

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARO PHARMACEUTICALS U.S.A., INC.,
Petitioner,

v.

APOTEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01446
Patent 7,049,328 B2

Before JEFFREY N. FREDMAN, ZHENYU YANG, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

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

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '328 patent is unpatentable. Paper 7. We modify our institution

decision to institute on all of the challenged claims and all of the grounds presented in the Petition.

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to otherwise change the schedule or submit further briefing, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

As an alternative, the Board authorizes the parties to file, within one week of the date of this Order, a Joint Motion to Limit the Petition by removing the claims or grounds upon which we did not institute in our Decision on Institution. *See, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision); *KVK-Tech, Inc. v. Silvergate Pharms., Inc.*, Case PGR2017-00039 (PTAB May 1, 2018) (Paper 17) (granting a joint motion to limit the petition by removing two grounds that were excluded from the institution decision).

In consideration of the foregoing, it is hereby:

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or any further briefing, and, if so, shall request a conference call with the panel to seek authorization for such changes or briefing within one week of the date of this Order.

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