

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,
v.

UPL LTD,
Patent Owner.

Case No. PGR2023-00017
Patent No. 11,445,727

**PATENT OWNER'S MOTION FOR
ADDITIONAL DISCOVERY
UNDER 37 C.F.R. § 42.51(b)(2)**

As authorized by the Board (Paper 22, 3; *see also* EX2017, 20:19-20), Patent Owner UPL, Ltd. (“UPL”) respectfully requests that the Board grant under 37 C.F.R. § 42.51(b)(2) targeted additional discovery from Petitioner Syngenta Crop Protection AG (“Syngenta”). Further to the Board’s guidance and to obviate Syngenta’s concerns that global discovery might be burdensome (Paper 22, 3; EX2017, 16:22-17:7), UPL limits its request to a single geographically limited topic:

Documents sufficient to show Syngenta’s promotion of and bases for promoting combinations of mancozeb + benzovindiflupyr + prothioconazole, such as combinations A9 and A10 described in EX1020 (Prates Declaration), in Brazil.

By way of context, Syngenta bases its obviousness and enablement grounds on assertions that claimed combinations “were neither synergistic nor surprising” and that “[t]he ’727 Patent fails to enable the full use of the scope of claims 1-10 as ‘fungicidal combinations providing... enhanced efficacy and synergy’ as represented by UPL.” Paper 1 (“Pet.”) at 2, 78. But contradicting those positions and reflecting multiple objective indicia of nonobviousness, Syngenta’s declarant, Dr. Caio Prates (EX1020), revealed that Syngenta had copied and is promoting in Brazil multiple claimed combinations of benzovindiflupyr, prothioconazole, and mancozeb because of beneficial “resistance management.” EX2018 (Prates Dep. Tr.), 64:11-65:13, 66:1-14, 74:8-75:5. Dr. Prates further testified that Syngenta has a “basis to

show *added value* in terms of resistance management or some other properties” for these combinations, but did not personally know what additional resistance management or other benefits were known to Syngenta. EX2018, 78:2-19 (emphasis added). These combinations are also relied upon in the Prates Declaration in support of Syngenta’s petition. They are designated therein as formulation A9, which Dr. Prates identified as a tank mix of a commercial Syngenta formulation Mitrion™ (benzovindiflupyr + prothioconazole) with mancozeb (EX2018, 66:1-3), and formulation A10, which Dr. Prates identified as a “ready mix” of benzovindiflupyr + prothioconazole + mancozeb under development by Syngenta (EX2018, 66:3-15). See EX1020, 4-5.

In view of this testimony and Syngenta’s PGR positions alleging obviousness and non-enablement, Syngenta should be required to produce documents sufficient to show its promotion of and bases for promoting combinations of mancozeb + benzovindiflupyr + prothioconazole in Brazil. Granting this request for additional discovery under 37 C.F.R. § 42.51(b)(2) is supported by good cause and satisfies the five-factor test from *Bloomberg Inc. v. Markets-Alert Pty. Ltd.*, CBM2013-00005, Paper 32 at 2-5 (PTAB May 29, 2013) (precedential) (“*Bloomberg*”).

I. UPL’S MOTION IS SUPPORTED BY GOOD CAUSE

The Board may grant discovery in a PGR upon a “showing of good cause” (37 C.F.R. § 42.224), a less exacting standard than the “in the interests of justice”

standard applied in IPRs. *See Bloomberg* at 2-3. Here, the *Bloomberg* factors all weigh in favor of granting UPL's single, narrowly defined discovery request.

A. Targeted Discovery is Based on More than a Possibility or Mere Allegation that Something Useful Exists (*Bloomberg* 1)

Syngenta's declarant admitted that Syngenta is promoting and developing claimed compositions and that it would have “*basis to show added value* in terms of resistance management or some other properties.” EX2018, 74:8-75:5, 78:2-11 (emphasis added). This is directly related to factual assertions advanced by Syngenta, as it relates to formulations on which it has specifically relied and contradicts Syngenta's obviousness and enablement positions. *See* Pet. at 2, 78; EX1020, 4-5. It is further relevant to objective indicia including copying and recognition. *See Apple Inc. v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034, 1053-54, (Fed. Cir. 2016) (en banc) (“Evidence that the industry praised a claimed invention or a product that embodies the patent claims weighs against an assertion that the same claimed invention would have been obvious.”).

Unlike where additional discovery has been denied, the request here is not based on a bare allegation. The testimony of Dr. Prates shows that Syngenta has useful responsive information. Indeed, Syngenta has not disputed that it has such relevant documents. *See* EX2017 10:13-20; EX3003. *Bloomberg* factor 1 thus weighs in favor of granting UPL's motion.

**B. Not Seeking Litigation Positions or Underlying Bases
(*Bloomberg* 2) and Unable to Generate Equivalent
Information by Other Means (*Bloomberg* 3)**

UPL is seeking documents related to Syngenta's recommendation and promotion of combination products to customers (farmers) in Brazil and the bases for those recommendations. These are not litigation positions or their underlying bases. Indeed, there is no pending litigation between the parties regarding the patent. As this information is in Syngenta's possession reflecting its own promotion and basis for promotion, it is unique to Syngenta and cannot be otherwise obtained. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1336 (Fed. Cir. 2016) ("The fact that a competitor copied technology suggests it would not have been obvious."). Thus, *Bloomberg* factors 2 and 3 weigh in favor of the Board granting UPL's motion.

C. Request Is Easily Understandable (*Bloomberg* 4)

Syngenta has not objected to the understandability of any requests, which track the testimony of its declarant and have now been narrowed to a single topic, geographically limited to Brazil. *See* EX3003. If Syngenta newly asserts that the single request is not easily understood, UPL will work with Syngenta to clarify its request. *Bloomberg* factor 4 thus weighs in favor of the Board granting UPL's motion.

D. Request Is Not Overly Burdensome (*Bloomberg* 5)

UPL's single request for production of "documents sufficient to show" is not unduly burdensome. It is expressly limited to Syngenta's work in Brazil, tracking the testimony of its declarant and obviating any potential concerns on burdensome global discovery. Any new contention by Syngenta that this limited scope would be burdensome would be undercut by Syngenta's rejection of the request apparently without having investigated the scope of responsive documents. *See* EX2017, 17:1-7; EX3003, 6. To the extent "documents sufficient to show" remains voluminous, this only reinforces their relevance at least to objective indicia. It would also underscore Syngenta's failure to produce materials inconsistent with its obviousness and enablement positions as routine discovery under Rule 42.51(b)(1)(iii). EX3003, 6. Thus, *Bloomberg* factor 5 weighs in favor of the Board granting UPL's motion.

II. CONCLUSION

For the forgoing reasons, UPL requests the Board grant its motion for additional discovery.

Respectfully submitted,

Dated: October 18, 2023

/Mark J. Feldstein/
Mark J. Feldstein, Reg. No. 46,693
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.

Lead Counsel for Patent Owner
UPL Ltd.

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)** was served electronically via email on October 18, 2023, in its entirety on the following:

Toni-Junell Herbert
David M. Klecyngier
Daniel Bucca Ph.D.
Charles C. Carson
BakerHostetler LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5403
therbert@bakerlaw.com
dklecyngier@bakerlaw.com
dbucca@bakerlaw.com
ccarson@bakerlaw.com
mrick@bakerlaw.com

Petitioner has consented to electronic service.

Dated: October 18, 2023

/William Esper/
William Esper
Case Manager and PTAB Coordinator
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP