

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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.

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)¹

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

PER CURIAM.

¹ 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.

² 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.").³

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,⁴ 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,⁵ 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."

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

⁴ "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.*

⁵ "Subject Products" refers to phytase products sold under Petitioners' Quantum[®] and Quantum[®] 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[®] and Quantum[®] 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[®] and Quantum[®] 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[®] and Quantum[®] 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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