

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GE HEALTHCARE LTD.,
Petitioner,

v.

THE JOHNS HOPKINS UNIVERSITY,
Patent Owner.

PGR2025-00059
Patent 12,115,233

Before DEBRA L. DENNETT, DEVON ZASTROW NEWMAN, and
JAMIE T. WISZ, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

This Order memorializes a conference call we held with the parties on May 11, 2026, in which the judges of this panel, counsel for Patent Owner, The Johns Hopkins University (“Patent Owner”), and counsel for Petitioner, GE Healthcare Ltd. (“Petitioner”), participated. Petitioner requested the conference call “to address means of securing production of experimental records from Patent Owner, Johns Hopkins University (JHU)” pertaining to experimental results that formed the basis of a declaration submitted during prosecution of the patent at issue in this proceeding. *See* Exhibit 3001 (May 4, 2026, email from Petitioner’s counsel). The declaration (Exhibit 1002, 166–177) was made pursuant to 37 C.F.R. § 1.132 by inventor Martin Pomper, M.D., Ph.D., and alleges “differences in specificity between the reference compounds and the compounds of the pending claims [that were] surprising and unexpected” at the time of the application for the patent. *Id.* at 176. The patent was allowed after submission of this declaration. *See* Ex. 1002, 212–213.

Petitioner seeks the production of records because Patent Owner’s declarant, Dr. VanBrocklin, relied upon Dr. Pomper’s § 1.132 declaration in Dr. VanBrocklin’s own declaration, Ex. 2029, in support of Patent Owner’s Response. Ex. 3001. Petitioner states that “Neither Dr. Pomper nor Patent Owner’s expert reported details of the experiments [underlying Dr. Pomper’s declaration] consistent with 37 C.F.R. 42.65.” *Id.* Petitioner seeks production of the following records:

1. Documents sufficient to identify all compounds synthesized, characterized, and/or tested in connection with that work, including any compounds synthesized or tested but not reported in Dr. Pomper’s Declaration;

2. Documents describing the experimental design and protocols used;
3. Lab notebook records of experiments conducted;
4. Results from experiments performed, including raw data, instrument outputs, analyses of data, internal summaries, presentations, test reports, memoranda or other documents compiling, discussing or analyzing the experimental results.

Ex. 3001. Petitioner states that the request is urgent as its deadline for reply in this matter is July 1, 2026, and seeks either authorization to file a motion for additional discovery of the records or an order directing their production.

Patent Owner alleges that Petitioner's records request is unwarranted for multiple reasons, including Petitioner's failure to address the information available in Dr. Pomper's declaration in its Petition, unjust burden due to comingling of records in connection with other records in the research laboratory, Petitioner's failure to create and test the compounds itself, and Petitioner's failure to explain why Petitioner is entitled to such discovery in light of the factors enumerated in *Garmin Int'l v. Cuozzo Speed Techs LLC.*, Case IPR2012-00001, Paper 26 (precedential, March 5, 2013) ("*Garmin* factors"). Patent Owner indicates that Dr. Pomper is no longer employed by The Johns Hopkins University such that Patent Owner cannot offer Dr. Pomper to testify regarding the experiments and their results.

During the call, Petitioner's counsel indicated that it might be amenable to restricting the scope of documents sought to lessen Patent Owner's burden and facilitate production.

It is

ORDERED that Petitioner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) by May 18, 2026, limited to

10 pages. In filing the motion, Petitioner is advised to consider restricting the scope of documents sought as suggested during the call, or further, to facilitate expedited handling; Patent Owner is authorized to file an opposition by May 26, 2026, also limited to 10 pages; and no reply is authorized;

FURTHER ORDERED that, in its motion, Petitioner should specifically address the *Garmin* factors and apply them to each item of requested discovery;

FURTHER ORDERED that Petitioner's motion should note, for each item of requested discovery, the purpose for seeking the item and how the information sought, in the best of circumstances, would assist in the presentation of Petitioner's reply;

FURTHER ORDERED that, in its motion, Petitioner explain why with respect to objective evidence of nonobvious such as unexpected results Petitioner must ask Patent Owner for any information and is otherwise unable to otherwise ascertain or independently determine the information;

FURTHER ORDERED that Patent Owner, in its opposition to the motion, should indicate with particularity the burden the discovery request imposes on Patent Owner, including financial burden, burden on human resources, and burden to meet deadlines in this proceeding.

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