

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SANDOZ INC.,  
Petitioner,

v.

ABBVIE BIOTECHNOLOGY LTD.,  
Patent Owner.

---

Case IPR2017-02105<sup>1</sup> (Patent 9,090,689 B1)  
Case IPR2017-02106 (Patent 9,067,992 B2)

---

Before SUSAN L. C. MITCHELL, TINA E. HULSE, and  
MICHELLE N. ANKENBRAND, *Administrative Patent Judges.*

ANKENBRAND, *Administrative Patent Judge.*

ORDER

Denying Without Prejudice Petitioner's Request for Authorization to File  
Motion for Additional Discovery and Request for Briefing Regarding  
Routine Discovery

*37 C.F.R. §§ 42.20(b), 42.51(b)(1)(iii), 42.51(b)(2)*

---

<sup>1</sup> We exercise our discretion to issue one order to be entered in both cases. The parties are not authorized to use this style heading for subsequent papers without prior Board approval.

IPR2017-02105 (Patent 9,090,689 B1)

IPR2017-02106 (Patent 9,067,992 B2)

On May 4, 2018, the Board held a conference call between counsel for the parties and Judges Ankenbrand, Mitchell, and Hulse. A court reporter was present for the conference, and Petitioner agreed to file a copy of the transcript as an exhibit in each proceeding. We convened the call to discuss, *inter alia*, Petitioner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) concerning Exhibits 1026 and 1049. In the Exhibit List section of each Petition, Petitioner describes Exhibit 1026 as "Humira™ (adalimumab) Package Insert (Abbott Labs, Dec. 2002)" and Exhibit 1049 as "Abbott Laboratories Press Release: Abbott laboratories initiates clinical trials to explore use of Humira™ (adalimumab) in psoriasis and psoriatic arthritis (Mar. 3, 2003)." IPR2017-02105 Paper 1, x, xiii; IPR2017-02106 Paper 1, x, xii.

Patent Owner filed objections to each exhibit. In particular, Patent Owner objects to Exhibit 1026 as irrelevant under Federal Rules of Evidence ("FRE") 401, 402, and 403 "because [P]etitioner has not established that it was published before the July 2002 priority date" of the challenged patents. Paper 17, 4.<sup>2</sup> Patent Owner also objects to Exhibit 1026 as hearsay under FRE 802 "to the extent [P]etitioner relies on the December 20, 2002 date in the header or the December 2002 issue date to establish publication date." *Id.* Patent Owner objects to Exhibit 1049 as "lacking authentication under FRE 901" and as hearsay "to the extent [P]etitioner relies on dates and quotes in the document for the truth of the matter asserted," such as relying

---

<sup>2</sup> Patent Owner filed the same objections to Exhibits 1026 and 1049 in both proceedings. Unless otherwise noted, citations are to the objections Patent Owner filed in IPR2017-02105.

IPR2017-02105 (Patent 9,090,689 B1)

IPR2017-02106 (Patent 9,067,992 B2)

on the quotes in the document regarding Humira psoriasis trials for their truth. *Id.* at 5.

During the conference call, Petitioner explained that it seeks to serve requests for admission and interrogatories on Patent Owner related to Exhibits 1026 and 1049. Petitioner represented that the additional discovery it seeks is necessary in light of Patent Owner's objections and is in the interests of justice under the five factors the Board identified in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (informative). Petitioner also contended that Patent Owner's objection to Exhibit 1049 as lacking authentication implicates routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) such that Patent Owner should serve on Petitioner any relevant information that is inconsistent with that objection.

Patent Owner responded that, to the extent Petitioner relies on Exhibits 1026 and 1049 in the Petition, it does so as background references, and that our decision instituting review specifically invited the parties to address during trial whether a petitioner must show that background references qualify as prior art printed publications. Patent Owner contended that Petitioner's request for authorization to file additional discovery is premature because Patent Owner has not yet filed its Response to the Petition, and its Response may moot the printed publication issue.

We took Petitioner's request under advisement. After having considered further the parties' arguments, we find Petitioner's request for authorization to file a motion for additional discovery premature. We also are not persuaded that briefing regarding Petitioner's request for production of routine discovery in connection with Patent Owner's lack of

IPR2017-02105 (Patent 9,090,689 B1)

IPR2017-02106 (Patent 9,067,992 B2)

authentication objection to Exhibit 1049 is ripe at this time. Petitioner, however, may renew both requests after Patent Owner files its Response to the Petition.

Accordingly, it is

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* without prejudice to renew after Patent Owner files its Response to the Petition; and

FURTHER ORDERED that Petitioner's request for briefing regarding whether Patent Owner's lack of authenticity objection to Exhibit 1049 requires Patent Owner to produce information inconsistent with that objection as routine discovery under 37 C.F.R. § 42.51(b)(1)(iii) is *denied* without prejudice to renew after Patent Owner files its Response to the Petition.

IPR2017-02105 (Patent 9,090,689 B1)

IPR2017-02106 (Patent 9,067,992 B2)

PETITIONER:

Deborah E. Fishman

David R. Marsh

David K. Barr

ARNOLD & PORTER KAYE SCHOLER LLP

[deborah.fishman@apks.com](mailto:deborah.fishman@apks.com)

[david.marsh@apks.com](mailto:david.marsh@apks.com)

[David.Barr@apks.com](mailto:David.Barr@apks.com)

PATENT OWNER:

William B. Raich

Michael J. Flibbert

Maureen D. Queler

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP

[william.raich@finnegan.com](mailto:william.raich@finnegan.com)

[michael.flibbert@finnegan.com](mailto:michael.flibbert@finnegan.com)

[maureen.queler@finnegan.com](mailto:maureen.queler@finnegan.com)