

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,

Petitioner,

v.

HORIZON THERAPEUTICS, INC.,

Patent Owner.

Case IPR2015-01117 (Patent 8,642,012)
Case IPR2015-01127 (Patent 8,404,215)¹

Before GRACE KARAFFA OBERMANN, *Administrative Patent Judge*.

OBERMANN, *Administrative Patent Judge*.

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

¹ This order addresses issues common to all cases; therefore, we issue a single order to be entered in both cases. The parties are authorized to use this style heading when filing an identical paper 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.”

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By email on June 24, 2015, Patent Owner requested a telephone conference with the Board to seek authorization to file two motions in each proceeding: (1) a motion for additional discovery directed to Petitioner's identification of real parties-in-interest; and (2) a motion to dismiss the Petitions for improper incorporation by reference of claim construction arguments. Attachment 1. Regarding additional discovery as to real parties-in-interest, Patent Owner appended to the email a draft "Requests for Production and Interrogatories to Par Entities and TPG." Attachment 2. A telephone conference was held on June 26, 2015. Ms. Lauren Stevens represented Patent Owner. Mr. David Silverstein represented Petitioner.

After some discussion, the Board denied Patent Owner's request for authorization to file a motion for additional discovery directed to the proposed "Requests for Production and Interrogatories to Par Entities and TPG." *See* Attachment 2. We determined that those requests were unduly broad and, based on specific representations made during the call, we ruled that discovery of the information set forth therein was not necessary in the interest of justice. *See* 35 U.S.C. § 316(a)(5)(B); 37 C.F.R. § 42.51(b)(2)(i); *see also* *Garmin International, Inc. v. Cuozzo Speed Technologies, LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (enumerating factors that bear on whether a discovery request meets the statutory and regulatory standard of necessary "in the interest of justice").

Upon further discussion, however, Petitioner agreed to produce the Management Rights Agreement identified in Request for Production No. 3. Attachment 2, p. 4. Petitioner also agreed to provide Patent Owner information relevant to Request for Production No. 4, *id.*; that is, a written response identifying all entities who directed, or had authority to direct, the

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activities of Petitioner's witness, Dr. Neal Sondheimer, in connection with these proceedings. Patent Owner indicated that the production of those two items would be sufficient to satisfy its discovery needs at this time.

Patent Owner and Petitioner agreed to meet and confer to arrange the exchange of the agreed-upon information by close of business on June 29, 2015. The parties were invited to seek a second telephone conference with the Board, after June 29, 2015, if necessary to facilitate the resolution of any remaining dispute.

Patent Owner was provided an opportunity to explain its reasons for seeking authorization to file a motion to dismiss the Petitions for improper incorporation by reference of claim construction arguments. Attachment 1. We denied Patent Owner's request for authorization to file a motion to dismiss the Petitions, where Patent Owner indicated its intention to file a Preliminary Response. We advised Patent Owner that the Preliminary Response is the proper vehicle for raising its arguments in support of denial of review, including those arguments stated during the conference in connection with the proposed motion to dismiss. We determined that separate briefing, outside the confines of the page limits that apply to preliminary responses, is not warranted based on the particular representations made during the call. No further briefing was authorized.

It is

ORDERED that Patent Owner's request for authorization to file a motion seeking additional discovery is *denied*;

FURTHER ORDERED that Patent Owner's request for authorization to file a motion to dismiss the Petitions is *denied*; and

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FURTHER ORDERED that, by close of business on June 29, 2015, the parties shall meet and confer to arrange for the exchange of information, as agreed upon by the parties during the telephone conference, and as identified in this Order.

PETITIONER:

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ATTACHMENT 1

From: Lauren Stevens [contact information omitted]

Sent: Tuesday, June 23, 2015 7:07 PM

To: Trials

Cc: Dennis Bennett; Matthew Phillips; Freno, Michael J.; Murthy, Sanjay K.; Silverstein, David

Subject: IPR2015-01117 and IPR2015-01127

Dear PTAB:

The patent owner requests a conference call with the Board to seek authorization to file two motions in each of the above-referenced IPRs: (1) a motion for additional discovery regarding the real parties in interest of the petitioner and (2) a motion to dismiss the petitions for improper incorporation by reference of its claim construction positions.

The additional discovery sought via the first motion is attached to this email. Discovery against Par, the petitioner in this IPR, regarding the same issue was granted to a different patent owner in IPR2015- 00548 and IPR2015- 00551. The parties have met and conferred about this additional discovery but cannot reach an agreement. The petitioner wishes to delay discovery in this matter until a decision is made in the IPR2015- 00548 and IPR2015- 00551 cases. The patent owner wishes to take this discovery in time to incorporate it in its preliminary response, as the real-party-in-interest issue is dispositive in this case and may result in avoidance of two trials.

The motion to dismiss is based on patent owner's position that petitioner has not provided its claim construction, as required to give notice to patent owner. The patent owner believes that footnote 3 in IPR2015-01127 and in footnote 5 in IPR2015-01117 is an improper incorporation by reference of the petitioner's claim construction positions, which are required to be in the body of the petition. The petitioner disagrees. The parties have conferred but are unable to reach agreement on this issue.

Counsel for both parties are available 1:00 PM PT / 4:00 PM ET on both Thursday, June 25 and Friday, June 26.

Thank you for your attention to this matter.

Best regards,

Lauren

Lauren L. Stevens, Ph.D.

Reg. No. 36,691

[contact information omitted]

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