

**From:** [Trials](#)  
**To:** [Sodikoff, Brian](#); [Trials](#)  
**Cc:** [Ferenc, Christopher B.](#); [Sommers, Erin](#); [Feldstein, Mark](#); [DeRoo, Pier](#); [McCurdy, Barbara](#)  
**Subject:** RE: IPR2019-00789 Sawai v. Biogen  
**Date:** Monday, June 3, 2019 3:23:55 PM

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**EXTERNAL Email:**

Counsel,

The panel declines Petitioner's request to limit the scope of Patent Owner Preliminary Response. Patent Owner may address RPI in its Preliminary Response. Petitioner may request authorization to file a reply to the Patent Owner Preliminary Response, if it so desires. The panel also notes that no right to cross-examination has been waived at this preliminary stage of the proceeding, but that cross-examination during the preliminary stages of a proceeding is not typically available, absent authorization from the Board. We have not authorized any cross-examination at this time. The panel believes that our guidance here addresses sufficiently the current dispute between the parties and, as such, a teleconference is not needed at this time.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
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**From:** Sodikoff, Brian <brian.sodikoff@kattenlaw.com>  
**Sent:** Friday, May 31, 2019 3:34 PM  
**To:** Trials <Trials@USPTO.GOV>  
**Cc:** Ferenc, Christopher B. <christopher.ferenc@kattenlaw.com>; Sommers, Erin <Erin.Sommers@finnegan.com>; Feldstein, Mark <mark.feldstein@finnegan.com>; DeRoo, Pier <Pier.DeRoo@finnegan.com>; McCurdy, Barbara <barbara.mccurdy@finnegan.com>  
**Subject:** IPR2019-00789 Sawai v. Biogen

To the Honorable Board:

Petitioners Sawai USA, Inc. and Sawai Pharmaceuticals, Ltd. (together "Sawai") respectfully request a telephone conference with the Board to determine whether briefing on the RPI issue, first raised in Patent Owner's opposition to Sawai's Motion for Joinder, is closed in view of the Sur-reply filed by Patent Owner on May 21, 2019. Sawai contends that briefing on the RPI issue is now closed in view of the Board's previous ruling (Paper No. 12). Patent Owner contends that Sawai has mischaracterized the Board's Order, and plans to further brief the RPI issue in its POPR. The parties met and conferred on May 29, 2019 to discuss this issue and were unable to resolve their dispute.

Patent Owner Biogen understands Sawai's position to be that (1) "Biogen waived any right it had to seek cross-examination of [Sawai's RPI declarant] Mr. Hiramatsu" though without any statute, rule, or precedent to support its position; (2) Biogen is not entitled to address RPI in its POPR, again without any authority in support, and (3) RPI should "be resolved by the Board in deciding Sawai's Motion for Joinder," also without any supporting authority. Biogen disagrees with Sawai's positions, and notes further that Sawai's actions--seeking additional hearings with the Board without basis in the PTAB's rules--further demonstrates the problems of potential joinder with a party that, like Sawai, has created RPI disputes and is taking an active rather than a bystander role.

Sawai and Patent Owner are generally available June 3, 4, 5 (before noon), 6 (before noon), and 11 for a conference with the Board.

Respectfully,

Brian Sodikoff  
Counsel for Sawai

**Brian Sodikoff**

Partner

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