

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARLES RIVER LABORATORIES, INC.,

Petitioner,

v.

SEIKAGAKU CORPORATION,

Patent Owner.

Case No. IPR2025-00440

Patent No. 11,236,318

**PATENT OWNER’S MOTION TO COMPEL
ROUTINE DISCOVERY UNDER 37 C.F.R. § 42.51(b)(1)(iii)¹**

¹ The motion filed in this proceeding and PGR2025-00023 is identical with the following exceptions: (i) reference to the IPR and PGR proceeding on pages 1 and 2 is changed to correspond with the proceeding the motion is filed; and (ii) citations to support the sentence on page 2 “[t]he statements made in the Opposition contradict statements made by CRL in its Petition” differ to match the proper proceeding.

I. INTRODUCTION

Pursuant to authorization granted on August 1, 2025, Paper 10, Patent Owner Seikagaku Corporation (“Seikagaku” or “PO”) moves to compel Petitioner Charles River Laboratories, Inc. (“CRL”) to (i) confirm whether it initiated Opposition proceedings before the European Patent Office against PO’s European Patent number 3530670 (“Opposition”); and (ii) produce any other relevant information of which it is aware that is inconsistent with a position it advanced in IPR2025-00440.

II. CRL MUST PRODUCE INFORMATION ON AN INCONSISTENT POSITION AS “ROUTINE DISCOVERY.”

The requested discovery is “routine” because it concerns information inconsistent with a position advanced by CRL. 37 C.F.R. § 42.51(b)(1)(iii). And CRL newly and mistakenly relies on the attorney-client privilege to evade its obligations. The issue is quite simple. If CRL is *not* the party behind the Opposition, then there is no attorney-client relationship involving CRL and, thus, no privilege. But if CRL *is* the party behind the Opposition, then the identity of CRL is a non-privileged fact. This Motion should be granted and privilege is no excuse.

A. PO’s Requested Discovery Qualifies as “Routine Discovery”

PO’s discovery requests fall within the purview of “routine discovery.” Indeed, 37 C.F.R. § 42.51(b)(1)(iii) states that as part of routine discovery, “a party must 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.”

PO thus requests that CRL confirm whether it filed the Opposition. As explained in PO's Preliminary Response, strong evidence indicates CRL filed the Opposition, including commissioning a declaration from an expert in the field—Professor Frohman. Paper 7 at 29, 34-41. The statements made in the Opposition contradict statements made by CRL in its Petition. *Compare* Pet. at 38 (asserting “extensive amount of experimentation” required to discover and characterize the gene and amino acid sequence for *Limulus polyphemus* Factor C), *with* Ex. 1048 ¶ 32 (“The fact that the [*Limulus polyphemus* Factor C] sequence determination necessary to arrive at claim 1 requires nothing more than ‘routine analysis’ has been confirmed in the expert declaration of Professor Frohman”); Paper 7 at 30-32 (describing Professor Frohman's statements, including reliance on publications from the 1990s, that no undue experimentation necessary to discover and characterize the sequence for *Limulus polyphemus* Factor C).

PO also requests that CRL produce any other inconsistent information of that is inconsistent with a position it advanced in IPR2025-00440. The inconsistencies between statements in the Opposition and statements in the Petition beg the question whether CRL has taken similarly inconsistent positions in other proceedings. *See, e.g., CommScope Techs. LLC v. Belden Inc.*, No. IPR2023-01061, Paper 27 at 3-7

(P.T.A.B. May 13, 2024) (granting motion to compel production of all relevant information that Patent Owner is aware is inconsistent with a position advanced in the IPR).

Thus, not only is PO entitled to discover this information as part of routine discovery, but CRL should have included this information as part of its original Petition. Whether CRL filed the Opposition and whether it has taken similar inconsistent positions, is relevant to institution. As explained in PO's Preliminary Response, the Opposition's statements tell a different story about the state of the art than what CRL argues for in its Petition and further highlights CRL's deficient § 112 analysis focusing only on the state of the art in 2013.

B. The Attorney-Client Privilege Does Not Protect The Information from Discovery

Raised for the first time during the August 1, 2025 conference call, Petitioner asserts that "whether or not it filed the '670 Opposition would be privileged." Paper 10 at 2; *see* Ex. 1062 at 28:5-30:5. The law overwhelmingly says otherwise.

The Federal Rules of Evidence control whether the attorney-client privilege applies. *See* 37 C.F.R. § 42.62(a) ("Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding."); 82 Fed. Reg. 51570, 51571 (Nov. 7, 2017) ("The precise metes and bounds of what types of communications are protected by privilege are determined according to Federal law."). Under the

Federal Rules, the privilege “shall be governed by the principles of the common law as they may be interpreted by the courts of the United States in the light of reason and experience.” Fed. R. Evid. 501.

For the attorney-client privilege to apply, the communications must be (1) between a client and its attorney, (2) intended to be and in fact were, kept confidential, and (3) for the purposes of obtaining or providing legal advice. *See, e.g., Fisher v. United States*, 425 U.S. 391, 403 (1976); *United States v. Roberts*, 84 F.4th 659, 670 (6th Cir. 2023); *In re Kellogg Brown & Root, Inc.*, 756 F.3d 754, 757 (D.C. Cir. 2014); *Gomez v. Vernon*, 255 F.3d 1118, 1131 (9th Cir. 2001); *Denius v. Dunlap*, 209 F.3d 944, 952 (7th Cir. 2000); *Cox v. Adm’r U.S. Steel & Carnegie*, 17 F.3d 1386, 1414 (11th Cir.), *opinion modified on reh’g*, 30 F.3d 1347 (11th Cir. 1994). And the burden of establishing the privilege rests with the party invoking it—here, CRL. *Siler v. Env’t Prot. Agency*, 908 F.3d 1291, 1297 (Fed. Cir. 2018).

