

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC, AMNEAL
PHARMACEUTICALS OF NEW YORK, LLC, and MYLAN
PHARMACEUTICALS INC.,
Petitioners,

v.

ALMIRALL, LLC,
Patent Owner.

IPR2019-00207¹
Patent 9,517,219 B2

Before SUSAN L. C. MITCHELL, CHRISTOPHER G. PAULRAJ, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

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

¹ Cases IPR2019-00207 and IPR2019-01095 have been joined in this proceeding.

In an Order dated December 31, 2019 (Paper 39), this Panel granted Petitioner's Motion for Additional Discovery (Paper 26), ordering Patent Owner's production of deposition transcripts of Dr. Kevin S. Warner, the deposition of this same Dr. Warner by January 17, 2020, and authorizing additional briefing to Petitioner by January 24, 2020 relating to this sought evidence, and, if submitted, also to Patent Owner on January 31, 2020 in response thereto.

On January 13, 2020, Patent Owner emailed the Board, stating the following:

Patent Owner requests a teleconference with the Board. Dr. Warner is not available for deposition by the January 17, 2020 deadline of the Board's December 31, 2019 Order (Paper 39). The Order also orders briefing to be submitted and evidence to be filed after the January 17, 2020 deadline for motions to exclude evidence (see Paper 14, Due Date 5). Patent Owner seeks the following relief:

- (1) A modification of the December 31, 2019 Order to allow Dr. Warner's deposition after January 17, 2020;
- (2) An extension of Due Date 5 to allow the parties to submit motions to exclude evidence included with the additional briefing ordered by the December 31, 2019 Order; and
- (3) Guidance regarding offering Dr. Warner's testimony live at oral argument.

Patent Owner conferred with Petitioners, and Petitioners confirmed that they oppose Patent Owner's request.

A conference call was held on January 17, 2020, between the parties and the Panel in this case. Patent Owner explained that the ordered production of the deposition transcript(s) had been completed, but explained that the deposition of Dr. Warner had not occurred because the witness was

not available until, at the earliest, January 30, 2020. Patent Owner explained that it had no direct control over Dr. Warner, who is not employed by Patent Owner. Patent Owner argued that the schedule of the proceedings could be modified to allow for a late deposition of Dr. Warner and related briefing, as well as related motions to exclude evidence, and alternatively argued to reserve the right to provide Dr. Warner at the final hearing whereat he might testify live as a substitute for his deposition. Patent Owner also argued that if supplemental briefing and evidence was submitted by Petitioner as provided for in the December 31, 2019 Order, Patent Owner lacked an opportunity to object and move to exclude such evidence on the current schedule of the proceedings.

Petitioner explained its understanding of the circumstances and argued that a deposition of Dr. Warner on January 30, 2020 would not be practical in view of its proximity to the final hearing, scheduled to occur on February 7, 2020. Petitioner suggested adhering to the current schedule of the proceedings, and as provided in the December 31, 2019 Order (Paper 39) and, should Dr. Warner not be deposed by Petitioner, Petitioner would address this in a motion to exclude evidence. Petitioner opposed having Dr. Warner present live testimony at the final hearing.

After considering the positions of each party set forth above, we conclude that this proceeding shall remain on its current schedule as set forth in the Scheduling Order (Paper 14) regarding Due Dates 5–8 and as provided for in the December 31, 2020 Order (Paper 39) regarding additional discovery and authorized briefing. The Panel is sensitive to Patent Owner's point regarding an opportunity to object and move to exclude any additional evidence and related briefing; therefore, we authorize

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Patent Owner to file a supplemental motion to exclude thereon by January 31, 2020, and authorize Petitioner to file an opposition to such a supplemental motion to exclude by February 7, 2020. The parties may address such supplemental motion to exclude and the related opposition at the final hearing. No live testimony by Dr. Warner or any witness is authorized.

For the foregoing reasons, it is

ORDERED that Patent Owner is authorized to file a Supplemental Motion to Exclude by January 31, 2020, with respect to evidence and arguments filed by Petitioner as authorized in the December 31, 2019 Order (Paper 39); and

FURTHER ORDERED that Petitioner is authorized to file an Opposition to Patent Owner's above-authorized Supplemental Motion to Exclude, if filed, by February 7, 2020.

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