

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOIOS PHARMACEUTICALS LLC,
Petitioner,

v.

MEDAC GESELLSCHAFT FÜR KLINISCHE SPEZIALPRÄPARATE
MBH,
Patent Owner.

Case IPR2016-01370
Patent 8,664,231 B2

Before JACQUELINE WRIGHT BONILLA, *Vice Chief Administrative
Patent Judge*, TONI R. SCHEINER, and ERICA A. FRANKLIN,
Administrative Patent Judges.

BONILLA, *Vice Chief Administrative Patent Judge*.

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

A conference call was held on September 29, 2017, between counsel for the parties, Koios Pharmaceuticals LLC (“Petitioner”) and medac Gesellschaft für klinische Spezialpräparate mbH (“Patent Owner”), and Judges Bonilla, Scheiner, and Franklin. Patent Owner requested authorization to file a surreply to Petitioner’s Reply filed on September 18, 2017 (“Reply”). Petitioner opposed Patent Owner’s request. Patent Owner arranged to have a court reporter present and agreed to submit a transcript of the call as an exhibit.

During the call, Patent Owner alleged that the Reply contained excerpts or summaries of the deposition cross-examination testimony of Patent Owner’s expert witness, Thomas Zizic, M.D., that were incomplete or misleading. Patent Owner requested authorization to file a surreply for the sole purpose of identifying those excerpts or summaries in the Reply, as well as relevant portions of the transcript of Dr. Zizic’s testimony as necessary. Petitioner opposed Patent Owner’s assertions, arguing that Patent Owner had no right to file a surreply and that a surreply was not warranted in this instance.

After considering the parties’ positions, although we agreed that there was no right to file a surreply, under the present circumstances, we decided that the information that Patent Owner sought to provide in a surreply would be useful and helpful in facilitating our review of the Reply and Dr. Zizic’s deposition testimony. Accordingly, we exercised our discretion by granting Patent Owner’s request to file a surreply.

Petitioner requested authorization to file a response to the surreply, and asserted that Patent Owner’s surreply should contain no argument and no quotations from the documents at issue, but rather only citations to page

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and line numbers. We agreed that the surreply shall not contain arguments and shall only cite to the particular page and line numbers of the documents of record that Patent Owner seeks to draw to our attention. We did not, however, authorize the filing of a response to the surreply (i.e., a sur-surreply), but explained that Petitioner will have an opportunity to address Patent Owner's surreply at oral argument.

Accordingly, it is:

ORDERED that Patent Owner's request for authorization to file a surreply is granted;

FURTHER ORDERED that the surreply shall cite to page, line, and/or paragraph numbers of the papers and exhibits of record, but shall not contain arguments, or quotations from the record;

FURTHER ORDERED that Patent Owner shall file its surreply by October 5, 2017, and the surreply shall not exceed five pages;

FURTHER ORDERED that Petitioner is not authorized to file a sur-surreply; and

FURTHER ORDERED that, after Patent Owner receives a transcript of the conference call, Patent Owner shall file the transcript as an exhibit.

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For PETITIONER:

DeAnn F. Smith
FOLEY HOAG LLP
dsmith@foleyhoag.com

William P. Rothwell
NOROOZI PC
william@noroozipc.com

For PATENT OWNER:

James F. Haley, Jr.
Brian Gummow
HALEY GUILIANO LLP
james.haley@hglaw.com
brian.gummow@hglaw.com