

From: [Trials](#)
To: [Cipriano, Linnea P](#); [Trials](#)
Cc: [Diner, Bryan](#); [Hasford, Justin](#); [Goldberg, Joshua](#); [Luneack, Matthew](#); [Officer, Cassandra](#); [Yang, Christina Ji-Hye](#); [McDonnell, Ryan](#); [david.weingarten@finnegan.com](#); [O'Quinn, Ryan](#); [extDG-Brimonidine](#)
Subject: RE: IPR2024-00467 & -00563 - Additional Discovery
Date: Tuesday, January 14, 2025 8:22:03 AM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)

Counsel,

From the Board –

Petitioner's request for authorization to file a motion for additional discovery is granted. The motion is limited to seven pages and must be filed within five business days of this email.

Patent Owner is authorized to file an opposition to Petitioner's motion. The opposition is limited to seven pages and must be filed within five business days of Petitioner's filing of the motion.

Patent Owner's request for authorization to submit sur-reply expert declaration(s) will be addressed separately at a later time, if necessary.

No conference is needed at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Cipriano, Linnea P <LCipriano@goodwinlaw.com>
Sent: Friday, January 10, 2025 4:53 PM
To: Trials <Trials@USPTO.GOV>
Cc: Diner, Bryan <bryan.diner@finnegan.com>; Hasford, Justin <Justin.Hasford@finnegan.com>; Goldberg, Joshua <Joshua.Goldberg@finnegan.com>; Luneack, Matthew <Matthew.Luneack@finnegan.com>; Officer, Cassandra <Cassandra.Officer@finnegan.com>; Yang, Christina Ji-Hye <Christina.Yang@finnegan.com>; McDonnell, Ryan <Ryan.McDonnell@finnegan.com>; david.weingarten@finnegan.com; O'Quinn, Ryan <Ryan.O'Quinn@finnegan.com>; extDG-Brimonidine <extDG-Brimonidine@goodwinlaw.com>
Subject: IPR2024-00467 & -00563 - Additional Discovery

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Dear Honorable Board,

Petitioners in the above-captioned proceedings respectfully request leave to move for additional discovery under 37 C.F.R. § 42.51(b)(2). The requested documents are relevant to objective indicia of non-obviousness that Patent Owner raised in its Responses, including but not limited to commercial success, unexpected results, industry praise, and nexus. All requested documents were produced by plaintiffs in the associated district court litigation, *In re Lumify*, 3:21-cv-16766-RK-RLS, and most were used as evidence during a preliminary injunction proceeding related to this patent family. All the documents are in Petitioners' counsel's possession, but these documents are subject to the provisions of a protective order, restricting their use in this proceeding. The parties have agreed to the cross use of some documents between these proceedings subject to the protective order in these IPR proceedings, but after over a month of discussions between the parties, no agreement has been reached related to these documents.

Petitioners submit that the additional discovery is necessary in the interest of justice. For example, many of the documents requested by Petitioners were exhibits to the district court depositions of Patent Owner's declarants in these IPR proceedings. Petitioners' motion would demonstrate that the factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential) favor granting discovery here.

Petitioners specifically request production of the following documents:

1. Unredacted, native versions of the Bausch & Lomb financial spreadsheets from 2021 to present, identified as Exhibits 213 (BAU_LUM00080128) and 212 (BAU_LUM00080129) to Docket Entry 283, *In re Lumify*, 3:21-cv-16766-RK-RLS.
2. Unredacted versions of the following Brand Health Trackers for Lumify:
 1. BAU-LUM00080130
 2. BAU-LUM00080376
 3. BAU-LUM00080690
 4. BAU-LUM00089020
 5. BAU-LUM00080904
 6. BAU-LUM00080205
 7. BAU-LUM00080761
 8. BAU-LUM00080834
 9. BAU-LUM00089156
 10. BAU-LUM00080983
 11. BAU-LUM00080281
3. Unredacted Declaration of Annelise Riebling and the documents cited therein (Exhibit 155 to Docket Entry 279, *In re Lumify*, 3:21-cv-16766-RK-RLS).
4. Unredacted Declaration of John Ferris and the documents cited therein (Exhibit 162 to Docket Entry 279, *In re Lumify*, 3:21-cv-16766-RK-RLS).
5. Unredacted Second Declaration of John Ferris and the documents cited therein (Exhibit 108 to Docket Entry 284, *In re Lumify*, 3:21-cv-16766-RK-RLS).
6. Unredacted transcripts and corresponding exhibits from the depositions taken in the district court litigation, *In re Lumify*, 3:21-cv-16766-RK-RLS, including:
 1. The deposition transcript of John Ferris (Exhibit 295 to Docket Entry 283) and marked exhibits;
 2. The deposition transcript of Annelise Riebling (Exhibit 298 to Docket Entry 283) and marked exhibits; and
 3. The deposition transcript of Bausch & Lomb's 30(b)(6) witness, John Ferris, and marked exhibits.

7. Unredacted versions of the following clinical study reports for IND No. 108,524:

1. BAU_LUM00002744 (Study # 10-100-0008)
2. BAU_LUM00001699 (Study # 11-100-0015)
3. BAU_LUM00044972 (Study # 13-100-0005)

The parties have met and conferred. As an initial matter, Patent Owner objects to the argumentative nature of Petitioners' email. That said, Patent Owner is amenable to the use of the documents listed above in IPR2024-00467 and IPR2024-00563, provided that (1) Petitioners redact protected personal information and protected health information from the three clinical study reports before using any of these documents in depositions and/or as exhibits to Petitioner's replies, and (2) Petitioners agree that Patent Owner may file expert declaration(s) with its sur-replies to the extent Petitioners raise arguments in declarations with their replies based on the documents listed above that Patent Owner's experts have not yet had a chance to address. Petitioners had these documents well before they filed the petitions, but they are asking—for the first time in these proceedings—that these documents be used in support of Petitioners' replies on the issue of obviousness for which Petitioners have the ultimate burden of proof, notwithstanding evidence of objective indicia being of record. Because Patent Owner cannot submit rebuttal expert declarations with its sur-replies as a matter of course, Patent Owner seeks the Board's authorization to submit sur-reply expert declaration(s) to address Petitioners' arguments based on the documents listed above that Patent Owner's experts have not yet had a chance to address to mitigate prejudice to Patent Owner caused by Petitioners' request.

Petitioners agree to Patent Owner's first condition. Petitioners do not believe that any modification of the rules regarding what is permitted in a Sur-Reply is appropriate at this time. Patent Owner disagrees.

The parties can be available for a teleconference on the following days:

- Monday, 1/13: 12-3pm
- Tuesday, 1/14: 9-12pm
- Wednesday, 1/15: 10-11am or 2-4pm
- Friday, 1/17: 10-2pm

The parties can also provide their availability the following week should the Board desire.

Regards,

Linnea P. Cipriano

she/her/hers



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