

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 authorized to use this style heading when filing identical papers in both proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

IPR2014-01041 (Patent 8,129,431 B2)

IPR2014-01043 (Patent 8,669,290 B2)

On September 8, 2014, counsel for Patent Owner requested a conference call with the Board to address alleged “further substantive and procedural errors” contained in Petitioner’s recently filed revised Mandatory Notices. Email dated Sept. 8, 2014 (attached). Counsel for Patent Owner further sought leave to request as relief “that the Board deny *inter partes* review in these proceedings.” *Id.* A conference call was held on September 9, 2014. During the conference call, it became apparent that Petitioner’s revised Mandatory Notices filed September 4, 2014, did not contain or involve substantive or procedural errors warranting dismissal of the Petition. It also became apparent, however, that Patent Owner’s Mandatory Notices are incomplete.

Patent Owner’s request to deny *inter partes* review based on Petitioner’s failure to comply with Board rules regarding the filing of revised mandatory notices is denied. Patent Owner shall file revised mandatory notices no later than September 10, 2014.

Going forward, the parties shall make reasonable efforts to meet and confer to resolve disputes before involving the Board. When a party in these proceedings sends an email to the Board requesting a telephonic conference call, counsel shall include a certification that the meet-and-confer has taken place, or a full statement explaining why a meet-and-confer could not take place prior to involving the Board. That email shall also fairly describe the nub of the dispute, providing the facts and authority that relate to the dispute, without attorney argument.

For the foregoing reasons, it is

ORDERED that Patent Owner’s request for denial of *inter partes* review based on Petitioner’s failure to comply with Board rules regarding the filing of mandatory notices is *denied*;

IPR2014-01041 (Patent 8,129,431 B2)

IPR2014-01043 (Patent 8,669,290 B2)

FURTHER ORDERED that Patent Owner shall file updated mandatory notices no later than September 10, 2014; and

FURTHER ORDERED that the parties shall comply with the meet-and-confer requirements set forth in this order before involving the Board in future disputes.

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For Patent Owner:

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

ATTACHMENT

Subject: IPR2014-01041 and IPR2014-01043: Seeking Board Conference Call

Mrs. Vignone—Patent Trial and Appeal Board,

Patent Owner Senju would like to request a conference call with the Board and the parties to discuss further substantive and procedural errors related to Metrics' improper, delayed, and unauthorized filing of Mandatory Notices on September 4, 2014 in IPRs2014-01041 and -01043, and to request that the Board deny *inter partes* review in these proceedings.

Patent Owner's counsel is available Monday afternoon and Tuesday all day, or later in the week at the Board's convenience.

Warm regards,

Jonathan R.K. Stroud

Patent Attorney

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