

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS VI, LLC,
Petitioner,

v.

CELGENE CORPORATION,
Patent Owner.

Case IPR2015-01092 (Patent 6,045,501)
Case IPR2015-01096 (Patent 6,315,720 B1)
Case IPR2015-01102 (Patent 6,315,720 B1)
Case IPR2015-01103 (Patent 6,315,720 B1)¹

Before MICHAEL P. TIERNEY, GRACE KARAFFA OBERMANN, and
TINA E. HULSE, *Administrative Patent Judges*.

TIERNEY, *Administrative Patent Judge*.

ORDER
37 C.F.R. § 42.5

¹ This Order addresses issues common to all identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading.

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A conference call was held on June 13, 2016 between respective counsel for the parties and Judges Tierney, Obermann and Hulse. The purpose of the call was to discuss Patent Owner's allegation that Petitioner's replies exceed the scope of a proper reply under 37 C.F.R. § 42.23(b) and Patent Owner's allegation that Petitioner's replies exceed the word limit set forth in 37 C.F.R. § 42.24(c).

Word Count

Patent Owner alleged that Petitioner's replies in IPR2015-01092, -1102, and -1103 exceeded the 5,600 word limit provided by rule. Specifically, Patent Owner alleged that Petitioner exceeded the word limit in amounts ranging from 62 to 93 words. Petitioner noted that the alleged discrepancy in word count arose from the use of block quotes appearing in images that were not counted by its word processor.

When certifying word count, a party need not go beyond the routine word count supplied by their word processing program. However, parties should be careful not to abuse the process. Excessive words in figures, drawings or images, deleting spacing between words, or using excessive acronyms or abbreviations for word phrases, in order to circumvent the rules on word count, may lead to dismissal of a party's brief. *See, e.g., Pi-Net Int'l, Inc. v. JPMorgan Chase & Co.*, 600 Fed. App'x. 774 (Fed. Cir. 2015) (per curiam). The alleged discrepancy in word count is noted but, based on the record presented, no action will be taken as the noted discrepancies are not excessive and do not appear to be an attempt to circumvent the rules on word count.

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Sur-Reply

Patent Owner alleges that Petitioner improperly raised new issues in its replies and requests that the Board strike the replies. Specifically, Patent Owner alleges that Petitioner's replies rely upon three (3) references that were not previously relied upon. Patent Owner requests authorization to strike the replies and/or antedate the additional references.

Petitioner disagrees with Patent Owner's characterization of Petitioner's replies, and contends that the additional references are not new exhibits, but were already of record.

Based upon the facts presented the Board authorized Patent Owner to file a sur-reply in each case limited to addressing: 1) the alleged new issues raised in Petitioner's reply; and 2) antedating the references cited in Petitioner's reply. Petitioner is authorized to file an opposition in each case to Patent Owner's sur-reply.

The Board and the parties agreed that Patent Owner's sur-replies would be due June 29, 2016 and Petitioner's oppositions due July 11, 2016. To accommodate the additional briefing, the Board exercised its authority and set Due Date 6 to July 15, 2016.

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