

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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4 THORNE RESEARCH, INC.

5 Petitioner Case: IPR2021-00268

6 vs. Patent No: 8,383,086

7 TRUSTEES OF DARTMOUTH
8 COLLEGE,

9 Patent Owner
10 _____

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12
13 CONFERENCE CALL

14 Friday, March 26, 2021

15 Washington, D.C.
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23 Reported by:

24 Paula J. Eliopoulos

25 JOB NO. 191947

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March 26, 2021

1:00 p.m.

Telephonic conference held before the
Patent Trial and Appeal Board reported
stenographically by Paula J. Eliopoulos, Notary
Public of the State of Maryland.

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APPEARANCES:

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BY: John Abramic, Esq.

Benjamin Holt, Esq.

Jamie Lucia, Esq.

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2 THE COURT: This is Judge Schneider.
3 We're here for a conference call for IPR
4 2021-00268.

5 On the phone with me are Judges
6 Mitchell and Pollock.

7 Do we have counsel for Petitioner on
8 the line?

9 MS. GREEN: Yes, Your Honor. This is
10 Lora Green with Wilson Sonsini and I also
11 have my colleagues Mike Rosato and Tasha
12 Thomas on the line with me.

13 THE COURT: All right. And do we have
14 counsel for the Patent Owner on the line?

15 MR. ABRAMIC: Yes, Your Honor. This
16 is John Abramic on behalf of Patent Owner
17 from Steptoe and Johnson. And with me on the
18 line are my colleagues Ben Holt and Jamie
19 Lucia.

20 THE COURT: All right.

21 I understand that the parties have met
22 and conferred about the possibility of
23 Petitioner filing a reply to the Patent
24 Owner's Preliminary Response. And while
25 there is general agreement that a reply is

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2 proper, it appears that there is a
3 disagreement with respect to what the scope
4 of the reply should be and potentially the
5 timing for filing the reply; is that correct?

6 MS. GREEN: Your Honor, that's
7 generally correct.

8 We haven't talked about the timing of
9 the reply. But in theory Patent Owner did
10 not disagree that we could file a reply in
11 responses to the argument that's By Another.

12 And I also wanted to let you know that
13 we do have a court reporter on the call and
14 we will file that transcript once we receive
15 a final copy.

16 THE COURT: Excellent. Excellent.

17 All right. Since it's the
18 Petitioner's request, I'll allow Petitioner
19 to go first. I think we should try to focus
20 on the issue, I believe which is the scope of
21 the reply and what issues you believe you
22 need to address in the Patent Owner's
23 response.

24 MS. GREEN: Thank you, Your Honor.
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2 We do believe that good cause supports
3 our request for a reply. I don't know if you
4 want me to talk to the By Another very much
5 right here considering that that is a place
6 where the parties do seem to have some level
7 of agreement.

8 THE COURT: I think we can skip that
9 and if you could focus on whatever the issues
10 you believe you have to address.

11 MS. GREEN: Okay. One of the
12 arguments that Patent Owner makes is that we
13 have not made -- we have not demonstrated
14 reasonable expectation of success or I should
15 say a likelihood of success over Stamler.

16 In making those arguments, Patent
17 Owner ignores their own specification and we
18 specifically called those out in the
19 petition. So their arguments are not
20 commensurate with their own Patent.

21 And we rely on their Patent as to
22 certain things that the ordinary artisan
23 would have understood and which they
24 characterized as conventional and well known.
25 And the same standard should be applied to

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2 the specification as well as the prior art.

3 Something else that Petitioner has
4 brought up is that the Board should exercise
5 its discretion under Fintiv to deny
6 institution.

7 And we understand it, Patent Owner is
8 currently in litigation with the previous
9 Petitioner in this case, Elysium. The
10 present Petitioner is in no way affiliated
11 with Elysium. It is in no way involved in
12 that previous litigation and we have no
13 relationship with Elysium in any way, shape
14 or form.

