

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 OPPOSITION
TO PETITIONER'S MOTION FOR
ADDITIONAL DISCOVERY
UNDER 37 C.F.R. § 42.51(b)(2)**

Syngenta’s Motion (Paper 37, “Motion”) misrepresents the facts and lacks merit. Wasting resources of the Board and parties, Syngenta seeks discovery of experimental data despite knowing that “UPL ha[d] investigated and was unable to locate data relating to trials described in the ’727 patent beyond those reported therein.” EX1045, 7. As an “alternative,” Syngenta seeks, but fails to establish good cause for, the deposition of Rajju Devidas Shroff—a 91-year-old *retired* UPL chairman (with an honorary *Chairman emeritus* title)—to fish for unspecified “inconsistencies.” Motion, 1, 5. The Motion lacks good cause and should be denied.

A. Syngenta’s Material Misrepresentations

The foundation of Syngenta’s Motion is its misrepresentation that “Dr. Jacobsen, did in fact rely on the examples and data in the ’727 patent to render his opinions.” Motion, 3 (citing EX2020, ¶52). But the two-sentence paragraph to which Syngenta points provides no more than a descriptive summary as part of a background section entitled “The ’727 Patent.”

52. 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. Beyond this non-opinion background describing what “the ’727 patent discloses,” Syngenta identifies nowhere that Dr. Jacobsen “rel[ied] on the examples and data in the ’727 patent *to render his opinions.*” Motion, 3 (emphasis added). Indeed, Dr. Jacobsen does not otherwise even mention the patent example. The irrelevance of the cited paragraph to Dr. Jacobsen’s opinions is confirmed by Syngenta’s failure to address it in even a single question during his deposition. *See generally* EX1043.

Syngenta admits that Dr. Jacobsen only “characterizes the data in Table 1 as showing a ‘*marked improvement*’” without alleging “‘enhanced efficacy,’ ‘synergy,’ or ‘unexpected results’” and without addressing “the data in Table 2 of the ’727 patent.” Motion, 4 (emphasis added). Syngenta’s allegation that this is “to purport the claimed combinations provide unexpected results” (Motion, 6) is demonstrably false. In fact, Dr. Jacobsen’s *opinions* regarding unexpected results are separately provided in the “Unexpected Results” section of his declaration. EX2020, ¶¶240-287. Those opinions rely *exclusively* on *Syngenta* data that Syngenta’s counsel generated specifically for, but fought to withhold in, this proceeding. *Id.* (relying on EX1031, EX1032, EX1033); Paper 31, 72-79; *see also* §B.4, *infra*.

Unlike *L'Oreal v. LIQWD*, neither Dr. Jacobsen nor Patent Owner have “made factual assertions using [any example in the patent], particularly the testing and data described therein, for evidentiary support of its positions.” PGR2018-00025, Paper 42, 3 (PTAB Jan. 25, 2019) (“*L'Oreal*”); *cf.* Motion, 4. Nor is Practice Guide Example 2—addressing “where a patent owner relies upon surprising and unexpected results to rebut an allegation of obviousness”—relevant since UPL relies exclusively on the initially withheld *Syngenta* data. *Cf.* Motion, 5. To the extent the Board nevertheless finds Dr. Jacobsen’s descriptive background or Patent Owner’s citation thereto as relying on the ’727 patent examples for evidentiary support of its positions, Patent Owner hereby withdraws any such substantive reliance on the ’727 patent examples in this proceeding.

B. Syngenta’s Motion Is Not Supported by Good Cause

Additional discovery in a PGR is limited to “evidence directly related to factual assertions advanced by either party” upon a “showing of good cause.” 37 C.F.R. § 42.224. Because Syngenta’s Motion rests entirely on its misrepresentations regarding the bases for Dr. Jacobsen’s opinions, it is not directly related and necessarily lacks good cause. Even leaving those misrepresentations aside, Syngenta still fails to establish good cause for its futile and overbroad discovery.

1. Syngenta Seeks Data UPL Could Not Locate and Speculative “Assessments In Relation” Thereto

Syngenta broadly seeks:

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.

Motion, 1.¹ As Syngenta has been informed multiple times, UPL investigated and was unable to locate the roughly 7-year-old data relating thereto beyond what is reported in the '727 patent. EX1045, 5, 7. Even if there were good cause for discovery of data not relied upon in this proceeding—though there is not—there is not even “[t]he mere possibility of finding something useful” where UPL has already searched for but was unable to locate the information. *Bloomberg, Inc. v. Markets-Alert Pty, Ltd.*, CBM2013-00005, Paper 32 (PTAB May 29, 2013) (“*Bloomberg*”).

Syngenta’s vague demands for “assessments *in relation* to the Examples” (Motion, 1 (emphasis added)) also fails *Bloomberg* Factor 1. Unlike the previously

¹ Syngenta’s demands for “assessments” and itemized “including” list differs from its request to UPL and the Board’s authorization. *Compare* Motion, 1, *with* EX1045, 2 (“(1) the underlying data and materials related to the examples in the patent at issue (the ‘727 patent’)” *and* EX3005, 1. Syngenta’s demand for an order “to produce the requested discovery as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii)” is likewise beyond the scope it requested and was authorized to seek.

ordered additional discovery (Paper 27), Syngenta provides no threshold showing of any such “assessments” beyond what is already provided in the ’727 patent and its “mere allegation that something useful will be found [is] insufficient to establish a good cause showing.” *Bloomberg*, 5.

