

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CYANOTECH CORPORATION
Petitioner

v.

THE BOARD OF TRUSTEES OF THE UNIVERSITY OF ILLINOIS
Patent Owner

Cases IPR2013-00401 and IPR2013-00404 (consolidated)
Patent 5,527,533

Before SCOTT E. KAMHOLZ, SHERIDAN K. SNEDDEN, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

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

A conference call was conducted on April 30, 2014 to discuss (a) the University's request for authorization to file a motion to submit supplemental information, and (b) Cyanotech's request for clarification regarding reply evidence.

A. The University's request

The University seeks to file documents that Cyanotech produced to the University during the course of discovery, in a related case, months before the University's Patent Owner Response was filed, but that the University became aware of only after filing its Response. The University explains that the documents formed part of a production in December 2013 that included approximately 100,000 to 200,000 pages. Cyanotech does not dispute the size of the production but says that the documents were produced in October 2013. The University contends that the documents are literature distributed by Cyanotech in which Cyanotech states that spectroscopy is not a reliable method for detecting astaxanthin. The University argues that these documents are relevant to this proceeding because some of the prior art Cyanotech relies upon states that astaxanthin was detected using spectroscopy. Cyanotech argues that it would be prejudiced by the late submission of this information because it is about to conduct cross-examination of the University's technical expert, and because its Reply to the Patent Owner Response is due May 21, 2014.

We authorized the University to file a motion to submit supplemental information by May 2, 2014 and for Cyanotech to file an opposition by May 6, 2014. We reminded the University that its motion must comply with the requirements of 37 C.F.R. §§ 42.20 and 42.123. In particular, the University must show that it is entitled to the relief requested and that consideration of the supplemental information is in the interests of justice. The motion and the opposition are each limited to five pages. No reply by the University is authorized.

The parties agreed, with our approval, that Cyanotech may question the University's technical witness about the supplemental documents during deposition, but that such testimony will be excluded from this proceeding if the motion is not granted.

B. Cyanotech's request

Cyanotech asked whether it needs permission to file a declaration with its Reply that is responsive to arguments made in the University's Patent Owner Response, and whether it needs permission to file a complete transcript of the University's deposition of Dr. Schweigert. We explained that Cyanotech requires permission for neither. We reminded Cyanotech that reply evidence must be responsive, i.e., directly refuting response evidence, and not new evidence. As to the deposition transcript, we reminded the parties that the proponent of deposition evidence is required to file a complete transcript of the deposition. 37 C.F.R. § 42.53(f)(7). The parties agreed that Cyanotech will file a complete transcript of Dr. Schweigert's deposition.

Accordingly, it is

ORDERED that the University is authorized to file a motion to submit supplemental information by May 2, 2014;

FURTHER ORDERED that Cyanotech is authorized to file an opposition to the motion by May 6, 2014;

FURTHER ORDERED that the motion and the opposition are each limited to five pages;

FURTHER ORDERED that the University is not authorized to file a reply;
and

Cases IPR2013-00401, -00404
Patent 5,527,533

FURTHER ORDERED that Cyanotech shall file a complete transcript of the deposition of Dr. Schweigert with its Reply to the Patent Owner Response, using a new exhibit number.

For PETITIONER:

Joseph A. Rhoa
NIXON & VANDERHYE P.C.

George E. Darby
PARADISE PATENT SERVICES, INC.

For PATENT OWNER:

Mark D. Schuman
Iain A. McIntyre
Todd Werner
CARLSON CASPERS