

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENZYME CORPORATION,
Petitioner,

v.

GENETECH, INC. AND CITY OF HOPE,
Patent Owner.

Cases IPR2016-00383
Patent 6,331,415 B1

Before LORA M. GREEN and ERICA A. FRANKLIN, *Administrative
Patent Judges.*

GREEN, *Administrative Patent Judge.*

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

A conference call was held on Wednesday, June 1, 2016, among Lisa Ferri and Richard McCormick, counsel for Petitioner; Robert Gunther, Jeffrey Kushnan, David Cavanaugh, and Josh Stern, counsel for Patent Owner; and Administrative Patent Judges Green and Franklin. A court reporter was present on the call, and a transcript will be filed as an exhibit by Patent Owner in due course.¹ Patent Owner requested the call seeking authorization to file a response to Petitioner's Reply to Patent Owner's Preliminary Response ("Petitioner's Reply") (Paper 12). Patent Owner also sought limited discovery, including the deposition of Petitioner's Declarant, Timothy Creagan, whose declaration was submitted in support of an argument in Petitioner's Reply (Ex. 1061) that Petitioner independently prepared its Petition that raised grounds that could not have been presented in an earlier petition filed by a related corporate entity, Sanofi SA.

As discussed during the call, an institution decision is due in this proceeding on July 7, 2016. In addition, we noted that the discovery sought by Patent Owner was not determinative of the issue of whether we should decline to institute trial under 35 U.S.C. § 325(d). Thus, given the posture and circumstances of this proceeding, we did not authorize Patent Owner to file a Response to Petitioner's Reply, and denied its request for limited discovery.

Accordingly, it is:

ORDERED that Patent Owner is not authorized to file a response to Petitioner's Reply to Patent Owner's Preliminary Response; and

¹ This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

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FURTHER ORDERED that Patent Owner's request for limited discovery is denied.

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