15 So we were surprised that they
16 suggested that the panel apply Fintiv to deny
17 institution. They do cite some cases to
18 support the thought that you can consider
19 that it's a different Petitioner. I have
20 gone through those cases and I'm happy to
21 discuss it a little bit more, but none of
22 them are really on point to the instance that
23 we have in front of us where the arguments
24 that we're presenting in this petition are
25 completely different than the arguments that

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2 were presented in the previous petition as
3 well as the arguments that are being
4 presented at the District Court.

5 Those are our main arguments at this
6 point. Do you have any questions, Your
7 Honor?

8 THE COURT: No. I understand your
9 e-mail you wanted to address the case
10 relating to the Fintiv decision but you took
11 the position in your initial, in your
12 petition that Fintiv was irrelevant to the
13 present application.

14 Why do you feel you need to address
15 that now?

16 MS. GREEN: We don't think that we do.
17 It was more Patent Owner's argument that the
18 panel could rely on Fintiv to exercise it's
19 discretion to deny institution. Given the
20 circumstances and the relationship between
21 Thorne and Elysium, i.e. there is absolutely
22 no relationship and given the relationship
23 that the arguments that were made in the
24 previous petition, the District Court and
25 here, which is basically there is no

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2 relationship, that the arguments that we make
3 in our petition are brand new and have no
4 relationship to the previous petition or
5 what's being done at the District Court, as
6 we understand it.

7 We don't understand why they are
8 trying to argue that the Board can use Fintiv
9 to use its discretion to deny institution at
10 this point.

11 THE COURT: Okay. Very good. Thank
12 you, Ms. Green.

13 And for the Patent Owner, Mr. Abramic.

14 MR. ABRAMIC: Thank you, Your Honor.
15 So I'd like to address the arguments that
16 were just made outside of the By Another
17 issue. But I do want to point out that the
18 issues raised by Petitioner when they first
19 requested a reply and that are addressed in
20 their e-mail to the Board are slightly
21 different from what I'm now hearing on the
22 call, but I will address those each in turn.

23 Just as an over-arching comment, my
24 understanding of the purpose for this call
25 today is to determine whether or not

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2 Petitioner has good cause for addressing
3 certain arguments that were made in the
4 preliminary reply. And I think what I just
5 heard from counsel were their arguments
6 disagreeing with arguments that we made in
7 the preliminary reply and not focused on
8 whether or not there was good cause.

9 And so I think that's the issue that
10 we need to focus on. So just touching on the
11 By Another issue quickly.

12 So we recognize, Patent Owner
13 recognizes that it's filed two declarations
14 from individuals and those are Exhibits 2002
15 and 2003.

16 And those declarations were filed in
17 support of the argument in Section 3A of the
18 petition.

19 And that's the By Another issue. And
20 so while we certainly think that it was
21 foreseeable that we were going to make that
22 argument but we recognize that those are
23 declarations that Petitioner has not seen.
24 And so we are okay with the reply addressing
25 that particular issue in the petition because

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2 there would arguably be good cause for
3 Petitioner to address those issues.

4 But those declarations are cited in
5 Section 3A of the petition and you will not
6 see a citation to those declarations after
7 Section 3A of the Petition which starts on
8 page 7 of the preliminary response brief.

9 The last citation to those
10 declarations is on page 13 of the preliminary
11 response brief and that's the end of Section
12 3A. So we're okay with a reply addressing
13 that issue.

14 Now the question that we have to
15 address is whether or not there's good cause
16 for Petitioner to file a reply addressing any
17 other issue.

18 And the two reasons that I just heard
19 on the call were, one, the Fintiv issue.
20 Well, as Your Honor correctly pointed out on
21 page 17 of the petition, the Petitioner has
22 an entire section arguing why there should be
23 no discretionary denial and it specifically
24 cites the Fintiv case. And so had an
25 opportunity to address Fintiv and chose not

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to do so.

And it's not as if the Delaware cause of action -- it's not as if Petitioner was not aware of the Delaware cause of action. They were aware of the Delaware cause of action. The Exhibit they filed, Exhibit 1004 which is a copy of the prosecution history of the challenged patent in this case at page 104 of that prosecution history it has a report on the filing of that Delaware action.

