

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARLES RIVER LABORATORIES, INC.,

Petitioner,

v.

SEIKAGAKU CORPORATION,

Patent Owner.

Case No. PGR2025-00023

Patent No. 11,959,109

**PATENT OWNER'S MOTION FOR ADDITIONAL
DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)(i)¹**

¹ This motion and the motion filed concurrently in IPR2025-00440 are substantially similar. The differences reflect the lower standard for granting motions for additional discovery applied in post grant reviews.

I. INTRODUCTION

Pursuant to authorization granted on November 12, 2025 (Paper 22), Patent Owner Seikagaku Corporation (“Seikagaku” or “PO”) moves to compel Petitioner Charles River Laboratories, Inc. (“CRL”) to confirm whether it initiated Opposition proceedings before the European Patent Office against PO’s European Patent number 3530670 (“Opposition”).

II. CRL MUST PRODUCE INFORMATION ON AN INCONSISTENT POSITION AS “ROUTINE DISCOVERY”

The requested additional discovery is appropriate here because it is “related to factual assertions advanced by [Petitioner] in the proceeding.” 35 U.S.C. § 326(a)(5). The Board considers five factors in determining whether additional discovery in a post grant review proceeding is necessary for good cause: (1) the request is based on “more than a possibility and mere allegation” of finding something useful; (2) the request does not seek the “litigation positions and the underlying basis for those positions” of the other party; (3) the request does “not seek information that can reasonably be generated without a discovery request”; (4) the request is “easily understandable”; and (5) the request is not “overly burdensome to answer.” *Bloomberg Inc. v. Markets-Alert Pty Ltd.*, CBM2013-00005, Paper 32

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at 5 (PTAB May 29, 2013) (precedential).² The good cause standard applied by *Bloomberg*, is lower than the interests of justice standard applied in *inter partes* reviews. *Id.* at 2–3. The *Bloomberg* factors favor PO's Motion.

A. Factor 1 – “More Than A Possibility And Mere Allegation”

Bloomberg Factor 1 weighs in PO's favor because the facts here establish that PO “expect[s] reasonably that the discovery will be ‘useful.’” *Bloomberg*, Paper 32 at 5. In this context, “useful” means “means favorable in substantive value to a contention of” PO. *Id.* The requested discovery is clearly useful because it concerns information inconsistent with a position advanced by Petitioner.

As explained in PO's Preliminary Response, strong evidence indicates CRL filed the Opposition, including commissioning a declaration from an expert in the field—Professor Michael A. Frohman. Paper 7 at 29, 34–41. The statements made in the Opposition contradict statements made by CRL in its Petition. For example, CRL cites the '109 Patent inventors' statements in PCT Patent Application Publication No. 2018/074498 (the “'498 PCT”) as evidence that even in 2017 the “field had struggled to sequence and structurally and functionally characterize the

² Although *Bloomberg* addresses a motion for additional discovery in a covered business method patent review, the same factors apply in a post grant review. Consolidated Trial Practice Guide, at 25 (Nov. 2019).

Limulus polyphemus ... horseshoe crab species.” Pet. at 32. Yet the Opposition characterizes these same statements as “very generic and entirely unsupported.” EX1048 at 9. Thus, the evidence that CRL relies on in arguing that the claims lack written description was dismissed by the Party who filed the Opposition as being too generic to be afforded any value.

CRL also argues in its Petition that it would require undue experimentation to practice the claimed invention “because the gene and sequence information for [*Limulus polyphemus*] Factor C . . . was not yet disclosed as of the claimed priority date. Pet. at 31. This argument is central to CRL’s argument that the priority application fails to enable claims 1-9 of the ’109 Patent. *See id.* at 43 (“a significant amount of research and experimentation was required to generate a particular protein, with the ability to detect endotoxin, across a number of different expression systems”). The Opposition, however, makes fundamentally contradictory arguments.

The Opposition cites a declaration by Professor Frohman as evidence that determining the *Limulus polyphemus* Factor C sequence “requires nothing more than ‘routine analysis.’” EX1048 at 9. The Opposition states that starting from references published as early as 1999, the determination of the *Limulus polyphemus* Factor C sequence would have “require[d] **nothing more than ‘routine analysis’**” using

RACE. EX1048 at 9 (emphasis added). As Prof. Frohman explains in his declaration, RACE was published in 1988 and quickly adopted: “[I]n 1989 alone, it was cited 9 times in renowned scientific journals.” EX2004 at 2. Prof. Frohman further explains that a POSA would have followed examples disclosed in **1995** to identify the *Limulus polyphemus* Factor C sequence—well before the earliest possible priority date of the ’109 Patent. EX2004 at 2–4.

It is immaterial that the claims involved in the Opposition are different than those at issue here. The Opposition and the ’109 Patent relate to *Limulus polyphemus* Factor C. The entity filing the Opposition advanced arguments that directly contradict CRL’s arguments here that a person of ordinary skill would have “struggled to sequence and recombinantly produce” *Limulus polyphemus* Factor C protein, and that “a significant amount of research and experimentation” would be required to generate the *Limulus polyphemus* Factor C protein. Pet. at 42.

Thus, as the Board agreed, the Opposition and Frohman Declaration are inconsistent with positions Petitioner has taken in this proceeding. Paper 17, 7. If Petitioner initiated the Opposition, the veracity of its arguments in this proceeding must be viewed with skepticism, if considered at all. Accordingly, the underlying facts demonstrate that the requested discovery will be useful. *See Bloomberg*, Paper 32 at 5.

B. Factor 2 – “Litigation Positions and Underlying Basis”

Bloomberg Factor 2 weighs in PO's favor. The requested information does not seek Petitioner's litigation positions.

C. Factor 3 – “Ability to Generate Equivalent Information”

Bloomberg Factor 3 weighs in PO's favor. The requested information relates to information solely within Petitioner's knowledge and is not otherwise publicly available. PO cannot generate the information without the requested discovery.

D. Factor 4 – “Easily Understandable Instructions”

Bloomberg Factor 4 weighs in PO's favor. PO's requests are targeted and clear. PO requests only that Petitioner confirm whether it initiated the Opposition. This request is easily understandable.

E. Factor 5 – “Not Overly Burdensome to Answer”

Bloomberg Factor 5 weighs in PO's favor. This factor considers “financial burden, burden on human resources, and burden on meeting the time schedule the trial.” *Bloomberg* at 5. PO seeks a simple answer to its question of whether Petitioner initiated the Opposition—information that is readily available to Petitioner.

III. The Attorney-Client Privilege Does Not Protect The Information from Discovery

Petitioner previously asserted that “whether or not it filed the ’670 Opposition would be privileged.” Paper 10 at 2; *see* Ex. 1062 at 28:5–30:5. The law overwhelmingly says otherwise.

The Federal Rules of Evidence control whether the attorney-client privilege applies. *See* 37 C.F.R. § 42.62(a) (“Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.”); 82 Fed. Reg. 51570, 51571 (Nov. 7, 2017) (“The precise metes and bounds of what types of communications are protected by privilege are determined according to Federal law.”). Under the Federal Rules, the privilege “shall be governed by the principles of the common law as interpreted by the courts of the United States in the light of reason and experience.” Fed. R. Evid. 501, 2011 Advisory Committee Notes.

For the attorney-client privilege to apply, the communications must be (1) between a client and its attorney, (2) intended to be and in fact were, kept confidential, and (3) for the purposes of obtaining or providing legal advice. *See, e.g., Fisher v. United States*, 425 U.S. 391, 403 (1976); *United States v. Roberts*, 84 F.4th 659, 670 (6th Cir. 2023); *In re Kellogg Brown & Root, Inc.*, 756 F.3d 754, 757 (D.C. Cir. 2014); *Gomez v. Vernon*, 255 F.3d 1118, 1131 (9th Cir. 2001); *Denius v. Dunlap*, 209 F.3d 944, 952 (7th Cir. 2000); *Cox v. Adm’r U.S. Steel & Carnegie*, 17

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F.3d 1386, 1414 (11th Cir. 1994), *opinion modified on reh 'g*, 30 F.3d 1347 (11th Cir. 1994). And the burden of establishing the privilege rests with the party invoking it—here, CRL. *Siler v. Env't Prot. Agency*, 908 F.3d 1291, 1297 (Fed. Cir. 2018).

CRL has done nothing to meet its burden to show that the privilege protects whether CRL is behind the Opposition. CRL has made no attempt to satisfy the elements, provide a privilege log, or otherwise “describe the nature of the documents, communications, or tangible things not produced or disclosed... in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.” Fed. R. Civ. P. 26(b)(5).

Nor could it. Courts have repeatedly held the attorney-client privilege does not protect the identity of a client. *E.g.*, *Taylor Lohmeyer Law Firm P.L.L.C. v. United States*, 957 F.3d 505, 512 (5th Cir. 2020); *United States v. Servin*, 721 F. App'x 156, 159 (3d Cir. 2018); *Reiserer v. United States*, 479 F.3d 1160, 1165 (9th Cir. 2007); *United States v. Hunton & Williams*, 952 F. Supp. 843 (D.D.C. 1997); *Lefcourt v. United States*, 125 F.3d 79, 86 (2d Cir. 1997); *United States v. Ellis*, 90 F.3d 447, 450 (11th Cir. 1996); *In re Grand Jury Subpoena*, 55 F.3d 368, 369 (8th Cir. 1995); *United States v. Ritchie*, 15 F.3d 592, 602 (6th Cir. 1994).

Indeed, courts have held that a client's identity is a *non-privileged fact*.³ Ex. 1062 at 28:18–30:5; *see Upjohn Co. v. United States*, 449 U.S. 383, 395 (1981) (the “privilege extends only to *communications* and not to facts”); *In re Grand Jury Subpoenas*, 803 F.2d 493, 496 (9th Cir. 1986) (“Generally, the identity of an attorney's client and the nature of the fee arrangement between an attorney and his client are not privileged. The fact of representation and the associated fee arrangement are preliminary, by their own nature, establishing only the existence of the relation between client and counsel, and therefore, normally do not involve the disclosure of any communication arising from that relation after it was created.” (internal citations omitted)); *see also* 82 Fed. Reg. 51570, 51571 (Nov. 7, 2017) (“the privilege only protects information exchanged for purposes of obtaining legal opinions or services, not underlying facts or business documents”).

Nothing about the Opposition salvages CRL's position. Although a representative may file an opposition and maintain the anonymity of the party behind it (a “strawman” filing), it is not due to the attorney-client privilege; instead, it is a procedural construct of the proceeding. *See* G 3/97, Decision of the Enlarged Board

³ If, in opposing this motion, CRL contends some exception to the general rule applies, it will be the first time that Patent Owner receives notice of such a position, and Patent Owner will seek leave to file a reply.

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of Appeal at 2.1 (Jan. 21, 1999), <https://www.epo.org/boards-of-appeal/decisions/pdf/g970003ep1.pdf> (“The status of opponent is a procedural status and the basis on which it is obtained is a matter of procedural law.... [T]he opponent is the person who fulfils the requirements of the EPC for filing an opposition; in particular, the person must be identifiable.... The EPC does not specify any further formal requirements to be met by the opponent.”); T 1839/18, Decision of the Board of Appeal at 2.1 - 2.12 (Mar. 19, 2021), <https://www.epo.org/boards-of-appeal/decisions/pdf/t181839eu1.pdf> (discussing public policy rationale).

Failing to establish the attorney-client privilege, CRL has no basis for protecting the identity of the party in the Opposition. *See, e.g., In re Rivastigmine Pat. Litig.*, 239 F.R.D. 351, 359 (S.D.N.Y. 2006) (“If no privilege is provided for by the statutes of the foreign forum, no privilege can be implied.”); *Astra Aktiebolag v. Andrex Pharms. Inc.*, 208 F.R.D. 92, 100 (S.D.N.Y. 2002) (“If no privilege is provided for by the statutes of the foreign forum, no privilege can be implied.”); *VLT Corp. v. Unitrode Corp.*, 194 F.R.D. 8, 15 (D. Mass. 2000) (“[T]he parties ... apparently agree that the privilege issue is to be determined with reference to foreign law if the communication has nothing to do with the United States. If in such instances there is no privilege under foreign law, there is no privilege here.”).

CRL has failed to meet its burden to show otherwise.⁴ *E.g., Cadence Pharms., Inc. v. Fresenius Kabi USA, LLC*, 996 F. Supp. 2d 1015, 1019 (S.D. Cal. 2014) (party asserting foreign privilege has the burden of proving the law protects the communications from discovery); *In re Rivastigmine Pat. Litig.*, 237 F.R.D. 69, 76 (S.D.N.Y. 2006) (same).

For these reasons, the identity of CRL as the party behind the Opposition is not protected by the attorney-client privilege.

IV. CONCLUSION

For these reasons, PO respectfully requests its Motion be granted.

Respectfully Submitted,

Dated: November 14, 2025

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397

⁴ If, in its opposition to this Motion, CRL attempts to show foreign privilege law applies, it will be the first time that PO receives notice of such a position, and PO will seek leave to file a reply.

CERTIFICATE OF COMPLIANCE

I, the undersigned, certify that the above, Patent Owner's Motion for Additional Discovery Under 37 C.F.R. § 42.51(b)(2)(i), complies with the applicable type-volume limitations of 37 C.F.R. § 42.24(b). Exclusive of the portions exempted by 37 C.F.R. § 42.24(a), this Motion is within the 10-page limit specified by the Board.

Respectfully Submitted,

Dated: November 14, 2025

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owner hereby certifies that on November 14, 2025, a copy of this PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY UNDER 37 C.F.R. § 42.51(b)(2)(i) was served via the email correspondence address of record for Petitioner's counsel of record:

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Respectfully Submitted,

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