

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

QUALICAPS CO., LTD.,
Patent Owner.

Case IPR2017-00203
Patent 6,649,180 B1

Before BRIAN P. MURPHY, CHRISTOPHER M. KAISER, and JEFFREY
W. ABRAHAM, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

On August 3, 2017, Mylan Pharmaceuticals Inc. (“Petitioner”) sent an email to the Board requesting a teleconference to discuss Petitioner’s request that Mr. Masaru Tanjoh “be presented for cross-examination as a part of routine discovery” or, in the alternative, that Petitioner be authorized to file a motion for additional discovery “in the form of Mr. Tanjoh’s deposition.” Ex. 2061, 2. Mr. Tanjoh is an inventor of U.S. Patent No. 6,649,180 B1, the patent at issue in this proceeding. Ex. 1001 (“the ’180 patent”). Qualicaps Co., Ltd. (“Patent Owner”) relies on the Declaration testimony of Mr. Tanjoh, submitted during prosecution of the ’180 patent (Ex. 1010, 105–108), as evidence of unexpected results in its Response to the Petition. Paper 26 (“PO Resp.”), 29, 33–35.

Petitioner’s email indicated that Patent Owner had refused to make Mr. Tanjoh available for cross-examination. Ex. 2061, 1. The Board responded by email on August 3, 2017 encouraging the parties to reach agreement regarding Mr. Tanjoh’s cross-examination, and authorizing Petitioner to file a motion for additional discovery in the absence of such agreement. Ex. 2061, 1.

On August 11, 2017, Petitioner filed a Motion for Additional Discovery pursuant to 37 C.F.R. § 42.51(b)(2). Paper 31 (“Motion” or “Mot.”). Petitioner’s motion requests:

- (i) Mr. Tanjoh’s deposition, and
- (ii) “[A]ll documents in Patent Owner and/or Mr. Tanjoh’s possession, custody, or control, supporting or refuting Patent Owner’s assertion that the invention of the U.S. Patent

6,649,180 (“the ‘180 patent”) yielded unexpected results,” or, in the alternative,

- (iii) That Patent Owner produce “the entirety” of Mr. Tanjoh’s March 17, 2017 30(b)(6) deposition transcript from the co-pending litigation between the parties “with exhibits including any portion or document marked confidential.”

Id., 1. Petitioner notes that Patent Owner declined to produce Mr. Tanjoh for a deposition in the present proceeding, and instead offered to consent to the use of Mr. Tanjoh’s March 17, 2017 deposition transcript from the litigation in the present proceeding. Mot., 2 (citing Ex. 1022). The parties’ dispute centers on Petitioner’s document request and Patent Owner’s refusal to agree to produce certain deposition exhibits designated as “Restricted–Attorneys’ Eyes Only” as part of its consent to the use of Mr. Tanjoh’s March 17th deposition transcript. Ex. 1023, 1–2.

Patent Owner justifies its refusal to provide Mr. Tanjoh for deposition because it has offered to file the complete deposition “testimony” of his March 17th deposition, which includes testimony regarding the issue of unexpected results. Paper 32, 4 (“Opposition” or “Opp.”). Patent Owner further states that Mr. Tanjoh is approximately 70 years old, resides in Japan, and requires an interpreter for deposition. *Id.* at 7. Patent Owner stresses that Mr. Tanjoh is a fact witness, his Declaration does not contain expert opinion testimony, and Patent Owner’s expert, Dr. McConville, provided expert opinion testimony regarding unexpected results and was cross-examined by Petitioner on August 17, 2017. *Id.* at 3, 5–7. Patent Owner asserts that Petitioner’s document request and request for a “second” deposition of Mr. Tanjoh are unduly burdensome, particularly because Petitioner has not alleged the confidential deposition exhibits being

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requested are directed to the experiments, data, and statements made in Mr. Tanjoh's Declaration, as opposed to the other 30(b)(6) deposition topics for which Mr. Tanjoh was designated as Patent Owner's corporate spokesperson. *Id.* at 4, 6–7.

II. ANALYSIS

A. Requested Deposition of Mr. Tanjoh

Patent Owner bears the burden of producing objective evidence of nonobviousness in rebuttal to Petitioner's evidence of obviousness.¹ *Prometheus Labs., Inc. v. Roxane Labs., Inc.*, 805 F.3d 1092, 1101-02 (Fed. Cir. 2015). Patent Owner affirmatively relies on Mr. Tanjoh's Declaration testimony in support of its burden of production, and Dr. McConville relies on Mr. Tanjoh's Declaration as a basis for his opinion of unexpected results. PO Resp. 29, 33–35 (citing Ex. 1010, 106–107; Ex. 2028 ¶¶ 99–100). Although Patent Owner sets out very practical reasons for why Mr. Tanjoh's deposition in this proceeding may be inconvenient and unnecessary, Patent Owner does not state that Mr. Tanjoh is unavailable for deposition. Opp. 6–7. Given that Dr. McConville relies directly on the experiments and data provided in Mr. Tanjoh's Declaration for Dr. McConville's opinion of unexpected results (Ex. 2028 ¶¶ 99–100), we are satisfied Petitioner has established the utility of the requested deposition testimony as it relates to Mr. Tanjoh's Declaration and that a deposition would not be unduly burdensome. *See Garmin Int'l Inc. et al. v. Cuozzo Speed Techs. LLC*, Case

¹ To be clear, Petitioner bears the ultimate burden of persuasion regarding the asserted obviousness of the challenged claims.

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IPR2012-00001, Paper 26 (PTAB March 5, 2013) (*Garmin* factors 1 and 5).

Petitioner is entitled to cross-examine Mr. Tanjoh with regard to the experiments, data, and statements in Mr. Tanjoh's Declaration, particularly regarding the criticality of the boundaries for combined methoxyl group and hydroxypropoxyl group content. Mot. 4.

With regard to *Garmin* factor 3, availability of equivalent information by other means, Petitioner acknowledges that the March 17th deposition of Mr. Tanjoh addresses Mr. Tanjoh's Declaration and the issue of unexpected results, one of the enumerated topics for which Mr. Tanjoh was designated to testify as Patent Owner's representative. Mot. 4–5 (“Patent Owner designated Mr. Tanjoh . . . to testify on this [secondary considerations including unexpected results] topic”), 6–7; Ex. 1024, 6 (Topic 17).² Petitioner expressly acknowledges that the issue of “unexpected results via the inventor's declaration . . . is addressed in the deposition transcript and exhibits thereto,” and that “the foundation, context, and facts underlying Mr. Tanjoh's Declaration easily could be made available in these proceedings via deposition or production of Mr. Tanjoh's deposition from the district court litigation.” Mot. 6. Patent Owner has consented to filing Mr. Tanjoh's “complete testimony” from his March 17th district court deposition in this proceeding, with due accommodation for

² Regarding *Garmin* factor 2 – whether Petitioner seeks Patent Owner's litigation positions and the underlying bases therefore – we are not persuaded that Petitioner's request seeks Patent Owner's litigation positions. Opp. 5. The parties have exchanged expert reports and completed expert discovery in the district court litigation. Mot. 5. Likewise, Petitioner's requests are easily understandable (*Garmin* factor 4). Given the circumstances of Petitioner's Motion, however, these two factors are not determinative of the result.

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