So if they wanted to address Fintiv in the context of the Delaware action, they could have.

But what I'm hearing from them right now is a disagreement over whether or not Fintiv applies because of the particular parties that were in that action. And that's -- that's an argument that would be in a reply brief. It's not an argument as to whether or not there's good cause for allowing them to make that argument.

And so we think they had an opportunity to address Fintiv and the precedent of the Board is that the

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2 Petitioner -- reply briefs are not allowed
3 when the Petitioner had an opportunity to
4 address an issue and then wanted to elaborate
5 on that previously raised issue later in a
6 reply brief.

7 I can cite to you a decision, IPR
8 2017-01526 at paper 9 for the notion that
9 it's improper for a reply brief to re-visit
10 or elaborate on previously raised arguments.

11 The second issue that counsel brought
12 up was she mentioned likelihood of success on
13 Stamler. This was not an issue that Thorne
14 previously raised as a basis for filing a
15 reply and it's not in the e-mail to the Board
16 so this is the first that we're hearing of
17 it.

18 But from what I heard, it was
19 something to the effect of a disagreement
20 with our reliance on the specification and
21 our arguments with respect to Stamler. And
22 that just goes to a disagreement over the
23 substance of our argument.

24 And, again, I think that that's an
25 argument that they would put in a reply brief

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2 to argue against our position. That's not an
3 argument for good cause.

4 And so the last topic I'll address,
5 and this was not mentioned by counsel today
6 on the call so I don't know that they're
7 still asking for this. But in their e-mail
8 they mentioned priority arguments. And so I
9 just want to address that very briefly to the
10 extent that Petitioner is still asking for a
11 reply to address priority issues.

12 The priority issues are addressed in
13 Section 3B of the Patent Owner preliminary
14 response. And that issue is whether or not
15 the challenged patent, the 086 patent is
16 entitled to claim priority back to the 701
17 application.

18 And the argument in the preliminary
19 response brief merely asserts the same
20 priority claim that is set forth in the
21 specification of the 086 patent. And that
22 priority claim is set forth in column 1, line
23 7 to 13 of the patent.

24 And the preliminary response brief
25 merely relies on that patent itself and other

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2 public documents. There's no new evidence
3 for that priority argument.

4 But more importantly, the Petitioner
5 has already had an opportunity to address
6 priority. And I can direct the Board to the
7 argument starting on page 6 of the petition
8 with the heading that says: The earliest
9 effective filing date of claim 2 is April 20,
10 2006.

11 And then on the top of page 7 of the
12 petition, Petitioners explicitly acknowledge
13 that the 086 patent makes a priority claim to
14 the 701 application. And then they go on for
15 six pages or so addressing their arguments as
16 to why the challenged patent is not entitled
17 to that priority claim.

18 So they had an opportunity to address
19 priority already and so we don't believe
20 there would be good cause to address that in
21 a reply brief. So we think the reply brief
22 ought to be limited to addressing Section 3A
23 and the By Another issue.

24 THE COURT: All right. Ms. Green,
25 would you like to respond?

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2 MS. GREEN: Yes, Your Honor. Thank
3 you.

4 In regard to the question of whether
5 or not the argument as to Stamler is new, we
6 did state in our e-mail that we wanted to
7 respond to the reply in its entirety and we
8 did in each case, for example. So I don't
9 think that the fact that we stated that we
10 wanted to reply to the Patent Owner's
11 preliminary response in its entirety, I think
12 it basically means what it says, we wanted to
13 respond to the whole reply and we feel good
14 cause exists for that.

15 As for the Fintiv argument, the Board
16 has never applied Fintiv in a case where the
17 new Petitioner is different and unrelated to
18 the prior Petitioner. The cases that Patent
19 Owner relies upon are related to cases where
20 there's a co-Defendant or there's a
21 co-pending litigation where the Petitioner
22 itself is also in litigation and the issues
23 are the same.

24 So we feel this would be making new
25 law and we don't -- and so we feel good cause

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2 exists because we could not have foreseen the
3 Board making new law here and applying Fintiv
4 in a situation where the Petitioner has
5 absolutely no relationship to the prior
6 Petitioner or to the prior -- or to the
7 Defendant in the co-pending litigation.

