From:	Guerra, Kenneth
To:	Herbert, Toni-Junell; Giannelli, Maximilienne; Feldstein, Mark; raj.gupta@finnegan.com; UPL-PGR-FINNEGAN
Cc:	Klecyngier, David M.; Bucca, Daniel; Carson, Charles C.; Rick, Michelle
Subject:	RE: PGR2023-00017
Date:	Friday, October 13, 2023 2:39:16 PM
Attachments:	image008.png image009.png image010.png image011.png

Hi Toni,

Thank you for your response and offering your availability. To clarify, we meant to reference the '727 patent and "field books."

Best,

Ken

Kenneth S. Guerra
Associate
Pronouns: He, Him, His
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413
+1 202 408 4124 | mobile +1 219 576 4160 | Kenneth.Guerra@finnegan.com | www.finnegan.com

From: Herbert, Toni-Junell <therbert@bakerlaw.com>
Sent: Friday, October 13, 2023 7:22 AM
To: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Klecyngier, David M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: FW: PGR2023-00017

***EXTERNAL* Email:**

Hello Ken,

Your below email is a bit confusing. You reference a '505 patent and "field guides" among several unclear and inconsistent statements.

As requested, we are available for a call with the Board on Oct. 16.

We reiterate and maintain—Patent Owner is not entitled to any of the requested production—nor what Petitioner is willing to voluntarily provide. To this end, we would like to confirm you are still interested in the raw data which Syngenta was willing to produce.

Nevertheless, we note your additional discovery request is not well taken. As you are most likely aware, the proposed discovery extends well beyond the scope of what is contemplated for PGRs, and such a production would not only be extremely burdensome, but also quite time consuming. Furthermore, any such discovery should have been sought with initial disclosure requests.

Your requested discovery seems more likely to be an improper effort to use Petitioner's resources, create a pretext for additional extensions of time, and increase cost on Petitioner.

As noted above, we are available for a call on Monday the 16th.

Regards,

Toni

Toni Herbert

Partner

Washington Square
1050 Connecticut Ave N.W. | Suite 1100
Washington, DC 20036-5403
T +1.202.861.1578

therbert@bakerlaw.com
bakerlaw.com

From: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Sent: Wednesday, October 11, 2023 9:02 AM
To: Herbert, Toni-Junell <therbert@bakerlaw.com>; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; Rick, Michelle <MRick@bakerlaw.com>
Subject: RE: PGR2023-00017

Hi Toni,

Notwithstanding Petitioner's agreement to produce "field books" identified by its declarant Mr. Prates in his deposition on Sept. 20, Petitioner is unduly delaying their production. This is prejudicial to Patent Owner as we requested those documents over two weeks ago and there is limited time remaining for preparing and filing the Patent Owner Response. Petitioner has cited no basis to withhold these documents pending entry of the agreed-upon Protective Order.

Given Petitioner's delay and its prior refusal to produce other documents identified by Mr. Prates, Patent Owner intends to request leave form the Board to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). Specifically, Patent Owner will be seek documents sufficient to show: (i) all benefits identified by Syngenta of using mancozeb in combination with benzovindiflupyr and prothioconazole; (ii) Syngenta's promotion of and bases for promoting combinations of mancozeb as claimed in the '505 patent, including combinations of mancozeb with MitrionTM (benzovindiflupyr + prothioconazole); and (ii) Syngenta's development and promotion of a ready-mix or tank-mix combination product containing mancozeb, benzovindiflupyr, and prothioconazole. To the extent Petitioner still has not produced the "field guides," we will also seek these as additional discovery. This evidence is directly related to factual assertions advanced by Petitioner with respect to alleged obviousness and/or lack of enablement.

Accordingly, absent agreement by Petitioner to voluntarily produce all these materials by Friday Oct. 13, please let us know Petitioner's availability over the next 3-4 business days for a call with the Board. We are also available to meet and confer.

