

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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*.

INITIAL CONFERENCE SUMMARY AND ORDER

Conduct of the Proceeding
Granting Extension of Time for Motion
37 C.F.R. §§ 42.5, 42.123(a)

¹ The parties are not authorized to use this style caption.

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

A consolidated initial conference call in both proceedings was held on March 17, 2015, between counsel for the parties and Judges Prats, Franklin, and Obermann. Patent Owner supplied a court reporter and agreed to file a true copy of the transcript of the call, as an exhibit in both proceedings. Petitioner and Patent Owner each filed a list of proposed motions. The following matters were discussed during the call.

Scheduling Order

Neither party expressed concerns about, or proposed any changes to, the schedule. Lead counsel for Patent Owner and lead counsel for Petitioner both confirmed their availability to attend the final oral hearing scheduled for November 12, 2015 (Due Date 7).

Related Cases

The parties indicated that neither of the two related district court actions is currently stayed pending the outcome of these administrative proceedings. *See Senju Pharmaceutical Co. v. Lupin, Ltd.*, C.A. No. 1:14-CV-00667-MAS-LHG (D.N.J.); *Senju Pharmaceutical Co. v. Metrics, Inc.*, C.A. No. 1:14-cv-03962-JBS-KMW (D.N.J.). We directed counsel to jointly apprise the Board, within five (5) business days, should a request to stay, or a motion to dismiss, be granted in either district court action.

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Motion to Seal and Joint Motion for a Protective Order

Patent Owner indicated that it is considering filing a motion to seal confidential information and a related motion to enter a protective order.

We advised counsel for both parties that a protective order does not exist in these proceedings until one is filed and approved by the Board. If a motion to seal is filed by either party, the proposed protective order should be presented as an exhibit to the motion. The parties are urged to operate under the Board's default protective order, should a need arise for a protective order. *See* Default Protective Order, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, App. B (Aug. 14, 2012).

If the parties choose to propose a protective order that deviates from the default protective order, they should submit the proposed protective order jointly. A marked-up comparison of the proposed and default protective orders should be presented as an additional exhibit to the motion, so that differences can be understood readily. If the parties cannot agree on the terms of the proposed protective order, they should contact the Board.

Redactions to documents filed in this proceeding should be limited strictly to isolated passages, consisting entirely of confidential information, and the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. Information subject to a protective order will become public if identified in our final written decision, and a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761.

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Motion to Amend

Patent Owner indicated that it is considering filing a motion to amend as well as a motion to waive the page limits related to motions to amend.

We instructed Patent Owner that, should it decide to file a motion to amend, counsel must confer with the Board before filing the motion. We directed counsel to the guidance for motions to amend that is posted on the Board's web site, www.uspto.gov/ptab. We also directed counsel to the guidance provided in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, Paper 26 (PTAB June 11, 2013) (providing general guidance on motions to amend); *see also* Paper 66, slip op. at 26–38 (PTAB Jan. 7, 2014). A conference, concerning the motion to amend, should be requested in time to occur at least two weeks before May 19, 2015 (Due Date 1).

We advised Patent Owner also that a motion to waive page limits is premature at this time. Counsel must seek Board pre-authorization before filing such a motion and, in the event that such authorization is sought, we will require Patent Owner to demonstrate good cause for that unusual remedy. The appropriate time to seek authorization for that purpose is during the conference call on the motion to amend.

Motions to Exclude

Patent Owner indicated that it is considering filing a motion to exclude. All motions to exclude must be filed no later than October 8, 2015

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(Due Date 4). We encouraged each party to file a single motion to exclude in each proceeding by that date, and explained that, generally, such motions are resolved in the Final Written Decision.

Motion to File Supplemental Information

Petitioner indicated that it may request authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a). Petitioner informed that Board that the supplemental information, sought to be submitted, is, in fact, supplemental evidence raised in response to Patent Owner's objections to the authenticity of certain exhibits filed by Petitioner. Specifically, Petitioner stated that the supplemental evidence is limited to a certificate of foreign translation and certain publication information, which has not yet been served on Patent Owner in response to those objections. *See* 37 C.F.R. § 42.64(b)(2). We explained that any request for authorization to file a motion, therefore, is premature.

Petitioner's time for requesting authorization to file a motion to submit supplemental information, under 37 C.F.R. § 42.123(a), will expire in these proceedings on March 19, 2015. Counsel for both parties agreed to meet and confer, prior to March 26, 2015, in an effort to resolve without Board involvement, any dispute surrounding the sufficiency of Petitioner's supplemental evidence. To the extent a dispute remains, counsel for Petitioner requested, and we granted, an extension of the time to request authorization to file a motion to submit supplemental information under 37

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