8 So we could not have foreseen that and
9 we do think good cause exists there.

10 As to Stamler, again, we could not
11 have foreseen that they would ignore the
12 specification of their challenge patent. So
13 I -- we do think good cause exists there.

14 And as to the priority argument, we
15 are still arguing that we should have, we
16 have good cause for a reply to the entire
17 Patent Owner preliminary response and we
18 could not, you know, Patent Owner chose to
19 avail itself of 371 and the PCT Statute -- I
20 mean the PCT Treaty and everything else and
21 now they're arguing, well, it applies -- we
22 got to take advantage of 371 but it doesn't
23 really apply to us because we're all in the
24 same country and we really could not have
25 foreseen that argument as well.

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2 So unless you have further questions,
3 I will leave it at that for now.

4 THE COURT: Mr. Abramic, do you have
5 anything you want to add?

6 MR. ABRAMIC: Just very briefly, Your
7 Honor. Everything that I just heard seems to
8 be disagreements on issues that they were
9 already aware of and could have addressed in
10 their Petition. Meaning that it doesn't go
11 to good cause, it goes to what they would put
12 in a reply brief that disagrees with the
13 arguments that we made in our preliminary
14 response if they had established good cause,
15 but I don't think they have established good
16 cause for filing a reply on anything other
17 than the By Another issue.

18 THE COURT: Thank you. I've got one
19 question for Ms. Green.

20 If we were to authorize a reply,
21 particularly with respect to the By Another
22 issue, do you believe that you would want to
23 depose the declarants that were, that filed
24 the declarations in support of the Patent
25 Owner's preliminary response?

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2 MS. GREEN: If the panel is inclined
3 to find that Bieganowski and the PCT are not
4 By Another, yes, we feel that due process
5 requires us the ability to cross examine the
6 declarants.

7 On line that's more of a factual issue
8 and should be left for trial and we are happy
9 to wait for trial, but we do feel that those
10 declarations are fairly conclusory and they
11 don't really explain, you know, they state
12 that it is all of Dr. Brenner's invention but
13 they don't explain what Dr. Bieganowski
14 invented. And Dr. Bieganowski was an
15 inventor on the original PCT that we're using
16 as art.

17 And it did claim subject matter that's
18 very similar if not the same as what they're
19 claiming now in claim 2.

20 THE COURT: So you would like the
21 opportunity to depose the declarants before
22 you file any reply; correct?

23 MS. GREEN: Yes.

24 THE COURT: Okay. Mr. Abramic, how
25 long would it take you to make the declarants

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2 available for a deposition?

3 MR. ABRAMIC: I will have to check.
4 I'll have to check on that, Your Honor. This
5 is the first time I'm hearing of a request
6 for a deposition, so I can investigate that.

7 But from what I heard from Petitioner
8 was that we would like to take depositions if
9 the Board is inclined to not go our way on
10 the By Another issue. And I don't think, I
11 think they need to decide whether or not they
12 actually want the deposition.

13 So -- and I don't think they're
14 entitled to the Board's leanings before
15 deciding whether or not they want a
16 deposition.

17 THE COURT: What I'm trying to, what
18 I'm driving at here, counsel for both sides,
19 is that I think -- I'm going to have to
20 discuss this with my colleagues, but as I sit
21 here presently I am inclined to allow the
22 briefing on the By Another issue, especially
23 given the parties agreed to it.

24 What I was trying to develop is a
25 reasonable time table for filing of the reply

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2 and a possible sur-reply and I want to insure
3 that we allow time for the parties, if there
4 is a belief that a deposition of the
5 declarants is necessary in order to
6 adequately prepare the reply and the
7 sur-reply.

8 So that's my question here right now.
9 And it's not, it's designed to not put you in
10 a box as far as not having enough time to
11 prepare, adequately prepare your reply or
12 sur-reply.

