

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC and AMNEAL
PHARMACEUTICALS OF NEW YORK, LLC
Petitioners,

v.

ALMIRALL, LLC,
Patent Owner.

Case IPR2019-00207
Patent 9,517,219 B2

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

FLAX, *Administrative Patent Judge*.

CONDUCT OF THE PROCEEDINGS
*Authorizing Petitioners' Motion for Discovery
and Patent Owner's Opposition Thereto
37 C.F.R. § 42.5(a); § 42.20; § 42.51(b)(2)*

On October 8, 2019, Petitioners emailed the Board, stating the following:

Petitioners request authorization to file a motion for additional discovery. Patent Owner in this proceeding relies upon a declaration of co-inventor Dr. Kevin Warner. Patent Owner has refused to make Dr. Warner available for cross-examination. Petitioners seek:

- (1) the opportunity to cross-examine Dr. Warner in this proceeding.
- (2) the production of the transcript of Dr. Kevin Warner's deposition that occurred in the related district court litigation (*Almirall LLC v. Taro Pharmaceutical Industries Ltd.*, No. 1-17-cv-00663 (D. Del. Mar. 11, 2019)) involving the same '219 patent challenged in this IPR proceeding.

Petitioners conferred with Patent Owner, and Patent Owner confirmed that it opposes Petitioners' request. Counsel for both parties are available for a teleconference with the Board any time on Thursday, October 10, per the Board's convenience.

A conference call was held on October 10, 2019 between the parties and the Panel in this IPR, where the parties explained their positions on such potential discovery.

Accordingly, it is:

ORDERED that Petitioners are granted authorization to file a motion, not exceeding ten (10) pages, on or before October 18, 2019, requesting additional discovery relating to the cross-examination of Kevin S. Warner, Ph.D. and to the production of a deposition transcript of Kevin S. Warner, Ph.D. from district court litigation *Almirall LLC v. Taro Pharmaceutical Industries Ltd.*, No. 1-17-cv-00663 (D. Del); and

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FURTHER ORDERED that Patent Owner is granted authorization to file an opposition to the aforementioned motion, not exceeding ten (10) pages, within five business days of receipt of said motion.

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FOR PETITIONERS:

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