

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.
Petitioner,

v.

UNITED THERAPEUTICS, CORP.
Patent Owner.

Case IPR2017-01621 and IPR2017-01622
Patents 9,358,240 B2 and 9,339,507 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

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

I. INTRODUCTION

On Friday June 15, 2018, Patent Owner emailed the Board to request a teleconference to address the scheduling and location of depositions of four non-party fact witnesses. Ex. 3009. Pursuant to this request, a teleconference was held on Wednesday, June 20, 2018, wherein both parties had the opportunity to address the panel. A court reporter was present, and we instructed the parties to file a copy of the transcript of the call as an exhibit. *See*, Ex. 2210.

The purpose of our June 20, 2018 teleconference was to resolve a dispute between the parties with respect to the location for the depositions of Drs. Seeger, Ghofrani, Reichenberger, and Grimminger. These four witnesses are all residents of Germany and all are non-parties. Patent Owner contends that the depositions should take place in Germany while Petitioner contends that depositions should take place in the United States. On the teleconference, both parties stressed that resolution of this issue was time sensitive, representing that scheduling the depositions would require substantial lead-time. In recognition of the time-sensitive nature of this issue, we notified the parties by email that we would authorize the depositions to take place “in Germany or, in the event depositions in Germany prove impracticable, in such other European country as is mutually agreeable to the parties and the witnesses.” Ex. 3009. We further indicated that we would issue an Order explaining the basis of our decision in due course. *Id.*

II. ANALYSIS

The witness at issue have offered declarations bearing on whether Ghofrani, a journal article published in the June 2005 issue of *Herz* (Ex.

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1005), qualifies as a prior art printed publication under 35 U.S.C. § 102(a). The Ghofrani article lists as authors two persons identified on the face of the '507 patent as inventors (Robert Voswinckel and Werner Seeger) as well as three non-inventors (Hossein Ardeschir Ghofrani, Frank Reichenberger, and Friedrich Grimminger). Ex. 1001, Ex. 1005. Patent Owner contends that Ghofrani does not qualify as prior art because it is not the work of “another.” Patent Owner has provided declarations from Dr. Seeger and from three of the non-inventor authors of the Ghofrani reference in support of its argument that Ghofrani is not the work of “another.” *See*, Ex. 2020, 2026, 2027, 2028, 2098, and 2099.

Although Patent Owner is compensating two of the witnesses, Drs. Ghofrani and Seegar, for their time spent in connection with these proceedings, counsel for Patent Owner represented that none of the witnesses are under the control of the Patent Owner. Ex. 2210, 5:21–6:1; 10:3–8 (“[T]hey’re not our employees and they’re not under our control in that sense. They’ve got their own counsel. We can’t – at the present time, we can’t even communicate directly with them. We’ve got to go, as you can appreciate, through their counsel.”). All of the witness “work as internists and professors in hospitals” and “treat patients directly.” *Id.* at 11:18–21. Patent Owner argues that requiring these witnesses to travel to the United States would impose a significant burden on the witnesses, requiring them to be away from their clinics for four to five working days. *Id.* at 12:11–16. Patent Owner has represented that the witnesses would consent to depositions in Germany. *Id.* at 13:3–12.

Petitioner argues that the declarations submitted by the witnesses at issue “go to a critical issue as between the parties.” *Id.* at 21:8–9. Petitioner

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asserts that two of the witnesses are paid consultants for Patent Owner and that one of the witnesses, Dr. Seeger, has a “long history with United Therapeutics, consulting relationships going back into the early 2000s.” *Id.* at 18:14–18. Petitioner further argues that Dr. Seeger has traveled to the United States for business meetings with United Therapeutics “as recently as a couple years ago.” *Id.* at 18:19–22. Finally, Petitioner argues that taking depositions in Germany would be burdensome to counsel given their tight time frame and the need to take at least ten depositions in a seven week time period. *Id.* at 24:16–25:10.

Our rules, provide that “[u]ncompelled deposition testimony outside the United States may only be taken upon agreement of the parties *or as the Board specifically directs.*” See 37 C.F.R. § 42.53(b)(3) (emphasis added). Under these circumstances, we determine that Patent Owner’s request for the depositions of Drs. Seeger, Ghofrani, Reichenberger, and Grimminger to take place in Germany is reasonable and appropriate. All four of the witnesses are third-parties. Moreover, Patent Owner has persuasively argued that traveling to the United States for deposition would impose a significant burden on these witnesses. Ex. 2210, 10:13–18 (arguing that the witnesses are medical professionals with “an ongoing responsibility to patients and their colleagues and their staff and their employer.”); 12:5–13:2 (arguing that the witnesses’ practices include operations and invasive procedures scheduled months in advance, “[s]o replacing any of them, much less all of them, for required planned clinics and procedures if they were to travel to the U.S. would be next to impossible for them.”); *see also, generally* 12:9–13:2.

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We acknowledge Petitioner's argument that the testimony of these witnesses is potentially case-dispositive, but do not see how taking the depositions in Germany substantively prejudices Petitioner. Indeed, during the conference call, Petitioner explained that it had offered, as an accommodation, to take the depositions of two of the witnesses in Germany. *Id.* at 26:1–5. We recognize that at least one of the witnesses has traveled to the United States in the past, but we understand that, to the best of Patent Owner's knowledge, he does not have plans to travel to the United States during the discovery period. *Id.* at 27:1–15. Finally, we acknowledge that taking depositions in Germany may create scheduling difficulties for Petitioner's counsel, but find that the potential burden imposed on these third-party witnesses outweighs the potential scheduling difficulties created for counsel. In this regard, we encourage the parties to work together to modify scheduling deadlines, as contemplated in the Scheduling Order, if necessary to accommodate these depositions.

We note that the Board has authorized accommodations to minimize the burden on third-party witnesses in situations like those present here. *See, e.g., Activision Blizzard, Inc. v Acceleration Bay*, IPR2015-01951, Paper 17, slip op. 6–7 (PTAB May 19, 2016) (ordering petitioner to make third-party Australian fact-witness available for video deposition); *IBM Corp. v. Intellectual Ventures LLC*, IPR2014-01385, Paper 19, slip op. at 6–7 (PTAB May 4, 2015) (encouraging telephonic deposition of third-party fact witness); and *Instradent USA, Inc. v. Novel Biocare Services AG*, IPR2015-01786, Paper 61 (PTAB August 25, 2016) (ordering deposition of third-party fact witness to occur in Israel or by video).

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