

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 Owner

Case No. IPR2025-01582

U.S. Patent No. 10,980,901

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
COMPEL ROUTINE DISCOVERY**

I. INTRODUCTION

The Board directed Patent Owner to tailor any request to the proper scope and identify specific inconsistent statements but Patent Owner's Motion to Compel Routine Discovery ("Motion to Compel") does neither. Paper 19, Board's Order at 2. Instead, Patent Owner's Motion to Compel seeks speculative document discovery covering the collection of a decade or more of communications across broad subject areas from multiple custodians and databases in the hope that an inconsistency may turn up. Paper 20, PO Motion to Compel at 1. Petitioner has fully complied with its routine discovery obligations and is not aware of any information inconsistent with a position advanced in this proceeding. *See* 37 CFR § 42.51(b)(1)(iii).

Patent Owner's Motion to Compel identifies statements in two papers Dr. Zalutsky co-authored as allegedly inconsistent and insinuates that "there appears to be more behind the scenes" implying that Dr. Zalutsky's private communications might produce some inconsistent information. Paper 20, PO Motion to Compel at 5-6 (citing Exhibits 2108 and 2134). Yet, Patent Owner's characterizations of Exhibits 2108 and 2134 as inconsistent are incorrect for multiple reasons.

The statements in Exhibit 2108 that the alpha therapy with ^{225}Ac used in Kratochwil 2016 (Exhibit 1045) showed "dramatic" and "significant" responses are consistent with Dr. Zalutsky's declaration testimony and the position in the Petition that a POSA would have a reasonable expectation of success in using a ^{225}Ac

therapy. Nor is this statement inconsistent with the idea that the response to ^{225}Ac treatment would be predictable. A treatment can be both predictable and have significant results despite Patent Owner's contention to the contrary. In addition, Patent Owner's argument that this statement is inconsistent with Petitioner's position on secondary considerations simply ignores Petitioner's position that "the narrow embodiment in Kratochwil 2016 is [not] commensurate with the broad scope of the '901 Patent claims." Petition at 57.

Next, Patent Owner's reliance on Exhibit 2134 is equally unavailing. Patent Owner alleges that Exhibit 2134 shows a preference for ^{211}At due to concerns about the daughter radionuclides of ^{225}Ac . Yet, Dr. Zalutsky expressly acknowledges in his declaration that the ^{225}Ac daughter radionuclides may cause harm to healthy tissue but opines that the benefits of using ^{225}Ac outweighed those risks. Ex. 1002 at ¶¶28-29 ("a POSA would have been aware that the potential benefit of ^{225}Ac -labeled radiopharmaceuticals for the treatment of cancer likely outweighed potential side effects, including those related to the daughter recoil effect.").

Patent Owner's speculation that "there appears to be more behind the scenes" is the epitome of a fishing-expedition discovery request that is not permitted under the limited discovery available in IPRs. Therefore, the Board should deny Patent Owner's Motion to Compel Routine Discovery.

II. PATENT OWNER’S “ROUTINE DISCOVERY” REQUEST IS IMPERMISSIBLY BROAD UNDER *GARMIN*

Garmin explains that the “routine discovery” obligation is “narrowly directed to specific information known to the responding party” to be inconsistent and that it is not “broadly directed to any subject area in general” in which a party hopes to find an inconsistency. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 3-4 (PTAB Mar. 5, 2013) (precedential). Patent Owner’s Motion to Compel falls within this latter category of “broadly directed” discovery prohibited by *Garmin*.

For example, Patent Owner requests all “[n]on-privileged communications such as emails, presentations, web sites, and publications by, or on behalf of, Dr. Michael Zalutsky, concerning Petitioner’s Exhibit 1045...between July 2016 and September 25, 2025” or all non-privileged communications of Dr. Zalutsky “describing the disadvantages of using radioactive actinium in therapeutics” with no time frame. PO Motion to Compel at 1. Notable, these requests encompass a period of a decade or more, any custodian including third parties (for example Duke University where Dr. Zalutsky was a professor during the relevant time frame), any recipients, etc. These requests are not “narrowly directed to specific information known to the responding party.”

Indeed, Patent Owner’s request suffers from the exact same flaws that the *Garmin* decision identified, namely that “[Patent Owner] is not referencing

information known to [Petitioner] to be inconsistent with positions taken in the petition. Rather, [Patent Owner] casts a wide net directed to broad classes of information which may not include anything inconsistent with positions taken by [Petitioner].” *Garmin*, Paper 26 at 4.

Finally, Patent Owner’s request should be denied because it is cumulative of information Patent Owner obtained during Dr. Zalutsky’s deposition. *See Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32 at 8 (PTAB May 29, 2013) (discovery request denied since it was “cumulative” of information of record) (precedential). Patent Owner asked Dr. Zalutsky questions under oath about the same topics on which it now seeks discovery, and Dr. Zalutsky’s testimony confirmed the lack of any inconsistency. There is no reason to believe that Dr. Zalutsky’s non-public communications would provide relevant information materially different from his sworn deposition testimony.

