Trials@uspto.gov
571-272-7822

Paper 48
Date: April 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUEBIRD BIO, INC.,
Petitioner,

v.

SLOAN KETTERING INSTITUTE FOR CANCER RESEARCH,
Patent Owner.

IPR2023-00070 (Patent 7,541,179 B2)
IPR2023-00074 (Patent 8,058,061 B2)[1]

Before SHERIDAN K. SNEDDEN, JAMES A. WORTH and CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.1, 42.5, 42.123(b)

[1] We exercise our discretion to issue one order to be entered in both cases. The parties are not authorized to use this style heading for subsequent papers without prior Board approval.

On March 29, 2024 via email, Petitioner requested authorization to submit papers related to a *Markman* hearing held in the parallel district court proceeding. The relevant portion of the email reads as follows:

> On March 20, 2024, a Markman hearing was held in the co-pending district court proceeding. Shortly before and during the hearing, Patent Owner SRT took positions that, in Petitioner bluebird's view, are inconsistent with and contradict positions SRT has taken before the Board. As such, Petitioner requests authorization to file recent papers relating to the Markman hearing (specifically, the transcript and slides from the Markman hearing, and a letter sent shortly before the hearing (D.I. 152)), together with a 5-page paper to explain Petitioner's positions. Petitioner would not oppose a 5-page responsive paper from SRT. In addition, Petitioner would propose that Petitioner's paper be due within 2 business days of the Board's authorization, and SRT's response be due 2 business days later.

We treat Petitioner's request as a request for authorization to file a Motion to Submit Supplemental Information pursuant to 37 C.F.R. § 42.123(b). According to that rule,

> A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

Id. "The moving party has the burden of proof to establish that it is entitled to the requested relief." *Id*. § 42.20(c). Patent Owner opposed the request.

On April 9, 2024, a conference call for this proceeding was held between respective counsel for the parties and Judges Snedden, Worth, and

Hardman. During the call, Petitioner indicated that recent developments in the parallel district court case prompted the need for entry of supplemental information. Specifically, Petitioner asserted that Patent Owner submitted a *Markman* hearing letter and demonstratives in the parallel district court case providing additional information regarding its positions on claim construction (i.e., Patent Owner's positions regarding what material could be included in the 3.2-kb nucleotide fragment recited in the challenged claims), which Petitioner contends contain concessions and admissions regarding the relevance of the prior art that are inconsistent with positions Patent Owner has taken in these proceedings. Petitioner alleged that Patent Owner narrows the scope of the claims in this proceeding while broadening the scope of the claims in the parallel district court case, thereby impacting the issue of whether fragments disclosed in the prior art asserted in the Petition are encompassed by the challenged claims.

Patent Owner asserted that Petitioner is misconstruing statements made during the *Markman* hearing. Patent Owner also contends that the information could have been raised earlier, and notes that in the Petitions of these proceedings, Petitioner took the position that no claim terms require construction to resolve the Petitioner's challenges. *Citing* IPR2023-00070, Paper 1, 22. Patent Owner asserted that, rather than take any affirmative position on claim construction in the Petitions, Petitioner took the position that it "reserves the right to advance appropriate claim construction positions as may be appropriate in the District of Delaware litigation between SRT and Petitioner." *Citing id.* at 22 n.9. Patent Owner asserted that Petitioner's attempt to assert in these proceedings its new position on claim construction advanced in the parallel district court case would require new briefing, new

expert declarations, and new depositions. Patent Owner further asserted that the nature of the evidence that Petitioner seeks to submit into these proceedings is merely attorney argument and would not classify as either intrinsic or extrinsic evidence.

We deny Petitioner's request for two independent reasons. First, the late stage of the proceedings weighs heavily against allowing any new information to be submitted. Petitioner makes its request after discovery and briefing are complete, after oral hearing, and less than 4 weeks before the statutory date for issuing final written decisions. Should the information be received into evidence at this late stage, however, we agree with Patent Owner that it would likely be necessary for us to receive and consider additional briefing and evidence for proper context and in order for us to weigh appropriately the new information against the information currently on record. Consideration of such information at the final hour of these proceedings would not satisfy our mandate to provide a just, speedy, and inexpensive resolution. *See Redline Detection, LLC v. Star Enivrotech, Inc*., 811 F.3d 435, 443 (Fed. Cir. 2015) (acknowledging that the overarching context of the regulations governing IPR proceedings includes a mandate to interpret the Rules "to secure the just, speedy, and inexpensive resolution" to this proceeding); 37 CF.R. § 42.1(b). Further to that point, we also decline to seek an extension of the statutory deadline in order to accommodate Petitioner's submission of these materials, as suggested by Petitioner.

Second, we do not discern that the allegedly inconsistent positions by Patent Owner would bear significantly on our consideration of the issues before us. That is, we are not persuaded that consideration of the proposed new information and briefing is warranted in light of our understanding of

the issues as presented in the parties' briefs and during oral hearing. Further, the information Petitioner seeks to submit appears to be, at least to some extent, similar to information we have considered. The new information pertains to claim construction issues disputed between the parties in the related district court proceedings and certain alleged inconsistent positions taken by Patent Owner and is related to arguments and evidence of record pertaining to whether certain LCR fragments disclosed by the cited prior art, (e.g., the May Article) are encompassed by the claims. Accordingly, we determine that consideration of the proposed materials would not be in the interests of justice.

For the reasons given, it is

ORDERED that Petitioner's request for authorization to submit supplemental information is *denied*.

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