

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHIGENIX, INC.,
Petitioner,

v.

IMMUNOGEN, INC.,
Patent Owner.

Case IPR2014-00676
Patent 8,337,856 B2

Before FRANCISCO C. PRATS, JACQUELINE WRIGHT BONILLA, and
ZHENYU YANG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

1. Introduction

On December 2, 2014, an initial conference call was conducted between respective counsel for the parties and Judges Prats, Bonilla, and Yang. Phigenix Inc. (“Petitioner”) was represented by counsel, Ping Wang and Gregory Porter. Immunogen, Inc. (“Patent Owner”) was represented by counsel, Eldora Ellison and Eric Steffe. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Papers 12, 13), and to discuss any motions contemplated by the parties. Prior to the call, Patent Owner filed a paper requesting authorization to file a motion for observations on cross-examination. Paper 14.

2. Scheduling Order

Neither party indicated any issues with respect to the Scheduling Order. We reminded the parties that, without obtaining prior authorization from the Board, they may stipulate to different dates for DUE DATES 1-5 by filing an appropriate notice with the Board.

3. Discovery

There are no discovery issues pending at this time. We remind the parties of the discovery provisions of 37 C.F.R. §§ 42.51–52 and Office Patent Trial Practice Guide. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48761-2 (Aug. 14, 2012). As noted in 37 C.F.R. § 42.51(b)(2)(i), the parties may agree to additional discovery between themselves. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 42.64, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48767.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Patent Trial Practice Guide at 77 Fed. Reg. at 48772, App. D.

4. No Proposed Motion to Amend

During the conference call, counsel for the Patent Owner indicated that Patent Owner will not file a motion to amend.

5. Motion for observation regarding cross-examination of reply witness

As stated in the conference call, each party may file a motion for an observation on the cross-examination testimony of a reply witness by DUE DATE.

4. Likewise, each party may file a response to an observation on cross-examination testimony by DUE DATE 5.

6. Motions

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). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No other motions are authorized in this proceeding at this time.

7. Protective Order

The parties have not discussed a protective order at this time. No protective order has been entered. Should circumstances change, the parties are reminded of the requirement for a protective order when filing a Motion to Seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default

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protective order in Appendix B to the Board's Office Patent Trial Practice Guide.
See id. at 48,769.

Accordingly, it is

ORDERED that Patent Owner and Petitioner are each authorized to file a motion for an observation on the cross-examination testimony of a reply witness by DUE DATE 4 in the Scheduling Order (Paper 13);

FURTHER ORDERED that Patent Owner and Petitioner are each authorized to file a response to an observation on cross-examination testimony by DUE DATE 5 in the Scheduling Order; and

FURTHER ORDERED that no other motions are authorized at this time, other than those already authorized by rule, the Notice of Filing Date Accorded to Petitioner, the Scheduling Order; and

FURTHER ORDERED that due dates specified in the Errata Scheduling Order dated November 20, 2014, remain unchanged.

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