

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GRÜNENTHAL GMBH,  
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,  
Patent Owner.

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Case PGR2018-00001  
Patent 9,539,268 B2

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Before TONI R. SCHEINER, GRACE KARAFFA OBERMANN, and  
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

*Granting Patent Owner's Request for Authorization to File a Sur-Reply*  
37 C.F.R. §§ 42.5(a), 42.24(c)(1)

A teleconference was held on October 30, 2018, to discuss Patent Owner's request for authorization to file a sur-reply in this proceeding. The teleconference was attended by Patent Owner's counsel (Messrs. R. Parrish Freeman and Brent A. Johnson), Petitioner's counsel (Messrs. Bruce C. Haas and Daniel J. Minion), and the panel of judges currently assigned to the case (Judges Scheiner, Obermann, and Snedden). Neither party retained a court reporter. Judge Obermann explained, with no objection from either party, that this Order shall constitute the record of the call.

The Board recently issued guidance in the form of a "Trial Practice Guide Update," dated August 2018 ("Practice Guide Update"). *See* 83 Fed. Reg. 38,989 (Aug. 13, 2018) (notifying the public of the updated "Practice Guide" and its accessibility through the USPTO website:

<https://go.usa.gov/xU7GP>). Patent Owner pointed out that, pursuant to that guidance, sur-replies presently are afforded as a matter of course in our administrative proceedings. *See id.* at 14. Given that aspect of current Board practice, Patent Owner requested, and Petitioner did not oppose, an opportunity to file a sur-reply in place of observations in this proceeding. Accordingly, during the teleconference, we *granted* Patent Owner's unopposed request to file a sur-reply that conforms to the word limit applicable to reply briefs; namely, the 5,600 word count. *See* 37 C.F.R. 42.24(c)(1) (applicable word count).

A question arose, however, surrounding a document that Patent Owner previously sought to introduce, without success, during the deposition of Dr. William Wargin taken in this action on or about

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October 25, 2018. *See* Paper 32 (Notice of Deposition, setting date for Dr. Wargin’s deposition as October 25, 2018). Based on the parties’ characterizations of that document during the teleconference, we refer to it herein as “the pK Values Excel Spreadsheet.” Petitioner objected to any intention on Patent Owner’s part to submit with its sur-reply any new evidence, including the pK Values Excel Spreadsheet.

Upon questioning, Patent Owner acknowledged that Dr. Wargin relied on the pK Values Excel Spreadsheet in preparing his declaration (Ex. 2017), which was filed in support of Patent Owner’s Response (Paper 22) on August 1, 2018. We questioned why Patent Owner should be allowed to submit the pK Values Excel Spreadsheet with the sur-reply, given that the document was available for filing with Patent Owner’s Response. We further observed that the Practice Guide Update discourages the filing of evidence in support of a responsive brief, where the evidence could, or properly should, have been presented earlier in the proceeding. *See* Practice Guide Update, 14 (a “[p]etitioner may not submit new evidence or argument in reply that it could have presented earlier”). Toward the end of this discussion, Patent Owner’s counsel stated, “This is not a hill I want to die on” and, thereafter, agreed that the pK Values Excel Spreadsheet would not be filed as an exhibit in support of the sur-reply.

The parties further agreed to stipulate to the terms of an Amended Scheduling Order that will accommodate the filing of the sur-reply and remove (from Due Dates 4 and 5) the filings pertaining to observations, without any changes to Due Dates 6 and 7. *See* Paper 18 (Scheduling Order). The Amended Scheduling Order shall be filed jointly by the parties at their earliest convenience. The parties were invited to contact the Board

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to request another telephone conference, in the event they are unable to agree upon the terms of an Amended Scheduling Order.

### ORDER

It is

ORDERED that Patent Owner's request for authorization to file a sur-reply is *granted*;

FURTHER ORDERED that the sur-reply shall comply with the 5,600 word count limit applicable to reply briefs;

FURTHER ORDERED that the sur-reply shall not be accompanied by new evidence, including the pK Values Excel Spreadsheet discussed herein;

FURTHER ORDERED that the parties shall stipulate to the terms of an Amended Scheduling Order that accommodates the filing of the sur-reply and removes (from Due Dates 4 and 5) the filings pertaining to observations, without any changes to Due Dates 6 and 7;

FURTHER ORDERED that the Amended Scheduling Order shall be filed jointly by the parties at their earliest convenience; and

FURTHER ORDERED that the parties should contact the Board to request another telephone conference, in the event they are unable to agree upon the terms of an Amended Scheduling Order.

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For PETITIONER:

Bruce Haas  
[grunenthalpgr@fchs.com](mailto:grunenthalpgr@fchs.com)

Stephen Yam  
[syam@fchs.com](mailto:syam@fchs.com)

For PATENT OWNER:

Brent Johnson  
[bjohnson@mabr.com](mailto:bjohnson@mabr.com)

Parrish Freeman  
[pfreeman@mabr.com](mailto:pfreeman@mabr.com)