13 So I --

14 MR. ABRAMIC: Understood, Your Honor.

15 THE COURT: So I'm trying to come up
16 with an answer now. Do you foresee the need
17 to be able to take a deposition, is it going
18 to be something that could be done in the
19 next two weeks, three weeks, month so that I
20 can give you some reasonable guidance as to
21 when you want to do this.

22 And these depositions would be limited
23 to the issue of By Another, it would not
24 preclude further depositions on other issues
25 going on. It's going to be on the very

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2 narrow issues of the question of the work
3 that's being reflected in the two documents
4 and whether or not its truly By Another or
5 not By Another which I think is the issue.

6 So we're talking about a very narrow
7 and very focused deposition just to be able
8 to give Petitioner any evidence they might
9 need to support their reply or to support
10 your position for a sur-reply.

11 We're still under the common rules, it
12 could conducted telephonic, they can be
13 video, whatever the parties agree to on that.

14 MR. ABRAMIC: Sure, sure. I guess
15 what I would recommend, Your Honor, given
16 that I hadn't contemplated that because there
17 had not been a previous request for a
18 deposition is that I could investigate the
19 timing on that and Petitioner could -- we
20 could confer with Petitioner. They could let
21 us know if they do want to proceed with the
22 depositions. We could figure out the timing
23 and then get back to the Board with a
24 proposed schedule.

25 THE COURT: I just don't want to drag

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2 the matter out longer than it has already.

3 I'm trying to think when our DI is due. Let
4 me confer with my other judges here and we'll
5 get back to you with our ruling on this. Let
6 me put you on hold or on mute here for a
7 minute.

8 (Off the Record at 1:22 p.m.)

9 (Back on the record at 1:26 p.m.)

10 THE COURT: We're back on the record.

11 This is Judge Schneider again. At
12 this time the panel is inclined to authorize
13 the filing of a reply but limited to the By
14 Another issue. I believe the other issues
15 have been addressed in the briefing so far
16 and we see no need for further briefing on
17 those issues.

18 But we understand the points that have
19 been raised by the parties in the call today.

20 A sur-reply is also authorized. At
21 the present time we're going to ask the
22 parties to develop a schedule including any
23 potential depositions that might be needed
24 and report back to the panel no later than a
25 week from today which I believe is April 2nd.

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2 If the parties cannot agree upon a
3 schedule and that's reported to us on the
4 2nd, we will schedule another conference with
5 the parties for April 6th.

6 And if the parties cannot reach an
7 agreement by next Friday, they're asked to
8 make a list of the report that they give us,
9 times that they will be available for a call
10 on April 6th. Are there any questions?

11 MS. GREEN: No, Your Honor. One
12 question -- I said no but I meant yes.

13 Your Honor, how long are you thinking
14 for the reply?

15 THE COURT: I'm sorry, say it again.

16 MS. GREEN: How much pages?

17 THE COURT: I believe ten pages should
18 be sufficient for both parties for both the
19 reply and sur-reply.

20 MS. GREEN: Okay. Thank you, Your
21 Honor. No other questions.

22 THE COURT: And in lieu of publishing
23 an Order, since we have a transcript, this
24 transcript will serve as the Order.

25 Is there anything else? Any other

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questions from the parties today?

MS. GREEN: No, that's it Your Honor.

MR. ABRAMIC: No, Your Honor.

THE COURT: All right. I thank the parties for their attendance today and this hearing is, conference call is now concluded. Thank you very much.

MS. GREEN: Thank you for your time, Your Honor.

MR. ABRAMIC: Thank you.

(Conference call concluded at 1:29 p.m.)

CONFERENCE CALL

CERTIFICATE

STATE OF MARYLAND)

COUNTY OF BALTIMORE)

I, PAULA J. ELIOPOULOS, a Notary Public within and for the State of Maryland, do hereby certify that foregoing is a true and accurate transcript of the proceedings indicated.

I further certify that I am not related to any of the parties to this action by blood or marriage and that I am in no way interested in the outcome of this matter.

In witness whereof, I have hereunto set my hand this 1st day of April, 2021.

Paula J. Eliopoulos Weigand

PAULA J. ELIOPOULOS