

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GE Healthcare Ltd.,
Petitioner,

v.

Johns Hopkins University,
Patent Owner.

Case No. PGR2025-00059
U.S. Patent No. 12,115,233

PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY

TABLE OF CONTENTS

I.	The Additional Discovery Exists, is Narrowly Tailored, and is Readily Accessible to Patent Owner Without Undue Burden.....	2
II.	<i>Garmin</i> Factor 1 – Useful Information	3
III.	<i>Garmin</i> Factor 2 – Not Seeking Litigation Positions	6
IV.	<i>Garmin</i> Factor 3 – No Access to Equivalent Information.....	6
V.	<i>Garmin</i> Factor 4 – Sufficiently Clear Instructions	9
VI.	<i>Garmin</i> Factor 5 – Not Overly Burdensome on Patent Owner	10
	APPENDIX	A-1

TABLE OF AUTHORITIES**Page(s)****Cases**

<i>Apple Inc. v. Singapore Asahi Chem. & Solder Indus. PTE Ltd.</i> , IPR2019-00377, Paper 22 (Oct. 21, 2019)	3, 4, 6, 7, 8, 9, 10
<i>Corning Inc. v. DSM IP Assets BV</i> , IPR2013-00043, Paper 27 (June 21, 2013).....	4, 7
<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001, Paper 26 (Mar. 5, 2013)	1, 6
<i>Mylan Pharm. Inc. et al. v. Allergan, Inc.</i> , IPR2016-01127, Paper No. 28 (May 31, 2017).....	1, 4

Regulations

37 C.F.R. § 42.51(b)(2).....	1, 2, 9
37 C.F.R. § 42.65(a).....	2, 8, 9
37 C.F.R. § 42.65(b)	2

Per 37 C.F.R. § 42.51(b)(2) and the Board’s Order (“Order”) (Paper 14), Petitioner GE Healthcare Ltd. moves for additional discovery of documents underlying certain experimental results that Patent Owner Johns Hopkins University (“JHU”) and its expert, Dr. VanBrocklin, used to contest the unpatentability grounds in this proceeding.¹ Those results were presented and discussed in paragraphs 42–43 of a §1.132 declaration that inventor Dr. Pomper submitted during examination.² But Dr. Pomper did not describe the details of the underlying experiments used to generate the results, and JHU’s counsel confirmed Dr. VanBrocklin has never seen them. Also, contrary to JHU’s counsel’s representation to the Panel, these experimental details are ***not*** publicly available.

The Board has explained that “rule § 42.65 favors the disclosure of the underlying facts or data on which an expert’s testimony is based.” *Mylan Pharm. Inc. et al. v. Allergan, Inc.*, IPR2016-01127, Paper No. 28 (May 31, 2017), at 3 (applying *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (precedential, Mar. 5, 2013)). Additional discovery serves the interests of justice when a party relies on tests or results from them to make factual assertions that support their substantive positions, but withholds the underlying materials

¹ POR at 52–54, 90–91, 95–97; EX2029, ¶¶ 117–20, 149–150, 187–89, 192.

² PGR2025-00069, EX1002, 166–177; IPR2026-00069, EX1002, 357–368.

necessary to evaluate those tests, results and positions. *See* 37 C.F.R.

§§ 42.51(b)(2); 42.65(b). That is the situation here: The records Petitioner seeks are those necessary to investigate and assess Dr. VanBrocklin's opinions and JHU's arguments that rely on Dr. Pomper's tests and the experimental evidence underlying them. *See* 37 C.F.R. § 42.65(a).

I. The Additional Discovery Exists, is Narrowly Tailored, and is Readily Accessible to Patent Owner Without Undue Burden

As the Board advised (Order, at 4), Petitioner has narrowed its requested discovery: Petitioner seeks records of the tests and test results from Dr. Pomper's lab described in paragraphs 42-43 of Dr. Pomper's Declaration ("In the process of developing FAP imaging agents, *my lab tested the specificity of a number of FAP imaging agents*, some of which have molecular structures covered by the pending claims..., and some ... not covered by the pending claims ... used as reference compounds. *The results are summarized in the Table below...*").³ Specifically, the revised document requests seek records documenting those tests and results: laboratory notebooks and other documents containing (a) protocols and procedures followed in testing the specificity of FAP imaging agents (including positive/negative controls, sources of compounds and reagents used, and compound selection criteria), and (b) the underlying data and results from such testing. *See*

³ PGR2025-00069, EX1002, 174–176; IPR2026-00069, EX1002, 365–367.

