

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS, LLC,
Petitioner,

v.

ENDO PHARMACEUTICALS INC.,
Patent Owner.

Case IPR2014-01365
Patent 8,329,216 B2

Before TONI R. SCHEINER, JACQUELINE WRIGHT BONILLA, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

A conference call in the above proceeding was held on November 12, 2014, between Judges Scheiner, Bonilla, and Snedden, and respective counsel for Petitioner and Patent Owner. The purpose of the call was to discuss Patent Owner's request for authorization to file, with its patent owner preliminary response, a transcript of deposition testimony of Dr. Anthony Palmieri taken in Case No. IPR2014-00360 involving the same patent and parties.

During the call, Patent Owner argued that Dr. Palmieri's deposition transcript, which is Exhibit 2012 in Case IPR2014-00360, presented testimony relevant to limitations in claims 72–82 of U.S. Patent No. 8,329,216 B2 (“the '216 patent”), a subset of claims challenged in the current proceeding. Patent Owner argued that contentions in the current Petition regarding inherency of those claims, as discussed in a Declaration by Dr. Palmieri (Ex. 1003) submitted by Petitioner, were refuted by statements made by Dr. Palmieri during his deposition in the other proceeding. Petitioner responded that a patent owner preliminary response may not present such testimonial evidence under 37 C.F.R. § 42.107(c), and that allowing such testimony at this time would not be in the interests of justice.

Under § 42.107(c), a patent owner preliminary response “shall not present new testimony evidence beyond that already of record, except as authorized by the Board.” In this case, the Petition was accorded a filing date of August 22, 2014. Paper 6. In Case IPR2014-00360, Patent Owner's counsel deposed Dr. Palmieri on September 24, 2014, a month later. IPR2014-00360, Ex. 2012. Thereafter, Patent Owner filed the transcript from the deposition as Exhibit 2012 on

October 27, 2014, with its Patent Owner Response. IPR2014-00360, Papers 31 and 32. Thus, Dr. Palmieri's deposition transcript corresponds to new testimony prohibited at this stage of the proceeding, as it was filed in a different IPR proceeding after Petitioner filed its Petition in this case. *See C&D Zodiac, Inc. v. B/E Aerospace, Inc.*, Case IPR2014-00727, slip op. at 18 (PTAB Oct. 29, 2014) (citing *FLIR Sys., Inc. v. Leak Surveys, Inc.*, 2014 WL 4444040, *15 (PTAB Sept. 5, 2014)).

The Board may permit, in its discretion, new testimonial evidence in a preliminary response if the patent owner demonstrates that such evidence is in the interests of justice. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764 (Aug. 14, 2012). For example, the Board may permit new testimonial evidence if it addresses issues relating to a petitioner's standing, or otherwise demonstrates that a trial may not be instituted. *Id.*

Here, however, Patent Owner has not established sufficiently that authorizing the filing of Dr. Palmieri's deposition transcript is in the interests of justice. While Patent Owner contends that the transcript evidence is relevant to Petitioner's challenge of claims 72–82, the current Petition also challenges claims 5, 16, 44, 46, and 47 of the '216 patent. Thus, even assuming the new testimonial evidence establishes that the Petitioner fails to show a reasonable likelihood that it would prevail regarding claims 72–82, we still might institute trial on one or more of the other challenged claims. We point out that if trial is instituted, Patent Owner will have the opportunity to rely on new testimonial evidence with its patent owner response.

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According, it is:

ORDERED that Patent Owner is not authorized to file the deposition testimony of Dr. Anthony Palmieri, taken in Case No. IPR2014-00360, with its patent owner preliminary response.

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