

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASSOCIATED BRITISH FOODS PLC, AB VISTA, INC.,  
PGP INTERNATIONAL, INC., ABITEC CORPORATION,  
AB ENZYMES, INC., and AB ENZYMES GMBH,  
Petitioners,

v.

CORNELL RESEARCH FOUNDATION, INC.,  
Patent Owner.

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Case IPR2019-00577 (Patent 8,993,300 B2)  
Case IPR2019-00578 (Patent 8,455,232 B2)  
Case IPR2019-00579 (Patent 7,829,318 B2)  
Case IPR2019-00580 (Patent 7,321,063 B2)  
Case IPR2019-00581 (Patent 7,026,150 B2)  
Case IPR2019-00582 (Patent 6,451,572 B1)<sup>1</sup>

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Before SUSAN L. C. MITCHELL, ROBERT A. POLLOCK,  
TIMOTHY G. MAJORS, and CYNTHIA M. HARDMAN,  
*Administrative Patent Judges.*<sup>2</sup>

PER CURIAM.

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<sup>1</sup> This Order addresses issues in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

<sup>2</sup> This is not a decision by an expanded panel of the Board. Judges Mitchell, Pollock, and Majors are paneled in IPR2019-00577, IPR2019-00578, IPR2019-00579, and IPR2019-00580. Judges Mitchell, Pollock, and Hardman are paneled in IPR2019-00581 and IPR2019-00582.

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## ORDER

### Granting Patent Owner’s Motion for Additional Discovery *37 C.F.R. § 42.51(b)(2)*

Pursuant to our authorization (Paper 37), Patent Owner Cornell Research Foundation, Inc. filed a motion for additional discovery (Paper 38, “Mot.”), and Petitioners filed an opposition (Paper 43, “Opp.”).<sup>3</sup>

Patent Owner seeks additional discovery pertaining to purported objective evidence of non-obviousness. Specifically, Patent Owner requests:

1. Production of a copy of the Huvepharma final infringement contentions served in the District Court Litigation,<sup>4</sup> along with the documents expressly cited therein; and to the extent not cited in Huvepharma’s final infringement contentions, Exhibits A to G in Huvepharma’s brief in support of its August 2, 2019 motion for leave to file a first amended complaint; and
2. Documents sufficient to show, for each Subject Product,<sup>5</sup> annual worldwide sales from the date of first sale of each product to the present. Patent Owner notes that it “would accept Petitioners’ prior interrogatory answer on sales, along with additional sales data in a sales summary chart to address any sales for any Subject Products not addressed in that interrogatory response.”

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<sup>3</sup> We cite to the documents filed in IPR2019-00577 only. Similar papers are part of the record in the other five proceedings.

<sup>4</sup> “District Court Litigation” refers to *Huvepharma et al. v. Associated British Foods, plc et al.*, C.A. No. 18-129 (D. Del. 2018). Mot. 1. Huvepharma is Patent Owner’s licensee. *Id.*

<sup>5</sup> “Subject Products” refers to phytase products sold under Petitioners’ Quantum<sup>®</sup> and Quantum<sup>®</sup> Blue product lines. *See* Mot. App. A at 2–3.

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Mot. 2. Patent Owner asserts that the “requested discovery is needed to establish certain objective evidence of non-obviousness, particularly the commercial success of Petitioners’ Subject Products and potentially copying.” Mot. 1.

### ANALYSIS

“The test for a party seeking additional discovery in an *inter partes* review is a strict one.” *Symantec Corp. v. Finjan, Inc.*, IPR2015-01545, Paper 9 at 4 (PTAB Dec. 11, 2015). “The moving party must show that such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i)(2018). Among the factors important to this analysis is whether the requesting party can show more than “[t]he mere possibility of finding something useful, and mere allegation that something useful will be found.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential). “The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice.” *Id.* The requesting party should already possess “evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.* We also consider whether the requested discovery seeks the other party’s litigation positions or the basis for those positions; seeks information that reasonably can be generated without the discovery requests; is easily understandable; and whether the requests are overly burdensome to answer. *Id.* at 6–7.

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As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c)(2018) and 42.51(b)(2)(i)(2018). To meet its burden, Patent Owner must explain with specificity the discovery requested and why the items corresponding to each request are in the interests of justice.

Having considered the parties' respective arguments, we grant Patent Owner's motion. We review each of the *Garmin* factors in turn below that inform our decision.

*Factor 1 – There must be more than a possibility and mere allegation that something useful will be discovered.*

Pursuant to factor 1, we consider whether Patent Owner is already in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered via the requested discovery. *Garmin*, IPR2012-00001, Paper 26, at 7. "Useful" in this context does not mean merely "relevant" and/or "admissible." *Id.* Rather, it means favorable in substantive value to a contention of the party moving for discovery. *Id.*

We begin with Patent Owner's argument that the requested discovery will show "the commercial success of Petitioners' Subject Products."

