

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,

v.

UPL LTD,
Patent Owner.

PGR2023-00017
U.S. Patent No. 11,445,727

**PETITIONER'S MOTION FOR DISCOVERY
UNDER 37 C.F.R. § 42.51(b)(1) AND § 42.51(b)(2)**

The Board authorized Petitioner to file this motion. In addition, the Board authorized Petitioner to provide the email correspondence between the parties regarding the requested discovery. The correspondence is concurrently filed as Exhibit 1045.

Petitioner's discovery request is as follows: (A) Production of underlying data and assessments in relation to the Examples referred to in the '727 patent and Table 1 including information sufficient to show the experimental protocol, the underlying data for disease control, and calculations or determinations of efficacy, disease control, synergistic effect, and any other parameters assessed. In the alternative, if the underlying data and materials cannot be located, (B) a deposition of the inventor Rajju Devidas Shroff, resident in India.

Petitioner is entitled to the discovery because (i) UPL's expert Dr. Jacobsen specifically relied on the testing data and examples in the '727 patent; (ii) UPL makes factual assertions relying on the testing data and examples in the '727 patent; (iii) it would reveal inconsistent positions advanced by UPL during the proceeding (*see* 37 C.F.R. § 42.51(b)(1)(iii)); and (iv) the requested discovery meets the Bloomberg Factors and standard for good cause (*see* 37 C.F.R. §42.51(b)(2)).

On December 13, 2023, Petitioner requested that UPL produce item (1) above. EX1045, page 8. Petitioner explained its bases for the request noting

UPL's expert, Dr. Jacobsen, relied on the examples and data of the '727 patent as "demonstrating the effectiveness of the fungicidal combinations of the invention ... as shown in Table 1" in paragraph 52 of his declaration. *Id.* UPL did not specifically disagree that Dr. Jacobsen had relied on the experiments in forming his opinions, nor did UPL contest discovery of the material. *Id.* at 4, *but see Id.* at 3. Rather, UPL responded that ". . . UPL has investigated and was unable to locate any data beyond those reported in the '727 patent." *Id.* at 7.

Given this remarkable representation, Petitioner requested UPL voluntarily make available for deposition, Rajju Devidas Shroff, resident in India, since the relied upon trials took place "at various locations in India."¹ *Id.* at 5-6. Petitioner also offered to take the deposition remotely. *Id.* at 6. UPL refused the deposition request. *Id.* at 5.

Only after Petitioner noted that UPL did not disagree that Dr. Jacobsen relied on the data in the '727 patent, UPL responded that Dr. Jacobsen's opinions do not "rely on testing referenced in the '727 patent." *Id.* at 3. This subsequent position is without merit. The position is contradicted by Dr. Jacobsen's

¹ Despite Petitioner's repeated requests about whether materials related to the '727 patent examples ever existed or have been discarded or lost, UPL's counsel refused to clarify. *See* EX1045, pages 3-4.

Declaration, and UPL's arguments for patentability. Even in UPL's Response, UPL cites this very portion of Dr. Jacobsen's declaration. Paper 31 at 4.

I. THE REQUESTED DISCOVERY IS GRANTABLE AS ROUTINE

UPL's expert, Dr. Jacobsen, did in fact rely on the examples and data in the '727 patent to render his opinions. The '727 patent examples purport to be experimental trials conducted over a two-year period to test certain fungicidal combinations for the efficacy of controlling Asian soybean rust in various locations in India. EX1001, 20:15-36; EX1003, ¶¶58-60. Tables 1 and 2 purport to show the resulting data from the experiments. EX1001, 20:37-21:10, EX1003, ¶¶58-60.

Dr. Jacobsen relied on these examples and data to opine that such examples and data *demonstrate* "the effectiveness of the fungicidal combinations of the invention" and show "a marked improvement" for a particular fungicidal combination. EX2020 at ¶52. Specifically, Dr. Jacobsen states:

The '727 patent provides examples demonstrating the effectiveness of the fungicidal combinations of the invention for controlling Asian soybean rust in soybeans. Exhibit 1001 ('727 patent) at 20:15-21:14. For example, the '727 patent discloses that the combination of mancozeb + prothioconazole + benzovindiflupyr controlled Asian soybean rust by about 95% for two consecutive years, which was a marked improvement over the combination of prothioconazole + benzovindiflupyr, as shown in Table 1.

EX2020, ¶52.

