

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADAMA MAKHTESHIM LTD.,
Petitioner

v.

FINCHIMICA S.P.A.,
Patent Owner.

Case IPR2016-00577
Patent 8,304,559 B2

Before SALLY GARDNER LANE *Administrative Patent Judge*.

SECOND ORDER MODIFYING SCHEDULING ORDER

The parties contacted the Board regarding scheduling a conference call to request an extension of times set in the Scheduling Order. In particular, Patent Order represented, via email communication, that its lead counsel recently underwent urgent surgery such that lead counsel has been unable to participate fully in preparing the Patent Owner response¹ currently due on 17 August 2016. Petitioner filed an email in response to Patent Owner's email. Both emails are in an attachment to this Order. (*See* attached email communication).

The concerns regarding scheduling raised by both parties have been considered. Under the circumstances, all times, except for the oral argument date,² are extended by two weeks as reflected in the attached Appendix.

It is

ORDERED that, as reflected in the Appendix to this Order, the Modified Scheduling Order (Paper 16, Appendix) is modified to extend all times except for the oral argument date, by two weeks.

¹ In the email Patent Owner stated that it is not filing a motion to amend its claims.

² The oral argument date was modified from that set in the Scheduling Order entered 24 May 2016 (Paper 8). The date was changed from 16 February 2017 to 14 February 2017. (Order Modifying Scheduling Order, Paper 16).

Case IPR2016-00577
Patent 8,304,559 B2

PETITIONER:

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PATENT OWNER:

Edward Figg
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Robert Huntington
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SECOND MODIFIED DUE DATE APPENDIX

INITIAL CONFERENCE CALL.....UPON REQUEST
DUE DATE 1**31 August 2016**
Patent owner’s response to the petition
~~Patent owner’s motion to amend the patent~~
DUE DATE 2**23 November 2016**
Petitioner’s reply to patent owner’s response to petition
~~Petitioner’s opposition to motion to amend~~
DUE DATE 3**21 December 2016**
~~Patent owner’s reply to petitioner’s opposition to motion to amend~~
DUE DATE 4**04 January 2017**
Motion for observation regarding cross-examination of reply witness
Motion to exclude evidence
Request for oral argument
DUE DATE 5**19 January 2017**
Response to observation
Opposition to motion to exclude
DUE DATE 6**02 February 2017**
Reply to opposition to motion to exclude
DUE DATE 7**14 February 2017**
Oral argument (if requested)

ATTACHMENT

From: Gary J. Gershik [<mailto:GGERSHIK@COOPERDUNHAM.COM>]
Sent: Wednesday, August 10, 2016 8:46 PM
To: Trials <Trials@USPTO.GOV>
Cc: E. Anthony Figg <efigg@rothwellfigg.com>; Danny Huntington <dhuntington@rothwellfigg.com>; Seth E. Cockrum <scockrum@rothwellfigg.com>; Sharon Crane <scrane@rothwellfigg.com>; Derek F. Dahlgren <ddahlgren@rothwellfigg.com>; Erik van Leeuwen <evanlee@rothwellfigg.com>; Norman Zivin <NZIVIN@COOPERDUNHAM.COM>
Subject: RE: IPR2016-00577; ADAMA MAKHTESHIM LTD. (Petitioner) v. FINCHIMICA S.P.A. (Patent Owner)

Dear Patent Trial and Appeal Board,

I write on behalf of Petitioner, Adama Makhteshim Ltd., to clarify an inaccuracy in Finchimica's below email and to provide the Board with all of the facts regarding the extension issue ahead of any telephone conference. Contrary to the third sentence of the third paragraph of Patent Owner's below email, Petitioner did not agree to a three week extension under any conditions.

On July 22nd, Finchimica first requested a three week extension for filing its Patent Owner's Response "[b]ecause of summer vacation schedules and deadlines in other cases." On the same day Adama replied by (1) pointing out that such an extension would unduly constrain the schedule, but (2) indicated a willingness "to add one extra week to [Finchimica's] period if [Finchimica would] agree to add one extra week to [Adama's] period, such that Due Date 1 would be August 24, 2016 and Due Date 2 would be November 23, 2016." Adama's counsel was and remains concerned that extra time will result in Finchimica preparing a complicated Patent Owner Response, for which Adama would likewise need more time to prepare a reply.

In an August 9th email, Finchimica requested a two-week extension to August 31, 2016. In response, Adama again expressed its concern that Finchimica's proposal "provides Finchimica with an extra 2 weeks of total time to prepare the Response, yet it provides Adama with no extra time to prepare its Reply." Nonetheless, to accommodate Finchimica's Lead Counsel, Adama indicated a willingness to provide Finchimica with its requested two week extension if Finchimica (1) agreed to extend Due Date 2 to December 7, 2016 to analogously provide Adama with two extra weeks of preparation time, and (2) agreed to schedule deposition of its expert(s) in Washington, D.C. or New York City taking into account the Thanksgiving holiday which would be subsumed within Petitioner's period for reply.

On August 10th, Finchimica expressed a willingness to accept Adama's two week extension proposal, on the condition that "[Adama] will agree to either: (1) not submit a new declaration from Dr. Gribble with Adama's Reply, or (2) agree to make Dr. Gribble available for deposition on December 19 or 20, and agree to move due dates 4 and 5 to January 3 and January 13 respectively." In response, Adama proposed to deal with only Due Dates 1 and 2 at this time, and leave the remainder of the schedule as is until everyone has the benefit of further briefing.

Two relevant email chains between counsel are attached providing the relevant facts.

Counsel for Petitioner is available for a telephone conference if needed.

Respectfully submitted on behalf of Petitioner,

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