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Paper 44
Filed: April 25, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IAN C. **ASHURST**, IGNATIUS LOY BRITTO,
CRAIG STEVEN HERMAN, LI LI-BOVET, and
MICHAEL THOMAS RIEBE

Junior Party

(Patent 6,532,955, 6,511,652, 6,511,653, and 6,546,928),

v.

FRANCOIS **BRUGGER** and ANGELIKA STAMPF

Senior Party

(Application 10/424,633).

Patent Interference No. 105,482 (SCM)

Decision - Miscellaneous - Bd.R. 104(a)

A. Introduction

1 On 17 April 2007, Ashurst filed “ASHURST MOTION 3 (Miscellaneous
2 Motion for Discovery)” (Paper 43), in which Ashurst seeks leave to obtain
3 additional discovery from Brugger. For the reasons that follow, Ashurst Motion 3
4 is denied.

B. Findings of fact

- 5
6 1. This interference is in the preliminary phase.
7 2. Motions and oppositions have been filed.

1 3. The interference is in the time prior to the cross-examination of those
2 witnesses relied on in support of oppositions, and prior to the filing of replies.

3 4. Prior to the filing of oppositions, and during the cross examination
4 deposition of one of Brugger's witnesses (Dr. Singh), a disagreement arose and a
5 conference call was had with me.

6 5. During that call, an agreement was reached and a ruling was made as to
7 the specific questions that counsel for Ashurst could ask Dr. Singh (Ex. 1086 page
8 206, line 15 to page 208, line 5).

9 6. Ashurst never sought reconsideration of that ruling.

10 7. Some days after the filing and serving of oppositions, a conference call
11 was held on 16 April 2007.

12 5. During the call, Ashurst requested leave to file a miscellaneous motion
13 for discovery.

14 6. Counsel for Ashurst represented that the discovery Ashurst sought was
15 not necessary for the impending cross-examination deposition of Brugger's
16 witness, Dr. Gupta.

17 7. Counsel for Ashurst also represented that the previous cross-examination
18 of Dr. Singh was adequate and that Ashurst was not seeking reconsideration of the
19 Board ruling made during the cross-examination deposition of Dr. Singh.

20 8. Ashurst was authorized to file a miscellaneous motion for discovery.

21 9. Ashurst filed its request for discovery the next day.

22 10. In its request, Ashurst seeks discovery of the following (Paper 43 at 9-
23 10):

24 1. Provide the names and titles of the three persons at Novartis who
25 have the most knowledge regarding the properties of the coatings on
26 the inside of a metered dose inhaler (MDI) tested at Novartis.
27

1 2. Provide the names and titles of the three persons at Novartis who
2 have the most knowledge regarding the interaction of the coatings
3 defined in 1 above with a hydrofluorocarbon (HFA) propellant and/or
4 drug.

5
6 3. Does Novartis have any data (either generated internally at
7 Novartis or provided from a third party – other than information
8 provided by Ashurst in this proceeding) regarding the properties
9 (short-term coating quality, long-term coating quality, adhesion of
10 coating to MDI can, drug deposition properties, etc.) of any of the
11 coatings defined in 1 above or any of the interactions defined in 2
12 above?

13
14 4. If the answer to 3 is yes, does Novartis have any documents or
15 information that show that (1) coatings comprising a fluorocarbon
16 polymer (with no non-fluorocarbon polymer) have any inferior
17 properties as compared with (2) coatings comprising both a
18 fluorocarbon polymer and a non-fluorocarbon polymer?

19
20 5. If the answer to 4 is yes, please identify all properties for which
21 some data exists that coatings (1) are inferior to coatings (2).

22
23 6. When did anyone at Novartis (including but not limited to the
24 inventors named in the Brugger patent application, research and
25 development personnel working at Novartis, etc.) first become aware,
26 either directly by personal observation or experience or indirectly
27 from a third party, of any problems with a coating applied on the
28 inside of an MDI that comprised fluorocarbon polymer with no non-
29 fluorocarbon polymer?