Mot. 1. To demonstrate nonobviousness based on commercial success, a patent owner must provide evidence of both commercial success and a nexus between that success and the merits of the claimed invention. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006).

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As to commercial success, Patent Owner asserts that based on various public documents that mention, *inter alia*, strong sales growth and increasing market penetration for Petitioners' Quantum<sup>®</sup> and Quantum<sup>®</sup> Blue product lines, Petitioners' products are commercially successful. Mot. 3–4. Petitioners respond that Patent Owner has not explained how Petitioners' sales, if considered, would support commercial success. Opp. 5.

We determine that Patent Owner has provided sufficient evidence and reasoning tending to show beyond speculation that the requested sales information about Quantum<sup>®</sup> and Quantum<sup>®</sup> Blue products will be useful to Patent Owner's allegations of commercial success. Commercial success typically is shown with evidence of "significant sales in a relevant market." *Ormco Corp.*, 463 F.3d at 1312 (citation omitted). On this record, the evidence cited by Patent Owner suggests that the Quantum<sup>®</sup> and Quantum<sup>®</sup> Blue product lines have seen year-over-year sales growth and market share growth, and that this growth has helped Petitioner AB Vista "climb[] to second in global phytase rankings." Ex. 2035; *see also* Exs. 2032–2034, 2036; Mot. 3–4.

As to nexus, Patent Owner contends that the Subject Products are "coextensive" with the claims of the patents challenged in the IPRs, and thus argues that "there is a presumed nexus between those products' commercial success and the claimed inventions." Mot. 4–5 (citing Exs. 2037–42 (claim charts)). Petitioners respond that nexus should not be presumed because "[n]o single product has even been alleged to infringe each of the challenged

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claims;” and because the commercial performance of Petitioners’ products is due to other factors including their “own, innovative technology and [] marketing efforts.” Opp. 3–5. Petitioners further argue that Patent Owner must provide evidence of nexus between the unique characteristics of the claimed invention and Petitioners’ sales, but cannot do so because the relevant methods “were taught in the prior art.” Opp. 4–5.

When “the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *Ormco Corp.*, 463 F.3d at 1312 (quoting *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997)). On the record at this stage, Patent Owner has provided sufficient evidence to suggest that all the claim elements of the challenged claims are present in one or more of the Subject Products, and we will assess this issue further (as needed) upon a more complete record developed through trial. *See* Exs. 2037–42. If established at trial, this would entitle Patent Owner to a presumption of nexus. Petitioners can, however, attempt to rebut any such presumption at trial by presenting evidence that shows that any commercial success was due to factors other than the patented invention, such as unclaimed features, marketing, or features known in the prior art. *See, e.g., Ormco Corp.*, 463 F.3d at 1312. Petitioners’ present arguments read to us as potential rebuttal points on the issue of nexus (should it be established), but it is premature on this record to decide the merits of all such points now.

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Patent Owner also suggested that the requested discovery will “potentially” show copying. Mot. 1, 6. Under Federal Circuit jurisprudence, “[n]ot every competing product that arguably falls within the scope of a patent is evidence of copying; otherwise, ‘every infringement suit would automatically confirm the nonobviousness of the patent.’” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010) (quoting *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004)). Copying as objective evidence of nonobviousness “requires evidence of efforts to replicate a specific product.” *Wyers*, 616 F.3d at 1246. Here, while Patent Owner asserts that the Subject Products fall within the scope of the challenged claims (Mot. 4), it has not demonstrated that it already possesses evidence tending to show beyond speculation that in fact something useful will be uncovered regarding purported copying. Accordingly, Patent Owner’s speculation regarding copying forms no basis for our decision to grant the requested discovery.

For the foregoing reasons, the first *Garmin* factor weighs in favor of granting Patent Owner’s Motion for Additional Discovery.

*Factor 2 – A party may not seek another’s litigation positions or the underlying basis for those positions.*

Patent Owner asserts that “[t]he requested discovery seeks only factual information.” Mot. 6. Petitioners respond that “Patent Owner’s focus on Petitioners’ products—despite the sale of products licensed under the challenged patents—suggests that Patent Owner is attempting to impermissibly litigate infringement.” Opp. 6.

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On this record, we do not perceive that Patent Owner’s requests are driven by an impermissible attempt to litigate infringement. Patent Owner contends that the requested information is relevant to establishing alleged commercial success, and as noted above, identity between the relevant products and the challenged patent claims is a component of demonstrating commercial success. *See Ormco Corp.*, 463 F.3d at 1311–12. Thus, it is reasonable for Patent Owner to request the existing infringement contentions to support its effort to show identity between the products and the challenged patent claims.

