

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GRÜNENTHAL GMBH  
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,  
Patent Owner.

---

Case PGR2019-00026 (Patent 9,931,352 B2)  
Case PGR2019-00027 (Patent 10,039,774 B2)<sup>1</sup>

---

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,  
and WESLEY B. DERRICK, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

SCHEDULING ORDER  
35 U.S.C. § 42.5

---

<sup>1</sup> This order addresses issues common to both cases; therefore, we issue a single order for entry in each case. The parties are authorized to use this style heading when filing an identical paper in both proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

## A. GENERAL INSTRUCTIONS

### 1. *Initial Conference Call*

The parties are directed to contact the Board within one month of this Order if there is a need to discuss proposed changes to this Scheduling Order or proposed motions that have not been authorized in this Order or other prior Order or Notice. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (“Practice Guide”) (guidance in preparing for the initial conference call). A request for an initial conference call shall include a list of proposed motions, if any, to be discussed during the call.

### 2. *Protective Order*

No protective order shall apply to this proceeding until the Board enters one. If either party files a motion to seal before entry of a protective order, a jointly proposed protective order must be filed as an exhibit to the motion. The parties may adopt the Board’s default protective order if they conclude that a protective order is necessary. *See* Office Patent Trial Practice Guide, July 2019 Update, App’x B (July 16, 2019) (“July 2019 TPG Update”).<sup>2</sup> If the parties choose to propose a protective order that deviates from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and, further, must explain why good cause exists to deviate from the default protective order. *See id.*

---

<sup>2</sup> Available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>

PGR2019-00026 (Patent 9,931,352 B2)  
PGR2019-00027 (Patent 10,039,774 B2)

The Board has a strong interest in the public availability of trial proceedings. Redactions to documents filed in this proceeding should be limited to the minimum amount necessary to protect confidential information, and the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order may become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See Practice Guide 48,761.*

### *3. Discovery and Other Disputes*

The Board encourages parties to resolve disputes on their own. If a dispute arises, the parties must meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board.

In any request for a conference call with the Board to resolve a dispute, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify the precise relief to be sought; and (c) propose specific dates and times at which both parties are available for the conference call. Such a request is not an opportunity to brief the merits of the dispute and must not include attorney argument.

### *4. Testimony*

The Testimony Guidelines appended to the Trial Practice Guide, Appendix D, apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines.  
37 C.F.R. § 42.12. Reasonable expenses and attorneys' fees incurred by any

PGR2019-00026 (Patent 9,931,352 B2)  
PGR2019-00027 (Patent 10,039,774 B2)

party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

Whenever a party submits a deposition transcript as an exhibit in this proceeding, the submitting party shall file the full transcript of the deposition rather than excerpts of only those portions being cited. After a deposition transcript has been submitted as an exhibit, all parties who subsequently cite to portions of the transcript shall cite to the first-filed exhibit rather than submitting another copy of the same transcript.

#### 5. *Cross-Examination*

Except as the parties might otherwise agree, for each due date—

1. Cross-examination ordinarily takes place after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).
2. Cross-examination ordinarily ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

#### 6. *Motion to Amend*

Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). Patent Owner should arrange for a conference call with the panel and opposing counsel at least two weeks before DUE DATE 1 in order to satisfy the conferral requirement. *See* Section B below regarding DUE DATES.

Patent Owner has the option to receive preliminary guidance from the Board on its motion to amend. *See Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84

PGR2019-00026 (Patent 9,931,352 B2)  
PGR2019-00027 (Patent 10,039,774 B2)

Fed. Reg. 9497 (Mar. 15, 2019) (“MTA Pilot Program Notice”). If Patent Owner elects to request preliminary guidance from the Board on its motion, it must do so in its motion to amend filed on DUE DATE 1.

Any motion to amend and briefing related to such a motion shall generally follow the practices and procedures described in the MTA Pilot Program Notice unless otherwise ordered by the Board in this proceeding. The parties are further directed to the Board’s Guidance on Motions to Amend in view of *Aqua Products* (<https://go.usa.gov/xU6YV>), and *Lectrosonics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (Paper 15) (PTAB Feb. 25, 2019) (precedential).

As indicated in the MTA Pilot Program Notice, Patent Owner has the option at DUE DATE 3 to file a revised motion to amend (instead of a reply, as noted above) after receiving petitioner’s opposition to the original motion to amend and/or after receiving the Board’s preliminary guidance (if requested). A revised motion to amend must provide amendments, arguments, and/or evidence in a manner that is responsive to issues raised in the preliminary guidance and/or petitioner’s opposition.

If Patent Owner files a revised motion to amend, the Board shall enter a revised scheduling order setting the briefing schedule for that revised motion and adjusting other due dates as needed. *See* MTA Pilot Program Notice, App’x B 1B.

As also discussed in the MTA Pilot Program Notice, if the Board issues preliminary board guidance on the motion to amend and the Patent Owner does not file either a reply to the opposition to the motion to amend or a revised motion to amend at Due Date 3, Petitioner may file a reply to the Board’s preliminary guidance, no later than three (3) weeks after Due

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.