

Kamada, Ltd. v. Grifols Therapeutics Inc: Denying Motion for Additional Discovery IPR2014-00899

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Takeaway: Merely having a similar patent and a similar commercial product do not rise to the level of a threshold amount of evidence or reasoning tending to show beyond speculation that Petitioner copied from Patent Owner to merit granting a motion for additional discovery relating to the secondary consideration of copying.

In its Decision, the Board denied Patent Owner's Motion for Additional Discovery relating to the secondary consideration of copying. Patent Owner contended that Petitioner's U.S. Patent No. 7,879,800 incorporates every step of the claimed process of the '180 patent, and that the filing date of the PCT application that led to the '800 patent is almost two years after the issuance of the '180 patent. Accordingly, Patent Owner proposed two discovery requests: documents and information in the possession of Shabtai Bauer, or those working directly with Bauer in developing the process that was claimed in the '800 patent during the time period between October 8, 2002 and September 22, 2004, (1) revealing any inspection, discuss, description, or characterization of the '180 patent; and (2) sufficient to show the timeline of development of such process, including how each step for the process, and the order of those steps, was considered and selected.

A party seeking discovery must show that additional discovery is "necessary in the interest of justice." The Board considers several factors in evaluating whether the additional discovery is in the interest of justice, including: (1) whether the party requesting discovery demonstrated more than a possibility and mere allegation; and (2) whether the requests are overly burdensome to answer.

Patent Owner asserted that the "existence and timing of Petitioner's '800 patent and the competing commercial product GLASSIA, and the unprovoked filing of the Petition, make clear this allegation of copying is much higher than a 'possibility or mere allegation.'" Petitioner argued that copying requires evidence of efforts to replicate a specific product and that the claimed process of the '180 patent cannot be evidence of copying because all of the steps are found in the prior art. Patent Owner contended that Petitioner copied the claims of the '180 patent into Petitioner's '800 patent, but Patent Owner failed to provide any authority to support its argument that copying claims into another patent application constitutes proof of copying for purposes of secondary considerations of nonobviousness. Accordingly, the Board determined that merely having a similar patent and a similar commercial product do not rise to the level of a threshold amount of evidence or reasoning tending to show beyond speculation that Petitioner copied from Patent Owner, and thus this factor weighed

against granting Patent Owner's Motion.

The Board also found the requests to be overly broad and burdensome on Petitioner. Seeking 13-year old documents and information "revealing *any* inspection, discussion, description, or characterization of the '180 patent" and documents and information "sufficient to show the timeline of development of the process, including how each step of the process, and the order of those steps, was considered and selected" would require significant time and effort for Petitioner to search for, review, and produce within the constraints of the IPR schedule.

***Kamada, Ltd. v. Grifols Therapeutics Inc.*, IPR2014-00899**

Paper 22: Decision Denying Patent Owner's Motion for Additional Discovery

Dated: March 4, 2015

Patent: 6,462,180 B1

Before: Rama G. Elluru, Sheridan K. Snedden, and Tina E. Hulse

Written by: Hulse

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