

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX, INC.
Petitioner,

v.

UCB BIOPHARMA SPRL,
Patent Owner.

U.S. Patent No. 8,633,194 to Fanara et al.

Issue Date: January 21, 2014

Title: Pharmaceutical Composition of Piperazine Derivatives

Inter Partes Review No.: IPR2019-00400

**JOINT STIPULATION REGARDING THE DEPOSITION OF
DOMENICO FANARA**

Petitioner Apotex Inc. (“Petitioner”) and Patent Owner UCB Biopharma Sprl (“Patent Owner”) hereby stipulate to the following pursuant to 37 CFR § 42.53(c)(2):

1. Domenico Fanara is a named inventor on the U.S. Patent No. 8,633,194 (“the ’194 patent”).
2. Mr. Fanara submitted a declaration pursuant to 37 CFR § 1.132 (EX1027) during the prosecution of the application which led to the ’194 patent.
3. Patent Owner and Patent Owner’s declarant, Dr. Sarfaraz Niazi, refer to Mr. Fanara’s declaration in their Patent Owner Response (Paper 22) and supporting declaration (EX2034) respectively.
4. Mr. Fanara was deposed on February 21, 2019 in the underlying litigation (*UCB, Inc. et al. v. Apotex Inc.*, No. 0-18-cv-60846 (S.D. Fla.)) in his individual capacity and as UCB’s 30(b)(6) witness for certain topics. The February 21, 2019 deposition of Mr. Fanara addressed subject matter that is not part of the record in this proceeding.
5. In the interest of avoiding a dispute between the parties as to whether Mr. Fanara must be made available for deposition in this proceeding upon notice from Petitioner, the parties have agreed to designate portions of Mr. Fanara’s February 21, 2019 deposition. These designations are reflected in the excerpted version of the transcript that is filed herewith as Attachment A.¹ Petitioner will also file the designated portions of Mr. Fanara’s February 21, 2019 deposition as a new Exhibit in this proceeding when Petitioner files its Reply.
6. Petitioner and Patent Owner agree that in view of this Stipulation:

¹ Attachment A hereto contains Patent Owner’s confidential information as is subject to the concurrently filed Patent Owner’s Motion to Seal Pursuant to 37 C.F.R. § 42.54. Therefore, the parties have only attached a coversheet for Attachment A to this Stipulation while a complete unredacted copy of Attachment A has been filed “Board and Parties Eyes only”. Attachment B hereto is a redacted, public version of Attachment A.

- A. Petitioner does not need to provide a Notice of Deposition for Mr. Fanara in connection with this proceeding (*see* 37 CFR § 42.53(d)).
 - B. Neither party will object in this proceeding that by providing only the excerpted version of the transcript (Attachment A) that Mr. Fanara’s transcript is incomplete under Federal Rule of Evidence 106.
 - C. The testimony in Attachment A may be used by either Party in this proceeding in any manner permitted by the United States Patent Trial and Appeal Board (“Board”) rules and/or applicable Board guidance.
 - D. Recognizing that the February 21, 2019 deposition was not taken pursuant to the rules of the Board, and with the exception of Paragraph 6.B of this Stipulation, Petitioner will not oppose any objection that Patent Owner may raise on the basis that Patent Owner did not state the objection on the record during the deposition. However, Petitioner maintains the right to rebut any objection made by Patent Owner in any *other* manner permitted by the Board rules and/or applicable Board guidance.
 - E. Patent Owner will not contend before the Board, the Southern District of Florida, or any other court, that use of the deposition of Mr. Fanara as contemplated by this Stipulation constitutes a violation of any protective order of any court or that its use in this proceeding is prohibited by any other protection Patent Owner enjoys.
 - F. Petitioner will not seek relief from the Board seeking a deposition of Mr. Fanara. However, Petitioner does not waive any other objection it timely raises pursuant to applicable Board rules and/or applicable Board guidance.
 - G. Patent Owner reserves the right to add additional counter-designations related to the specific subject matter of Petitioner’s Reply.
 - H. The designation of the exhibit list at page 4 of Attachment A is solely for ease of reference, and no exhibit listed therein is being submitted as an exhibit in this proceeding solely due to its inclusion in those designations.
7. Except as otherwise noted in this Stipulation, nothing herein waives any objection that either party may raise in this proceeding, presently or in the future, including objections to the admissibility under Board rules and/or

applicable Board guidance to any portion of the above-designated testimony and/or exhibits referenced therein.

DATED: 11/26/19

Counsel of Record in IPR 2019-00400

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on November 26, 2019, the foregoing document is being served by filing this document through the Patent Trial and Appeal Board End to End System, as well as by delivering a copy via electronic mail upon the following counsel of record for the Petitioner:

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Respectfully submitted,

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