

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

VALEK, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion for Discovery
37 C.F.R. § 42.51(b)(1-2), 42.224

I. INTRODUCTION

Petitioner sought authorization to file a motion for discovery under 37 C.F.R. § 42.51(b)(1) and (2). Ex. 3005, 1. We authorized Petitioner to file that motion. *Id.* Petitioner filed its motion (Paper 37 “Motion” or “Mot.”), seeking the following:

(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 calculation 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.

Mot. 1. Petitioner contends it is entitled to this discovery as routine discovery because Patent Owner and its declarant “specifically relied on the testing data and examples in the ’727 patent” and “it would reveal inconsistent position advanced by [Patent Owner] in the proceeding.” *Id.* (citing 37 C.F.R. § 42.51(b)(1)(iii)). Petitioner further asserts “the requested discovery meets the Bloomberg Factors and standard for good cause.” *Id.* (citing 37 C.F.R. § 42.51(b)(2)).

Patent Owner opposes the Motion. Paper 39 (“Opp.”). Patent Owner asserts that it has “investigated and was unable to locate data relating to trials described in the ’727 patent beyond those reported therein.” Opp. 1 (quoting Ex. 1045, 7). Moreover, Patent Owner contends its declarant, Dr. Jacobsen did not rely on the examples and data in the ’727 patent and “withdraws any substantive reliance on the ’727 patent examples in this proceeding.” *Id.* at 1, 3. For similar reasons, Patent Owner contends good cause for additional discovery has not been shown. *See Id.* at 3–5.

Regarding Petitioner’s alternative request for the deposition of Mr. Shroff, Patent Owner represents that, in addition to residing in India, “Mr. Shroff is 91 years old and *retired* from UPL.” Opp. 5–6. According to Patent Owner, Petitioner’s request 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 the factual assertions in this proceeding.” *Id.* at 6 (quoting Ex. 1045, 6). Accordingly, Patent Owner contends good cause has not been shown.

For the reasons explained below, we deny the Motion.

II. PETITIONER’S ROUTINE DISCOVERY ARGUMENT

Petitioner argues that the discovery it seeks is routine discovery under 37 C.F.R. § 42.57(b)(1)(iii) because (1) Dr. Jacobsen and Patent Owner rely on the patent examples, and (2) Dr. Jacobsen’s “characterization of the examples and data in the ’727 patent” are inconsistent with the unexpected results arguments in Patent Owner’s Response. Mot. 3–5. We disagree on both points.

First, as Patent Owner points out, Dr. Jacobsen’s declaration only refers to the patent examples in passing “as part of a background section” describing the ’727 patent. Opp. 1–2 (quoting Ex. 2020 ¶ 52). In contrast, Dr. Jacobsen’s opinions regarding unexpected results are offered in a separate section of his declaration and premised on a different set of data, i.e., Petitioner’s field book data, which Petitioner introduced to show a lack of synergy. *See* Ex. 2020 ¶¶ 240–287 (citing Exhibits 1031–1033). Dr. Jacobsen disagrees with Petitioner’s interpretation of this data, testifying that “[Petitioner’s] testing *does* demonstrate synergy for the claimed subject matter in fungus control, defoliation, and yield.” *Id.* ¶ 246. It is that

testimony premised on Petitioner’s own data—not the data or experiments in the ’727 patent examples—that Patent Owner relies upon for the unexpected results arguments in the Response. *See* Paper 31, 72–79.

Second, to remove any doubt, Patent Owner has affirmatively “withdraw[n] any . . . substantive reliance on the ’727 patent examples in this proceeding.” Opp. 3. Since neither Patent Owner, nor its declarant, are taking a position on the ’727 patent examples, we do not see how the requested discovery pertaining to those examples is “inconsistent with a position advanced” by Patent Owner such that this would be routine discovery under 37 C.F.R. § 42.51(b)(1)(iii).

For the same reason, Petitioner’s reliance on example 2 in the TPG¹ is misplaced. *See* Mot. 5. That example refers to inconsistent evidence “where a patent owner relies upon surprising and unexpected results.” TPG, 23. But the results Patent Owner relies on here are unrelated to the discovery Petitioner seeks. Accordingly, Petitioner has not demonstrated that this is routine discovery that it is entitled to under 37 C.F.R. § 42.51(b)(1).

III. PETITIONER’S ADDITIONAL DISCOVERY ARGUMENT

A. *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

¹ Patent Trial and Appeal Board Consolidated Trial Practice Guide, Nov. 2019 (“TPG”).

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.

B. Analysis

Beginning with *Bloomberg* factor 1, Petitioner has not demonstrated more than the mere possibility that something useful will be found. As an initial matter, Petitioner identifies no reason to doubt Patent Owner's representation that it was unable to locate data underlying the '727 patent examples beyond what is reported in the Specification. *See* Opp. 1, 4; Ex. 1045, 5, 7. Thus, Petitioner has not shown that part (A) of its request will discover anything, much less something useful.

Nor has Petitioner offered "a specific factual reason for expecting that the discovery will be useful." *Bloomberg*, 5. Petitioner's assertion that "it is expected that the calculations or determinations of efficacy, disease control, and synergistic effect" for the '727 patent examples "will reveal inconsistent analysis" with Dr. Jacobsen's analysis pertaining to Petitioner's field book data is entirely speculative. *See* Mot. 6–7. Indeed, as Petitioner acknowledges, Dr. Jacobsen does not even testify that the data and experiments in the '727 patent examples demonstrate synergy. *See id.* at 4 (citing Ex. 2020 ¶ 52). Thus, even if Patent Owner were relying on the '727 patent examples (which Patent Owner is not), Petitioner identifies no reason to expect that additional information regarding those examples would reveal

any inconsistency.

Petitioner's attempt to leverage Patent Owner's inability to locate additional data regarding the '727 patent examples into a deposition of the inventor is similarly unpersuasive. As noted above, Petitioner has not identified a specific factual reason why the testimony of the inventor regarding experiments that Patent Owner does not rely upon is expected to be useful to any issue in this proceeding.² Moreover, the undisputed facts that Mr. Shroff: (1) resides in India; (2) is of advanced age; and (3) is no longer employed by Patent Owner, demonstrate that the requested deposition would be unduly burdensome, if not impossible, for Patent Owner to provide in this proceeding (*Bloomberg* factor 5).

In sum, Petitioner has not made a sufficient showing under *Bloomberg* factor 1. *Bloomberg* factor 5 also disfavors Petitioner's request. Accordingly, after considering the *Bloomberg* factors³ in view of the particular circumstances of this proceeding, we find that Petitioner has not shown good cause for the additional discovery sought in the Motion.

In view of the foregoing, it is hereby:

ORDERED that Petitioner's Motion (Paper 37) is denied.

² To the extent Petitioner might seek to question Mr. Shroff regarding other issues, we agree with Patent Owner that this would be a "fishing expedition" contrary to the requirements of *Bloomberg* factor 1. *See* Opp. 6.

³ We have considered the parties' arguments regarding the other *Bloomberg* factors and determine that, on balance, those factors are neutral and do not demonstrate good cause for the additional discovery Petitioner seeks.

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