Appx. A (Petitioner's Requests).

The documents Petitioner seeks invariably exist—JHU would have needed to use those documents to prepare and submit the Pomper Declaration during examination of patent applications in December 2023 and February 2024,⁴ and to prepare PCT/US2022/023374 (EX1057), filed in April 2022 (*i.e.*, the PCT application JHU's counsel represented to the Panel contains information about the experiments referenced in the Pomper Declaration). JHU relies on these tests and results (via Dr. Pomper's and Dr. VanBrocklin's declaration testimony) to contend that certain compounds' specificity profiles demonstrate patentability of the challenged claims.⁵ JHU cannot use this evidence to advance its arguments, then claim it cannot produce it. Particularly in view of their narrowed scope, Petitioner's document requests seek a readily ascertainable, tailored set of documents that should not present undue difficulty for JHU to identify and produce.

Each of the *Garmin* factors supports granting Petitioner's motion.

II. *Garmin* Factor 1 – Useful Information

The Board has found “per se useful” the details of the experiments that generated results used by a party or its experts. *Apple Inc. v. Singapore Asahi*

⁴ PGR2025-00069, EX1002, 166–177; IPR2026-00069, EX1002, 357–368.

⁵ POR at 52, 90, 95–97; EX2029, ¶¶ 117–20, 149–150, 187–89, 192.

Chem. & Solder Indus. PTE Ltd., IPR2019-00377, Paper 22 (Oct. 21, 2019), at 5, 12 (quoting *Corning Inc. v. DSM IP Assets BV*, IPR2013-00043, Paper 27 at 4).

“The details of the procedures used to synthesize and test the [compounds] involved in this case are per se useful as [Patent Owner] has proffered the expert testimony, which relies upon those details, to demonstrate the [patentability of [Patent Owner’s]’s claims.” *Apple*, at 5, 11–12 (quoting *Corning*, at 4). Likewise, the Board has compelled discovery where an expert’s declaration lacked “critical information required to confirm” the reliability of the proffered testing. *Corning*, at 4. So too here; Dr. Pomper’s and Dr. VanBrocklin’s declarations lack critical information required to confirm that the tested compounds uniformly have the “specificity” characteristics that Dr. Van Brocklin and JHU allege they do.

Petitioner intends to use the requested documents to rebut JHU’s arguments and evidence in its Reply. *See Order*, at 4. Access to those records is necessary to prepare for and afford a fair rebuttal of Dr. VanBrocklin’s opinions and JHU’s contentions, especially in view of JHU counsel’s admission that Dr. VanBrocklin relied solely on Dr. Pomper’s Declaration statements about the data, rather than independently evaluating the experimental evidence. *Mylan*, at 3. For example, JHU and Dr. Van Brocklin contend that all claimed B-L-A compounds exhibit “dramatic, orders-of-magnitude” better selectivity than what is observed for the A molecules in those compounds, despite no constraints on the B and L components

(other than aggregate molecular weight).⁶ Those allegations rest on “PREP/FAP ratio” values in Dr. Pomper’s Declaration, which are calculated using experimentally measured values of FAP and PREP inhibition. But Dr. Pomper did not describe how those values were experimentally determined or describe any experimental metrics that inform their accuracy (*e.g.*, controls, variability of measurements, replicates, reagents, compound selection criteria, etc.). Access to the protocols, procedures, data, and results underlying the experiments will enable Petitioner to address these questions.

During the May 11 conference, JHU’s counsel represented to the Panel that the information missing from Dr. Pomper’s declaration can be found in PCT/US2022/023374 (EX1057).⁷ Not so. EX1057 omits PREP and FAP values required to calculate the PREP/FAP ratio for 29 of 48 molecules in Table 3, including two of the molecules in Dr. Pomper’s Declaration.⁸ And while the application identifies the *types* of assays used, it does not describe *how* those assays were performed, provide data from control assays, or reveal variability in the data.⁹

⁶ EX2029, ¶¶ 118–19; POR at 52.

