

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAWAI USA, INC. AND
SAWAI PHARMACEUTICAL CO., LTD.,
Petitioner,

v.

BIOGEN MA INC.,
Patent Owner.

Case IPR2019-00789
Patent No. 8,399,514

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

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

In an email correspondence sent to the Board on May 8, 2019, counsel for Patent Owner requested a teleconference to seek permission to file a sur-reply to Petitioner's Response to Patent Owner's Opposition to Petitioner's Motion for Joinder (Paper 10). The relevant portion of the email reads as follows:

Patent Owner Biogen writes to seek leave to file a sur-reply to Sawai's May 6, 2019, Response to Patent Owner's Opposition to Petitioner's Motion for Joinder (Paper No. 10) as Sawai raises new arguments and new evidence. Sawai's statement that it "does not intend to produce its own testifying witnesses or file substantive papers in the Mylan IPR so long as Mylan remains a party to the case" constitutes a new position, as Sawai's motion for joinder did not disclaim reliance on Sawai's declarants absent agreement from Mylan. Compare Paper No. 10 at 1 with Paper 2 at 4, 8; see also Ex. 1064, 1. Sawai also introduces five new exhibits, including new declaration evidence related to the RPI issue (Ex. 1060).

Patent Owner has consulted Sawai, which has indicated that it (1) would "oppose a sur-reply on" its new position on its testifying experts but (2) "would not oppose a sur-reply that is (a) no more than 3 pages in length; (b) limited to the RPI issue; and (c) does not seek to introduce additional evidence." As indicated above, however, Biogen seeks leave to file a sur-reply not limited to the RPI issue.

In an email correspondence sent to the Board on May 9, 2019, the counsel for Petitioner provided the following clarification:

Because it is not reflected in Biogen's email below, Sawai clarifies that that it objected to a sur-reply on the issue regarding testifying experts with the explanation that it disagrees that such is a "new" position.

A conference call in the above proceeding was held on May 14, 2019, among respective counsel for Petitioner and Patent Owner, and Judges Snedden, Chagnon, and Harlow. During the call, we discussed 1) whether to

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grant Patent Owner a sur-reply on the RPI issue and 2) whether to grant Patent Owner a sur-reply limited to the joinder issue raised by Patent Owner. A transcript of the conference call will be entered by Patent Owner.

Upon consideration of the parties' positions, we denied Patent Owner's request for a sur-reply on the joinder issue and granted Patent Owner's request for a sur-reply limited to the RPI issue. In particular, we authorized Patent Owner to file a 3-page sur-reply limited to the RPI issue due, within 5 business days of the conference call, i.e., no later than May 21, 2019. This Order memorializes that authorization for the record.

We also reminded the parties that they should confer before any request for a conference call with the Board, that such requests should not include argument, but should be limited to a short statement of the issue to be discussed, and that such requests should propose agreed upon dates and times for the conference call.

It is

SO ORDERED.

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