

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IKARIA, INC.,
Petitioner,

v.

GENO LLC,
Patent Owner.

Case IPR2013-00253
Patent 8,083,997 B2

Before LORA M. GREEN, SCOTT E. KAMHOLZ, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

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

Conference calls were held on February 12, 2014, at approximately 2:30 p.m., and March 31, 2014, at approximately 10:00 a.m., among Scott Servilla and Rory Alegria representing Petitioner Ikaria, Inc., Harold Fox and Stephanie Schonewald representing Patent Owner GeNO LLC, and Judges Green, Kamholz, and Crumbley. The following matters were discussed.

Deposition of David Fine

Ikaria sought the deposition of Mr. David Fine pursuant to 37 C.F.R. § 42.51(b)(1)(ii). As noted by Ikaria, GeNO's patent owner response cites Exhibit 2010, a declaration of Mr. Fine contained in the file history of Patent 8,083,997. Paper 14, 8. Ikaria contends that Mr. Fine's testimony is "affidavit testimony" within the meaning of Rule 42.51(b)(1)(ii), and cross-examination is routine discovery required by the Rules. GeNO disagreed, noting that Mr. Fine's declaration was not prepared for the purposes of this proceeding and arguing that cross-examination is, therefore, not required.

During the first conference call with the parties, the Board determined that cross-examination of Mr. Fine was required by the Rules, and that GeNO should make the declarant available for deposition. In the second conference call, however, GeNO informed the Board that it had been unable to arrange the deposition of Mr. Fine due to ongoing medical issues. Counsel for GeNO offered to withdraw the declaration of Mr. Fine, and Ikaria did not object to this proposal. GeNO is authorized to file a motion to expunge Exhibit 2010 from the record.

Reasonable Search for Inconsistent Information

Ikaria also sought discovery from GeNO pursuant to 37 C.F.R. § 42.51(b)(1)(iii), alleging that counsel for GeNO had not undertaken a reasonable search for information inconsistent with a position advanced by the party during the proceeding. GeNO disagreed, arguing that a reasonable search had been

conducted and that no such information was located that had not already been provided to Ikaria.

Upon questioning by the Board, counsel for GeNO agreed to file a certification with the Board that a reasonable search for the information sought by Ikaria had been conducted.

In light of the foregoing, it is

ORDERED that GeNO is authorized to file a motion to expunge Exhibit 2010, the declaration of David Fine, from the record; and

FURTHER ORDERED that, within three business days of this Order, counsel for GeNO will file a signed certification with the Board attesting to the following:

Upon reasonable search and inquiry, any relevant, nonprivileged information that is inconsistent with a position advanced by Patent Owner during this proceeding, has been produced or does not exist.

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