

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOVEN PHARMACEUTICALS, INC.,
Petitioner,

v.

NOVARTIS AG AND LTS LOHMANN THERAPIE-SYSTEME AG,
Patent Owners.

Case IPR2014-00549 (Patent 6,316,023 B1)
Case IPR2014-00550 (Patent 6,335,031 B1)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This decision addresses issues that are identical in the two cases. We, therefore, exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading for any papers.

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IPR2014-00550 (Patent 6,335,031 B1)

The initial conference call for this case was held on October 30, 2014, between Mr. Steven J. Lee, Mr. Michael K. Levy, counsel for Petitioner, Noven Pharmaceuticals, Inc.; Mr. Raymond R. Mandra, Mr. Nicholas N. Kallas, counsel for Patent Owner, Novartis AG and LTS Lohmann Therapie-Systeme AG; and Administrative Patent Judges Prats, Franklin, and Kamholz. Petitioner and Patent Owner each filed a List of Proposed Motions (Papers 12 and 13)².

The following matters were discussed during the call.

Scheduling Order

Both parties confirmed that they have stipulated to modify DUE DATES 1-3 of the Scheduling Order. The parties are reminded that a stipulation is not effective until a notice of it is filed with the Board.

Related Cases

The parties were reminded of their obligation to update their mandatory notices within twenty-one (21) days of any change in the information provided therein, including changes in the status of co-pending litigation. *See* 37 C.F.R. § 42.8(a)(3).

Pro Hac Vice Motion

Patent Owner anticipates filing a motion for *pro hac vice* admission of Ms. Charlotte C. Jacobsen. We reminded the parties that such motion is authorized in the Notice of Filing Date Accorded to the Petition (Paper 4). Such motion shall be filed in accordance with the “Order -- Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under “Representative Orders, Decisions, and Notices.” The parties are advised that under 37

² Paper numbers cited in this Order relate to each case.

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C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. We also advised Patent Owner to indicate in the motion whether Petitioner opposes the motion. Petitioner was advised that a party seeking to oppose a motion for *pro hac vice* admission must file its opposition no later than one week after the filing of the underlying motion.

Protective Order

We noted that a protective order has not been entered in these proceedings. Petitioner and Patent Owner indicated that they may seek entry of a protective order. If the parties file a motion to seal, and no protective order has been entered, a protective order must accompany the motion as an exhibit. The panel recommended 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, we 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.

Motion 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

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understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). Board authorization is not required before the filing of a motion to seal.

Motion to Amend

In Patent Owner's List of Proposed Motions, Patent Owner stated that it does not intend to request to file a motion to amend the challenged claims of the patents at issue in these proceedings.

Remaining Motions

The parties confirmed that the remaining motions included in their respective lists of proposed motions are not intended to be filed imminently and do not require Board attention at this time. The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). The party seeking to file a motion should request a conference to obtain authorization to file the motion.

Responses to Objections to Evidence

Petitioner sought guidance regarding responding to Patent Owner's objections to evidence. As provided by 37 C.F.R. § 42.64(b)(2), the party relying on evidence to which an objection is served timely may respond to the objection by serving supplemental evidence within ten business days of service of the objection. If the parties agree that the supplemental evidence cures the alleged defect in the evidence, the parties are directed to seek authorization to file a motion to correct the relevant exhibit(s) or paper(s). If an objection is not resolved, the party who timely served the objection may file a motion to exclude evidence to preserve the objection no later than DUE DATE 4. *See* 37 C.F.R. § 42.64(c).

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