

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INCYTE CORPORATION,
Petitioner,

v.

CONCERT PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2017-01256
Patent 9,249,149 B2

Before ERICA A. FRANKLIN, TINA E. HULSE, and
RICHARD J. SMITH, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*

ORDER
Granting-in-Part Petitioner's Motion for Additional Discovery
37 C.F.R. §§ 42.1(b)(2)

I. INTRODUCTION

Petitioner filed a motion for additional discovery relating to Exhibit 1006, which we have referred to as “the Concert Backgrounder.” Paper 31 (“Mot.”). Petitioner’s proposed discovery requests are set forth in Appendix A to the Motion. Specifically, Petitioner proposes to serve eight requests for admission (“RFA”), one request for production (“RFP”), and four interrogatories (“ROG”). Mot., App’x A. Patent Owner filed an opposition to the motion. Paper 33 (“Opp’n”). We invited Petitioner to file a short reply to address certain concessions allegedly made by Patent Owner in its opposition. Paper 42 (“Reply”).

Having considered the parties’ respective arguments, we grant-in-part Petitioner’s motion with respect to certain discovery requests, as explained further below.

II. ANALYSIS

Discovery in an *inter partes* review proceeding is significantly narrower in scope than that available in district court litigation. Here, a party seeking discovery beyond what is considered routine discovery must establish that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2) (“The moving party must show that such additional discovery is in the interest of justice.”). Thus, to secure the just, speedy, and inexpensive resolution of our proceedings, we generally take a conservative approach to granting additional discovery. 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl).

The Board has identified five factors (the “*Garmin* factors”) to be considered in determining whether additional discovery is in the interest of justice:

1. More than a possibility and mere allegation that something useful will be found
2. Litigation positions and underlying basis
3. Ability to generate equivalent information by other means
4. Easily understandable instructions
5. Requests not overly burdensome to answer

See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential).

We evaluate Petitioner’s motion with these principles in mind.

B. Whether Certain Discovery Requests Are Moot

As an initial matter, Patent Owner states that it is “willing to stipulate to the authenticity of the substance of Exhibit 1006 as a Concert-drafted document, thereby mooting RFAs 1–4 and 8, Interrogatory 4, and part of RFP 1 (‘preparation’ of the document).” Opp’n 4.

In its Reply, Petitioner argues that if Patent Owner is stipulating that the content of Exhibit 1006 is “an authentic, non-hearsay Concert document, withdrawing these objections . . . , and agreeing not to file a motion to exclude on these grounds, [Petitioner] agrees that [RFA] 1, 2, and 4 . . . would be moot.” Reply 1. Petitioner continues, however, stating that if Patent Owner’s stipulation “is anything short of the above or still disputes that in 2007 it claimed a copyright to Ex. 1006, this discovery is *not* moot.” *Id.* Moreover, Petitioner does not agree that any other discovery request is moot in light of Patent Owner’s concession. According to Petitioner, Patent Owner’s “stipulation does not moot RFAs 3 and 8, [RFP] 1, or [ROG] 4,

which seek information regarding the date, preparation, and/or dissemination of Ex. 1006.” *Id.*

We understand that by stipulating to the authenticity of the substance of Exhibit 1006 and “thereby moot[ing] RFAs 1–4 and 8,” Patent Owner effectively admits to those RFAs. We, therefore, grant Petitioner’s motion as to RFAs 1–4 and 8.

As for ROG 4 and the portion of RFP 1 regarding the preparation of the document, we agree with Petitioner that it is unclear how stipulating to the authenticity of the substance of Exhibit 1006 necessarily moots those requests. We will, therefore, consider ROG 4 and RFP 1 together with the remaining discovery requests as we address the *Garmin* factors below.

C. More than a Possibility and Mere Allegation that Something Useful Will Be Found

Petitioner argues that because the Concert Backgrounder is Patent Owner’s document, there is more than a possibility that Patent Owner has useful information regarding this document. Mot. 4. Moreover, according to Petitioner, Patent Owner admits that the Concert Backgrounder was “designed to find business partners for Concert’s proprietary product platform.” *Id.* at 5 (citing Paper 8, 33). Petitioner also asserts that because the archived version of the Concert Backgrounder indicates that the Concert Backgrounder was cached from the “concertpharma.com” website on January 27, 2009, it is not speculation that Patent Owner made the document publicly available as of at least that date. *Id.*

Patent Owner does not dispute that the content of the Concert Backgrounder was drafted by Concert. Opp’n 4. Patent Owner does, however, dispute that discovery about the availability of the Concert Backgrounder on Concert’s website (i.e., RFA 5–7, ROG 1, ROG 2) would

be useful. Opp'n 5. Specifically, Patent Owner asserts that Petitioner's only theory of public availability set forth in the Petition was with respect to Exhibit 1006's "alleged presence 'via the cached WebCite® page.'" *Id.* at 6. As such, Patent Owner contends that granting discovery on the availability of Exhibit 1006 on Concert's website would be allowing Petitioner to change its strategy of public availability, which is not in the interest of justice. *Id.* (citing *Hughes Network Sys., LLC v. Calif. Inst. Tech.*, IPR2015-00059, slip op. at 7, 9 (PTAB Dec. 30, 2015) (Paper 34)).