CRL has done nothing to meet its burden to show that the privilege protects whether CRL is behind the EPO opposition. CRL has made no attempt to satisfy the elements, provide a privilege log, or otherwise “describe the nature of the documents, communications, or tangible things not produced or disclosed... in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.” Fed. R. Civ. P. 26(b)(5).

Nor could it. Courts have repeatedly held the attorney-client privilege does

not protect the identity of a client. *E.g., Taylor Lohmeyer Law Firm P.L.L.C. v. United States*, 957 F.3d 505, 512 (5th Cir. 2020); *United States v. Servin*, 721 F. App'x 156, 159 (3d Cir. 2018); *Reiserer v. United States*, 479 F.3d 1160, 1165 (9th Cir. 2007); *United States v. Hunton & Williams*, 952 F. Supp. 843 (D.D.C. 1997); *Lefcourt v. United States*, 125 F.3d 79, 86 (2d Cir. 1997); *United States v. Ellis*, 90 F.3d 447, 450 (11th Cir. 1996); *In re Grand Jury Subpoena*, 55 F.3d 368, 369 (8th Cir. 1995); *United States v. Ritchie*, 15 F.3d 592, 602 (6th Cir. 1994).

Indeed, courts have held that a client's identity is a ***non-privileged fact***.² *Ex. 1062* at 28:18-30:5; *see Upjohn Co. v. United States*, 449 U.S. 383, 395 (1981) (the "privilege extends only to communications and not to facts"); *In re Grand Jury Subpoenas*, 803 F.2d 493, 496 (9th Cir. 1986) ("Generally, the identity of an attorney's client and the nature of the fee arrangement between an attorney and his client are not privileged. The fact of representation and the associated fee arrangement are preliminary, by their own nature, establishing only the existence of the relation between client and counsel, and therefore, normally do not involve the disclosure of any communication arising from that relation after it was created."

² If, in opposing this motion, CRL contends some exception to the general rule applies, it will be the first time that Patent Owner receives notice of such a position, and Patent Owner will seek leave to file a reply.

(internal citations omitted)); *see also* 82 Fed. Reg. 51570, 51571 (Nov. 7, 2017) (“the privilege only protects information exchanged for purposes of obtaining legal opinions or services, not underlying facts or business documents”).

Nothing about the EPO proceeding salvages CRL’s position. Although a representative may file an opposition and maintain the anonymity of the party behind it (a “strawman” filing), it is not due to the attorney-client privilege; instead, it is a procedural construct of the proceeding. *See* G 3/97, Decision of the Enlarged Board of Appeal at 2.1 (Jan. 21, 1999), <https://www.epo.org/boards-of-appeal/decisions/pdf/g970003ep1.pdf> (“The status of opponent is a procedural status and the basis on which it is obtained is a matter of procedural law.... [T]he opponent is the person who fulfils the requirements of the EPC for filing an opposition; in particular, the person must be identifiable.... The EPC does not specify any further formal requirements to be met by the opponent.”); T 1839/18, Decision of the Board of Appeal at 2.1 - 2.12 (Mar. 19, 2021), <https://www.epo.org/boards-of-appeal/decisions/pdf/t181839eu1.pdf> (discussing public policy rationale).

Failing to establish the attorney-client privilege, CRL has no basis for protecting the identity of the party in the EPO opposition. *See, e.g., In re Rivastigimine Pat. Litig.*, 239 F.R.D. 351, 359 (S.D.N.Y. 2006) (“If no privilege is provided for by the statutes of the foreign forum, no privilege can be implied.”); *Astra Aktiebolag v. Andrex Pharms. Inc.*, 208 F.R.D. 92, 100 (S.D.N.Y. 2002) (“If

no privilege is provided for by the statutes of the foreign forum, no privilege can be implied.”); *VLT Corp. v. Unitrode Corp.*, 194 F.R.D. 8, 15 (D. Mass. 2000) (“[T]he parties ... apparently agree that the privilege issue is to be determined with reference to foreign law if the communication has nothing to do with the United States. If in such instances there is no privilege under foreign law, there is no privilege here.”).

CRL has failed to meet its burden to show otherwise.³ *E.g.*, *Cadence Pharms., Inc. v. Fresenius Kabi USA, LLC*, 996 F. Supp. 2d 1015, 1019 (S.D. Cal. 2014) (party asserting foreign privilege has the burden of proving the law protects the communications from discovery); *In re Rivastigmine Pat. Litig.*, 237 F.R.D. 69, 76 (S.D.N.Y. 2006) (same).

For these reasons, the identity of CRL as the party behind the EPO opposition is not protected by the attorney-client privilege.

III. CONCLUSION

For these reasons, PO respectfully requests its Motion be granted.

Respectfully Submitted,

Dated: August 8, 2025

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397

³ If, in its opposition to this Motion, CRL attempts to show foreign privilege law applies, it will be the first time that PO receives notice of such a position, and PO will seek leave to file a reply.

CERTIFICATE OF COMPLIANCE

I, the undersigned, certify that the above, Patent Owner's Motion to Compel Routine Discovery Under 37 C.F.R. § 42.51(b)(1)(iii), complies with the applicable type-volume limitations of 37 C.F.R. § 42.24(b). Exclusive of the portions exempted by 37 C.F.R. § 42.24(a), this Motion is within the 7-page limit specified by the Board.

Respectfully Submitted,

Dated: August 8, 2025

/Alexander B. Stein/
Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owner hereby certifies that on August 8, 2025, a copy of this PATENT OWNER'S MOTION TO COMPEL ROUTINE DISCOVERY UNDER 37 C.F.R. § 42.51(b)(1)(iii) was served via the email correspondence address of record for Petitioner's counsel of record:

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