

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 B2

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

NEWMAN, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

As authorized by our Order of May 13, 2026 (Paper 14), Petitioner GE Healthcare Ltd. (“GE”), filed a Motion for Additional Discovery (Paper 15) (“Mot.”), seeking the production of documents pertaining to testing of FAP imaging agents performed by Patent Owner, The Johns Hopkins University (“JHU”). JHU filed an opposition (Paper 17) (“Opp.”). For the reasons stated below, GE’s motion is granted.

II. ANALYSIS

Petitioner describes the documents it seeks (the “Materials”) in the following two passages in the Motion:

1. Petitioner seeks records of the tests and test results from Dr. Pomper’s lab described in paragraphs 42-43 of Dr. Pomper’s Declaration . . . [specified as] 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.
2. 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).

Mot. 2, Appendix A-1.

We may order additional discovery if the moving party shows “that such additional discovery is in the interests of justice.” 37 C.F.R.

§ 42.51(b)(2)(i). The Board has identified several factors (“the *Garmin* factors”) that are important in determining whether additional discovery is in the interests of justice. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26)

(informative). Those factors include: 1) whether there is more than a mere possibility or allegation that something useful will be found; 2) whether the requesting party seeks the other party’s litigation positions and the underlying basis for those positions; 3) the requesting party’s ability to generate equivalent information by other means; 4) whether the instructions are easily understandable; and 5) whether the requested discovery is overly burdensome. *Id.* We analyze the parties’ showing on these factors below.

A. *Garmin* Factors

1. First Factor

GE argues that the Materials are needed because JHU’s expert, Dr. VanBrocklin, relied upon Dr. Pomper’s Declaration under 37 C.F.R. § 1.132 (“Pomper Declaration”) in Dr. VanBrocklin’s own declaration, Ex. 2029, in support of Patent Owner’s Response, to support a patentability defense of nonobviousness. Ex. 3001. GE argues that the Materials, which

were used to form the basis of Dr. Pomper's Declaration and upon which Dr. VanBrocklin relies, were never provided as required by 37 C.F.R.

§ 42.65, and have not been reviewed by Dr. VanBrocklin. Ex. 3001; Mot. 1. GE asserts that the Materials are "per se useful" because GE needs these documents 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" and to rebut JHU's arguments and evidence in its Reply. Mot. 2, 4. Specifically, GE alleges that it needs the Materials to understand how the measured "values were experimentally determined or describe any experimental metrics that inform their accuracy." *Id.* at 5.

JHU responds that GE's response does not comply with our Order to demonstrate the usefulness of the Materials, and that Dr. VanBrocklin's nonreliance on the Materials negates their usefulness. Opp. 3. JHU alleges GE's request is a "fishing expedition" without a specific aim, and that the failure to identify the specific need for each requested item fails to show why the Materials are needed.

We are persuaded by GE's assertions that the Materials are useful as the Office allowed the patent at issue based on the results generated from the Materials and Dr. VanBrocklin has relied upon them in his defense of the patent. *See* Ex. 1002, 212–213; Mot. 1. GE's arguments are directed to whether JHU ultimately will prevail in demonstrating the presence of objective indicia of nonobviousness. We are not persuaded that Dr. VanBrocklin's failure to review the documents before making his declaration negates their usefulness in assessing the experiments that formed the basis for allowance of the patent. On this record, we find that the first *Garmin* factor weighs in favor of granting Petitioner's Motion.

2. Second Factor

GE argues that it is not seeking discovery of JHU's litigation positions (Mot. 6), and JHU does not address this factor (*see generally* Opp.). On this record, we find that the second *Garmin* factor weighs in favor of granting Petitioner's Motion.

3. Third Factor

The third *Garmin* factor addresses whether the requesting party can generate the requested information without the need for discovery. *Garmin*, IPR2012-00001, Paper 26 at 6. GE asserts that it does not have access to equivalent information because JHU did not provide details of the “protocols, procedures, data, or results actually used” and the records are non-public and held by JHU. Mot. 6–7. GE further contends that its ability to recreate the experiments to attempt to replicate the results achieved by Dr. Pomper is impossible without information regarding how the experiments were performed, which was not explained in Dr. Pomper's Declaration and cannot be obtained from Dr. Pomper as JHU cannot offer him for deposition. *Id.* at 7–8. GE argues that Dr. VanBrocklin cannot provide this information, having not reviewed the Materials, and that the Materials are needed to test Dr. VanBrocklin's testimony. *Id.* at 8. GE further argues that JHU's representation that information regarding the Materials could be found in PCT/US2022/023374 (Ex. 1057) is inaccurate because “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.” Mot. 5.

