

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEPTUNE GENERICS, LLC,
Petitioner,

v.

ELI LILLY COMPANY,
Patent Owner.

Case IPR2016-00237
Patent 7,772,209 B2

Telephone hearing before Administrative
Patent Judges, MICHAEL P. TIERNEY and TINA E. HULSE,
commencing on October 31, 2016 at 2:00 p.m. in the
above-entitled cause pursuant to the applicable rules.

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A P P E A R A N C E S:

BRINKS, GILSON & LIONE by
MS. LAURA LYDIGSEN and
MR. JOSHUA H. JAMES
NBC Tower
455 Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200
lleydigsen@brinksgilson.com
jjames@brinksgilson.com
appeared on behalf of Sandoz;

GOODWIN PROCTER, LLP by
MS. CYNTHIA L. HARDMAN
620 Eighth Avenue
New York, New York 10018
(212) 459-7295
chardman@goodwinlaw.com
appeared on behalf of Fresenius;

SKIERMONT DERBY, LLP by
MS. SARAH SPIRES
2200 Ross Avenue
Suite 4800W
Dallas, Texas 75201
(214) 978-6600
sspires@skiermontderby.com
appeared on behalf of Neptune;

CARLSON CASPERS by
MR. GARY J. SPEIER
225 South 6th Street
Minneapolis, Minnesota 55402
(612) 436-9600
gspeier@carlsoncaspers.com
appeared on behalf of Teva;

1 WILLIAMS & CONNOLLY, LLP by
2 MR. DAVID M. KRINSKY and
3 MR. DOV P. GROSSMAN
4 725 Twelfth Street, N.W.
5 Washington, DC 20005
6 (202) 434-5338
7 dkrinsky@wc.com
8 dgrossman@wc.com

9 appeared on behalf of Eli Lilly;

10 BLANK & ROME, LLP by
11 MR. PAUL M. ZAGAR
12 405 Lexington Avenue
13 New York, New York 10174
14 (212) 885-5290
15 pzagar@blankrome.com
16 appeared on behalf of Emcure and
17 Glenmark;

18 ALSTON, BIRD, LLP by
19 MR. THOMAS J. PARKER
20 MS. ELLEN CHEONG and
21 MR. CHARLES A. NAGGAR
22 90 Park Avenue
23 15th Floor
24 New York, New York 10016
(212) 210-9529
thomas.parker@alston.com
ellen.cheong@alston.com
charles.nagggar@alston.com

appeared on behalf of Mylan;

25 RAKOCZY, MOLINO, MAZZOCHI & SIWIK, LLP by
26 MR. PATRICK GILORE
27 6 West Hubbard Street
28 Suite 500
29 Chicago, Illinois 60654
30 (312) 527-2157
31 appeared on behalf of Apotex.

32 REPORTED BY:

33 CAROL CONNOLLY, CSR, CRR

1 JUDGE TIERNEY: This is Judge Tierney. Welcome to
2 the conference call. The cases we are talking about are
3 IPR 2016-00237 and 00240, as well as IPR 2016-00318. The
4 parties that will be speaking today it's my understanding
5 will be Neptune, Sandoz, and Lilly. If another party,
6 for example, one who has joined needs to speak, let me
7 know, otherwise, I'll direct all conversation to Neptune,
8 Sandoz, and Lilly.

9 Are there any questions before we begin?

10 Not hearing any questions, we'll begin. My
11 understanding is that the petitioners, Neptune and
12 Sandoz, wanted to request additional discovery. I'll
13 turn it over -- I'll begin with Neptune, then I'll turn
14 it over to Sandoz, afterwards I'll turn it over to Lilly.
15 But beginning with Neptune, if you could please give the
16 board a sense of what discovery issue we need to look at
17 today.

18 MS. SPIRES: Good afternoon, your Honor. This is
19 Sarah Spires speaking on behalf of Neptune. In all three
20 petitions, so the Sandoz ones and the Lilly ones --
21 Sandoz and Neptune ones, Lilly has relied on Exhibit 2116
22 in its patent owner response, and that exhibit is the
23 trial testimony from the district court litigation of
24 Dr. Clet Niyikiza, and because Lilly has relied, I'll say

1 fairly extensively, I think we counted 9 or so cites and
2 about 36 or so pages cited at the trial testimony, both
3 Sandoz and Neptune would like the opportunity to depose
4 Dr. Niyikiza under 37 CFR, 42.51(b)(2).

5 JUDGE TIERNEY: Do you have anything else to add
6 before I turn it over to Sandoz?

7 MS. SPIRES: I'll just mention that we've looked
8 around at the case law, and it seems that the board has
9 ruled repeatedly that when patent owner relies on
10 testimony that's in a prior proceeding or different
11 proceeding, that the board has still ruled that that is
12 affidavit testimony within the meaning of 37 CFR
13 42.51(b)(1)(2), and instances of that -- April of this
14 year the board ruled that way in PGR 2015-00011, paper
15 29, the board ruled similarly in 2014 in IPR 2013-00253
16 on paper 20.

17 JUDGE TIERNEY: Before I turn it over to Sandoz, I
18 did have a question. If Sandoz wants to jump in, they
19 can. Have the petitioners contacted the patent owner and
20 come to any agreement, or has this issue already been
21 attempted to be resolved and no issue was forthcoming?

22 MS. SPIRES: We have attempted to resolve this
23 issue, your Honor. While the parties were able to
24 resolve several other discovery disputes, this one the

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