⁷ JHU’s counsel did not identify this PCT until the call with the Panel. EX1058.

⁸ EX1057, 135–141 (compounds 29 and 33).

⁹ EX1057, 110:16–27.

Discovery of experimental results generated when Dr. Pomper “tested the specificity of a number of FAP imaging agents” (EX1002, ¶¶ 42–43) will permit Petitioner to evaluate the completeness and accuracy of Dr. Pomper’s and Dr. VanBrocklin’s testimony regarding the purported specificity of the compounds being claimed (Petitioner’s Request 2). Likewise, discovery into the protocols and procedures used to generate those compounds (Petitioner’s Request 1), as well as the data produced (Petitioner’s Request 2), will enable Petitioner to test the reliability and accuracy of Dr. Pomper’s representations, upon which Dr. VanBrocklin’s opinions rest.

III. *Garmin* Factor 2 – Not Seeking Litigation Positions

Petitioner is not seeking to uncover JHU’s litigation positions. Each request seeks only factual evidence generated by JHU concerning the experimental results that JHU and Dr. VanBrocklin have put at issue in this proceeding, and that were used to secure issuance of the challenged patent. The requested discovery is warranted, given that it underpins positions already advanced in the proceeding. *See Apple*, at 7 (citing *Garmin*, Paper 26 at 13).

IV. *Garmin* Factor 3 – No Access to Equivalent Information

Contrary to JHU counsel’s representation to the Panel, the information Petitioner seeks discovery of cannot be obtained elsewhere. As explained in § II, the PCT application JHU’s counsel pointed to does not provide the requested details

of protocols, procedures, data, or results actually used. Nor do other sources available to Petitioner, as these records are non-public and in JHU's possession.

Petitioner's ability to independently test the compounds in Dr. Pomper's Declaration is not a viable substitute. As the Board observed for similar reasons in *Apple*, "Petitioner seeks information to help it understand Patent Owner's data and to help Petitioner develop its response to that data. Different data, obtained by a different party in a different facility using different [compound] samples under different conditions, may be of limited use in helping Petitioner to understand and respond to Patent Owner's particular data." *Apple*, at 13. Here, Petitioner lacks the "critical information," *Corning*, at 4, needed to recreate the work Dr. Pomper's lab did. Petitioner is in the dark about the full complement of compounds tested and how the assays used to assess them were designed and conducted (Petitioner's Request 1). Independent testing by Petitioner cannot replicate the Pomper lab's own records and experimental results (Petitioner's Request 2) due to errors or inaccuracies that independently disqualify them. Those records and results are not in Dr. Pomper's Declaration, Dr. VanBrocklin's Declaration, the contested patent's disclosure, the PCT application JHU's counsel referenced, or anywhere else available to Petitioner. Without discovery, Petitioner cannot recreate the experimentation Dr. Pomper's lab undertook, assess its quality, or determine if it adhered to the teachings or steps of any particular disclosure or protocol.

Cross-examination is also not a suitable substitute for the requested documentary evidence. First, JHU confirmed that it cannot offer Dr. Pomper for a deposition to address these issues. Order, at 3. Deposing Dr. VanBrocklin cannot provide information about the details of the experiments because ***he has not reviewed any experimental records from*** Dr. Pomper's lab (despite relying on Dr. Pomper's Declaration); any testimony he might offer on the quality of Dr. Pomper's experimental procedures and results is unreliable.¹⁰ Second, Petitioner needs this discovery to ***prepare*** for examining Dr. VanBrocklin. *Apple*, at 7–8, 13. To do so, Petitioner needs the requested discovery to examine the actual protocols, procedures, data, and results directly.

The fact that JHU presented Dr. Pomper's declaration during examination to support non-obviousness via secondary considerations does not undercut Petitioner's requests. *See* Order, at 4. First, that declaration is facially deficient under 37 C.F.R. § 42.65(a), which governs how the Board evaluates experimental evidence. Simply changing the timing of submission of the declaration does not remedy its omission of the underlying experimental records to which only JHU has

¹⁰ *See, e.g.*, EX2029, ¶ 150.

access.¹¹ Second, discovery into the requested experimental records will enable Petitioner to contest the reliability of the proffered results and to uncover bias in selection or presentation. And JHU's and Dr. VanBrocklin's *present* reliance on the experimental results in Dr. Pomper's Declaration places the reliability of those results at issue now, warranting additional discovery. 37 C.F.R. § 42.51(b)(2).

