

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERICO, LLC and
FLAT LINE CAPITAL, LLC,
Petitioner,

v.

DR. FALK PHARMA GMBH,
Patent Owner.

Case IPR2016-00297
Patent 8,865,688 B2

Before LORA M. GREEN, GRACE KARAFFA OBERMANN, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

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

On July 13, 2016, a conference call was held among counsel for
Petitioner, GeneriCo, LLC and Flat Line Capital, LLC, and counsel for
Patent Owner, Dr. Falk Pharma GmbH, and Administrative Patent Judges
Green, Obermann, and Roesel. By e-mail to the Board on July 11, 2016,

Petitioner requested the call to request authorization for a motion to file supplemental information pursuant to 37 C.F.R. § 42.123. We issue this order to summarize the substance of the discussion during the conference call.

Both in the e-mail to the Board and during the call, Petitioner characterizes the supplemental information that Petitioner seeks to submit as supplemental evidence that Petitioner served on Patent Owner in response to Patent Owner's objections to evidence. Petitioner explained that the information falls into two categories: (1) a supplemental declaration addressing Patent Owner's contention that Petitioner's asserted prior art references would not have been relied upon by a person of ordinary skill in the art; and (2) documents from related district court litigations responsive to Patent Owner's objections to portions of Petitioner's declaration on the basis that the declarant is not a person of ordinary skill in the art.

During the call, the panel explained that, if Patent Owner preserves its objections to evidence by filing a Motion to Exclude pursuant to 37 C.F.R. § 42.64(c), then Petitioner will have an opportunity to file an opposition to the Motion to Exclude, including any supplemental evidence that Petitioner served on Patent Owner pursuant to 37 C.F.R. § 42.64(b)(2). The panel further explained that, if Patent Owner addresses the issues raised in its objections to evidence in a Patent Owner Response, then Petitioner will have an opportunity to file a Reply to the Patent Owner Response, including a reply declaration or other reply evidence responsive to issues raised in the Patent Owner Response. *See Activision Blizzard, Inc. v. Acceleration Bay, LLC*, Case IPR2015-01951, slip op. at 6–7 (PTAB May 4, 2016); *see also* 37 C.F.R. § 42.23(b); *Office Patent Trial Practice Guide*, 77 Fed. Reg.

48,756, 48,767 (U.S. Patent & Trademark Office Aug. 14, 2012) (addressing proper scope of a reply).

The panel explained that no prior authorization from the Board is required for Petitioner to file an opposition to a Motion to Exclude including supplemental evidence that has been served pursuant to 37 C.F.R. § 42.64(b)(2) or to file a Reply to a Patent Owner Response including a reply declaration or other reply evidence.

The panel explained that supplemental information pursuant to 37 C.F.R. § 42.123 is information that Petitioner intends to rely upon as part of its case-in-chief to support an argument on the merits. The Board explained that, a motion to file supplemental information would need to explain why the information was not included with the Petition. The Board referred Petitioner to the Federal Circuit's discussion of motions to file supplemental information in *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435 (Fed. Cir. 2015).

Based on the panel's explanations as summarized above, Petitioner withdrew their request for authorization to file a motion to file supplemental information pursuant to 37 C.F.R. § 42.123.

We confirm the procedural guidance provided during the call, as summarized above. We note that, although Petitioner stated during the call that Patent Owner served objections to evidence on June 24, 2016, no such objections appear to have been filed, as required by 37 C.F.R. § 42.64(b)(1). We further note that Patent Owner need not wait until Petitioner files the declaration that has been served as supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2) before cross-examining Petitioner's declarant.

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Cross-examination regarding the already-served declaration may take place at any time during Patent Owner's discovery period.

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