

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIODELIVERY SCIENCES INTERNATIONAL, INC.,
Petitioner,

v.

MONOSOL RX, LLC,
Patent Owner.

Cases IPR2015-00165,
IPR2015-00168, and IPR2015-00169
Patent 8,765,167 B2¹

Before FRANCISCO C. PRATS, JACQUELINE WRIGHT BONILLA, and
ZHENYU YANG, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

Order
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading when filing a single paper in all three proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

A conference call was held on September 21, 2015, among counsel for BioDelivery Sciences International, Inc. (“Petitioner”), counsel for MonoSol Rx, LLC (“Patent Owner”), and Judges Prats, Bonilla, and Yang. A court reporter was present on the call. Patent Owner indicated that it would file a copy of the transcript of the call into the record in these three proceedings.

The purpose of the call was to discuss Patent Owner’s request for authorization to file a motion for sanctions under 37 C.F.R. § 42.12. Specifically, Patent Owner contended that Petitioner entered numerous improper leading objections during Patent Owner’s depositions of Petitioner’s experts, Drs. Reitman and Cohen, and that the volume and impropriety of those objections impeded, delayed, and frustrated Patent Owner’s fair cross examinations of Petitioner’s witnesses.

Petitioner contended that Patent Owner’s request is untimely, because Patent Owner did not raise its assertions regarding Petitioner’s allegedly improper conduct until seven weeks after the depositions, and four weeks after the Patent Owner Response was filed. Petitioner noted also that Patent Owner actually cited to transcripts of the depositions at issue in the Patent Owner Response.

We do not authorize Patent Owner’s motion for sanctions.

The Office Patent Trial Practice Guide provides that the Board “may impose an appropriate sanction—including the reasonable expenses and attorneys’ fees incurred by any party—on a person who impedes, delays, or frustrates the fair examination of the witness.” 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D).

The Office Patent Trial Practice Guide also provides that if a party wishes to move to terminate or limit deposition testimony on the ground that the deposition is conducted in bad faith or in a manner that unreasonably annoys, embarrasses, or oppresses that party, that party “*must promptly* initiate a conference call with the Board to discuss the proposed motion.” *Id.* (emphasis added).

In the instant case, Dr. Reitman’s deposition was taken on July 28, 2015, and Dr. Cohen’s deposition was taken on July 30 and 31, 2015. *See* Ex. 2012, 1; Ex. 2013, 1; Ex. 2014, 154.² During our September 21, 2015 call with the parties, however, Patent Owner indicated that it did not seek to initiate a conference call with the Board during the depositions at issue here, nor any time soon after the depositions. Patent Owner indicated also, in an September 17, 2015 email that prompted our call, that a meet and confer to resolve these issues was conducted unsuccessfully with Petitioner on September 16, 2015.

As is evident, rather than promptly initiating a conference call to address its perceived issues of concern during the depositions or soon thereafter, Patent Owner allowed nearly seven weeks to pass between the depositions and its request for authorization to file its motion for sanctions. Also, Patent Owner did not express its concerns regarding the depositions until several weeks after the August 21, 2015 filing of its Patent Owner Responses, where Patent Owner ultimately cited the depositions at issue. IPR2015-00165, Paper 16, 14, 43; IPR2015-00168, Paper 15, 14, 43; IPR2015-00169, Paper 15, 14, 43. Given these facts, and looking at the

² The Exhibit numbers for the depositions are the same in each of IPR2015-00165, IPR2015-00168, and IPR2015-00169.

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totality of the record as it pertains to the issue at hand, we decline to authorize Patent Owner to file its motions for sanctions, as discussed during the conference call on September 21, 2015.

Accordingly, it is:

ORDERED that Patent Owner's request to file a motion for sanctions is *denied*.

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