

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC.
Petitioner

v.

WYETH LLC
Patent Owner

Case IPR2014-00115
Patent 7,879,828 B2

Before LORA M. GREEN, FRANCISCO C. PRATS, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

I. Introduction

An initial conference call was held on Thursday, May 22, 2014, among Stanley Fisher, representing Patent Owner; Kenneth Burchfiel, representing Petitioner; and Judges Green, Prats, and Kokoski.

II. Scheduling Order

Both parties confirmed that they seek no changes to the current Scheduling Order (Paper 11). The parties are reminded that they may stipulate to different dates for DUE DATES 1-5, as provided in the Scheduling Order, by filing an appropriate notice with the Board.

III. Protective Order

The panel noted that a default protective order has not been entered in this case. If the parties file a motion to seal and there is no protective order entered, a protective order must accompany the motion as an exhibit. The Board recommends the default protective order in the Office Trial Practice Guide. 77 Fed. Reg. 48,756, Appendix B (Aug. 14, 2012). If the parties choose to deviate from the default protective order, the Board suggested that the parties schedule a conference with the Board for guidance. Moreover, if the parties deviate from the default protective order, the modifications should be indicated in “redline” when the modified default protective order is submitted to the Board.

IV. Motions to Seal

We reminded the parties that the Board has a strong interest in the public availability of the proceedings. Any motion to seal must be narrowly tailored to the confidential information. The parties are encouraged to stipulate to facts or use

other means to present the evidence without the need for a motion to seal. The parties are reminded that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

V. *Deposition Testimony*

We remind the parties that if deposition testimony is submitted as an exhibit, the parties should file the full transcript of the deposition rather than excerpts of only those portions being cited by the parties.

VI. *Motions Lists*

Patent Owner's Motions List included several motions, such as a contingent motion to amend, which were listed essentially as place holders. Paper 16. We remind the parties that that there is no need to include such motions in the list of proposed motions that are automatically authorized to be filed during the proceeding, such as motions for observations on cross-examination. Moreover, there is also no need to list a motion as only a place-holder.

As to the possible motion to amend, we remind Patent Owner that although it may file one motion to amend the patent by cancelling or substituting claims without Board authorization, Patent Owner must confer with the Board before filing such a motion to amend. 37 C.F.R. § 42.121(a). Guidance on motions to amend is provided in the Board's Trial Practice Guide and recent decisions, especially those in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB) (Papers 26 and 66), *Nichia Corp. v. Emcore Corp.*, IPR2012-00005

(PTAB) (Papers 27 and 68), and *ZTE Corp. v. ContentGuard Holdings, Inc.*, IPR2013-00136 (PTAB) (Papers 32 and 33).

Patent Owner did request authorization to file a motion to permit video recording of deposition testimony, and in particular, the deposition of Dr. Nelson. Patent Owner noted that it offered to cover the expense of video-taping the deposition, and would also make its own experts available for video-recorded deposition. Petitioner objects on the basis that the rules require that the parties agree to video recording of deposition testimony. *See* 37 C.F.R. § 42.53(a) (“Parties may agree to video-recorded testimony, but may not submit such testimony without prior authorization of the Board.”).

By recording the deposition, Patent Owner is only preserving an opportunity for the panel to review the video. We, therefore, authorize the video-taping of the depositions at Patent Owner’s expense. *See, e.g.*, Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48612 , 48622-23 (Aug. 14, 2012) (stating that “[i]f the nature of the testimony makes direct observation of the witness demeanor necessary or desirable, the Board may authorize or even require that the testimony be presented live or be video-recorded in addition to filing of the required transcript”). That authorization, however, does not extend to the filing of the video-taped deposition transcripts, for which separate authorization is required under 37 C.F.R. § 42.53.

Petitioner also filed a Motions List. Paper 17. Petitioner’s Motions List, however, was not just a list of proposed motions, but was in fact, the substance of the motions that Petitioner wished to file. We reminded Petitioner that the motions list is exactly that, a list a proposed motions. For example, Petitioner could have listed a motion for additional discovery, setting forth those items for which it was

seeking discovery, as well as only listed a motion to stay prosecution of co-pending application 13/011,164. Because Petitioner's Motions List is, in essence, an unauthorized motion, we expunge it from the record.

Petitioner, in its Motions List, discussed a Motion for Additional Discovery, as well as a Motion to Stay Prosecution of SN 13/011,164.

As to the motion for additional discovery, Petitioner stated that it wished a copy of a slideshow shown to the Examiner during prosecution, before allowance of the case. According to Petitioner, it should have been part of the prosecution history of the patent at issue in the instant proceeding. Patent Owner responded that it may file the slideshow with its Patent Owner Response. Patent Owner further noted, that if the client agreed, it would supply Petitioner with a copy of the slideshow within two weeks of this call.

As to the remaining items on which Petitioner wished additional discovery, the parties agreed to confer as to any such discovery to see if they could come to an agreement between them. The panel noted that if the parties could not come to an agreement as to any such discovery, they could at that time request a conference call. The parties were reminded that they should refrain from making any arguments in the email requesting the conference call. Rather, the email should simply state the purpose of the call. In the case of a request for additional discovery, the party requesting the call could simply list those items they for which they are seeking discovery. We did remind the parties, however, that conferring with each other to determine those issues on which agreement may be reached before requesting a conference call, is always preferred.

We do not authorize Petitioner to file a motion to stay prosecution of co-pending application 13/011,164. In that regard, we pointed the parties' attention to *EMC Corp. v. Personal Web Technologies, LLC.*, IPR2013-00083 (PTAB) (Paper

12), which notes that while the Board may stay a reexamination proceeding pursuant 35 U.S.C. § 315(d) in the situation where the involved patent is the subject of reexamination proceeding, there is nothing in the statute that extends that authority to allow the Board to take jurisdiction over related applications.

Accordingly, it is

ORDERED that Patent Owner is authorized to take the depositions of Petitioner's experts via video recording, and Patent Owner shall bear the costs of the video-taped depositions;

FURTHER ORDERED that the authorization granted in this order does not extend to the submission of such video-taped testimony as evidence in the proceeding without a separate authorization of the Board pursuant to 42 C.F.R. § 53;

FURTHER ORDERED that Paper 17 is expunged;

FURTHER ORDERED that Patent Owner must confer with the Board before the filing of any motion to amend; and

FURTHER ORDERED that no other motions, other than those already authorized by rule or order, are authorized at this time.

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