

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METRICS, INC., MAYNE PHARMA, and JOHNSON MATTHEY, INC.
Petitioners,

v.

SENJU PHARMACEUTICAL CO., LTD., BAUSCH & LOMB, INC., and
BAUSCH & LOMB PHARMA HOLDINGS CORP.
Patent Owners.

Case IPR2014-01041 (Patent 8,129,431 B2)
Case IPR2014-01043 (Patent 8,669,290 B2)¹

Before FRANCISCO C. PRATS, ERICA A. FRANKLIN, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

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

¹ This order addresses issues common to both cases, therefore, we issue a single order to be entered in each case. The parties are not authorized to use this style heading.

IPR 2014-01041 (Patent 8,129,431 B2)
IPR 2014-01043 (Patent 8,669,290 B2)

On June 26, 2014, Petitioners filed petitions (Papers 1, 1)² in these proceedings. On July 22, 2104, the petitions were accorded a filing date of June 26, 2014, and certain defects in the petitions were identified—including failure to sequentially number each page of the exhibits; and failure to provide a complete exhibit list. Papers 5 at p. 2, 5 at p. 2. Petitioners were provided five business days within which to correct those defects. *Id.* Petitioners filed corrected petitions (Papers 6, 6) on July 29, 2014, and notices of accepting those corrected petitions (Papers 7, 7) issued on July 31, 2014.

On August 11, 2014, Patent Owner requested a telephone conference with the Board to discuss several outstanding procedural errors in the corrected petitions. A call was held on August 14, 2014, between Petitioners' counsel, Patent Owners' counsel, and Administrative Patent Judges Prats, Franklin, and Obermann. Based on the information provided during the call, and our review of the record, we are persuaded that the corrected petitions are defective and that those papers should not have been accepted without further correction. *See* Papers 7, 7 (accepting corrected petitions). During the course of the telephone conference, the parties arrived at an agreement regarding resolution of the issues presented, which we adopt and summarize, as follows:

Petitioners are directed to file, no later than Wednesday, August 20, 2014, second corrected petitions that comply with the instructions set forth in this order. The filing date accorded the petitions—June 26, 2014—is not affected by this order. *See* Papers 5, 5. Patent Owners' time for filing a preliminary response is

² Paper numbers refer to IPR 2014-01041 and IPR 2014-01043 in sequence.

IPR 2014-01041 (Patent 8,129,431 B2)

IPR 2014-01043 (Patent 8,669,290 B2)

reset to no later than three months after the date on which Petitioners file second corrected petitions.³

In each proceeding, Petitioner is directed to expunge all exhibits, and refile a new set of exhibits, wherein (1) each exhibit has an exhibit label beginning with Ex. 1001, and continuing sequentially in the range 1001-1999 as needed; and (2) each page of each exhibit is uniquely numbered in sequence. For guidance, Petitioner is directed to 37 C.F.R. § 42.63.

In each proceeding, Petitioner is directed to file a second corrected petition that is identical in substance to the corrected petition filed on July 29, 2014, except that: (1) The Appendix and all references to it shall be deleted from the second corrected petition; and (2) the second corrected petition shall refer to the newly-filed exhibits by number without any explanation as to how the exhibit replaces an expunged exhibit, or any further reference to expunged exhibits.

All exhibits referred to in a second corrected petition and filed in a proceeding pursuant to this order—as well as all exhibits referred to in any declaration or other evidence filed in that proceeding—shall be included in the Exhibit List of the second filed petition filed in that proceeding.

The second corrected petitions shall comply with the formatting requirements of 37 U.S.C. § 42.6 and the page limits for petitions set forth in 37 U.S.C. §42.24.

Failure to comply with this order, within the time prescribed, shall result in an order to show cause why the Board should not deny *inter partes* review in these proceedings.

³ The date of the Notice of the Filing Date Accorded to Petition shall be changed to reset in PRPS the due date for the filing of the Preliminary Response. That change is administrative only and shall not alter the filing date accorded the petitions of June 26, 2014.

IPR 2014-01041 (Patent 8,129,431 B2)
IPR 2014-01043 (Patent 8,669,290 B2)

For the foregoing reasons, it is

ORDERED that Petitioners are directed to file, no later than Wednesday, August 20, 2014, second corrected petitions that comply with the instructions set forth in this order;

FURTHER ORDERED that the filing date accorded the petitions—June 26, 2014—is not affected by this order; and

FURTHER ORDERED that Patent Owners' time for filing a preliminary response is reset to no later than three months after the date on which Petitioners file second corrected petitions.

PETITIONERS:

Patrick D. McPherson
Vincent L. Capuano
DUANE MORRIS LLP
PDMcPherson@duanemorris.com
VCapuano@duanemorris.com

PATENT OWNERS:

M. Andrew Holtman
Jonathan R.K. Stroud
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
Andy.Holtman@finnegan.com
Jonathan.Stroud@finnegan.com