Best,
Ken

Kenneth S. Guerra
Associate
Pronouns: He, Him, His
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413
+1 202 408 4124 | mobile +1 219 576 4160 | Kenneth.Guerra@finnegan.com | www.finnegan.com

From: Herbert, Toni-Junell <therbert@bakerlaw.com>
Sent: Tuesday, October 10, 2023 6:15 PM
To: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017

***EXTERNAL* Email:**

Hello Ken,

As we indicated in our correspondence last Friday, we expect to make a production sometime this week. However, unless the Board has entered the Modified Protective Order by then, we will not be able to produce internal documents until the terms of the protective order are recognized by the Board and enforceable.

Please recall that although we voluntarily offered to provide "field books" on condition of an agreed protective order, we also pointed out that Petitioner is not obligated to provide any of the information requested. We further advised that if the Patent Owner wanted additional data from "field books", it should have requested such information well before the deposition of Dr. Prates on September 20th, and during the initial disclosure period under 37 C.F.R. 42.51.

Separately, we have learned that "field books" are not in physical form per se, but are rather an electronic database including information not relevant to the Prates Declaration. We intend to voluntarily provide the underlying data in the tables of the Prates declaration upon entry of the modified protective order.

Kind regards,

Toni

Toni Herbert
Partner

Washington Square
1050 Connecticut Ave N.W. | Suite 1100
Washington, DC 20036-5403
T +1.202.861.1578

therbert@bakerlaw.com
bakerlaw.com

From: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Sent: Friday, October 6, 2023 1:08 PM
To: Herbert, Toni-Junell <therbert@bakerlaw.com>; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; Rick, Michelle <MRick@bakerlaw.com>
Subject: RE: PGR2023-00017

Hi Toni,

Thank you for your response. Please provide the field books no later than Tuesday, October 10,

which will be more than two weeks after our request.
Best,
Ken

Kenneth S. Guerra
Associate
Pronouns: He, Him, His
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413
+1 202 408 4124 | mobile +1 219 576 4160 | Kenneth.Guerra@finnegan.com | www.finnegan.com

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From: Herbert, Toni-Junell <therbert@bakerlaw.com>
Sent: Friday, October 6, 2023 7:39 AM
To: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017

***EXTERNAL* Email:**

Morning Max,
We will prepare and submit the modified protective order to the Board today. As for the "field books," we expect to make a production sometime next week.
Kind regards,
Toni

From: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>
Sent: Thursday, October 5, 2023 9:00 AM
To: Herbert, Toni-Junell <therbert@bakerlaw.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Carson, Charles C. <ccarson@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Rick, Michelle <MRick@bakerlaw.com>
Subject: RE: PGR2023-00017

Hi Toni,
Please let us know when we can expect to receive the "field books" identified by Dr, Prates at his deposition. We can agree to be bound by the terms of the protective order, as agreed by the parties, until it is entered by the Board.
Regards,
Max

From: Giannelli, Maximilienne
Sent: Tuesday, October 3, 2023 3:19 PM
To: Herbert, Toni-Junell <therbert@bakerlaw.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Carson, Charles C. <ccarson@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; EXT-Mrick@bakerlaw.com

<Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017
Toni,
We have one edit to paragraph 8, shown in redline in the attached draft. Please let us know if you have any questions.
Regards,
Max

From: Herbert, Toni-Junell <therbert@bakerlaw.com>
Sent: Monday, October 2, 2023 12:50 PM
To: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Carson, Charles C. <ccarson@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017
***EXTERNAL* Email:**
Hello Max,
Attached is a draft protective order; the attached draft is a marked up version based on the Model protective order. We look forward to your comments.
Kind regards,
Toni

From: Bucca, Daniel <dbucca@bakerlaw.com>
Sent: Wednesday, September 27, 2023 3:25 PM
To: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Herbert, Toni-Junell <therbert@bakerlaw.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; Rick, Michelle <MRick@bakerlaw.com>
Subject: RE: PGR2023-00017
Dear Max,
We are responding to your email below.
We will not be able to produce the "field books" by today. If you wanted the raw data underlying the declaration of Dr. Prates you should have requested that information well before Dr. Prates' deposition. Further, UPL noticed the deposition of Dr. Brannen to take place tomorrow. Nowhere in your email of Monday did you indicate that you wanted the requested information before Dr. Brannen's deposition. Your email merely asked for our availability for a call this week with the Board. We expect Dr. Brannen's deposition to proceed as noticed.
Best regards,
Daniel Bucca, Ph.D.
T +1.202.861.1575
M +1.703.402.9442

