

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC and
FRESENIUS KABI SWISSBIOSIM GmbH.,
Petitioner,

v.

AMGEN INC. and AMGEN MANUFACTURING, LIMITED,
Patent Owner.

Case IPR2019-00971
Patent 9,856,287 B2

Before ZHENYU YANG, J. JOHN LEE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

Petitioner contacted the Board to request authorization to file a reply to the Patent Owner Preliminary Response (Paper 8). Specifically, Petitioner requests a reply of 7 pages to address the following issues:

1. Whether 35 U.S.C. § 311(c)(2) or 37 C.F.R. § 42.102(a)(3) bars the filing of a petition for *inter partes* review more than nine months after issuance of the challenged patent and before institution of any post-grant review on the challenged patent; and
2. Whether the Board should exercise its discretion under either 35 U.S.C. § 325(d) or 35 U.S.C. § 314(d) to deny institution of the Petition.

Patent Owner opposes Petitioner's request but has indicated it does not oppose a 5-page reply addressing these topics if it is limited only to addressing any new cases post-dating the petition, no additional exhibits or evidence are filed therewith, and Patent Owner is granted a 5-page sur-reply. Petitioner does not oppose the sur-reply but otherwise disagrees with Patent Owner's proposed restrictions on the reply.

Considering the parties' positions, we authorize Petitioner to file a reply addressing only the two topics identified above. The reply shall not exceed five pages, and no additional evidence or exhibits may be filed in support of the reply, but Petitioner may address any relevant legal authority. Further, Patent Owner is authorized to file a sur-reply. The sur-reply shall not exceed five pages, no additional evidence or exhibits may be filed in support of the sur-reply, and the sur-reply may only address matters raised in the reply.

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It is, therefore,

ORDERED that Petitioner is authorized to file a reply of no more than five (5) pages consistent with the limitations set forth above, and which may be filed no later than August 22, 2019; and

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply of no more than five (5) pages consistent with the limitations set forth above, and which may be filed no later than September 5, 2019.

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