For the foregoing reason, the second *Garmin* factor weighs in favor of granting Patent Owner’s Motion for Additional Discovery.

*Factor 3 – A party should not seek information that reasonably can be generated without a discovery request.*

With respect to factor three, Patent Owner asserts that its requests “narrowly target non-public information.” Mot. 6. Petitioners do not appear to dispute this contention with respect to the requested financial information. With respect to the requested technical information, Petitioners assert that “Patent Owner fails to explain why it requires a copy of Huvepharma’s final infringement contentions (and thousands of pages of supporting documents) as compared to those publicly available.” Opp. 6.

We again note that demonstrating identity between the relevant products and the challenged patent claims is a component of demonstrating commercial success. *See Ormco Corp.*, 463 F.3d at 1311–12. Although Patent Owner contends that the “public information indicates that the



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Subject Products are coextensive with the claims of the Cornell patents challenged in the ABF IPRs the Subject Products,” it is reasonable to assume that the final infringement contentions served in the District Court Litigation contain citations to non-public information from Petitioners’ own files that could be useful to fill-in gaps in technical details supplied in the public information.

Thus, we determine that the third *Garmin* factor weighs in favor of granting Patent Owner’s motion.

*Factor 4 – Instructions and questions should be easily understandable.*

Patent Owner asserts that the instructions associated with its discovery requests are “straightforward.” Mot. 6. Petitioners do not dispute this assertion. Thus, this factor weighs in favor of granting Patent Owner’s motion.

*Factor 5 – The discovery requests must not be overly burdensome to answer.*

Patent Owner asserts that “the requested discovery is not overly burdensome” because it can be satisfied by consent for access to certain information from the District Court Litigation, together with “a sales summary chart for any of the requested sales information not in the interrogatory answer.” Mot. 6–7. On this record, it appears that Patent Owner’s requested discovery largely targets specific documents that Patent Owner knows exist, and which have been prepared already and served in the District Court Litigation. Accordingly, we do not perceive that the discovery requests are overly burdensome to answer.

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Petitioners argue that the requested financial information is not tailored to the respective issue and expiration dates of the subject patents.

Opp. 7. Petitioners, however, have not cited any legal authority demonstrating that only sales occurring during the patent term maybe considered when analyzing commercial success.

Petitioners also assert that the requested financial information “goes well beyond the discovery produced in the District Court Litigation, and would require Petitioners to retrieve sales information from archived databases.” Opp. 7. On this record, Petitioners have not established that it is overly burdensome to access the archived databases to obtain whatever additional sales information is missing from the existing interrogatory response, and the nature and detail of such alleged burden is information uniquely in Petitioners’ possession.

We note that the burden to consider under this *Garmin* factor includes the “burden on meeting the time schedule” of the *inter partes* review. *Garmin*, IPR2012-00001, Paper 26 at 7. Patent Owner’s assertion that it “may not have time to analyze any documents produced, prepare declaration(s), and submit its patent owner response by the current October 31, 2019 deadline” (Mot. 7) weighs against granting this motion. Although Patent Owner blames any delay on “Petitioners’ refusal to produce the requested documents” (Mot. 7), Patent Owners’ role in the timing of the current dispute should not be overlooked. The Board’s scheduling order (Paper 26), which issued together with the institution decision, accorded

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Patent Owner twelve weeks to prepare its Patent Owner Response. Patent Owner waited nearly six weeks after trial was instituted to first raise its request for additional discovery with the Board.

Despite Patent Owner's expressed concern with respect to meeting the existing time schedule, we are granting Patent Owner's request in large part because it seeks specific, defined documents that we understand have already been exchanged in the District Court Litigation, the contents of which Patent Owner alleges support its commercial success arguments. The parties are reminded that they may stipulate to different dates for DUE DATES 1 through 3, 5, and 6 in the Scheduling Order (provided the dates are no later than DUE DATE 7). Paper 26 at 6. We caution, however, that absent extraordinary circumstances, the Board is not inclined to delay the schedule to accommodate Patent Owner's evaluation of the requested discovery.

#### CONCLUSION

Upon review of the parties' arguments and supporting evidence in view of the *Garmin* factors, we conclude that it is in the interests of justice to grant Patent Owner's motion for additional discovery.

#### ORDER

In consideration of the foregoing, it is hereby  
ORDERED that Patent Owner's Motion for Additional Discovery is  
*granted*;

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FURTHER ORDERED that Patent Owner shall serve the discovery requests attached to its Motion no later than one business day after entry of this Order; and

FURTHER ORDERED that Petitioners shall produce the requested discovery no later than five business days after service of the discovery requests, or at a time that is mutually agreeable to the parties.

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