

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. REDDY'S LABORATORIES S.A. and
DR. REDDY'S LABORATORIES, INC.,

Petitioners,

v.

EYE THERAPIES, LLC,

Patent Owner.

Case IPR2024-00467
U.S. Patent No. 11,833,245

**PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION FOR
ADDITIONAL DISCOVERY**

In response to Petitioners' skewed factual-recounting leading to the Motion for Additional Discovery (Paper 46, "Mot."), Patent Owner level-sets that background and explains why Petitioners failed to carry their burden justifying nearly 10,000 pages of discovery. Still, Patent Owner proposed a compromise resolution, rejected by Petitioners, that would allow the discovery while fairly and equitably protecting Patent Owner from undue prejudice.

I. BACKGROUND

In December 2023, Patent Owner Eye Therapies, along with the Bausch+Lomb entities ("Bausch"), filed a motion for preliminary injunction ("PI") against Petitioners in the related district court proceeding. Up to and through the PI motion, the parties engaged in extensive discovery producing thousands of Bausch confidential documents, including the documents Petitioners' Motion seeks as allegedly relevant to objective indicia of nonobviousness. All briefing on the motion closed by mid-January 2024, and by the end of that month, the District Court held a six-day evidentiary hearing. During the hearing, Petitioners filed this IPR but did not rely on any Bausch confidential documents, notwithstanding Petitioners' concession (Mot., 6) that Patent Owner had previously advanced objective indicia "arguments to the Board [and] District Court." Nor did Petitioners approach Patent Owner to use the documents it now seeks, though they could have and thus potentially avoided having this Panel address this Motion.

In October 2024, the parties agreed to treat the deposition transcripts and hearing transcripts from the PI as if the testimony were taken in IPR2024-00467 and IPR2024-00563 (“IPR proceedings”) to avoid duplicative witness depositions. EX-2276 at 1-2. Contrary to Petitioners’ factual recounting, they never asked to broaden the mutually beneficial agreement to include documents beyond the PI deposition and hearing transcripts. *See id.*

By November 2024, the District Court stayed the litigation pending resolution of the IPR proceedings and administratively closed the proceeding. EX-2277. In December 2024, Petitioners contacted Patent Owner, proposing for the first time that the parties modify the Discovery Confidentiality Order (DCO) in the litigation to permit the use of produced Bausch confidential documents in the IPR proceedings. EX-2278 at 25. Because the District Court administratively closed the case, Patent Owner responded it was not aware of a procedural mechanism to do so and sought Petitioners’ input in that regard. *Id.* at 24. Petitioners ignored this and pivoted instead to demanding that Patent Owner agree to cross-use. *Id.* at 20-21. Though the DCO contemplates possible modification, Petitioners chose not to seek the District Court’s guidance in doing so and opted instead to have this Panel decide a district court discovery issue that could have been addressed, and possibly resolved, a year earlier. Ex. 1039, ¶¶ 15-16.

II. THE *GARMIN* FACTORS WEIGH AGAINST DISCOVERY

Several *Garmin* factors demonstrate that the requested discovery is *not* “in the interest of justice.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential).

A. Factor 3: The Discovery was Obtainable by Other Means

The third *Garmin* factor weighs in favor of Patent Owner—Petitioners’ position (Mot., 7) that they did not “have any other means to generate this information” is false. *See Mianyang BOE Optoelectronics Tech. Co. Ltd. v. Samsung Display Co. Ltd.*, IPR2023-00941, Paper 30 at 8-9 (PTAB Feb. 27, 2024) (finding Factor 3 weighed “very strongly against granting ... Additional Discovery” where requesting party failed to seek modification of the protective order to use information in IPR). Notwithstanding the litigation stay, Petitioners could have, but did not, seek the Court’s guidance to amend the modifiable DCO, choosing instead to burden this Panel with a discovery request of nearly 10,000 pages of largely irrelevant documents. *See generally, Steuben Foods, Inc. v. GEA Process Eng’g, Inc.*, C.A. 12-cv-00904-EAW-JJM (W.D.N.Y. Feb. 15, 2015) (granting relief from modifiable protective order in stayed litigation to use requested document in IPR).

