

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ETON PHARMACEUTICALS, INC.,  
Petitioner

v.

EXELA PHARMA SCIENCES, LLC,  
Patent Owner

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PGR2020-00064  
Patent US 10,478,453 B1

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Before ULRIKE W. JENKS, SUSAN L. C. MITCHELL and  
CHRISTOPHER G. PAULRAJ, Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

ORDER

Conduct of Proceeding

37 C.F.R. §§ 42.5; 42.208(c)

A conference call was held on September 21, 2020, between counsel for the respective parties and Judges Jenks, Mitchell, and Paulraj. The purpose of the call was to discuss Petitioner's request to file a reply to Patent Owner's preliminary response. In the conference call, we authorized Petitioner to file a 6-page reply due September 28, 2020 and Patent Owner may, if necessary, file a 6-page sur-reply due October 5, 2020.

Under 37 C.F.R. § 42.208(c), Petitioner "may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c)," but "[a]ny such request must make a showing of good cause." Here, Petitioner has shown good cause. On the facts in this case, we determine that the Board would benefit from additional briefing.

In particular, Petitioner would like to address arguments presented in Patent Owner's preliminary response citing certain alleged deficiencies in the petition. In addition, Petitioner asserts that Patent Owner's argument in a related proceeding is inconsistent with arguments made during the prosecution leading to the patent at issue in the present proceeding. At this stage, we agree with Petitioner that additional briefing would clarify the record with respect to the assertions made in Patent Owner's preliminary response, which would allow the Board to make an informed determination on the issues.

For the reasons given, it is:

ORDERED that Petitioner is authorized to submit a 6-page reply no later than September 28, 2020;

FURTHER ORDERED that Patent Owner is authorized to submit a 6-page sur-reply no later than October 5, 2020, responsive to Petitioner's reply.

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PETITIONER:

Ralph J. Gabric  
Eugene Goryunov  
Judy K. He  
Jeff Wolfson  
HAYNES AND BOONE LLP  
Email: ralph.gabric.ipr@haynesboone.com  
Email: eugene.goryunov.ipr@haynesboone.com  
Email: judy.he.ipr@haynesboone.com  
Email: jeff.wolfson.ipr@haynesboone.com

PATENT OWNER:

Dorothy P. Whelan  
Alana Mannige  
FISH & RICHARDSON P.C.  
whelan@fr.com  
mannige@fr.com