

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LIQUIDIA TECHNOLOGIES, INC.,  
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,  
Patent Owner.

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IPR2021-00406  
Patent 10,716,793 B2

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Before ERICA A. FRANKLIN, CHRISTOPHER M. KAISER,  
and DAVID COTTA, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

On March 15, 2022, Judges Franklin, Cotta, and Kaiser held a conference call with counsel for both parties to discuss Patent Owner's email request for guidance from the Board regarding the scheduling of a deposition of one of Petitioner's reply declarants, Dr. Nicholas Hill. This order memorializes the oral orders we issued during the conference call.

### BACKGROUND

Petitioner filed its Reply in this proceeding on February 10, 2022. Previously, the parties agreed to extend the due date for Patent Owner's Sur-Reply to March 16, 2022, a date Petitioner is unwilling to agree to extend further. Along with its Reply, Petitioner filed several declarations of witnesses, including one by Dr. Nicholas Hill. *See Ex. 1106.*

On or about March 1, 2022, Patent Owner requested that Petitioner provide dates when its reply declarants would be available for deposition. The parties were able to agree on deposition dates for other witnesses, but Petitioner could not provide a date for Dr. Hill's deposition before the March 16 due date of Patent Owner's Sur-Reply. After apparently protracted negotiations, the parties approached us to resolve the dispute.

Patent Owner argues that it is entitled to take Dr. Hill's deposition and that its Sur-Reply should not be due until after it has had an opportunity to take the deposition. Further, Patent Owner argues that, in an attempt to make it possible for the deposition to go forward, it offered to reduce the length of the deposition to two and a half hours and to take the deposition on a weekend or evening, if necessary. Petitioner argues that, due to his clinical responsibilities and participation in other litigation, Dr. Hill is unavailable, even for a shortened deposition, at any time prior to April 14, 2022. Further,

Petitioner argues that Patent Owner waived its right to the deposition by failing to comply with the notice requirement of Rule 42.53(d)(4).

### ANALYSIS

Routine discovery in this proceeding includes “[c]ross-examination of affidavit testimony prepared for the proceeding.” 37 C.F.R.

§ 42.51(b)(1)(ii). Because Dr. Hill’s testimony was prepared for this proceeding, Patent Owner is entitled to cross-examine Dr. Hill on that testimony “within such time period as the Board may set.” *Id.* It is correct, as Petitioner notes, that “[t]he party seeking the deposition must file a notice of the deposition at least ten business days before a deposition,” and the parties agree that Patent Owner did not comply with this requirement.

37 C.F.R. § 42.53(d)(4). That said, we do not believe that, at least under the circumstances prevailing here, denying an authorized deposition altogether is an appropriate sanction for this violation. Accordingly, we decline to find that Patent Owner has waived its right to depose Dr. Hill.

At the same time, we are required to follow a schedule for this proceeding that permits us to issue a final written decision no more than one year after trial was instituted. 35 U.S.C. § 316(a)(11). Delaying the filing of Patent Owner’s Sur-Reply until some time after Dr. Hill becomes available for deposition on April 14, 2022, would make following this schedule quite difficult, so we also will not pursue this course.

Instead, Patent Owner’s Sur-Reply will remain due on March 16, 2022, even though Dr. Hill’s deposition cannot be completed by then. As Patent Owner proposed during the conference call, Patent Owner will be permitted to take Dr. Hill’s deposition on any date to which the parties can agree that falls on or before April 15, 2022. If the parties do not agree to an

earlier date, Petitioner shall make Dr. Hill available for deposition on April 15, 2022. The deposition will be limited to two and one-half hours on the record. Finally, following Dr. Hill's deposition, both parties will have an opportunity to file two-page observations on cross-examination. These observations will be due no later than two business days after the conclusion of the deposition.

For the foregoing reasons, it is

ORDERED that Patent Owner's Sur-Reply shall be filed no later than March 16, 2022;

FURTHER ORDERED that Petitioner shall produce Dr. Nicholas Hill for a deposition, limited to two and one-half hours on the record, no later than April 15, 2022;

FURTHER ORDERED that the parties may agree to a date earlier than April 15, 2022, but not to any later date, for Dr. Hill's deposition; and

FURTHER ORDERED that both parties are authorized to file observations on the cross-examination of Dr. Hill, with each set of observations not to exceed two pages, and with both sets of observations due no later than two business days after the conclusion of Dr. Hill's deposition.

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