

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.,
Petitioner,

v.

EYE THERAPIES, LLC,
Patent Owner.

IPR2024-00467 (Patent 11,833,245 B2)
IPR2024-00563 (Patent 11,596,600 B2)¹

Before ZHENYU YANG, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

ORDER

Denying without Prejudice Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)(i)

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

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With our authorization (Ex. 3003), Dr. Reddy's Laboratories S.A. and Dr. Reddy's Laboratories, Inc. (collectively, "Petitioner") filed a Motion for Additional Discovery. Paper 46² ("Mot."). Eye Therapies, LLC ("Patent Owner") filed an opposition to the Motion. Paper 53 ("Opp."). For the following reasons, we deny Petitioner's Motion without prejudice.

I. Background

Patent Owner asserted several related patents in a family, including U.S. Patent Nos. 11,833,245 and 11,596,600, in the district court in *In re Lumify*, Case No. 3:21-cv-16766 (D.N.J.). Mot. 1. In December 2023, Patent Owner filed a motion for a preliminary injunction. *Id.*; Opp. 2. According to the parties, in connection with that motion, the parties engaged in extensive discovery, filed numerous declarations and took depositions of those declarants. Mot. 1; Opp. 2. The parties agreed to "treat the deposition transcripts and hearing transcripts from the preliminary injunction proceeding as if the testimony were taken in IPR2024-00467 and IPR2024-00563" (collectively "the current IPR proceedings"). Ex. 2276, 1–2.

In the district court, Patent Owner also produced "thousands of Bausch confidential documents."³ Opp. 2. Those documents "contain information that Patent Owner (or Bausch) claims is confidential and is subject to a protective order." Mot. 1. When the parties filed the stipulated protective order in the district court, they included a provision regarding potential cross-use of documents between the district court case and two

² For expediency, we cite to papers in IPR2024-00467. Similar papers and exhibits were filed in IPR2024-00563.

³ Patent Owner identified Bausch & Lomb, Inc. and Bausch & Lomb Ireland Limited as real parties in interest in the IPR proceedings. Paper 3, 2.

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then-pending IPRs (not the current IPR proceedings). Ex. 1039 ¶ 2 (“If IPR2022-00142 and/or IPR2022-00146 is instituted, the Parties will confer regarding the need for, and appropriate terms of, an agreement permitting the cross-use of Counsel’s Eyes Only information in IPR2022-00142 and/or IPR2022-00146.”).⁴ Petitioner now seeks the ability to use some of those documents in the current IPR proceedings. Mot. 1.

II. Analysis

Under our Rules, “a party may move for additional discovery” where the parties fail to agree to it between themselves. 37 C.F.R. § 42.51(b)(2)(i). As Petitioner is seeking discovery beyond what is expressly permitted by rule for an *inter partes* review, Petitioner bears the burden of demonstrating that it is entitled to the additional discovery sought, and must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5)(B); 37 C.F.R. §§ 42.20(c), 42.51(b)(2)(i). We consider several factors in determining whether additional discovery is necessary in the interest of justice. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential).

The parties dispute over whether the *Garmin* factors weigh in favor or against the additional discovery requested by Petitioner. Mot. 5–7; Opp. 4–6. Petitioner argues that “[c]ounsel for Petitioners are in possession of these documents and know that the requested documents contain information that is relevant to Patent Owner’s arguments on secondary considerations of non-obviousness.” Mot. 5; *see also id.* at 3–6 (asserting that the documents requested are relevant to Patent Owner’s alleged commercial success and

⁴ Each of IPR2022-00142 and IPR2022-00146 challenges a patent in the same family as the ’245 and ’600 patents.

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unexpected results). Petitioner asserts that it does not have any other means to generate this information, and there is no burden on Patent Owner because Petitioner's counsel are already in possession of the documents. *Id.* at 7.

Petitioner further contends that it has given easily understandable instructions by identifying the exact documents and is not using the document requests to “inappropriately seek Patent Owner's litigation strategy.” *Id.* at 6–7.

Patent Owner does not dispute that Petitioner's instructions are easily understandable or that Petitioner is not seeking Patent Owner's litigation strategy. *See generally* Opp. Patent Owner, however, argues that Petitioner does not cite any evidence to show the requested documents contain information relevant to secondary considerations, and thus, fails to show the discovery will be useful. *Id.* at 5–6. Patent Owner also contends that Petitioner's requested discovery was obtainable by other means. *Id.* at 4. Patent Owner asserts that the district court's protective order “contemplates possible modification.” *Id.* at 3 (citing Ex. 1039 ¶¶ 15, 16). Thus, Patent Owner continues, although the district court stayed the litigation and administratively closed the proceeding, “Petitioners could have, but did not,” seek the district court's guidance to amend the modifiable protective order, presumably to address the cross-use of documents between the district court case and the current IPR proceedings. *Id.* at 4 (citing Ex. 2277). Further, according to Patent Owner, because about 3,000 pages of the requested documents require redaction, the discovery requests are overly burdensome. *Id.* at 4–5.

Patent Owner, however, states that it would agree to Petitioner's use of the identified documents subject to two conditions:

(1) Petitioners redact any personal identifying and protected health information from the clinical study reports before use in depositions or Petitioners' Replies and (2) Petitioners agree that Patent Owner may file expert declarations with its Sur-Replies to the extent Petitioners raise arguments in its Replies based on any of the documents requested.

Pet. 3; Opp. 7. Petitioner agrees to the first condition, but argues that "modification of the rules governing Sur-Replies is not appropriate at this time." Pet. 3.

It is undisputed that the documents Petitioner seeks to use are subject to the district court's protective order. Thus, the critical question here, independent of our *Garmin* factor analysis, is whether Petitioner is complying with the district court's protective order. That is not a question that this panel can answer. Petitioner may wish to seek guidance from the district court for relief.

Alternatively, Petitioner may use the requested documents with Patent Owner's permission. Patent Owner has indicated that it would give such permission subject to the two conditions, one of which Petitioner has agreed to. Regarding the second condition, to the extent it helps the parties' further discussion of this matter, in the event that Petitioner relies on the requested documents in the Reply, the panel hereby authorizes Patent Owner to submit Sur-reply declarations, limited to addressing Petitioner's reliance on the requested documents. Patent Owner must make the Sur-reply declarants available for deposition. Petitioner is authorized to depose the Sur-reply declarants and file a ten-page Sur-sur-reply, limited to addressing the Sur-reply declarations and Patent Owner's reliance thereon. No other papers or exhibits will be authorized as related to this matter. If the parties choose this approach, the parties are instructed to meet and confer and jointly

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propose a modified scheduling order. To facilitate this discussion, and depending on the resources, the panel may be able to postpone the oral argument to a date no later than June 13, 2025.

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's Motion for Additional Discovery is denied without prejudice.

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