JHU alleges that GE could have “synthesized and tested compounds within the challenged claims to assess FAP-selectivity and generate

equivalent information” and that GE relied on a reference that provided such protocols. Opp. 7. JHU also alleges that PCT/US2022/023374 (Ex. 1057) includes a “‘Competitive inhibition assays’ section describing the methods and materials used to assess FAP-selectivity and identifying FAPI-04 as the ‘positive control’”, which JHU alleges is equivalent information. Opp. 4–8 (citing Ex. 1057, 110:16–27).

We are persuaded by GE’s assertions that it does not have access to equivalent information. The description of the assays provided in the PCT provides some information (e.g., identification of substrates) but not all information that GE needs to analyze Dr. Pomper’s experiments (e.g., raw data from testing compounds and from control assays, as well as compilations and analyses of such data). JHU has not identified where in the PCT the data reported in the Pomper Declaration is provided, or how GE may access that data. Accordingly, the third *Garmin* factor weighs in favor of granting GE’s Motion.

4. Fourth Factor

GE argues that it has specifically identified the requested Materials, including illustrating the expected types of information in the records to be produced. Mot. 4.

JHU disagrees, finds the terms of the revised request broad and vague, and argues that the material is not useful because GE “has not shown that synthesis [of the compounds] would affect ultimate activity.” Opp. 8.

We are persuaded by GE’s assertions that it has meaningfully narrowed its discovery requests to seek the limited information necessary to depose Dr. VanBrocklin and compose its reply. Mot. 2. Furthermore, now that JHU has identified the relevance of PCT/US2022/023374 (Ex. 1057) to

the Materials¹, we believe that the parties can work together to accurately identify the Materials related to the experiments at issue. On this record, we determine that the fourth *Garmin* factor favors production of the Materials.

5. Fifth Factor

GE argues that production of the Materials is not unduly burdensome, and that it is not asking JHU to create reports or compilations of data to satisfy the request. Mot. 10. GE disputes that JHU's record-keeping methods should be used as a basis to prevent production of the Materials. *Id.*

JHU disagrees, characterizes the request as broad and alleges that substantial burden and unilateral cost would be required to produce the Materials, which are "several years old" and are requested at a high level of granularity. Opp. 8–10. JHU argues that this type of discovery is contrary to the purpose of the AIA and would alter the case schedule. JHU asserts that GE delayed seeking discovery and did not address the unexpected results in its Petition. *Id.* at 2.

We acknowledge that factor five shows a burden falling on JHU alone and weighs somewhat against production of the Materials; however, Dr. VanBrocklin's reliance on the Pomper Declaration in support of his testimony without JHU having provided information pursuant to 37 C.F.R.

¹ See Mot. n.7, alleging that JHU had not identified the relevance of PCT/US2022/023374 (Ex. 1057) to the Materials before this dispute was raised with the Board.

§ 42.65(b) to permit analysis of the data from which the results were reported in the Pomper Declaration, counsels otherwise. We are not persuaded that GE was required to address the unexpected results demonstrated in Dr. Pomper's Declaration for the reasons given in factor 4: the materials necessary to do so are solely within JHU's control. The issue of Dr. VanBrocklin's reliance on that data without further details being provided was the genesis of this dispute, and we find that GE timely raised this issue after attempts to confer failed. Ex. 3001.²

B. Additional Considerations

An additional consideration in these cases, which does not fit neatly into any of the *Garmin* factors discussed above, is the close relationship of this case to IPR2026-00069, which the parties seek to consolidate with this proceeding. Ex. 3002. In view of the close relationship of these proceedings, the quality and efficiency of the Board's decision making will be best served if the evidentiary record regarding secondary considerations is complete in the consolidated case. This consideration favors granting the Motion.

III. CONCLUSION

² The parties have requested consolidation of this case with related case IPR2026-00069, and have filed a Notice of Joint Stipulation to Modify Due Dates. Paper 18. The Board appreciates counsels' efforts to collaborate on a revised schedule, and will soon issue an order consolidating the cases and setting a new Scheduling Order for the consolidated cases.

For the reasons given above, we find that, on balance, the *Garmin* factors favor granting the Motion.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that GE's Motion for Additional Discovery in the above-captioned action is granted;

FURTHER ORDERED that Patent Owner shall provide copies of the requested documents that may be used in these proceedings to Petitioner no later than July 8, 2026.

PGR2025-00059
Patent 12,115,233 B2

PETITIONER:

Jeffrey Kushan
Lauren Katzeff
SIDLEY AUSTIN LLP
jkushan@sidley.com
lkatzeff@sidley.com

PATENT OWNER:

Eldora Ellison
Olga Partington
Christopher Gallo
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
cellison-ptab@sternekessler.com
opartington-ptab@sternekessler.com
cgallo-ptab@sternekessler.com