

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GNOSIS S.P.A., GNOSIS BIORESEARCH S.A., and GNOSIS U.S.A., INC.  
Petitioners

v.

SOUTH ALABAMA MEDICAL SCIENCE FOUNDATION  
Patent Owner

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Case IPR2013-00116  
Patent 5,997,915

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Before JACQUELINE WRIGHT BONILLA, SCOTT E. KAMHOLZ, and  
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

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

The Board conducted a conference call with the parties on October 9, 2013, to discuss Patent Owner's Motion to Seal. Patent Owner sought to seal an extensive section of the patent owner response, as well as large portions of the content of many exhibits. The Board explained that the motion was not grantable as filed because, among other problems, Patent Owner had not shown good cause to justify such extensive redaction of the record. The Board also questioned the relevance of some of the evidence that Patent Owner submitted.

The Board ordered, with the parties' agreement, that Patent Owner will have one week, i.e., by October 16, 2013, to file a replacement patent owner response and exhibits that minimize the amount of redacted material and also reduce the evidence strictly to that which is relevant and necessary to Patent Owner's case. The Patent Owner may also, by that date, file a renewed Motion to Seal, a motion to withdraw the prior Motion to Seal, and a motion to expunge the original versions of the redacted patent owner response and any exhibits replaced or no longer relied upon. The Board emphasized that Patent Owner must limit redactions strictly to isolated passages consisting entirely of confidential information and that the thrust of Patent Owner's argument must be clearly discernible from the redacted versions of the patent owner response and evidence. The Board also reminded the parties that information subject to a protective order will 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* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). The replacement patent owner response and exhibits may not present any new argument or evidence beyond that already of record.

The Board encouraged the parties to stipulate to undisputed facts, to the greatest reasonable extent, and to present such stipulated facts in summary form. *See* FED. R. EVID. 1006.

The Board also noted that the Motion to Seal did not include a redline version of the Default Protective Order, alluded to as Appendix A to the motion. Patent Owner agreed to supply a redline version of the Default Protective Order with its renewed Motion to Seal.

The Board also noted that exhibits 2016 and 2017 were filed in proceeding IPR2013-00116 in redacted form only and reminded the parties that unredacted versions of all material sought to be sealed must be filed with the Board. Patent Owner agreed to remedy this deficiency with its replacement filings to the extent that evidence is still relied upon.

Patent Owner reiterated its request, from the initial conference call, about its opportunity to file a motion for observation on cross-examination testimony of a petitioner reply witness. The Board reiterated its statement that Patent Owner will be afforded an opportunity to file a motion for observation should it conduct a cross-examination of a petitioner reply witness.

The Board addressed several issues that Patent Owner raised in an email to the Board dated October 7, 2013 (copy attached to this Order).

First, Patent Owner asked whether supplemental evidence provided in response to an evidentiary objection may be filed, as well as served. The Board instructed Patent Owner not to file such evidence. In the event Petitioner files a motion to exclude evidence, Patent Owner may seek authorization to file an opposition thereto and to file its supplemental evidence.

Next, Patent Owner requested correction of certain misnumbered exhibits, as listed in its email. The Board indicated that it will correct the exhibit numbers.

Finally, Patent Owner requested authorization to submit copies of various exhibits unintentionally omitted from this proceeding but filed in one or more of related proceedings IPR2013-00116, IPR2013-00117, IPR2013-00118, and IPR2013-00119. Petitioner did not oppose this request, and the Board granted it.

Accordingly, it is hereby

ORDERED that Patent Owner is authorized to file, by 5 pm ET on October 16, 2013:

1. A replacement redacted version of the patent owner response;
2. Replacement redacted versions of exhibits;
3. A motion to withdraw the original Motion to Seal;
4. A renewed Motion to Seal, including a redline version of the Default Protective Order; and
5. A motion to expunge the original versions of the redacted patent owner response and of any exhibits replaced or no longer relied upon;

FURTHER ORDERED that the replacement patent owner response and exhibits may not present any new argument or evidence beyond that already of record;

FURTHER ORDERED that the replacement exhibits shall use the original exhibit numbers of the exhibits they are replacing;

FURTHER ORDERED that Patent Owner shall limit redactions in the replacement patent owner response and exhibits strictly to isolated passages consisting entirely of confidential information;

FURTHER ORDERED that Patent Owner shall reduce the evidence of record strictly to that which is relevant and necessary to Patent Owner's case;

FURTHER ORDERED that Patent Owner is encouraged to submit undisputed evidence in summary form;

FURTHER ORDERED that any exhibits for which Patent Owner seeks to redact any portion thereof must be filed in redacted and unredacted versions;

FURTHER ORDERED that the Board will correct exhibit numbers as set forth in the email attached to this Order;

FURTHER ORDERED that Patent Owner is authorized to file exhibits unintentionally omitted from this proceeding but that have been filed in one or more related proceedings;

FURTHER ORDERED that Patent Owner shall file a revised exhibit list to reflect the changes to the record it seeks; and

FURTHER ORDERED that the parties are not authorized at present to file supplemental evidence served in response to evidentiary objections.