30
31 7. Does Novartis have any documents that suggest that a coating on
32 the inside of an MDI comprised of a fluorocarbon polymer (with no
33 non-fluorocarbon polymer) has any properties, or lacks any properties,
34 that would cause possible FDA regulatory concerns?
35

36 11. Ashurst argues that the request is necessary to “rebut the testimony of
37 Dr. Gupta either directly or on cross-examination” (Paper 43 at 7, lines 21-22).

1 12. Yet, Ashurst also states that “cross-examination of Dr. Gupta on this
2 inconsistency will not suffice since he does not have access to the pertinent
3 information” (Paper 43 at 1, lines 11-12).

4 13. Ashurst also argues that there is a high probability that the requested
5 information exists, that Dr. Singh knows who has the requested information, but
6 that previous attempts to obtain information from Dr. Singh were unsuccessful
7 (Paper 43 at 8, lines 1-3; at 5, lines 4-7).

8 14. However, in other parts of its brief, Ashurst states that it received
9 adequate cross-examination of Dr. Singh (Paper 43 at 1, lines 5-6; at 7, lines 10-
10 11).

11 15. Ashurst argues that the discovery is necessary, since Brugger’s
12 opposition and declaration of Dr. Gupta are inconsistent with testimony provided
13 by Dr. Singh (Paper 43 at 1, lines 6-7).

14 **C. Discussion**

15 A party requesting additional discovery must show that the additional
16 discovery is in the interests of justice. Bd.R. 150(c)(1). The standard for granting
17 discovery requests is high and requires specific bases for expecting that the
18 discovery will be productive. SO ¶150.2. As with any motion filed with the
19 Board, the movant bears the burden to demonstrate that it is entitled to the
20 requested relief.

21 A party cannot be granted relief when the relief requested is not clearly
22 articulated or is not meaningful in the first instance. Ashurst makes inconsistent
23 statements regarding why the requested discovery is necessary. For example,
24 Ashurst indicates that the discovery is necessary to properly cross examine Dr.
25 Gupta (ff 11), while also representing that the requested information is not
26 necessary to cross examine Dr. Gupta (ffs 6 and 12). Ashurst also indicates that

1 the prior cross examination of Dr. Singh was sufficient (ffs 7 and 14), while also
2 representing that Ashurst was denied, during cross examination, enough latitude to
3 gain certain requested information from Dr. Singh and that the discovery is
4 necessary to gain access of information known to Dr. Singh (ff 13).

5 Ashurst must take a position in order for the Board to properly determine if
6 such a position justifies granting the requested relief. Since Ashurst has failed to
7 clearly and consistently articulate why it needs the information in the first place,
8 the Board will not grant the request.

9 Additionally, Ashurst's request appears to be nothing more than what the
10 Board refers to as a "fishing expedition." The Board has a long history of not
11 embarking upon such expeditions. *See e.g., Shiokawa v. Maienfisch*, 58 USPQ2d
12 1479 (Bd. Pat. App. & Int. 2001).

13 Ashurst has failed to sufficiently demonstrate that the requested information
14 is necessary for a resolution of the issues raised by the parties. That there are
15 inconsistencies between Brugger's motions and its oppositions or between
16 statements made by witnesses, is not cause enough to authorize the discovery
17 requested. Ashurst could properly direct the Board to any alleged inconsistencies
18 as part of any response to any paper filed by the opponent. Thus, there is no
19 apparent reason why anything more is necessary.

20 Moreover, Ashurst's requested discovery is quite extensive and goes beyond
21 the issues raised in this interference. For example, it is not apparent why data
22 regarding properties of short-term coating quality, long-term coating quality,
23 adhesion of coating to MDI can, drug deposition properties, etc. of any of the
24 coatings that Novartis has ever tested with respect to a MDI is not beyond the
25 scope of this proceeding. For example, Ashurst has failed to adequately show how
26 any of the properties of any coating ever tested by Novartis for a MDI is relevant to

1 the count, the proposed count or any of the claims involved in this interference.

2 Thus, the Board concludes that the request is too broad and overreaching.

3 For all of these reasons, Ashurst miscellaneous motion 3 is denied.

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6

/Sally C. Medley/

7

Administrative Patent Judge

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