

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.

APTAR FRANCE S.A.S.,
Patent Owner.

Cases¹
IPR2018-01054 (Patent No. 8,936,177)
IPR2018-01055 (Patent No. 9,370,631)

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

JUNG, *Administrative Patent Judge*.

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

¹ This order addresses issues that are the same in all identified proceedings. We exercise our discretion to issue one order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

IPR2018-01054 (Patent No. 8,936,177)

IPR2018-01055 (Patent No. 9,370,631)

AptarFrance S.A.S. (“Patent Owner”) requested by email authorization to file a motion to strike portions of Petitioner’s replies that it believed exceeded proper scope in each of these proceedings. *See* 37 C.F.R. § 42.23(b). Patent Owner alternatively sought authorization to file a supplemental declaration to respond to what it believed were new issues and belatedly presented evidence in the replies. 3M Company, Merck & Co., Inc., and Merck Sharp & Dohme Corp. (collectively “Petitioner”) argued that such requests should have been made within one week of its replies being filed and served.

Even though the Board can decide whether Petitioner’s replies are responsive to an argument already made, and despite Patent Owner’s belated request, the panel authorized Patent Owner to file a paper identifying the arguments in the replies that it believed exceeded proper scope. Petitioner was also authorized to file a paper identifying for each argument identified by Patent Owner where the contention it is responding to can be found. The parties filed these authorized papers. Papers 32, 33 in IPR2018-01054 and IPR2018-001055. Patent Owner was also authorized to file a supplemental declaration, which it did. Ex. 2023 in both proceedings.

Petitioner then requested to file a 7-page sur-sur-reply to address the supplemental declaration. Petitioner represented that Patent Owner opposed the request. Petitioner’s request for authorization to file a 7-page sur-sur-reply is *granted*. *See* 37 C.F.R. § 42.5(a). The sur-sur-reply is limited to addressing only the supplemental declaration and must be filed within five (5) business days after the deposition. *See* Paper 34 in both proceedings (providing notice that deposition is presently scheduled for July 11, 2019).

IPR2018-01054 (Patent No. 8,936,177)

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The parties should be aware that, in the event that we determine that Petitioner's replies are properly responsive to an argument already made in the record, there will be no need to consider these additionally authorized papers and exhibits.

Petitioner also indicated that the parties agree to cross-examination of Patent Owner's declarant regarding the supplemental declaration but cannot presently reach agreement as to the length of the cross-examination. In view of the limited subject matter of the supplemental declaration and thus, the scope of the cross-examination, we see no reason to allow a full deposition for a brief that may not need to be considered. Petitioner indicates that two hours would be insufficient. Based on the present record and limited additional information provided by the parties, we determine that four (4) hours would be sufficient. If there are issues with only four hours, the parties should request a conference with dates and times when both parties are available.

ORDER

It is

ORDERED that Petitioner's request to file a sur-sur-reply in each proceeding is *granted*; and

FURTHER ORDERED that the sur-sur-reply in each proceeding is limited to seven (7) pages, may only address Patent Owner's supplemental declaration, and must be filed within five (5) business days of the deposition.

IPR2018-01054 (Patent No. 8,936,177)

IPR2018-01055 (Patent No. 9,370,631)

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