Case IPR2013-00116  
Patent 5,997,915

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**Subject:** Re: IPR2013-00116, IPR2013-00117, IPR2013-00118, and IPR2013-00119

Dear PTAB:

We are counsel for Patent Owners in the above-listed four (4) IPRs. We were contacted last Thursday, October 3 by Andrew Kellogg requesting a conference call regarding Patent Owners' motions to seal filed in the above-listed IPRs. Of the available times provided by the Mr. Kellogg, Patent Owners and Petitioners are both available Wednesday (Oct. 9) between 10:00AM and 11:00AM (EST). Please let us know if that date and time is acceptable.

In addition, Patent Owners also respectfully requests the Board's indulgence during this call and allow Patent Owners to seek guidance on the following issues:

**1. Procedure for Responding to Petitioners' Evidentiary Objection**

Patent Owners write to seek guidance from the Board regarding how to proceed in responding to Petitioners' Evidentiary Objections to Patent Owner's Response served in each respective petition. Pursuant to 37 CFR § 42.64(b)(2), Patent Owners intend to serve supplemental evidence in the form of supplemental declarations to address certain evidentiary objections including, for example, lack of authenticity and/or identification, and lack of personal knowledge, among others. We note that in prior IPRs, the Board has indicated that supplemental declarations addressing evidentiary objections may be filed in addition to being served. See Case IPR2012-00005, Paper 28 at 2, dated June 7, 2013 and Case IPR2013-00082, Paper 41, dated June 19, 2013. Therefore, Patent Owners seek guidance regarding whether supplemental declarations that address only Petitioners' evidentiary objections should be filed in addition to being served, and if so whether authorization from the Board is necessary.

**2. Correction of Typographical Errors on the Electronic Docket**

We also seek guidance from the Board on how to address certain typographical and clerical errors in the electronic dockets of the above-listed IPRs. Specifically, Patent Owner has noticed the electronic dockets in IPR2013-00116, IPR2013-00118, and IPR2013-00119 contain certain typographical errors regarding the designation of exhibit numbers. Specifically:

In IPR2013-00116:

- Ex. 2065 is incorrectly listed on the docket as Ex. 2063; and
- Ex. 2297 is incorrectly listed on the docket as Ex. 2299.

In IPR2013-00118:

- Ex. 2058 is incorrectly listed on the docket as Ex. 2057;

- Ex. 2176 is incorrectly listed on the docket as Ex. 2177; and
- Ex. 2213 is incorrectly listed on the docket as Ex. 2013.

In IPR2013-00119:

- Ex. 2051 is incorrectly listed on the docket as Ex. 2050.

Patent Owners respectfully request guidance from the Board regarding how we may correct these typographical errors. Petitioners have indicated they will not object to this correction.

### **3. Permission to Correct Clerical Errors to Ensure an Accurate Trial Record**

Further, due to a clerical error, Exs. 2063 (deposition transcript excerpts) and 2064 (deposition transcript excerpts) that Patent Owner filed in IPR2013-00117 and IPR2013-00118 were incorrect copies of those exhibits, as they do not comport with the correctly filed exhibits bearing the same exhibit numbers in IPR2013-00116 and IPR2013-00119 – the latter were redacted versions of the deposition excerpts which were correctly served on Petitioners in all 4 IPRs. To correct this clerical error, Patent Owners respectfully request that, in the interest of maintaining an accurate trial record, we be authorized to substitute correct copies of Exs. 2063 and 2064 in IPR2013-00117 and IPR2013-00118. The correct copies would be identical to those already filed in IPR2013-00116 and IPR2013-00119 and served on Petitioners in all 4 IPRs. Petitioners have indicated they will not object to this correction.

Finally, in responding to Petitioners' Evidentiary Objections, Patent Owners noticed that Exs. 2281, 2283, and 2284, which are cited in Petitioners' evidentiary objections and in Patent Owner's Responses in the above-listed IPRs, are absent from the electronic docket in IPR2013-00117. Petitioners objected to Exs. 2281, 2283, and 2284 on hearsay grounds in IPR2013-00116, IPR2013-00117, IPR2013-00118, and IPR2013-00119. No other objections were lodged by Petitioners for these exhibits. The exhibits were filed and served in IPR2013-00116, IPR2013-00118, and IPR2013-00119, however, we noticed that these exhibits were absent from the electronic docket in IPR2013-00117. At the time, we believed the documents were uploaded in IPR2013-00117, as was the case in the other IPRs. Patent Owners respectfully request that, in the interest of maintaining an accurate trial record, we be authorized to file Exs. 2281, 2283, and 2284 in IPR2013-00117, as well as an updated list of exhibits to reflect the inclusion of these documents. Petitioners have indicated they will not object to this correction.

Best regards,

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