing the aforementioned document to be electronically mailed to the following attorneys of record for the Petitioners listed below:

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