

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDOZ INC.,
Petitioner,

v.

PHARMACYCLICS LLC,
Patent Owner.

Case IPR2019-00865
Patent 9,795,604 B2

Before SHERIDAN K. SNEDDEN, JENNIFER MEYER CHAGNON, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

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

On Tuesday May 12, Patent Owner emailed the Board to request authorization to “file a motion to strike improper new arguments included in Petitioner’s Reply Brief pursuant to 37 C.F.R. § 42.23(b).” Ex. 3001. The email specifically identified Section III.B and Section III.C.1 of Petitioner’s Reply as presenting new arguments. *Id.* Petitioner opposes Patent Owner’s request. *Id.* A teleconference was held on Friday, May 15, 2018, wherein both parties had the opportunity to discuss Patent Owner’s request with the panel.

During the call, Patent Owner argued that the argument presented in Sections III.B and III.C of Petitioner’s Reply constitutes new argument and that it would be prejudiced by having to devote space in its Sur-Reply to addressing this material. Patent Owner made clear that resolution of whether Petitioner’s arguments were, in fact, new arguments, was not time sensitive and that it would not be prejudiced if we resolve the issue after oral argument. Patent Owner did, however, request that we issue a decision on whether to authorize its motion to strike before the deadline for filing its Sur-Reply. Patent Owner proposed that briefing on this issue occur on the same schedule as provided for motions to exclude.

Petitioner argued that the material at issue was not new argument, that the material identified as new argument was not lengthy, and that Patent Owner did not act promptly in reaching out to the Board with its request for authorization.

We share Petitioner’s concern that Patent Owner delayed in seeking authorization to file a motion to strike. *See* Patent Trial and Appeal Board

Consolidated Trial Practice Guide (Nov. 2019)¹ at 81 (“Generally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission.”) We also recognize that that the material at issue constitutes just two paragraphs in Petitioner’s Reply, and that Petitioner’s alleged new argument could be addressed in a Sur-Reply. However, we find that briefing on this issue would be helpful to the panel in resolving this issue. Accordingly, we authorize Patent Owner to file a motion to strike regarding only the material presented in Sections III.B and III.C of Petitioner’s Reply on the basis that it presents new argument.

It is therefore,

ORDERED that Patent Owner’s request for leave to file a motion to strike Sections III.B and III.C of Petitioner’s Reply is *granted*. Patent Owner’s motion shall not exceed three pages and shall be filed by DUE DATE 5 of the Scheduling Order (Paper 10), accounting for any stipulations to extend deadlines agreed to by the parties.

FURTHER ORDERED that Petitioner may file an opposition to Patent Owner’s motion. Petitioner’s opposition shall not exceed three pages and shall be filed by DUE DATE 6 of the Scheduling Order (Paper 10), accounting for any stipulations to extend deadlines agreed to by the parties.

FURTHER ORDERED that Patent Owner may file a reply to Petitioner’s Opposition. Patent Owner’s Reply shall not exceed one page and shall be filed by DUE DATE 7.

¹ Available at:
<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>

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