

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 and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

ORDER
Granting Additional Discovery
Modifying Scheduling Order
37 C.F.R. §§ 42.5, 42.51(b)(2)

Petitioner previously agreed to produce the underlying data from the “field books” for the field tests described in Petitioner’s Exhibit 1020 (“Prates Declaration”). Paper 22, 2; *see also* Ex. 2017 (transcript of Oct. 16, 2023 teleconference) 9:15–10:12 (explaining that Petitioner agreed to produce underlying data from the “field books” database). After receiving that production, Patent Owner contends the production is deficient because Petitioner has produced only the “severity” data from these tests, while withholding the data for three other parameters, i.e., “phytotoxicity,” “defoliation,” and “yield,” (collectively, the “other parameters”) that were assessed as part of the same experiments Petitioner relies upon in the Prates Declaration. Ex. 3004 (email correspondence with the Board); *see also* Ex. 1020 ¶¶ 5, 9 (identifying assessed parameters).

On October 26, 2023, a conference call was held with counsel for both parties to discuss this issue.¹ On that call, Patent Owner asserted that good cause exists for this additional discovery because Petitioner has put the results of these field tests at issue by affirmatively relying upon data from those tests in the Prates Declaration. Patent Owner also argued that the data for the other parameters is relevant to factual assertions regarding, *inter alia*, enablement and unexpected results.

In response, Petitioner represented that it has now produced all of the severity data for the tests in Exhibit 1020 and that the severity data is the only data Dr. Prates relied upon for his calculations in Exhibit 1020. According to Petitioner, it need not produce the data for the other parameters, even though such data was assessed as part of the same field tests and is specifically identified in the Prates Declaration, because the

¹ A transcript of this call has been entered as Exhibit 2019.

other parameters are unrelated to Petitioner's assertion of no synergy. Moreover, Petitioner contends that Patent Owner should have equivalent data available to it by virtue of Patent Owner's own testing and experiments.

As indicated on the call, and having considered both sides' arguments, we grant Patent Owner's request for this additional discovery. Here, Petitioner has placed the specific results of the field tests relied upon in the Prates Declaration at issue by affirmatively offering Dr. Prates's direct testimony to support its allegations. While Petitioner contends that only some of the data from these tests, i.e., the severity data, is relevant, we do not agree that Petitioner can effectively prevent Patent Owner from testing that assertion by withholding production of the rest of the data from the same experiments. That additional data is directly relevant to the factual allegations in this proceeding whether it supports Patent Owner's arguments regarding enablement and unexpected results or is simply consistent with the testimony in the Prates Declaration and Petitioner's other factual assertions.²

For these reasons, we find that the *Bloomberg* factors³ favor the requested production. That is, Patent Owner has demonstrated more than a

² Indeed, our rules explain that "[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight." 37 C.F.R. § 42.65(a). Thus, to the extent the data for the other parameters is consistent with Petitioner's factual assertions, it is in Petitioner's interest to disclose all of the data from the field tests it seeks to rely upon.

³ In a post-grant review, additional discovery may be ordered if the party moving for the discovery shows good cause as to why the additional discovery is needed. 37 C.F.R. §§ 42.51(b)(2), 42.224. In *Bloomberg, Inc. v. Market-Alerts Pty, Ltd.*, CBM2013-00005, Paper 32, 5 (PTAB May 29, 2013) (precedential) ("*Bloomberg*"), the Board set forth five factors for determining whether such good cause exists. We refer to those factors here

mere possibility of finding something useful in the production of the data for the other parameters referenced in the Prates Declaration (*Bloomberg* Factor 1). In addition, Patent Owner's request is narrowly tailored to specific data that Dr. Prates confirmed exists (*see* Ex. 1020 ¶¶ 5, 9) from a particular source, i.e., the "field books" database, which Petitioner has already accessed to produce the subset of the data from those experiments it seeks to rely upon. Thus, *Bloomberg* Factors 4 and 5 likewise support production. As for Petitioner's suggestion that Patent Owner can generate its own data regarding these other parameters (*Bloomberg* factor 3), such data would not be equivalent to the data that already exists in Petitioner's field books because it would not pertain to the same experiments that form the basis for the testimony in the Prates Declaration. For these reasons, Patent Owner has sufficiently shown that good cause exists for this additional discovery.

On the call, Patent Owner requested that the deadline for its Response be moved to at least a week after it received the additional data from the field books. With that in mind, we moved Due Date 1 from the scheduling order (Paper 9) to November 9, 2023. This extension assumes that Petitioner will be able to produce the additional data by November 2, 2023. Petitioner indicated it would check internally regarding the timeline for this production. If after doing so, Petitioner is concerned it will not be able to produce the remaining data by November 2, 2023, it should request an additional conference with the Board.

In view of the foregoing, it is hereby:

ORDERED that Petitioner will produce the remaining data from its field books for the other parameters from the field tests referenced in the

by the same numbers used in *Bloomberg*.

PGR2023-00017
Patent 11,445,727 B2

Prates Declaration by November 2, 2023. As with the other field book data, Patent Owner will treat this data per the terms of the parties' proposed protective order (*see* Paper 20); and

FURTHER ORDERED that Due Date 1 from the Scheduling Order (Paper 9) is moved to November 9, 2023.

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