Especially where the ’727 patent examples were not relied upon (§A, *supra*), speculative but unidentified “inconsistent positions advanced by UPL during the proceeding” (Motion, 1) are not “specific factual reason[s] for expecting reasonably that the discovery will be ‘useful.’” *Bloomberg*, 5; *see also* §B.4, *infra*. To the extent there is any issue regarding the Colby thresholds, Syngenta has—as it admits—taken testimony related thereto. *See* Motion 6-7 (citing EX1043). By contrast, Syngenta willfully forwent questioning Dr. Jacobsen regarding any differences of opinion concerning the ’727 patent examples by not asking him a single question related thereto (*see* EX1043) and instead focusing on a separate patent family (*see* §3, *infra*).

The hopelessly vague and unbounded nature of “*in relation to*” would require an equally unbounded fishing net cast across the company to look for an unknown and unidentified class of documents. This contravenes *Bloomberg* factors 4 (easily understandable instructions) and 5 (requests not overly broad to answer).

2. Syngenta Fails to Proffer Good Cause to Depose UPL’s 91-Year-Old *Former* Chairman

Syngenta alternatively seeks “a deposition of the inventor Rajju Devidas Shroff, resident in India.” Motion, 1. Mr. Shroff is 91 years old and *retired* from

UPL—public information of which Syngenta should already be aware or could have determined from a simple internet search. Syngenta has failed to articulate good cause to depose the retired Mr. Shroff, who UPL lacks authority to provide.

Reflecting an intent to harass, Syngenta has made clear that its demands to depose Mr. Shroff as an “inventor who *may be able to* provide information as to the trials in India” is an express fishing expedition with no identified substance related to factual assertions in this proceeding. EX1045, 6 (emphasis added). This again contravenes *Bloomberg* Factor 1, where “[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to establish a good cause showing.” *Bloomberg*, 5.

Syngenta’s only attempt to justify its extraordinary request is to “verify there are no inconsistencies” with Dr. Jacobsen’s descriptive summary of the ’727 patent. Motion, 5. Syngenta, however, has failed to identify any such inconsistencies. Further, as discussed *supra*, neither Dr. Jacobsen nor Patent Owner have “made factual assertions using [any example in the patent], particularly the testing and data described therein, for evidentiary support of its positions.” *L’Oreal*, 3. Again failing *Bloomberg* Factor 1, this is not “a specific factual reason for expecting reasonably that the discovery will be ‘useful.’” *Bloomberg*, 5.

Regardless, UPL lacks authority to compel 91-year-old retired Mr. Shroff to stand for a deposition, which would further be an undue burden given his age and

health. *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2048-49 (TTAB 1988) (cannot compel former employee for deposition). And, even if Mr. Shroff was still the UPL chairman and could be compelled, he would be properly protected from a deposition by the “apex” doctrine. *See, e.g., Celerity, Inc. v. Ultra Clean Holding, Inc.*, 2007 WL 205067, at *3 (N.D. Cal. Jan. 25, 2007) (“Virtually every court that has addressed deposition notices directed at an official at the highest level or ‘apex’... has observed... [the] tremendous potential for abuse or harassment”).

3. Syngenta is Seeking Ammunition for Other Litigation

Syngenta revealed its improper ulterior motives of seeking litigation positions, contrary to *Bloomberg* Factor 2, when deposing Dr. Jacobsen. After avoiding any questioning regarding the examples in the '727 patent, Syngenta deposed Dr. Jacobsen extensively about foreign patent applications and oppositions in another UPL patent family, plainly in an effort to develop litigation positions for those separate matters. *See* EX1034 (EPO opposition paper); EX1045 at 79:4-87:21, 88:1-95:16, 199:6-211:1, 293:6-297:1 (e.g., “Would it cause you to not trust the results that are reported in Exhibit 1034?”).

Syngenta’s discovery should be denied for this reason as well. *Bloomberg*, 5.

4. Syngenta’s Pending Motion is Distinct from the Board’s October 27, 2023, Order

The contrast between Syngenta’s Motion and the Board’s previous additional discovery order (Paper 27) reinforces Syngenta’s failure to demonstrate good cause.

The Board previously ordered discovery related to experiments Syngenta’s counsel directed and expressly relied upon specifically for the purposes of this proceeding. As the Board recognized, Syngenta’s declarant—who generated their data—had identified exactly what data existed and where it existed in electronic “field books.” Paper 27, 4. Syngenta’s counsel had agreed in writing to produce the field book data, but then reneged and falsely represented that it need not be produced because it was “not helpful to Patent Owner.” EX2019, 10:13-14.

The discovery Syngenta now seeks is not analogous. The experiments UPL conducted roughly 7 years ago were generated independent from and were not relied upon in this proceeding. And rather than having already known locations in readily accessible databases (*id.*, 12:8-16), UPL has investigated but was unable to locate the underlying data (EX1045, 7).

For the forgoing reasons, Patent Owner requests the Board deny Syngenta’s motion for additional discovery.

Respectfully submitted,

Dated: January 29, 2024

/Mark J. Feldstein/

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S
OPPOSITION TO PETITIONER'S MOTION FOR ADDITIONAL
DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)** was served electronically via email
on January 29, 2024, in its entirety on the following:

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Petitioner has consented to service by electronic mail.

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