

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC,
Petitioner,

v.

CEPHALON, INC.,
Patent Owner.

Case IPR2016-00098 (Patent 8,791,270 B2)
Case IPR2016-00111 (Patent 8,895,756 B2)¹

Before JACQUELINE WRIGHT BONILLA, ZHENYU YANG, and
TINA E. HULSE, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

SCHEDULING ORDER

¹ This order addresses issues that are common to both cases. We, therefore, issue a single order that has been entered in each case. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the caption.”

IPR2016-00098 (Patent 8,791,270 B2)

IPR2016-00111 (Patent 8,895,756 B2)

A. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. The parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 6 and 7.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony (see section B, below).

The parties are reminded that the Testimony Guidelines appended to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (“Trial Practice Guide”) (Appendix D), apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys’ fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

1. INITIAL CONFERENCE CALL

The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions. *See* Trial Practice Guide, 77 Fed. Reg. at 48,765–66 (providing guidance in preparing for the initial conference call).

IPR2016-00098 (Patent 8,791,270 B2)

IPR2016-00111 (Patent 8,895,756 B2)

2. DUE DATE 1

The patent owner may file—

- a. A response to the petition (37 C.F.R. § 42.120), and
- b. A motion to amend the patent (37 C.F.R. § 42.121).

The patent owner must file any such response or motion to amend by DUE DATE 1. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

3. DUE DATE 2

The petitioner must file any reply to the patent owner's response and opposition to the motion to amend by DUE DATE 2.

4. DUE DATE 3

The patent owner must file any reply to the petitioner's opposition to the patent owner's motion to amend by DUE DATE 3.

5. DUE DATE 4

- a. Each party must file any motion for an observation on the cross-examination testimony of a reply witness (*see* section C, below) by DUE DATE 4.
- b. Each party must file any motion to exclude evidence (37 C.F.R. § 42.64(c)) and any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.

IPR2016-00098 (Patent 8,791,270 B2)

IPR2016-00111 (Patent 8,895,756 B2)

6. DUE DATE 5

a. Each party must file any response to an observation on cross-examination testimony by DUE DATE 5.

b. Each party must file any opposition to a motion to exclude evidence by DUE DATE 5.

7. DUE DATE 6

Each party must file any reply for a motion to exclude evidence by DUE DATE 6.

8. DUE DATE 7

The oral argument (if requested by either party) is set for DUE DATE 7.

B. CROSS-EXAMINATION

Except as the parties might otherwise agree, for each due date—

1. Cross-examination begins after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).

2. Cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

C. MOTION FOR OBSERVATION ON CROSS-EXAMINATION

A motion for observation on cross-examination provides the parties with a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. *See* Trial Practice Guide, 77 Fed. Reg. at 48,768. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph.

IPR2016-00098 (Patent 8,791,270 B2)

IPR2016-00111 (Patent 8,895,756 B2)

The opposing party may respond to the observation. Any response must be equally concise and specific.

D. COMMUNICATIONS WITH THE BOARD

Except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a non-preauthorized motion should request a conference to obtain authorization to file the motion. Parties may request a conference with us by contacting the Board staff by e-mail at Trials@uspto.gov or by telephone at 571-272-7822.

Finally, we refer the parties to the instructions on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> regarding the proper use of email communication to the Board. Specifically, an email requesting a conference call should copy the other party, indicate generally the relief being requested or the subject matter of the conference call, state whether the opposing party opposes the request, and include multiple times when all parties are available. The email may not contain substantive argument. The parties also are reminded that they should discuss and attempt to resolve issues with each other first before requesting conference calls with the Board.

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