Having considered the parties' respective arguments, we agree with Patent Owner, in part. Petitioner's theory of the public availability as set forth in the Petition was that the Concert Backgrounder was available on the cached WebCite® page. Paper 1 (Petition), 27–28. In particular, the Petition stated, "The Concert Backgrounder (Ex. 1006) was publically accessible by at least January 27, 2009, as shown in the cached WebCite® page (Ex. 1016; also available at <http://www.webcitation.org/5e81SGCnl>)."
Id. The Petition continued, stating, "The cached WebCite® page was readily accessible to the public as indicated by the WebCite® description of its services (Ex. 1017)." *Id.* Petitioner also argued that the "public accessibility of the Concert Backgrounder *via the cached WebCite® page* is further evidenced by" various documents, such as a law review article and an International Search Report that both cite the same WebCite page. *Id.* at 28 (emphasis added).

Thus, the Petition relies on the cached WebCite page to establish the public availability of the Concert Backgrounder. To allow Petitioner to now investigate other theories as to when, where, and how the Concert Backgrounder allegedly became publicly available would allow Petitioner to

shift the basis of its argument to something not presented in the Petition. We decline to allow Petitioner to do so, as we agree with our colleagues in *Hughes Network* that “[p]ermitting a change in strategy for [Petitioner] is not in ‘the interest of justice.’” *Hughes Network*, slip op. at 9 (denying motion for additional discovery where Petitioner shifted strategy of public availability of a paper from availability in a library to seek discovery from authors of the paper). Petitioner argues that its motion is not an attempt to change its argument, as it has asserted that Ex. 1006 was a Concert document from the beginning. Mot. 8–9. But whether the document is a Concert document is not the issue, particularly now that Patent Owner has admitted that fact. The issue is whether the document was publicly available, which Petitioner has attempted to establish through the cached WebCite page. Any requests outside that theory of public availability would be beyond the scope of a proper reply and, therefore, not useful to this proceeding.

Where we disagree with Patent Owner is with respect to which proposed requests are beyond the scope of Petitioner’s public availability theory. We agree that RFA 5, RFA 7, ROG 1, and ROG 2, which either broadly seek information as to “the domain concertpharma.com” or to a different “concertpharma” webpage are beyond the scope. The specific concertpharma.com webpage archived in the cached WebCite page that Petitioner relies on is <http://www.concertpharma.com/about/documents/CoNCERTProductPlatformBackgrounder16Dec08.pdf>. *See* Ex. 1016. Thus, we determine that there is more than a possibility that RFA 6, which seeks an admission that Exhibit 1006 is a true and correct copy of the

document available at that webpage as of January 27, 2009, is likely to uncover useful information.

We also determine that ROG 3, which seeks Patent Owner's knowledge regarding the availability of Exhibit 1006 from the WebCite page, <http://www.webcitation.org/5e81SGCnl>, on any date before November 7, 2011, is likely to uncover information that is favorable in substantive value to Petitioner's public availability theory. *Garmin*, slip op. at 7 (stating "'useful' means favorable in substantive value to a contention of the party moving for discovery"). Although Patent Owner is correct that the mere fact that a document was available online does not establish that it was a printed publication, Petitioner does not rely on that fact alone to assert Ex. 1006 was publicly available. In making our determination, we must look to the evidence as a whole. Thus, Patent Owner's knowledge as to the public availability of Ex. 1006 via the cached WebCite page is evidence that will likely be useful.

As for ROG 4 and the preparation portion of RFP 1, we determine that those requests are not directed to useful information beyond that which has already been admitted by Patent Owner. That is, ROG 4 seeks information regarding the authors of Exhibit 1006, including their names and job titles. RFP 1 seeks documents regarding the preparation of Exhibit 1006 before January 27, 2009. Petitioner has not established why such information would be useful to its theory of public availability of Exhibit 1006 via the cached WebCite page given Patent Owner's admissions that it prepared the substance of Exhibit 1006. Accordingly, this factor weighs against ROG 4 and RFP 1.