B. Factor 5: The Discovery Requests Are Overly Burdensome

Regarding the fifth *Garmin* factor, Petitioners’ argument that there is “no burden on Patent Owner” is incorrect. Petitioners do not simply request seven

documents, but rather seven **groups** of documents, containing sub-parts and seeking “documents cited therein” and “corresponding exhibits.” Petitioners’ request seeks about 10,000 pages of information, the majority of which is irrelevant to objective indicia. For example, the three clinical study reports (Group 7, ~3000 pages) contain reams of raw data and protected patient data/health information, which is not only irrelevant but will require extensive, meticulous, and verified redacting to comply with privacy laws. Petitioners’ broadbrush, burdensome, and unnecessary requests of ~10,000 pages of information were not properly and “responsibly tailored according to a genuine need,” needlessly complicating and increasing this matter’s complexity. *Garmin*, Paper 26 at 7. For instance, Petitioners should have, but failed, to identify the specific pages they seek from ~3000 pages of clinical study information. Petitioners’ failure to do so should not be countenanced.

C. Factor 1: Petitioners Failed to Show Discovery will be Useful

The discovery of “useful” information within the context of Factor 1 does not mean “admissible” or even “relevant” but rather requires the evidence be “favorable in substantive value to a contention of the party moving for discovery.” *Garmin*, Paper 26 at 7. Petitioners merely and insufficiently allege that the requested ~10,000 pages of documents “contain information that is relevant to ... secondary considerations of non-obviousness” while failing to cite **any** evidence in support thereof. *See Scout Energy Mgmt. LLC v. Pilot Intell. Prop., LLC*, IPR2024-00385,

Paper 18 at 5 (PTAB Nov. 5, 2024) (finding nonsatisfaction on Factor 1 where movant's assertions "are without any factual support" and fail to cite "any evidence to support its many assertions"). Petitioners' discovery requests are tantamount to categorical "requests for production," and their self-serving, non-particular relevancy assessment cannot meet the threshold level of evidence required to show the ~10,000 pages will be substantively useful. *See Mianyang*, Paper 30 at 6 (declining to "trust . . . and not just adopt [discovery requester's] 'self-serving' assessment that is not backed by any reviewable evidence"); *see also Silicon Labs, Inc. v. Cresta Tech. Corp.*, IPR2014-00728, Paper 27 at 3 (PTAB Dec. 10, 2014) (declining additional discovery request for lack of any evidence to assess "accuracy of [requester's] contentions").

For example, Petitioners admit that the clinical trial reports they seek "*may* provide appropriate context for or rebut Patent Owner's unexpected results arguments." Mot., 6 (emphasis added). This "mere possibility" further exemplifies Petitioners' failure to meet the minimum evidence *Garmin* requires to show beyond speculation that ~3,000 pages from clinical studies will be substantively useful. *Garmin*, Paper 26 at 6. Petitioners needed to provide some evidentiary showing to explain why specific documents should be produced. They did not, providing instead broad, general statements to support equally broad swaths of document categories totaling ~10,000 pages and failing to satisfy Factor 1.

III. PROPOSED COMPROMISE TO RESOLVE DISPUTE

Patent Owner would agree to Petitioners' use of the identified documents subject to two conditions Petitioners' Motion notes (Mot., 3), which would reasonably and fairly minimize prejudice to Patent Owner. Only one condition is disputed—Patent Owner seeks to submit sur-reply declarations to challenges by Petitioners' experts on objective indicia. To the extent Petitioners would argue their Petition could not prebut whether Patent Owner would proffer objective indicia evidence—notwithstanding Petitioners' acknowledgement that they already had in hand *all* of Plaintiffs' expert declarations and evidence on objective indicia related to the '245 patent from the PI proceeding (*see* Mot. at 6)—neither could Patent Owner have reasonably anticipated what information from financial or clinical study documents Petitioners might rely on, if any, to challenge objective indicia. And as Patent Owner has the burden of production on objective indicia, just as Petitioners have the burden of proof on obviousness permitting them two rounds of expert declarations (in the Petition and Reply), fairness dictates Patent Owner should have two rounds of expert declarations to support its burden on the issue of objective indicia.

IV. CONCLUSION

Patent Owner respectfully requests the Board either deny the discovery motion or grant Patent Owners' proposed compromise.

Respectfully submitted,

Dated: January 29, 2025

/Bryan C. Diner/
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Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Opposition to Petitioners' Motion for Additional Discovery** was served on January 29, 2025, via email directed to counsel of record for the Petitioners at the following:

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Dated: January 29, 2025

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