

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CURIUM US LLC
Petitioner,

v.

UNIVERSITÄT HEIDELBERG AND THE EUROPEAN ATOMIC ENERGY
COMMUNITY (EURATOM), REPRESENTED BY THE EUROPEAN
COMMISSION,
Patent Owners

Case No. IPR2022-01582
Patent No. 10,980,901 B2

**PATENT OWNERS' MOTION TO COMPEL ROUTINE DISCOVERY
PURSUANT TO 37 C.F.R. §42.51(b)(1)(iii)**

INTRODUCTION

Patent Owners are seeking the production of documents held by the Petitioner's expert, Dr. Michael Zalutsky, and/or the Petitioner that are inconsistent with the positions held by the Petitioner and/or the expert. Patent Owners narrowly request that the Petitioner provides:

- Non-privileged communications such as emails, presentations, web sites, and publications by, or on behalf of, Dr. Michael Zalutsky, concerning Petitioner's Exhibit 1045 ("225 Ac-PSMA-617 for PSMA-Targeted α -Radiation Therapy of Metastatic Castration-Resistant Prostate Cancer," *Journal of Nuclear Medicine*, vol. 57, no. 12, pgs.1941-1944 (2016) ("Kratochwil 2016")), between July 2016 and September 25, 2025; and
- Non-privileged communications such as emails, presentations, web sites, and publications by, or on behalf of, Dr. Michael Zalutsky, describing the disadvantages of using radioactive actinium in therapeutics.

This request is made necessary by evidence that, although Petitioner claims that there are no secondary factors supporting the non-obviousness of the patent (Paper 2 at, e.g., 57-63), embodiments of the patented product, as exemplified by Exhibit 1045, received public praise from Petitioner's own expert. Moreover, while the expert stated in his Declaration that using ²²⁵Ac as claimed in the invention would be the "common-sense solution" because "the potential benefit of 225Ac-labeled

radiopharmaceuticals for the treatment of cancer likely outweighed potential side effects” (Exhibit 1002 at ¶¶29-30), he has actually spent the last decades arguing against the use of ^{225}Ac with PSMA, both before and after the patent-in-suit, demonstrating significant skepticism in its use and countering his sworn testimony.

LEGAL STANDARD

37 C.F.R. § 42.51(b)(1)(iii) specifies that routine discovery include “relevant information that is inconsistent with a position advanced by the party during the proceeding” and notes that this “extends to inventors, corporate officers, and persons involved in the preparation or filing of the documents or things.” Such involvement with the filing of documents or things includes party experts. *See Multi-Color Corporation v. Brook & Whittle LTD*, PGR2025-00025, Paper 31, at 9-10 (PTAB January 23, 2026) (providing routine discovery from expert); *Frameless Hardware Company LLC v. C.R. Laurence Co., Inc.*, IPR2022-003561, Paper 37, at 4 (PTAB February 6, 2023).

Additionally, the language of §42.51(b)(1)(iii) is not limited to impeachment-style evidence, in which the contradictory evidence may only be used against the originator. The evidence may be from a source other than the Petitioner but be used to contradict the Petitioner. *Charles River Laboratories, Inc. v. Seikagaku Corporation*, PGR2025-00023, Paper 17, at 11 (PTAB September 30, 2025)

(providing routine discovery of declaration by a third party which was inconsistent with Petitioner's position).

Garmin International, Inc. et al. v. Cuozzo Speed Technologies LLC explains that the requested information must be “specific information known to the responding party to be inconsistent with a position advanced by that party in the proceeding.” IPR2012-0001, Paper 26, at 4 (PTAB Mar. 5, 2013) (precedential). But “responding party” under § 42.51(b)(1)(iii) would include those involved in the preparation or filing of documents and things.” *See Multi-Color Corp.* Paper 31, at 9-10.

ARGUMENT

Patent Owners informed the Board on July 7, 2026, that Dr. Zalutsky “praised an embodiment of the patent and publicly discussed the difficulties of using the ²²⁵Ac, which contradicts views that he has expressed in his expert declaration.” The evidence of Dr. Zalutsky's about-face as an expert for Petitioner is significant and certainly reflects his personal communications or more fleetingly public statements like those in public presentations (which would likely include PowerPoint presentations), but Patent Owners cannot gain access to less public materials without the routine discovery. As explained by Patent Owners, “[s]uch documents would be inconsistent with the positions advanced by Petitioner and Dr. Zalutsky and therefore fall under routine discovery under 37 C.F.R. § 42.51(b)(2).”

