

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
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2), 42.224

I. INTRODUCTION

Patent Owner sought authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). Ex. 3002, 1. Following a teleconference with the parties, we authorized Patent Owner to file a motion for additional discovery. Paper 22. Patent Owner filed that motion (Paper 23 “Motion” or “Mot.”), seeking the following additional discovery:

Documents sufficient to show [Petitioner’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.

Mot. 1. Petitioner opposes the Motion. Paper 25 (“Opp.”). For the reasons explained below, we deny the Motion.

II. STANDARDS FOR ADDITIONAL DISCOVERY

“[T]here is a strong public policy to limit discovery in administrative trial proceedings, as opposed to the practice in district court patent litigations that have broad discovery.” *Bloomberg, Inc. v. Market-Alerts Pty, Ltd.*, Case CBM2013–00005, Paper 32, (PTAB May 29, 2013) (precedential) (“*Bloomberg*”). Thus, the party moving for discovery in a post-grant review must show good cause as to why the additional discovery is needed. 37 C.F.R. §§ 42.51(b)(2), 42.224. Discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding. *Id.* In determining whether good cause exists for granting a motion for additional discovery, we consider five factors set out in *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012–00001, Paper 26, 6–7 (PTAB Mar. 5, 2013) (precedential), as modified for post-grant review by *Bloomberg*.

These factors and the accompanying explanation from *Bloomberg* are reproduced below:

1. *More Than A Possibility And Mere Allegation*—

The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing. “Useful” means favorable in substantive value to a contention of the party moving for discovery. A good cause showing requires the moving party to provide a specific factual reason for expecting reasonably that the discovery will be “useful.”

2. *Litigation Positions And Underlying Basis*—

Asking for the other party’s litigation positions and the underlying basis for those positions is insufficient to demonstrate that the additional discovery is necessary for good cause. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.

3. *Ability To Generate Equivalent Information By Other Means*—

A party should not seek information that reasonably can be generated without a discovery request.

4. *Easily Understandable Instructions*—

Instructions and questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder’s ability to answer efficiently, accurately, and confidently.

5. *Requests Not Overly Burdensome To Answer*—

Requests must not be overly burdensome to answer, given the expedited nature of a covered-business method patent review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of the trial. Requests should be sensible and responsibly tailored according to a genuine need.

Bloomberg 5.

III. ANALYSIS

Beginning with *Bloomberg* factor 1, Patent Owner argues the Motion should be granted because “the request here is not based on a bare allegation,” but rather the testimony of Petitioner’s declarant, Dr. Prates,¹ “shows that [Petitioner] has useful responsive information.” Mot. 3. More specifically, Petitioner contends Dr. Prates “admitted that [Petitioner] is promoting and developing claimed compositions,” i.e., in Patent Owner’s view, fungicidal combinations of benzovindiflupyr, prothioconazole, and mancozeb, “and that [Petitioner] would have ‘*basis to show added value*’ in terms of resistance management or other properties.” *Id.* (quoting Ex. 2018, 74:8–75:5, 78:2–11) (emphasis added by Patent Owner). Patent Owner asserts that the additional discovery it seeks showing such is “directly related to factual assertions” in this proceeding because it would contradict Petitioner’s “obviousness and enablement positions” and is “relevant to objective indicia including copying and recognition.” *Id.*

Petitioner disputes Patent Owner’s characterization of Dr. Prates’s testimony and urges that “even assuming Dr. Prates testified that combinations including mancozeb added value, this does not contradict Dr. Prates’[s] finding of no synergy in his declaration.” Opp. 3–4. According to Petitioner, Patent Owner has not explained “with any specificity, how the documents it seeks would contradict Petitioner’s assertions.” *Id.* at 2. Petitioner also disputes Patent Owner’s assertions regarding copying and promotion because “copying requires the replication of a specific product”

¹ Petitioner submitted Exhibit 1020 (“Prates Declaration”) with the Petition. Patent Owner subsequently deposed Dr. Prates and filed the deposition transcript as Exhibit 2018.

and Patent Owner points to no evidence of such. *Id.* at 2–3 (quoting *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004)). Thus, Petitioner urges the Motion fails to show “more than a possibility and mere allegation” of finding something useful. *Id.* at 3.

