

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORTE BIOSCIENCES, INC.,
Petitioner,

v.

UNIVERSITY OF MASSACHUSETTS,
Patent Owner.

PGR2023-00014
Patent 11,278,505 B2

Before GEORGIANNA W. BRADEN, ROBERT A. POLLOCK, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.51(b)(2)
Granting Patent Owner's Motion to Withdraw
37 C.F.R. § 42.10(e)

I. INTRODUCTION

On July 3, 2023, we instituted trial in the above identified proceeding. Paper 10. Shortly thereafter, and with our authorization, Patent Owner, University of Massachusetts filed a Motion for Withdrawal of Counsel. Paper 14 (“Motion to Withdraw”). The Motion to Withdraw requests the withdrawal of Li Zhang as back-up counsel. In the Motion, Patent Owner indicates that Petitioner, Forte Biosciences, Inc., does not oppose the Motion. *Id.* Because Patent owner continues to be represented by lead counsel and at least one back-up counsel, we grant the Motion to Withdraw.

A September 5, 2023 email from Patent Owner’s counsel to the Board requested leave to file a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) related to Petitioner’s public statements in a press release regarding the use of and reliance on animal models for development of its IL-15 receptor antibody (FB-102) for the treatment of vitiligo and other autoimmune diseases. Patent Owner asserts the statements are inconsistent with Petitioner’s arguments and factual assertions in the Petition regarding enablement of the challenged claims. On the same day, Petitioner sent an email opposing the request. In a response email, the Board required the parties to meet and confer about Patent Owner’s request for additional discovery, and if the parties were unable to come to an agreement, then the parties were instructed to jointly request a conference call with the Board. On September 11, 2023, the parties sent an email requesting a call with the Board to discuss Patent Owner’s request to file a motion for additional discovery.

A conference call took place on September 15, 2023 to discuss Patent Owner’s request. Judges Braden, Pollock, and Valek were present, and the

parties were represented by their respective counsel. For the reasons that follow, we deny Patent Owner's request for authorization to file a motion for additional discovery.

II. DISCUSSION

Under our rules for additional discovery, parties may agree to provide voluntarily additional discovery. 37 C.F.R. § 42.51(b)(2)(i). If agreement cannot be reached, a party must request additional discovery by seeking authorization to file a motion for additional discovery, as was done here by Patent Owner. In post-grant reviews, additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding. *See* 37 C.F.R. § 42.224. Here, as noted, Patent Owner's request is based on contentions that Petitioner's factual assertions in the Petition are inconsistent with Petitioner's public statements. In particular, Patent Owner contends that the testimony of Petitioner's expert, Dr. R. Todd Plott, is inconsistent with statements Petitioner made in a press release regarding the use of and reliance on animal models for development of Petitioner's IL-15 receptor antibody (FB-102) for the treatment of vitiligo and other autoimmune diseases. As pointed out during the conference call, however, Patent Owner will have the opportunity to address the alleged inconsistencies during the upcoming cross-examination of Dr. Plott. *See* Paper 16.

In view of this, we deny Patent Owner's request for authorization to file a motion for additional discovery. Instead, as explained on the conference call, we authorize Patent Owner to serve an interrogatory on Petitioner in which Petitioner must identify and describe the particular models referred to in the press release in advance of Dr. Plott's deposition.

Accordingly, it is:

ORDERED that Patent Owner's Motion to Withdraw is *granted*;

FURTHER ORDERED that Patent Owner must file updated mandatory notices reflecting the change in backup counsel;

FURTHER ORDERED that Patent Owner's request for authorization to file a motion for additional discovery is *denied*;

FURTHER ORDERED that Patent Owner may seek additional discovery in the form of the following interrogatory: "identify and describe the particular models referred to in the press release"; and

FURTHER ORDERED that Petitioner must respond to the interrogatory no later 6:00PM EST on Wednesday, September 20, 2023.

PGR2023-00014
Patent 11,278,505 B2

PETITIONER:

Michael Rosato
Jad Mills
Sonja Gerrard
Michael Hostetler
WILSON SONSINI GOODRICH & ROSATI
mrosato@wsgr.com
jmills@wsgr.com
sgerrard@wsgr.com
mhostetler@wsgr.com

PATENT OWNER:

Mark Feldstein
Joshua Goldberg
Jessica Roberts
Kenneth Guerra
Li Zhang
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
mark.feldstein@finnegan.com
joshua.goldberg@finnegan.com
jessica.roberts@finnegan.com
kenneth.guerra@finnegan.com
li.zhang@finnegan.com