

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

Case PGR2019-00028
Patent 10,052,338 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and WESLEY B. DERRICK, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

REVISED SCHEDULING ORDER
35 U.S.C. § 42.5

A. GENERAL INSTRUCTIONS

1. *Initial Conference Call*

Following an email request by Petitioner, the Board held an initial conference call with counsel for both parties on September 25, 2019. During the call, Petitioner requested that the schedule in this case be changed to align with the schedule set in the related cases currently pending as PGR2019-00026 and PGR2019-00027. Patent Owner stated during the call that it did not oppose the request to align the schedules in the three cases by moving each of the due dates in this case earlier in order to make each date the same as the corresponding due date in the two related cases. Accordingly, we enter this Revised Scheduling Order setting new due dates for filings in PGR2019-00028. This Order supersedes the original Scheduling Order, Paper 7, which we entered on August 20, 2019.

2. *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 must be filed as an exhibit to the motion. The parties may adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Office Patent Trial Practice Guide, July 2019 Update, App'x B (July 16, 2019) ("July 2019 TPG Update").¹ If the parties choose to propose a protective order that deviates from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default

¹ Available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>

protective orders showing the differences between the two and, further, must explain why good cause exists to deviate from the default protective order.

See id.

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 Practice Guide 48,761.*

3. Discovery and Other Disputes

The Board encourages parties to resolve disputes on their own. If a dispute arises, 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.

In any request for a conference call with the Board to resolve a dispute, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify the precise relief to be sought; and (c) propose specific dates and times at which both parties are available for the conference call. Such a request is not an opportunity to brief the merits of the dispute and must not include attorney argument.

4. *Testimony*

The Testimony Guidelines appended to the Trial Practice Guide, Appendix D, 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. 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.

Whenever a party submits a deposition transcript as an exhibit in this proceeding, the submitting party shall file the full transcript of the deposition rather than excerpts of only those portions being cited. After a deposition transcript has been submitted as an exhibit, all parties who subsequently cite to portions of the transcript shall cite to the first-filed exhibit rather than submitting another copy of the same transcript.

5. *Cross-Examination*

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

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

6. *Motion to Amend*

Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). Patent Owner should arrange for a conference call with the panel and opposing counsel at least

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two weeks before DUE DATE 1 in order to satisfy the conferral requirement. *See* Section B below regarding DUE DATES.

Patent Owner has the option to receive preliminary guidance from the Board on its 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”). 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 the MTA Pilot Program Notice unless otherwise ordered by the Board in this proceeding. The parties are further directed to the Board’s Guidance on Motions to Amend in view of *Aqua Products* (<https://go.usa.gov/xU6YV>), and *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (Paper 15) (PTAB Feb. 25, 2019) (precedential).

As indicated in the MTA Pilot Program Notice, Patent Owner has the option at DUE DATE 3 to file a revised motion to amend (instead of a reply, as noted above) after receiving petitioner’s opposition to the original motion to amend and/or after receiving the Board’s preliminary guidance (if requested). A revised motion to amend must provide amendments, arguments, and/or evidence in a manner that is responsive to issues raised in the preliminary guidance and/or petitioner’s opposition.

If Patent Owner files a revised motion to amend, the Board shall enter a revised scheduling order setting the briefing schedule for that revised

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