

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANTARES PHARMA, INC., LEO PHARMA A/S AND
LEO PHARMA INC.,
Petitioner,

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE
SPEZIALPRÄPARATE MBH.,
Patent Owners.

Case IPR2014-01091
Patent 8,664,231 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges.*

FRANKLIN, *Administrative Patent Judge.*

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

The initial conference call for this case was held on January 21, 2015, between Mr. Sanya Sukduang, Mr. Thomas Jenkins, counsel for Petitioner, Antares Pharma, Inc., Leo Pharma A/S and Leo Pharma Inc.; Mr. James F. Haley, Mr. Ching-Lee Fukuda, counsel for Patent Owner, Medac Gesellschaft für klinische Spezialpräparate mbH; and Administrative Patent Judges Scheiner, Franklin, and Bonilla. The parties indicated that a court reporter was present on the call.¹

The following matters were discussed during the call.

Scheduling Order

Counsel for Patent Owner provided details regarding a request submitted to counsel for Petitioner to extend certain due dates listed in the Scheduling Order by one week. Petitioner's counsel explained that they have not agreed yet to the proposed modification. We encouraged the parties to meet, confer, and agree upon requests to modify DUE DATES 1–5 that are reasonable. The parties were reminded that once an agreement is reached, notice of such stipulation must be promptly filed. Additionally, counsel for each party confirmed their availability on August 17, 2015, for oral argument, if necessary.

Related Cases

The parties provided updates on the status of co-pending district court cases. We remind the parties of their obligation to update their mandatory notices within twenty-one (21) days of any changes in the information provided therein, including any further changes in the status of co-pending litigations. *See* 37 C.F.R. § 42.8(a)(3).

¹ We requested the parties to file with the Board as an Exhibit a copy of the transcript prepared by the court reporter.

Additional Discovery Request

Counsel for Patent Owner described a request submitted to counsel for Petitioner for the discovery of documents containing information relating to, for example, the Safety and Tolerance Study disclosed in Grint, Ex. 1003,² and statements made in the Declaration of Dr. Michael E. Wineblatt, Ex. 1012, ¶ 33. Both parties confirmed that they have not had an opportunity to meet and confer regarding this discovery request. We instructed the parties to do so, and encouraged them to consider points that each party raised during the discussion of the issue during this call. For example, if Petitioner is aware that any of the requested documents or information are publicly available, we recommended that Petitioner direct Patent Owner to that source. Further, we suggested that Patent Owner consider whether the limited information sought from the requested documents, i.e., the concentration of methotrexate administered in certain studies, may be obtained and confirmed in another acceptable manner, e.g., by deposition, stipulation, or the production of small portions of relevant documents. If the parties are unable to resolve satisfactorily the discovery request, counsel for Patent Owner may request a conference call to seek authorization to file a motion for such discovery. *See* 37 C.F.R. § 42.52(a)(2).

Protective Order

We noted that a protective order has not been entered in this proceeding. If either party seeks to have a protective order entered, we recommend 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 suggest scheduling a

² US 6,544,504 B1, issued Apr. 8, 2003.

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conference with the Board for guidance. If either party seeks to file a motion to seal, and no protective order has been entered, a protective order must accompany the motion as an exhibit.

Upon confirming that the parties did not have additional motions or matters to discuss, the initial conference call was adjourned.

PETITIONER:

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