D. Litigation Positions and Underlying Basis

According to Petitioner, there is no pending court litigation between the parties. Mot. 7. We, therefore, consider this factor to be neutral.

E. Ability to Generate Equivalent Information by Other Means

Petitioner contends that it has attempted to authenticate and obtain the requested information through various ways, but that Patent Owner has still maintained its objections. Mot. 7–8. As such, Petitioner argues that Patent Owner is in the best position to authenticate and provide information regarding its own document. *Id.* at 8. Patent Owner argues, with respect to RFP 1, that Petitioner has not explained why Petitioner cannot “rely on its own analysis” of how Exhibit 1006 was allegedly publicly available.

To the extent the discovery requests specifically relate to Petitioner’s cached WebCite theory of public availability, we agree that this factor favors Petitioner’s discovery requests from Patent Owner regarding its own document. Otherwise, we agree with Patent Owner that RFP 1 and its broad request for documents relating to the “public availability of Exhibit 1006” improperly seeks Patent Owner’s views on what “public availability” means.

F. Easily Understandable Instructions and Requests Not Overly Burdensome to Answer

Petitioner asserts that the discovery requests are easily understandable and straight forward. Mot. 9. Petitioner also argues that its requests are narrowly tailored and not overly burdensome, as it only proposes a limited number of discovery requests. Mot. 9–10.

Patent Owner disagrees. With respect to RFP 1, Patent Owner contends that it is neither easily understandable nor reasonably tailored. Opp’n 9. According to Patent Owner, RFP 1 has no limitation on timing and no explanation as to whether Patent Owner must provide documents

regarding any theory of public availability. *Id.* Patent Owner also asserts that discovery requests regarding the accessibility of Exhibit 1006 on Concert’s website (i.e., RFAs 5–7; ROGs 1–2; and part of RFP 1) are unduly burdensome because it “would require Concert to search from 2009 back to the company’s founding.” Opp’n 8. Moreover, it would require Patent Owner to “delve into data related to its historical, noncurrent website, potentially implicating the type of data that is often off-limits as ‘not reasonably accessible’ even in district court litigation.” *Id.* at 8–9.

We agree with Patent Owner that RFP 1 is overly broad and unduly burdensome because it does not specify what theory of public availability it seeks documents for. Moreover, because RFAs 5 and 7 and ROGs 1–2 seek information beyond the scope of Petitioner’s theory of public availability via the cached WebCite page, we determine those discovery requests are overly burdensome to answer, as well.

On the other hand, we find RFA 6 to be a reasonable request, particularly in light of Patent Owner’s submission of the cached WebCite page before the earliest effective filing date of the ’149 patent in an Information Disclosure Statement (“IDS”) in another patent application. *See* Mot. 8 (citing Ex. 1047, Ex. 1050).¹

A closer call is ROG 3, which asks Patent Owner to “describe in detail” its “knowledge regarding the availability of Exhibit 1006 from

¹ Exhibits 1047 and 1050 have not yet been filed in this proceeding, but are referenced in Petitioner’s motion. Mot. 8. According to Petitioner, the exhibits were previously served on Patent Owner as supplemental evidence in response to evidentiary objections. Per the parties’ agreement, the Board authorized Petitioner to submit the exhibits by email for purposes of considering Petitioner’s motion only.

<http://www.webcitation.org/5e81SGCnl>.” It is unclear what type of “knowledge” Patent Owner is expected to “describe in detail.” To the extent Petitioner seeks an admission from Patent Owner that Exhibit 1006 was available at <http://www.webcitation.org/5e81SGCnl> on or before November 7, 2011 (i.e., the date of the IDS submission in Ex. 1050), we will permit the discovery request. Otherwise, we find the request vague and overly broad.

III. CONCLUSION

Having considered the parties’ respective arguments and evidence in view of the *Garmin* factors, including Patent Owner’s concessions with respect to RFAs 1–4, we conclude that it is in the interest of justice to grant Petitioner’s motion for additional discovery as to RFAs 1–4 and 6 and ROG 3 (as limited above to seeking an admission regarding whether Exhibit 1006 was available at <http://www.webcitation.org/5e81SGCnl> on or before November 7, 2011). Otherwise, we deny Petitioner’s motion as to the remaining discovery requests.

ORDER

In light of the foregoing, it is

ORDERED that Petitioner’s motion for additional discovery is *granted-in-part and denied-in-part*;

FURTHER ORDERED that Petitioner shall serve its discovery requests consistent with this Decision no later than three business days after entry of this Decision; and

FURTHER ORDERED that Patent Owner shall respond to Petitioner’s discovery requests no later than 10 business days after service of the discovery requests, or at a time that is mutually agreeable to the parties.

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