We agree with Petitioner. At most, the testimony cited in the Motion suggests that Petitioner has in Brazil recommended the use of multisite fungicides, including mancozeb, in combination with benzovindiflupyr and prothioconazole for the purpose of “resistance management.” *See* Ex. 2018, 64:11–65:13, 66:1–14, 74:8–75:5. However, Patent Owner does not sufficiently explain how documents showing the promotion and bases for promoting that combination would undermine Petitioner’s allegations that the claimed combinations do not exhibit synergy or that the challenged claims are not enabled for that reason. *See* Paper 8, 22 (Institution Decision noting that Petitioner’s non-enablement argument is premised on its assertion that “the ’727 patent fails to enable the use of the full scope of the challenged claims as ‘fungicidal combinations providing . . . enhanced efficacy and synergy.’”) (quoting Paper 2 (“Petition”), 78).

Similarly, Patent Owner’s argument that its request is likely to lead to evidence of copying and recognition is mere speculation. Patent Owner identifies nothing that suggests Petitioner copied its patented work or a product embodying such. *See Iron Grip*, 392 F.3d at 1325 (“Not every competing product that arguably falls within the scope of a patent is evidence of copying. . . . Rather, copying requires the replication of a specific product.”); *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347–48 (Fed. Cir. 2013) (“Copying requires duplication of features of the patentee’s work based on access to that work, lest all infringement be mistakenly treated as copying.”). In addition, the

Motion does not explain how discovery limited to the particular combination of benzovindiflupyr, prothioconazole, and mancozeb is likely to lead to evidence reasonably commensurate with the scope of the challenged claims, which seemingly encompass a variety of other fungicidal combinations. *See, e.g., South Alabama Med. Science Foundation v. Gnosis S.P.A.*, 808 F.3d 823, 827 (Fed. Cir. 2015) (objective indicia evidence must be “reasonably commensurate with the scope of the claims”). For these reasons, the Motion does not provide a “specific factual reason” from which one could reasonably expect the requested discovery will be useful. Thus, *Bloomberg* Factor 1 weighs against Patent Owner.

Bloomberg factors 4 and 5 also weigh against Patent Owner. While Patent Owner characterizes its request as “targeted” and “narrowly defined” (Mot. 3), we do not agree. Even considering the “documents sufficient to” and geographical limitations, the phrase “promotion of and bases for promoting” potentially encompasses broad swaths of information. At the same time, Patent Owner points to no source for obtaining such information.² Indeed, Dr. Prates testified that he did not know if Petitioner had “any data or experiments reflecting the resistance management provided by the combination of benzovindiflupyr, prothioconazole, and mancozeb.” Ex. 2018, 77:9–15. Thus, on the facts of this case, we agree with Petitioner that the request is overly burdensome because it would require Petitioner’s

² In this regard, the request at issue here differs from Patent Owner’s request for additional discovery of the underlying data for the field test experiments described in the Prates Declaration. *See* Paper 27, 1–4 (granting additional discovery). There, Dr. Prates confirmed the data existed and could be obtained from a particular source, i.e., Petitioner’s “field books” database, and indeed Petitioner had already produced the portion of that data it contended was relevant to Dr. Prates’s testimony supporting the Petition. *Id.*

counsel “to *find* individuals” with appropriate knowledge within its Brazilian business unit before it could even begin to cast a net to look for documents that might be responsive. *See* Opp. 4.

In sum, after considering the *Bloomberg* factors³ in view of the particular circumstances of this proceeding, we find Patent Owner has not shown that good cause exists for the discovery sought in the Motion.

In view of the foregoing, it is hereby:

ORDERED that Patent Owner’s Motion for Additional Discovery Under 37 C.F.R. § 42.51(b)(2) (Paper 23) is denied.

³ Each party asserts that Bloomberg factors 2 and 3 favor their respective positions. *See* Mot. 4; Opp. 5. We have considered those arguments and find that, on balance, Bloomberg factors 2 and 3 are neutral and do not demonstrate good cause for the additional discovery Patent Owner seeks.

PGR2023-00017
Patent 11,445,727 B2

For PETITIONER:

Toni-Junell Herbert
David Klecyngier
Daniel Bucca
Charles C. Carson
BAKERHOSTETLERLLP
therbert@bakerlaw.com
dklecyngier@bakerlaw.com
dbucca@bakerlaw.com
ccarson@bakerlaw.com

For PATENT OWNER:

Mark J. Feldstein
Maximilienne Giannelli
Rajeev Gupta
Kenneth S. Guerra
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
mark.feldstein@finnegan.com
maximilienne.giannelli@finnegan.com
raj.gupta@finnegan.com
kenneth.guerra@finnegan.com