

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOMARIN PHARMACEUTICAL INC.
Petitioner,

v.

DUKE UNIVERSITY
Patent Owner.

Case IPR2013-00535
Patent 7,056,712 B2

Before LORA M. GREEN, JACQUELINE WRIGHT BONILLA, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

A conference call was held on Thursday, September 11, 2014, among John White, representing Patent Owner; Mary Armstrong, representing Petitioner; and Judges Green, Bonilla, and Snedden. The purpose of the call was to discuss Petitioner's request to file an opposition to Patent Owner's Motion to Exclude Evidence (Paper 73), as well as any appropriate supporting evidence.

Initially, we note that Petitioner is authorized to file the opposition, as well as any appropriate supporting evidence. *See* Paper 17 at 4 (authorizing an opposition to a motion to exclude, and a reply to opposition to motion to exclude). Patent Owner responded that Petitioner should not be allowed to file any supporting evidence with its opposition. Specifically, according to Patent Owner, Petitioner failed to file any supplemental evidence under 37 C.F.R. 42.64(b)(2) in response to Patent Owner's objections.

Petitioner responded that it did not have any supporting evidence in mind when it was requesting authorization. We reiterated that Petitioner could file appropriate supporting evidence, but that Petitioner would have to explain in its opposition why the evidence is "appropriate." Moreover, Patent Owner will have an opportunity, in its reply to the opposition, to point out why any evidence that may be filed by Petitioner should not be considered.

Patent Owner also requested authorization to substitute Mr. Steven Zelesin for Mr. Herman Yue as back-up counsel. Patent Owner noted that Mr. Yue has left Patterson Belknap Webb & Tyler LLP, and that Mr. Zalesin has already been admitted *pro hac vice* in this proceeding. We noted that all Patent Owner needs do to replace backup counsel is to file updated mandatory notices, listing Mr. Zalesin as back-up counsel.

Patent Owner also requested clarification as to how oral hearings will be conducted on Friday, October 3, 2014, in the three *inter partes* review proceedings filed by Petitioner, for which Patent Owner, Duke, is only a party to one of those proceedings. We noted that we would hear the two proceedings with the same Patent Owner, *i.e.*, IPR2013-00534 and IPR2013-00537, together, most likely in the morning, and hear the instant proceeding

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in the afternoon. An order addressing the October 3, 2013 hearings will be issued shortly.

It is:

ORDERED, that Petitioner is authorized to file an opposition to Patent Owner's Motion to Exclude Evidence, as well as any appropriate supporting evidence.

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