V. *Garmin* Factor 4 – Sufficiently Clear Instructions

The scope of documents Petitioner seeks, and the instructions to produce them, are sufficiently clear. Indeed, Petitioner's requests employ the terms Dr. Pomper used to describe the experimental work that is the object of Petitioner's discovery. *See Apple*, at 8. For example, Petitioner's first request seeks laboratory notebooks and other documents that contain information on the design and conduct of the experiments when Dr. Pomper's "lab tested the specificity of a number of FAP imaging agents" (EX1002, 174). Petitioner's second request seeks the underlying data and results Dr. Pomper's lab obtained from those experiments. And to avoid any potential for confusion, Petitioner's document requests illustrate the expected types of information in the records to be produced.

¹¹ Dr. VanBrocklin's failure to investigate and explain Dr. Pomper's experimental procedures means his testimony is entitled to little or no weight. 37 C.F.R. § 42.65(a).

Beyond an abstract complaint about fishing, JHU has never sought to clarify the scope of documents Petitioner seeks. Petitioner's requests are now even more precisely tailored. And Petitioner is not fishing for anything—it is asking for the documentation of specific experimental work and results of that work that JHU used to secure issuance of multiple patents in the last three years; such documents certainly exist and can be located based on the descriptions in Petitioner's requests.

VI. *Garmin* Factor 5 – Not Overly Burdensome on Patent Owner

JHU is the party who possesses the evidence and who relied on it, both to secure the contested patent and to defend it here. Petitioner is not asking JHU to create any reports or compilations of data that do not already exist. *Apple*, at 15. It simply seeks records that must have been created and evaluated to substantiate the sworn testimony in Dr. Pomper's Declaration that JHU relied on.

At the May 11 conference, JHU's counsel expressed concerns about “co-mingling of records in connection with other records in the research laboratory,” which JHU claims creates difficulty in identifying responsive documents. Order, at 3. JHU has not shown this is more than a theoretical concern. Regardless, logistical obstacles in locating and producing the records JHU used to support its own inventor's sworn declaration is not a burden Petitioner created and not a basis to excuse this production.

Dated: May 18, 2026

Respectfully Submitted,

/Jeffrey P. Kushan/
Jeffrey P. Kushan
Reg. No. 43,401
Sidley Austin LLP
1501 K Street, N.W.
Washington, D.C. 20005
jkushan@sidley.com
(202) 736-8914
Attorney for Petitioner

APPENDIX

As used in these document requests, the phrase “Pomper Experiments” refers to experiments performed by Dr. Martin Pomper, or individuals working with him or under his direction, in connection with the statement that “[his] lab tested the specificity of a number of FAP imaging agents,” in ¶ 42 of the Declaration under 37 C.F.R. § 1.132 submitted by Dr. Pomper during examination of each of U.S. Patent Nos. 11,938,201 and 12,115,233. *See* PGR2025-00059, EX1002, 174–76; IPR2026-00069, EX1002, 365–67.

1. Laboratory notebooks and other documents describing the protocols and procedures (including controls, sources of compounds and reagents, and compound selection criteria) used in the Pomper Experiments.
2. Laboratory notebooks and other documents describing the underlying data and results of the Pomper Experiments (including raw data from testing compounds and from control assays, as well as compilations and analyses of such data).

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 18th day of May, 2026, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by e-mail on the following counsel of record for Patent

Owner:

Eldora L. Ellison, ellison-PTAB@sternekessler.com
Olga A. Partington, opartington-PTAB@sternekessler.com
Christopher M. Gallo, cgallo-PTAB@sternekessler.com
Christina E. Dashe, cdashe-PTAB@sternekessler.com
PTAB@sternekessler.com

Dated: May 18, 2026

Respectfully Submitted,

/Jeffrey P. Kushan/

Jeffrey P. Kushan
Reg. No. 43,401
Sidley Austin LLP
1501 K Street, N.W.
Washington, D.C. 20005
jkushan@sidley.com
(202) 736-8914
Attorney for Petitioner