

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC.,
Petitioner,

v.

CELLGENE CORPORATION,
Patent Owner.

IPR2023-00512
Patent 8,846,628 B2

Before TINA E. HULSE, RYAN H. FLAX, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

SCHEDULING ORDER

I. INTRODUCTION

Celgene Corporation (“Patent Owner”) is the owner of U.S. patent 8,846,628 B2 (“the ’628 patent”). Paper 5, 1. On February 10, 2023, Apotex Inc. (“Petitioner”) filed a Petition for *inter partes* review challenging the patentability of claims 1, 2, 6–9, 11–28, 32–36, and 38–43 of the ’628 patent. Paper 1, 6 (“Pet.”). On July 20, 2023, we instituted trial in this proceeding. Paper 7.

II. GENERAL INSTRUCTIONS

A. INITIAL AND ADDITIONAL CONFERENCE CALLS

The parties are directed to contact the Board within a month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. *See Consolidated Trial Practice Guide* (“Consolidated Practice Guide”) at 9–10, 65 (guidance in preparing for a conference call); *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019).¹ A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

The parties may request additional conference calls as needed. Any email requesting a conference call with the Board should: (a) copy all parties, (b) indicate generally the relief being requested or the subject matter of the conference call, (c) include multiple times when all parties are available, (d) state whether the opposing party opposes any relief requested,

¹ If either party has questions about the proceeding they are encouraged to first consult the Consolidated Trial Practice Guide, which is a resource explaining most Board procedures; it can be found at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. We encourage familiarity with the Consolidated Trial Practice Guide.

and (e) if opposed, either certify that the parties have met and conferred telephonically or in person to attempt to reach agreement, or explain why such meet and confer did not occur. The email may not contain substantive argument and, unless otherwise authorized, may not include attachments. *See Consolidated Practice Guide at 9–10.*

As with requesting any conference call, neither party shall make any *ex parte* communication with the Board. Before contacting the Board for any remedy during the proceeding the parties shall meet and confer on the matter in good faith to seek a resolution without Board intervention.

B. PROTECTIVE ORDER

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order shall be filed as an exhibit with the motion. It is the responsibility of the party whose confidential information is at issue, not necessarily the proffering party, to file the motion to seal.²

The Board encourages the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See Consolidated Practice Guide at 107–122 (App'x B, Protective Order Guidelines and Default Protective Order).* If the parties choose to propose a protective order deviating from the default protective order, they must submit their proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

² If the entity whose confidential information is at issue is not a party to the proceeding, please contact the Board.

The Board has a strong interest in the public availability of trial proceedings. Redactions to documents filed in this proceeding should be limited to the minimum amount necessary to protect confidential information, and the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order may become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See Consolidated Practice Guide at 21–22.*

C. DISCOVERY DISPUTES

The Board encourages parties to, in good faith, resolve disputes relating to discovery on their own. To the extent that a dispute arises between the parties relating to discovery, the parties must meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board.

D. TESTIMONY

The parties are reminded that the Testimony Guidelines appended to the Consolidated Practice Guide at 127–130 (App’x D, Testimony Guidelines) apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys’ fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

E. CROSS-EXAMINATION

Except as the parties might otherwise agree, for each due date:

Cross-examination ordinarily takes place after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).

Cross-examination ordinarily ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

F. MOTION TO AMEND

Patent Owner may file a motion to amend without prior authorization from the Board. However, Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). To satisfy this requirement, Patent Owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1. *See infra* Section III regarding DUE DATES.

Patent Owner has the option to receive (non-binding) preliminary guidance from the Board on a motion to amend. *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497 (Mar. 15, 2019) (“MTA Pilot Program Notice”); *see also* Consolidated Practice Guide at 67. If Patent Owner elects to request preliminary guidance from the Board on its motion, it must do so in its motion to amend filed on DUE DATE 1.

Any motion to amend and briefing related to such a motion shall generally follow the practices and procedures described in MTA Pilot Program Notice unless otherwise ordered by the Board in this proceeding. The parties are further directed to *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential), and Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in

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