

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,

v.

UPL LIMITED,
Patent Owner.

PGR2023-00017
Patent 11,445,727 B2

Before SUSAN L.C. MITCHELL, ZHENYU YANG, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On October 16, 2023, a conference call was held with counsel for both parties to discuss Patent Owner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). *See* Ex. 3002 (email correspondence with the Board); Ex. 3003 (email correspondence between the parties attached to Exhibit 3002).¹

During the call, Patent Owner referred to two categories of information it was seeking: (1) the underlying data from the "field books" for the testing described in Petitioner's Exhibit 1020 ("Prates Declaration"); and (2) materials relating to Petitioner's testing of fungicide combinations that Patent Owner contends were identified during the deposition of Petitioner's declarant Dr. Prates. Patent Owner contends this second category of information is relevant because it contradicts certain arguments in the Petition, e.g., lack of enablement and/or synergy.

Petitioner does not oppose Patent Owner's request for the first category of information, but seeks to maintain the confidentiality of that information according to the terms of the protective order the parties have separately moved to enter in this proceeding. *See* Paper 20. Patent Owner has agreed to treat these materials as confidential pursuant to the terms of that order pending its entry. *See* Ex. 3003. On the call, Petitioner agreed to produce the first category of information by October 18, 2023.

Petitioner opposes Patent Owner's request for the second category of information. Among other things, Petitioner urges the request is overbroad and amounts to a "fishing expedition" based on a selective reading of Dr. Prates's deposition testimony.

¹ Patent Owner arranged for a court reporter to prepare a transcript of the call, which should be entered as soon as it is ready.

As explained on the call, we authorize Patent Owner to file the requested motion. Because the parties reached an agreement on the production of the first category of information during the call, the motion is limited to the second category. In crafting its motion, Patent Owner should be mindful of Petitioner's argument that, at least as presently articulated, the second category of information it seeks is overbroad. Patent Owner's motion may prove more persuasive to the extent Patent Owner can narrow its request to particular documents identified by Dr. Prates and show how Dr. Prates's testimony demonstrates those documents are likely to undermine specific positions Petitioner takes in this proceeding. The parties have agreed to a schedule for briefing this issue, which is reflected in the order below.

In view of the foregoing, it is hereby:

ORDERED that Petitioner will produce the first category of information described above by October 18, 2023. To the extent the parties have not already done so, they should discuss the form of this production in an effort to anticipate and resolve any issues that may impede Patent Owner's reasonable access to the same. Moreover, pending entry of the parties' proposed protective order (*See* Paper 20), Patent Owner will treat this information per the terms of that proposed order;

FURTHER ORDERED that Patent Owner is authorized to file, on or before October 18, 2023, a motion for additional discovery of no more than 5 pages pertaining to the second category of information described above. Patent Owner is authorized to file Dr. Prates's deposition testimony as an exhibit with that motion; and

FURTHER ORDERED that Petitioner is authorized to file, on or before October 25, 2023, an opposition to Patent Owner's motion of no more than 5 pages.

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