UPL relied on this paragraph in its Patent Owner's Response to support its position that the '727 patent provided "surprising and unexpected advantages," including enhanced efficacy and surprising reduction in disease. Patent Owner Response (Paper 31), page 4 citing EX2020, ¶¶45-52. Accordingly, the examples in the '727 patent are relied upon. As such, UPL should be ordered to produce the requested discovery under 37.C.F.R. 42.51(b)(1). *See also L'Oreal v. LIQWD*, PGR2018-00025, Paper No. 42 (PTAB Jan. 25, 2019).²

Moreover, Dr. Jacobsen does not characterize the data in Table 1 of the '727 patent as demonstrating "enhanced efficacy," "synergy," or "unexpected results." Instead, Dr. Jacobsen characterizes the data in Table 1 as showing a "marked improvement." EX2020 at ¶52. Dr. Jacobsen is silent on the data in Table 2 of the '727 patent. Dr. Jacobsen's characterization of the examples and data in the '727 patent are therefore inconsistent with UPL's position that the same fungicidal

² In *L'Oreal*, as in the present case, the Patent Owner made factual assertions using testing and data for evidentiary support of its positions. The Board found that even though the testing was not specifically prepared for the post-grant review proceeding, because the testing was relied upon and submitted in an inventor affidavit, the Petitioner was granted deposition of the inventor affiant.

combination used for the same control of Asian soybean rust resulted in “data as a whole show[ing] strong synergistic effects for the claimed combinations and demonstrates that the claimed invention is objectively nonobvious under every metric.” Paper 31 at 79.

To this end, routine discovery includes “. . . relevant information that is inconsistent with a position advanced by the party. . . .” 37 C.F.R. § 42.51(b)(1)(iii). “This requirement extends to *inventors*, corporate officers, and persons involved in the preparation or filing of the documents or things.” *Id.* (emphasis added). UPL believes it can escape § 42.51(b)(1)(iii) by stating no such documentation exists. This is gamesmanship of the rules. To verify there are no inconsistencies, Petitioner should be granted discovery request (A), and in the event this material does not exist, deposition of the inventor Rajju Devidas Shroff (alternative discovery request (B)).

Accordingly, UPL should be ordered to produce the requested discovery as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). *See also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (2019), Example 2 (providing “where a patent owner relies upon surprising and unexpected results to rebut an allegation of obviousness, the patent owner should provide the petitioner with non-privileged evidence that is inconsistent with the contention of unexpected properties.”)

II. PETITIONER’S MOTION IS GRANTABLE FOR GOOD CAUSE

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). Petitioner’s discovery request is supported by good cause and satisfies the five-factor test set forth in *Bloomberg, Inc. v. Market–Alerts Pty, Ltd.*, CBM2013-00005, Paper 32 (PTAB May 29, 2013) (precedential) (“Bloomberg”).

Bloomberg factor 1 requires that the moving party provide a specific factual reason for expecting the sought-after discovery will be useful. *See Bloomberg* at 5. In *L’Oreal*, Factor 1 was met when the relevant data at issue was subjective, and the requested deponent was uniquely positioned to answer questions related to the testing. *L’Oreal* at 5. In this case, UPL attempts to complicate the record using terms such as “enhanced efficacy,” “synergy,” and “marked improvement,” in an effort to purport the claimed combinations provide unexpected results. It is unclear how each of these terms relate to each other. The requested discovery would clarify what is meant by these terms, and what terms are actually appropriate when characterizing the data in this case.

Furthermore, it is expected that the calculations or determinations of efficacy, disease control, and synergistic effect for the ’727 patent examples will reveal inconsistent analysis between “enhanced efficacy,” “synergy,” and “marked

improvement.” For instance, UPL and Dr. Jacobsen have “lowered” the threshold for synergy from the standard threshold of greater than 1 to show synergy, to an arbitrarily chosen threshold of 0.8 or higher for synergy. EX2020 at 251; Paper 31 at 73. Whereas only 6 months ago, in an opposition involving the European patent equivalent to De Oliveira (EX1007), UPL identified ratios of 0.9, 0.8, and 0.7 as not showing synergy, but rather the opposite—antagonism. EX1034; EX1043, 199:3-17, 208:11-211:11.

Bloomberg factor 2 relates to not revealing an opponent’s litigation positions and their underlying bases. This discovery request would not reveal litigation positions or their underlying bases. *Bloomberg* factor 3 strongly weighs in favor of granting the requested discovery as it appears only UPL possesses the requested discovery. *Bloomberg* factors 4 and 5 also weigh in favor of granting the requested discovery. These factors require that the request be easily understandable and not overly burdensome. The request is specific, readily understandable and tailored to seek underlying data and materials related to the examples in the ’727 patent or a deposition of a knowledgeable inventor, which is in the control of UPL.

III. CONCLUSION

For the foregoing reasons, Petitioner's motion for discovery should be granted.

Date: January 17, 2024

Respectfully submitted,

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on January 17, 2024, a copy of the foregoing PETITIONER'S MOTION FOR DISCOVERY UNDER 37 C.F.R. § 42.51(b)(1) and § 42.51(b)(2) was provided via email to the following:

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