

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

PALETTE LIFE SCIENCES, INC.,  
Petitioner,

v.

INCEPT LLC.,  
Patent Owner.

---

IPR2020-00002 (Patent US 8,257,723 B2)  
IPR2020-00004 (Patent US 7,744,913 B2)

---

Before ERICA A. FRANKLIN, ULRIKE W. JENKS, and CHRISTOPHER  
G. PAULRAJ, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

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

On October 23, 2020, a conference call was conducted between respective counsel for the parties and Judges Franklin, Jenks, and Paulraj. The purpose of the call was to discuss Petitioner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2). Specifically, Petitioner explained that it seeks to serve upon Dr. Noyes, the listed inventor for the challenged patents, 14 interrogatories "drawn mainly to his education, training and professional experience, including teaching and research experience, as well as any medical products or devices (both FDA and non-FDA regulated) that he may have been involved in developing." Ex. 3001 (Petitioner's email to PTAB Trials, dated October 21, 2020).

According to Petitioner, "patent owner has made what constitutes the level of ordinary skill at issue in this proceeding." *Id.* We understand that Petitioner is referring to Patent Owner's contention in the Patent Owner Response that Petitioner's declarant, Dr. Adam Dicker, M.D., Ph.D., is "not one of ordinary skill in the art." Paper 24, 3 (Patent Owner Response).<sup>1</sup> According to Patent Owner, "Petitioner has offered no testimony from someone with 'an understanding in polymer science.' DI 6. In particular, Petitioner's expert makes no mention of research or collaborative work in polymer science, neither in his testimony (Ex. 1003 ¶¶ 2–12) nor in his CV (Ex. 1004)." *Id.* Patent Owner's contention refers to our description of a person of ordinary skill in the art in the Institution Decision. *Id.*; *see, e.g.*, Paper 8, 5–7 (Institution Decision). In the Institution Decision, we adopt Petitioner's definition of such person and clarify that "the experience of the

---

<sup>1</sup> Citations to Papers refer to papers filed in IPR2020-00002. Similar papers were filed in IPR2020-00004.

IPR2020-00002 (Patent US 8,257,723 B2)

IPR2020-00004 (Patent US 7,744,913 B2)

hypothetical person of ordinary skill in the art includes an understanding of polymer science via their own research or collaborative work with a research team or group in the medical or biotechnology industry.” *Id.* at 6. Thus, Petitioner seeks to scrutinize the education and experience of Dr. Noyes to determine whether he, himself, has such an understanding of polymer science.

The timing of Petitioner’s requested authorization to file a motion for additional discovery is problematic. As reflected in the parties’ Joint Notice of Stipulation to Modify Schedule, Paper 19, Modified Due Date 2 (Petitioner’s Reply to the Patent Owner’s Response) is November 5, 2020, and Modified Due Date 3 (Patent Owner’s Sur-reply to Petitioner’s Reply) is December 16, 2020. In Petitioner’s email to PTAB Trials, Petitioner explained that “[o]ur reply is due November 5, 2020, and we would like to have a response to our interrogatories before that date for our reply and so we don’t encroach on patent owner’s sur-reply preparation time.” Ex. 3001.

As discussed during the conference call, achieving that goal is not feasible. Even if Petitioner filed a motion on the date of the conference call, Patent Owner would be entitled to a reasonable amount of time to prepare and file an opposition to the motion. Upon doing so, the Board would require time to consider the motion and opposition, and to prepare a decision. If the motion were granted, additional time would be required for: (a) serving the interrogatories, (b) responding to the interrogatories, (c) considering those responses and incorporating their contents, if any, in Petitioner’s Reply, and (d) filing Petitioner’s Reply. Further, as Patent Owner suggested during the conference, responses to such interrogatories may prompt Petitioner to pursue additional discovery requests or actions that

IPR2020-00002 (Patent US 8,257,723 B2)

IPR2020-00004 (Patent US 7,744,913 B2)

would require additional time and potentially further delay filing Petitioner's Reply. The schedule in these proceedings has already been extended once. And we see no viable further extension to the existing schedule that would allow sufficient time for the additional discovery requested to be completed.

Moreover, during the conference call, when asked, we did not hear any reasonable explanation as to why Petitioner waited until now to request the additional discovery. Petitioner confirmed that it received notice of Patent Owner's challenge to its declarant, Dr. Dicker, in the Patent Owner Response, which was timely filed on July 28, 2020, nearly three months ago.

Thus, we deny Petitioner's authorization to file a motion for additional discovery because the inexplicably delayed timing of Petitioner's request makes Petitioner's plan to use the additional discovery for the Petitioner's Reply unfeasible, as the due date for that filing is in less than ten business days.

Additionally, as noted during the conference call, we do not find it likely that Petitioner could demonstrate that the additional discovery would be in the "interests of justice." *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2); *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013). For example, Petitioner explains both (a) that it seeks discovery into whether Dr. Noyes has an understanding of polymer science via education, training, or professional experience, and (b) that it has no information regarding Dr. Noyes' education, training, or professional experience. Insofar as Petitioner seeks that information to compare the background of the inventor with the background of its declarant, we do not find that such a comparison would be useful to the issue serving as the basis of Petitioner's request, i.e., whether Petitioner's

IPR2020-00002 (Patent US 8,257,723 B2)

IPR2020-00004 (Patent US 7,744,913 B2)

declarant is qualified to provide opinion testimony in these proceedings from the perspective of a person having ordinary skill in the art.

#### ORDER

In accordance with the foregoing, it is hereby:

ORDERED that Petitioner's request for authorization to file a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) is *denied*.

IPR2020-00002 (Patent US 8,257,723 B2)

IPR2020-00004 (Patent US 7,744,913 B2)

For PETITIONER:

Jeffrey Guise

Lora Green

Richard Torczon

Lorelei Westin

Kristin Havranek

Tasha Thomas

WILSON SONSINI GOODRICH & ROSATI

jguise@wsgr.com

lgreen@wsgr.com

rtorczon@wsgr.com

Lwestin@wsgr.com

khavranek@wsgr.com

tthomas@wsgr.com

For PATENT OWNER:

Scott Kamholz

Jennifer Robbins

COVINGTON & BURLING LLP

skamholz@cov.com

jrobbins@cov.com