

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,
v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner.

Cases
IPR2018-01675 (Patent 8,603,044 B2)
IPR2018-01676 (Patent 8,603,044 B2)¹

Before HYUN J. JUNG, BART A. GERSTENBLITH, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

SCHEDULING ORDER

¹ The parties are not authorized to use a multiple-case caption.

IPR2018-01675 (Patent 8,603,044 B2)

IPR2018-01676 (Patent 8,603,044 B2)

A. GENERAL INSTRUCTIONS

1. Initial Conference Call

The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (“Practice Guide”) (guidance in preparing for the initial conference call). A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

2. Procedure for Conference Call Requests

If either party requests a conference call during this proceeding, the parties must follow this procedure:

a. Prior to requesting a conference call, the parties must confer in an effort to resolve any issue prior to discussion with the Board, or be prepared to explain to the Board why such a conference was not possible.

b. Parties may request a conference call by contacting the Board at the email address or telephone number listed above the caption of this Order. Requests by email are expected and preferred; requests by telephone should be reserved for time-critical circumstances. Requests by email must copy opposing counsel. Requests by telephone should include opposing counsel as practicable.

c. The request must include a list of proposed issues and/or motions to be discussed during the call.

IPR2018-01675 (Patent 8,603,044 B2)

IPR2018-01676 (Patent 8,603,044 B2)

d. The request may include a brief background discussion of the issue(s) and/or motion(s) to be discussed, but must not include arguments. Email correspondence between the parties and the Board is for administrative purposes only and is not part of the record.

e. The request must certify that the parties conferred in accordance with 2.a., and must indicate the result of the conference (e.g., whether the non-requesting party opposes or does not oppose the request).

f. The request must include a list of dates and times when both parties are available for the call.

3. Protective Order

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. The Board encourages the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Practice Guide, App'x B (Default Protective Order). If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

The Board has a strong interest in the public availability of trial proceedings. Redactions to documents filed in this proceeding should be limited to the minimum amount necessary to protect confidential information, and the thrust of the underlying argument or evidence must be

IPR2018-01675 (Patent 8,603,044 B2)

IPR2018-01676 (Patent 8,603,044 B2)

clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order may become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See Practice Guide 48,761.*

4. Discovery Disputes

The Board encourages parties to resolve disputes relating to discovery on their own. To the extent that a dispute arises between the parties relating to discovery, the parties must meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board.

5. Testimony

The parties are reminded that the Testimony Guidelines appended to the Trial Practice Guide, Appendix D, apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

6. Cross-Examination

Except as the parties might otherwise agree, for each due date: Cross-examination ordinarily takes place after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).

IPR2018-01675 (Patent 8,603,044 B2)

IPR2018-01676 (Patent 8,603,044 B2)

Cross-examination ordinarily ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

7. Motion to Amend

Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). To satisfy this requirement, Patent Owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1. *See* Section B below regarding DUE DATES.

Patent Owner has the option to receive preliminary guidance from the Board on its motion to amend. *See Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (“MTA Pilot Program Notice”). If Patent Owner elects to request preliminary guidance from the Board on its motion, it must do so in its motion to amend filed on DUE DATE 1.

Any motion to amend and briefing related to such a motion shall generally follow the practices and procedures described in MTA Pilot Program Notice unless otherwise ordered by the Board in this proceeding. The parties are further directed to the Board’s Guidance on Motions to Amend as set forth in *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (Paper 15) (PTAB Feb. 25, 2019) (precedential).

As indicated in the MTA Pilot Program Notice, Patent Owner has the option at DUE DATE 3 to file a revised motion to amend (instead of a reply, as noted above) after receiving petitioner’s opposition to the original motion

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.