Patent Owner's cases do not alter this outcome as they all granted narrowly tailored discovery based on specific inconsistent statements, not, as here, an open-ended search for unknown documents with the mere hope of finding an inconsistent statement. *See Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 31 at 9-10 (PTAB Jan. 23, 2026); *Charles River Labs., Inc. v. Seikagaku Corp.*, PGR2025-00023, Paper 17 at 11 (PTAB Sept. 30, 2025); *CommScope Techs. LLC v. Belden Inc.*, IPR2023-01061, -01062, Paper 26 at 3-4 (PTAB May 13, 2024).

The Board should deny Patent Owner's overly broad "routine discovery" request under the precedential *Garmin* standard. Even if the request was not impermissibly broad, it should be denied as cumulative of information Patent Owner already obtained via the deposition of Dr. Zalutsky.

III. STATEMENTS IN EXHIBITS 2108 AND 2134 ARE CONSISTENT WITH DR. ZALUTSKY'S TESTIMONY AND THE PETITION

Even assuming Patent Owner's request was permissible under *Garmin*, it would still fail because Patent Owner has not identified any inconsistencies.

A. Dr. Zalutsky's Declaration is Consistent with Ex. 2108 and 2134

1. Exhibit 2108

Exhibit 2108 states that there was accumulating evidence that alpha emitters may outperform beta emitters, then notes the "dramatic" and "significant" results in Kratochwil 2016 (Ex. 1045) using ^{225}Ac -PSMA-617 to treat prostate cancer patients previously treated with beta therapy. Ex. 2108 at 3. Patent Owner wrongly equates the words "dramatic" and "significant" in Ex. 2108 with the legal concept of unexpected results to allege an inconsistency where none exists. Paper 20 at 4. Yet, calling the treatment response in Kratochwil 2016 dramatic and significant does not contradict Dr. Zalutsky's opinion that the response was also predictable based on principles known prior to Kratochwil 2016. If anything, Exhibit 2108 reinforces the correctness of Dr. Zalutsky's declaration testimony that a POSA would pursue ^{225}Ac treatment with reasonable expectation of success.

In particular, Dr. Zalutsky's declaration explained that prior to the critical date of the '901 Patent (and prior to Kratochwil 2016), alpha emitters' greater energy and cytotoxicity to cancer cells were known and that publications had shown improved efficacy for ^{225}Ac over beta emitters like ^{177}Lu . Ex. 1002 ¶¶32, 69, 93-94. Kratochwil 2016 later confirmed empirically the expected successful treatment of cancer in humans using ^{225}Ac . Indeed, Kratochwil 2016 acknowledged that targeted alpha therapy was already known to have broken resistance to beta radiation and that the results obtained "ideally matches the theoretic considerations" for targeted alpha therapy. Ex. 1045, 3. Thus, evidence prior to Kratochwil 2016 provided the basis for a POSA to predict the dramatic and significant result shown in Kratochwil 2016.

2. Exhibit 2134

Exhibit 2134 concerns production and availability of ^{211}At , but nowhere does it say that ^{225}Ac should not be used as Patent Owner suggests. *See* PO Motion to Compel at 4-5. At most, Exhibit 2134 identifies some concerns with using ^{225}Ac . Ex. 2134, 1-2. However, Dr. Zalutsky's declaration expressly addresses the potential concerns of ^{225}Ac noted in Exhibit 2134, such as daughter-recoil toxicity. Ex. 1002 ¶¶ 28-29. Yet, the totality of the evidence shows that safe and effective treatment would still reasonably be achieved with ^{225}Ac despite these issues. Ex. 1002 ¶¶ 29-30. Indeed, the FDA had approved Xofigo® as a treatment in humans despite it using an alpha emitter with similar daughter recoil concerns as ^{225}Ac . Ex. 1002 ¶30.

Notably, Dr. Zalutsky's declaration does not state that ^{225}Ac was the sole or universally best radionuclide. *Id.* ¶¶ 86-94. Thus, the fact that there may be other viable alpha emitters, such as ^{211}At , is not inconsistent with Dr. Zalutsky's testimony that a POSA would have been motivated to use ^{225}Ac despite potential concern about daughter radionuclides. *See In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (obviousness does not require that the proposed combination "is the preferred, or most desirable, combination").

B. Petition is Consistent with Ex. 2108 and 2134

Patent Owner reiterates its arguments that Exhibits 2108 and 2134 are inconsistent with the Petition's positions that the results in Kratochwil 2016 would have been predictable or that a POSA would have selected ^{225}Ac for an obviousness combination. PO Motion to Compel at 6. Both assertions are incorrect for the same reasons provided above with respect to Dr. Zalutsky's declaration.

Moreover, with respect to Kratochwil 2016, Patent Owner purposefully ignores that the Petition directly addressed the lack of relevance of Kratochwil 2016 to secondary considerations for the '901 Patent. Petition at 57-60 ("Patent Owner has not shown that the narrow embodiment in Kratochwil 2016 is commensurate with the broad scope of the '901 Patent claims.").

IV. CONCLUSION

The Board should deny Patent Owner's Motion to Compel Routine Discovery.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on August 5, 2026, a copy of the foregoing document is being served via email on the following counsel of record for Patent Owner:

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