

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M COMPANY, MERCK & CO., INC. and
MERCK SHARP & DOHME CORP.,
Petitioner,

v.

APTARFRANCE S.A.S.,
Patent Owner.

Cases¹
IPR2018-01054 (Patent 8,936,177 B2)
IPR2018-01055 (Patent 9,370,631 B2)

Before HYUN J. JUNG, SCOTT A. DANIELS, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

SCHEDULING ORDER
37 C.F.R. § 42.5(a)

This Order sets a schedule for trial, including due dates for the parties to take action upon entry of the Decision to Institute. *See* Appendix. The

¹ The parties are not authorized to use a caption identifying multiple proceedings.

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trial will be administered in a just, speedy, and inexpensive manner such that pendency before the Board is no more than one year after institution. 37

C.F.R. §§ 42.1(b) and 42.100(c).

A. GENERAL INSTRUCTIONS

1. Initial Conference Call

An initial conference call will be scheduled only upon request by either party within thirty (30) days of this Order. To request a conference call, the parties should consult with each other and submit a list of proposed dates and times for the call. If an initial conference call is scheduled, the parties are directed to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (“Trial Practice Guide”), for guidance in preparing for the call, and should be prepared to discuss any proposed changes to the schedule and any motions the parties anticipate filing during the trial.

2. Meet and Confer Requirement

The parties are encouraged to engage in meaningful discussions before seeking authorization under 37 C.F.R. § 42.20(b) to file a motion for relief with the Board. At a minimum, before requesting authorization, the parties shall confer with each other in a good-faith effort to resolve the issue for which relief is to be sought. Only if the parties cannot resolve the issue on their own may a party request a conference call with the Board in order to seek authorization to move for relief. In any request for a conference call with the Board, the requesting party shall: (1) certify that it has in good-faith conferred (or attempted to confer, if the request is a time-sensitive emergency) with the other party in an effort to resolve the issue; (2) identify

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with specificity, but without argument, the issue for which agreement has not been reached; (3) state the precise relief to be sought; and (4) propose specific dates and times for which *both parties* are available for the conference call.

3. 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 should be presented as an exhibit to the motion. The Board encourages the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Default Protective Order, Trial Practice Guide, 77 Fed. Reg. at 48,756 (App. B). If the parties choose to propose a protective order deviating from the default protective order, they must submit the 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.

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* Trial Practice Guide, 77 Fed. Reg. at 48,761.

4. Cross-Examination Testimony

The parties are reminded that the Testimony Guidelines appended to the Trial Practice Guide, 77 Fed. Reg. at 48,772 (App. D), apply to this proceeding. The Board may impose an appropriate sanction on any party who fails to adhere to the Testimony Guidelines, including reasonable expenses and attorney fees incurred by a party affected by another party's misconduct. 37 C.F.R. § 42.12.

Except as the parties might otherwise agree, for each due date—
(1) cross-examination of a witness begins after any supplemental evidence is due; and (2) cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. 37 C.F.R. § 42.53(d)(2). Should a party submit a deposition transcript of a witness's testimony as an exhibit in this proceeding, the submitting party shall file the full transcript of the testimony 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. Oral Argument

Requests for oral argument must comply with 37 C.F.R. § 42.70(a). To permit the Board sufficient time to schedule the oral argument, the parties may not stipulate to an extension of the request for oral argument beyond the date set forth in the Appendix hereto.

Unless the Board notifies the parties otherwise, oral argument, if requested, will be held at the United States Patent and Trademark Office headquarters in Alexandria, Virginia. Seating in the Board's hearing rooms

may be limited, and will be available on a first-come, first-served basis. If either party anticipates that more than five (5) individuals will attend the argument on its behalf, the party should notify the Board as soon as possible, and no later than the request for oral argument. The parties should note that the earlier a request for accommodation is made, the more likely the Board will be able to accommodate additional individuals.

B. DUE DATES

The Appendix specifies due dates for the parties to take action in this proceeding. The parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of any stipulation, specifically identifying the changed due dates, must be filed promptly with the Board. The parties may not stipulate to an extension of DUE DATES 6 and 7.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony.

1. Due Date 1

The patent owner may file—

- a. A response to the petition (37 C.F.R. § 42.120), and
- b. A motion to amend the patent (37 C.F.R. § 42.121).

The patent owner must file any such response or motion to amend by DUE DATE 1. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. *The*

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patent owner is cautioned that any arguments for patentability not raised and fully briefed in the response will be deemed waived.

The patent owner may file a motion to amend without prior authorization from the Board. Nevertheless, the patent owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). To satisfy this requirement, the patent owner should request a conference call with the Board no later than two weeks prior to DUE DATE 1. The parties are directed to the Board's Guidance on Motions to Amend in view of *Aqua Products*, which can be found at https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf. In addition, the parties are directed to the Board's decision in *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018-00082 (PTAB April 25, 2018) (Paper 13) (informative), which provides guidance on motions to amend.

2. Due Date 2

The petitioner must file any reply to the patent owner's response and opposition to the motion to amend by DUE DATE 2.

3. Due Date 3

The patent owner must file any sur-reply to the petitioner's reply and any reply to the petitioner's opposition to any motion to amend by DUE DATE 3.

4. Due Date 4

The petitioner must file any sur-reply to the patent owner's reply to the opposition to the motion to amend, and each party must file any motion to exclude evidence (37 C.F.R. § 42.64(c)) and any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.

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5. Due Date 5

Each party must file any opposition to a motion to exclude evidence by DUE DATE 5.

6. Due Date 6

Each party must file any reply for a motion to exclude evidence by DUE DATE 6.

Either party may file a request for a pre-hearing conference.

7. Due Date 7

If requested by either party, an oral hearing will be held on DUE DATE 7.

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APPENDIX

INITIAL CONFERENCE CALL Upon Request

DUE DATE 1 February 13, 2019

- Patent owner's response to the petition
- Patent owner's motion to amend the patent

DUE DATE 2 May 13, 2019

- Petitioner's reply to patent owner's response to the petition
- Petitioner's opposition to motion to amend

DUE DATE 3 June 13, 2019

- Patent owner's sur-reply to petitioner's reply
- Patent owner's reply to petitioner's opposition to motion to amend

DUE DATE 4 July 15, 2019

- Petitioner's sur-reply to patent owner's reply to opposition of motion to amend
- Motion to exclude evidence
- Request for oral argument

DUE DATE 5 July 22, 2019

- Opposition to motion to exclude

DUE DATE 6 July 29, 2019

- Reply to opposition to motion to exclude
- Request for pre-hearing conference

DUE DATE 7 August 12, 2019

- Oral argument (if requested)

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