

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDIVIOR INC.,
Petitioner,

v.

RHODES PHARMACEUTICALS L.P.,
Patent Owner.

Case IPR2018-00795
Patent 9,370,512 B2

Before SHERIDAN K. SNEDDEN and TINA E. HULSE,
Administrative Patent Judges.

HULSE, *Administrative Patent Judge.*

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

A conference call was held on July 31, 2018, among counsel for Petitioner, counsel for Patent Owner, and Judges Snedden and Hulse.

Petitioner requested the conference call on July 25, 2018, to seek authorization to file a reply to Patent Owner's Preliminary Response to address Patent Owner's arguments regarding 35 U.S.C. § 325(d) and the prosecution histories of the patent at issue and its parent patent. Patent Owner opposed the request, but, in the event we grant Petitioner's request, Patent Owner requested leave to file a surreply.

Having considered the parties' respective arguments, we grant Petitioner's request. Although Petitioner did address § 325(d) in the Petition, we do not expect Petitioner to foresee and address every potential counterargument in the Petition. Given that the issue is potentially case dispositive and that the prosecution history of the parent patent appears sufficiently complicated, we are persuaded that additional briefing would be helpful.

Finally, we noted during the call that there are two pending motions for pro hac vice admission filed by Petitioner's prior counsel, Thomas H. Wintner and Adam P. Samansky, both from the law firm of Mintz, Levin, Cohn, Ferris, Glovsky, and Popeo P.C. Paper 6; Paper 7. Because counsel for Mintz Levin have withdrawn from this proceeding, those motions are dismissed as moot.

It is, therefore,

ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response to address Patent Owner's 35 U.S.C.

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§ 325(d) arguments and the characterization of the prosecution histories of U.S. Patent Nos. 9,370,512 and 9,101,625 is *granted*;

FURTHER ORDERED that Patent Owner's request for authorization to file a surreply to Petitioner's reply is *granted*;

FURTHER ORDERED that Petitioner's reply shall be limited to five pages and filed no later than August 7;

FURTHER ORDERED that Patent Owner's surreply shall be limited to five pages and filed no later than August 14; and

FURTHER ORDERED that the pending Motions for Pro Hac Vice Admission of Thomas H. Wintner and Adam P. Samansky are dismissed as moot.

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