

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MODERNA THERAPEUTICS, INC.,
Petitioner,

v.

PROTIVA BIOTHERAPEUTICS, INC.,
Patent Owner.

Case IPR2018-00680 (Patent 9,404,127)
Case IPR2018-00739 (Patent 9,364,435)¹

Before SHERIDAN K. SNEDDEN, SUSAN L.C. MITCHELL, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

¹This Order addresses issues that are common to both cases. We, therefore, issue a single Order that has been entered in each case.

IPR2018-00680 (Patent 9,404,127)

IPR2018-00739 (Patent 9,364,435)

Pursuant to our scheduling order, oral argument is scheduled to proceed on June 6, 2019, if requested by the parties. Paper 14.² Petitioner and Patent Owner have both requested oral argument in IPR2018-00680 (Papers 34, 35) and in IPR2018-00739 (Papers 39, 40). The requests are *granted*.

The oral argument will commence at 1:00 PM EDT on Thursday, June 6, 2019, at the USPTO headquarters in Alexandria, Virginia (Hearing Room A). The oral argument will be open to the public for in-person attendance, which will be accommodated on a first-come, first-served basis.

Petitioner requests a total of 60 minutes of argument time per side for each of IPR2018-00680 (Paper 35) and IPR2018-00739 (Paper 40). Patent Owner requests a total of 20 minutes of argument time per side for IPR2018-00680 (Paper 34) and 40 minutes per side for IPR2018-00739 (Paper 39). Patent Owner further requests that arguments in IPR2018-00739 be held first, followed by separate arguments in IPR2018-00680, and that there be a separate transcript for each proceeding.

Each party will have one hour total to present arguments in IPR2018-00739 and 45 minutes total to present arguments in IPR2018-00680. At the request of Patent Owner, the hearing will begin with IPR2018-00739 followed by a separate hearing in IPR2018-00680.

Petitioner bears the ultimate burden of proof that Patent Owner's patent claims at issue are unpatentable. Therefore, at oral argument and with respect to each proceeding, Petitioner will proceed first to present its case with respect to the pending grounds of unpatentability. Petitioner may

² Paper 14 was filed in IPR2018-00680. The same scheduling order was filed in IPR2018-00739. Paper 16.

IPR2018-00680 (Patent 9,404,127)

IPR2018-00739 (Patent 9,364,435)

reserve some of its argument time for rebuttal, but may not reserve more than half of its allotted time for rebuttal. Patent Owner will then respond to Petitioner's initial presentation. Petitioner may then use the time it has reserved to reply to Patent Owner's presentation. Patent Owner is permitted the opportunity to present a brief sur-rebuttal if requested at the hearing.

The Board will provide a court reporter for the oral argument, and the reporter's transcript will constitute the official record of the oral argument. The hearing transcript will be separate for each proceeding, and will be entered in the record of the corresponding proceeding.

The parties shall serve any demonstrative exhibits on opposing counsel at least three business days before the hearing. The parties shall also provide a courtesy copy of any demonstrative exhibits to the Board no later than two business days before the hearing by emailing them to Trials@uspto.gov. Notwithstanding 37 C.F.R. § 42.70(b), the parties shall not file any demonstrative exhibits in these proceedings without prior authorization from the Board. Each party shall also provide a hard copy of its demonstrative exhibits to the court reporter and panel at the hearing.

The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. The parties shall confer with each other regarding any objections to demonstrative exhibits. For any issue that cannot be resolved after conferring, the parties may each file a one-page list of objections at least two business days before the hearing. The list should identify with particularity which demonstrative exhibits are subject to

IPR2018-00680 (Patent 9,404,127)

IPR2018-00739 (Patent 9,364,435)

objection and include a short statement of the reason for each objection. No argument or further explanation is permitted.

The Board will consider the objections and schedule a telephone conference if deemed necessary. Otherwise, the Board will reserve ruling on the objections until after the oral argument. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

The parties are advised that at least one member of the panel will be attending the hearing from a remote location. The parties are reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript and the ability of the judge participating remotely to follow the presenter's arguments. The parties should note that the remote judge will not be able to see what is projected on the screen in the hearing room.

The Board expects lead counsel for each party to be present at oral hearing, although any backup counsel may make the actual presentation, in whole or in part. If either party expects that its lead counsel will not be attending the oral hearing, the Board should be notified via a joint telephone conference call no later than two business days before the oral hearing to discuss the matter.

The parties may request the use of audio-visual equipment during the oral hearing. Formal requests are to be made three business days in advance of the hearing date and should be sent to Trials@uspto.gov. If the request is not timely, the equipment may not be available on the day of the hearing.

IPR2018-00680 (Patent 9,404,127)
IPR2018-00739 (Patent 9,364,435)

PETITIONER:

Michael Fleming
mfleming@irell.com

Crawford Wells
mwells@irell.com

PATENT OWNER:

Michael Rosato
mrosato@wsgr.com

Steven Parmelee
sparmelee@wsgr.com

Sonja Gerrard
sgerrard@wsgr.com