Contrary to Dr. Zalutsky's Positions in his Declaration

Before becoming an expert in this case, Dr. Zalutsky previously praised the treatment discussed in the Kratochwil 2016 paper. In his 2024 paper, "A Third Generation PSMA-targeted Agent [211At]YF2: Synthesis and In Vivo Evaluation" (Exhibit 2108), he praises the results of the Kratochwil 2016 paper as "dramatic," "significant responses, even in individuals nonresponsive to prior β -emitter therapy." *Id.* at 3. But in his Declaration, Dr. Zalutsky says that he disagrees that the "difference in efficacy would be surprising or unexpected" and disagrees that the '901 Patent's results were "considerably and significantly better" and chalks the improvement up to "known benefits." Exhibit 1002 at ¶¶42, 50-51. Dr. Zalutsky's acknowledgement of the patent's data being "dramatic" and "significant" is also contrary to his claim that Miederer had already shown that alpha emitters were better, thereby making the '901 Patent's results obvious. *Id.* at ¶¶93-94. If it was already commonly known that alpha emitters were so much better, then no amount of improvement would have been "dramatic" or "significant." But in 2024, Dr. Zalutsky said it was.

Moreover, although praising the '901 Patent's results published in Kratochwil 2016, Dr. Zalutsky previously argued against the use of ^{225}Ac in 2011. In his paper "Astatine-211: Production and Availability," Dr. Zalutsky argued in favor of another alpha-emitting radionuclide, Astatine-211 (^{211}At), over ^{225}Ac . Exhibit 2134 at 1. This

is in contrast with Dr. Zalutsky's claim that ^{225}Ac was the "common sense" solution (Exhibit 1002 at ¶50) or that a POSA would have been motivated to use it (*Id.* at ¶86). In fact, this publication is only one of many articles by Dr. Zalutsky claiming the benefits of ^{211}At over ^{225}Ac . Dr. Zalutsky even started a company around the ^{211}At compound.¹ Exhibit 1002 at ¶6). And yet, despite this, Dr. Zalutsky claims in his Declaration that ^{225}Ac was the obvious choice for an alpha-emitting radionuclide. Exhibit 1002 at ¶¶86-89.

To the extent that Petitioner argues that Patent Owners' request is too broad because it cannot specify the documents, this reverses the burden because it was Petitioner's and Dr. Zalutsky's burden to initially provide those documents under § 42.51(b)(1). It is not Patent Owners' obligation to identify documents containing Petitioner's inconsistent statements. *See Commscope Technologies LLC v. Belden Inc.*, IPR2023-01061, IPR2023-01062, Paper 26, at 4 (PTAB May 13, 2024).

There is evidence that Dr. Zalutsky's opinions before becoming an expert for Petitioner are inconsistent with those he is expressing now. With all of this inconsistent information already on the record, there appears to be more behind the

¹ In fact, Patent Owners have many more examples of Dr. Zalutsky publicly countering his own Declaration, but the Board instructed that "No new evidence is allowed." Paper 19.

scenes that Dr. Zalutsky knows about. Petitioner should not be allowed to rely on inconsistent statements and simultaneously be allowed to avoid routine discovery regarding them. Patent Owners have a right to receive this routine discovery so that it can defend its patent.

Contrary to Petitioner's Positions in its Petition

Dr. Zalutsky's positions are also inconsistent with Petitioner's own positions. Dr. Zalutsky's previous praise and skepticism are both evidence of secondary considerations, which Petitioner denies. Paper 2 at, *e.g.*, 60-63. Petitioner's claim that the '901 Patent's/ Kratochwil 2016 paper's results were predictable (*Id.* at 62) is undermined by its own expert's contradictory statements.

It also undermines its claim that ^{225}Ac was the obvious choice for a radionuclide. In fact, Petitioner merely parrots Dr. Zalutsky's Declaration by claiming that the ^{225}Ac was the "common-sense solution" (*Id.* at 14) – but we have already shown that Dr. Zalutsky did not believe that until after he became an expert for Petitioner.

CONCLUSION

The existing record already establishes material inconsistencies between Dr. Zalutsky's prior statements, his present Declaration, and the Petition. Those inconsistencies are unlikely to be limited to the few public materials Patent Owners have been able to locate. Rather, they are likely reflected more fully in the non-

privileged documents Petitioner and Dr. Zalutsky have withheld— including presentations to colleagues and communications discussing the field—documents that fall squarely within Patent Owners’ routine-discovery rights under §42.51(b)(1)(iii). Patent Owners ask the Board to compel routine discovery in the requested topics.

DATED: July 29, 2026,

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that on July 29, 2026, a copy of this **PATENT OWNERS' MOTION TO COMPEL ROUTINE DISCOVERY PURSUANT TO 37 C.F.R. §42.51(b)(1)(iii)**, was served by E-MAIL on the following correspondence address of record for Petitioner, pursuant to 37 C.F.R. § 42.6(e):

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