

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.
Petitioner

v.

ALCON RESEARCH, LTD
Patent Owner.

Cases IPR2013-00428 (Patent 8,268,299 B2)
IPR2013-00429 (Patent 8,323,630 B2)
IPR2013-00430 (Patent 8,388,941 B2)¹

Before LORA M. GREEN, FRANCISCO C. PRATS, and RAMA G. ELLURU,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

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

¹ This order addresses the consolidated initial conference held on February 3, 2014, for all three cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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I. Introduction

On February 3, 2014, an initial conference call was held including the following individuals:

- (1) Eldora Ellison and Ralph Powers III, counsel for Apotex Corp. (“Petitioner”);
- (2) Stanley Fisher, counsel for Alcon Research, Ltd. (“Patent Owner”); and
- (3) Lora M. Green, Francisco C. Prats and Rama G. Elluru, Administrative Patent Judges.

A court reporter was present on the call, and Petitioner indicated that it would file a copy of the hearing transcript as an exhibit.²

II. Scheduling Order

The purpose of the call was to discuss any motions that the parties intend to file and any proposed changes to the Scheduling Orders (Papers 10, 9 and 10).³ The parties indicated that they have reached an agreement as to modifying Due Dates 1-3 set forth in the Scheduling Orders, and are working on a stipulation to that effect. The parties were reminded that a stipulation changing Due Dates 1-3 must be filed with the Board. The parties were advised that Board authorization of such stipulation is not required. No other issues with respect to the Scheduling Orders were raised by the parties and, accordingly, the Board sees no reason to modify the Scheduling Orders at this time.

² This order summarizes the statements made during the conference call. A more detailed record may be found in the transcript.

³ All references to the papers refer to the three proceedings in numerical order; *i.e.*, the first paper number refers to the paper number in IPR2013-00428, the second paper number refers to the paper number in IPR2013-00429, and the third paper number refers to the paper number in IPR2013-00430.

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III. Motions List

Petitioner did not file a proposed motions list.

Patent Owner's List of Anticipated Proposed Motions, (Papers 15, 13 and 14), identified a possible contingent motion to amend under 37 C.F.R. § 42.121, one or more of the challenged claims of the challenged patents. In connection with that contingent motion, Patent Owner inquired whether the claim listing required by 37 C.F.R. § 42.121(b) would be counted against the 15-page limit for a motion, or whether the claim listing may be submitted as an attachment to the motion. Specifically, Patent Owner inquired whether the claim listing may be submitted as an "appendix" to the motion. Patent Owner was advised that claims may not be set forth in an appendix, and thus the claim listing is counted against the 15-page limit for a motion. The Board further advised Patent Owner of the requirement to confer with the Board prior to filing such motion to amend, and at that time, Patent Owner should provide a good reason why it requires additional pages to support the motion. *See* 37 C.F.R. § 42.121(a).⁴ As issues arise, the parties may contact the Board to discuss the filing of any additional motions.

Patent Owner's List also identified a Motion requesting *Pro Hac Vice* Admission of Adam L. Perlman (Papers 13, 11 and 12), which motion was unopposed and granted in the Board's Order of February 3, 2014 (Papers 18, 16 and 17).

⁴ Additional guidance on motions to amend is provided in the Board's Trial Practice Guide and recent decisions, including Case IPR2012-00005, Paper 27, dated June 3, 2013, and Case IPR2012-00027, Paper 26, dated June 11, 2013 ("*Idle Free*"). For example, *Idle Free* explains that "in the absence of special circumstance, a challenged claim can be replaced by only one claim, and a motion to amend should, for each proposed substitute claim, specifically identify the challenged claim which it is intended to replace." *Idle Free* at 5.

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During the conference, Patent Owner indicated that it had no opposition to Petitioner's pending Motion requesting *Pro Hac Vice* Admission of Paul A. Ainsworth (Papers 16, 14 and 15). The ruling on the Ainsworth Motion will be set forth in a separate order.

IV. Protective Order

The parties are reminded that there is currently no protective order in place in the instant proceeding.

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