

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KVK-TECH, INC.,
Petitioner,

v.

SHIRE PLC,
Patent Owner.

Case IPR2018-00290 (Patent 8,846,100 B2)
Case IPR2018-00293 (Patent 9,173,857 B2)¹

Before RAMA G. ELLURU, SHERIDAN K. SNEDDEN, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

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

¹ This Decision addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Decision to be entered in each proceeding. The parties are not authorized to use this joint heading and filing style in their papers.

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On February 25, 2019, counsel for Petitioner sent the following email to the individual email address of a paralegal at the Board:

I am an attorney working on the above-referenced IPRs. In addition to this email, I left you a voicemail message.

I write to ask for your guidance to correct an expert declaration filed on February 7. The required oath was inadvertently left out of the expert's declaration, and we would like to correct this error.

The questions I have are more procedurally-based, and I'm hoping you can help. For example, do we add the oath to the Feb. 7 declaration (exhibit 1045) and keep the dates the same, or do we need to file a new declaration updated dates, and a new exhibit number? Or perhaps there is a different convention or protocol we should follow that is not in the rules?

Any advice you may provide would be greatly appreciated, and I thank you for your time.

This email was improper for the following reasons. First, all email communications to the Board should be sent to Trials@uspto.gov, as instructed in the Scheduling Order (Paper 14). Email sent to the Board should not be addressed to an individual email address(es). *See* 37 C.F.R. § 42.5(d) (prohibiting ex parte communications with any member of the Board, including employees acting with authority of the Board). Second, a party may communicate with the Board, without also copying opposing counsel, only on purely administrative matters (*e.g.*, how to use E2E). On email communications to the Board involving issues that may not be entirely procedural, a party should copy opposing counsel out of an abundance of caution. In this instance, Petitioner's email did not make clear that Patent Owner did not object to correction of the expert declaration, and thus, the issue was not entirely procedural and should not have been the subject of an

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email communication to the Board that did not copy counsel for Patent Owner.

With respect to Petitioner's need to correct Ex. 1045 to include a proper oath (Ex. 1045), the panel orders the parties to meet and confer in an attempt to seek an agreed upon resolution (*e.g.*, a motion to file a corrected declaration).

IT IS:

ORDERED that the parties meet and confer in an attempt to seek an agreed upon resolution (*e.g.*, a motion to file a corrected declaration) with respect to Petitioner filing a declaration without a proper oath (Ex. 1045).

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