From: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>
Sent: Wednesday, September 27, 2023 9:39 AM

To: Herbert, Toni-Junell <therbert@bakerlaw.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; Rick, Michelle <MRick@bakerlaw.com>
Subject: RE: PGR2023-00017

Toni,

Thank you for your response. Please let us know when you are available today to discuss. There is obviously an issue of timing as we need the materials sufficiently in advance of taking the deposition of Dr. Brannen, such that it may need to be rescheduled depending on how soon the materials are produced and their volume.

We can discuss further, but in principle UPL can agree to a modification of the PTAB default protective order (Consolidated Trial Practice Guide, Appendix B) that excludes UPL employees from access to internal Syngenta information.

Regards,

Max

From: Herbert, Toni-Junell <therbert@bakerlaw.com>
Sent: Wednesday, September 27, 2023 8:22 AM
To: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>
Cc: Bucca, Daniel <dbucca@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017

***EXTERNAL* Email:**

Hello Max,

Although Syngenta disagrees that it is obligated to provide the referenced documents under 37 C.F.R 42.51(b)(1)(iii), Syngenta is willing to provide copies of the "field books."

As for:

1) any report Syngenta submitted to the Brazilian government;

2) "materials related to the benefits of using mancozeb in combination with benzovindiflupyr and prothioconazole";

3) "Syngenta's bases for promoting combinations with mancozeb and the other claimed fungicides (including in combination with Mitrion in Brazil)"; and

4) "information related to Syngenta's development or promotion of a ready-mix or tank-mix combination product containing benzovindiflupyr, prothioconazole, and mancozeb"

Syngenta does not agree to provide this material.

Further, any exchange of Syngenta internal documents would require an agreement on a protective order that would exclude UPL from reviewing the internal Syngenta information.

We are available to meet and confer on the above this week and believe such a call would be fruitful.

Kind regards,

Toni

Toni Herbert

Partner

Washington Square
1050 Connecticut Ave N.W. | Suite 1100
Washington, DC 20036-5403
T +1.202.861.1578

therbert@bakerlaw.com
bakerlaw.com

From: Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>
Sent: Monday, September 25, 2023 9:03 AM
To: Herbert, Toni-Junell <therbert@bakerlaw.com>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>
Subject: PGR2023-00017

[External Email: Use caution when clicking on links or opening attachments.]

Hi Toni,
In view of the testimony of Dr. Caio Prates, we believe Syngenta is obligated to provide the following as routine discovery under 37 CFR s. 42.51(b)(1)(iii):

- The "field books" containing all the data and assessments that Syngenta performed in relation to the trials addressed in Dr. Prates declaration;
- The report that Syngenta submitted to the Brazilian government that is associated with those field books and/or trials;
- Materials related to the benefits of using mancozeb in combination with benzovindiflupyr and prothioconazole;
- Syngenta's bases for promoting combinations with mancozeb and the other claimed fungicides (including in combination with Mitrion in Brazil); and
- Information related to Syngenta's development or promotion of a ready-mix or tank-mix combination product containing benzovindiflupyr, prothioconazole, and mancozeb.

These documents would contradict Syngenta's assertion that the claimed combinations are obvious, did not exhibit any unexpected benefits such as synergy, and/or are not enabled. To the extent that Syngenta disagrees that it is obligated to provide these documents, please let us know if Syngenta is willing to agree to provide them voluntarily under 37 CFR s. 42.51(b)(2).
If Syngenta is not willing to comply with these specific and narrow requests, please provide your availability for a call this week with the Board. We are available to meet and confer if you believe a call would be fruitful.
Regards,
Max

Maximilienne Giannelli, Ph.D.
Intellectual Property Attorney
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
1875 Explorer Street, Suite 800, Reston, VA 20190-6023
work: 571.203.2432 | mobile: 202.286.8587 | fax: 202.408.4400 | max.giannelli@finnegan.com |

www.finnegan.com

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