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Paper 32
Entered: January 24, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUHTAMAKI FLEXIBLE PACKAGING GERMANY GMBH & CO. KG,

Petitioner,

v.

ADAPA FLEXIBLES DENMARK SLAGELSE A/S
f/k/a DANAPAK FLEXIBLES A/S,[1]
Patent Owner.

PGR2023-00008
Patent 11,260,624 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and BRIAN D. RANGE, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

REVISED SCHEDULING ORDER

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[1] Patent Owner represents that "Danapak Flexibles A/S has changed its name to adapa flexibles Denmark Slagelse A/S." Paper 23, 2 (Patent Owner's Second Updated Mandatory Notices).

A. REVISED MOTION TO AMEND

1. Introduction

On January 16, 2024, Patent Owner filed a revised motion to amend ("revised MTA") in accordance with our Scheduling Order (Paper 15) and the March 15, 2019 Federal Register notice regarding a new pilot program relating to motion to amend practice at the Office. *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 Fed. Reg. 9497 (Mar. 15, 2019) ("MTA Pilot"). In accordance with the MTA Pilot, we revise our original June 20, 2023 Scheduling Order to set subsequent due dates based on the date Patent Owner filed its revised MTA. *See* MTA Pilot, Appendix 1B (Revised MTA Timeline).

In particular, this Revised Scheduling Order adds DUE DATES RMTA1 and RMTA2 and modifies and supersedes DUE DATE 4 and subsequent due dates as presented in our original Scheduling Order. Further, this Revised Scheduling Order supplements the instructions provided in our original Scheduling Order, including those discussing the content of the briefing related to the revised MTA. To the extent that our original Scheduling Order provides instructions that are not addressed in this Revised Scheduling Order, the original instructions remain in effect.

2. Evidence and Depositions

Generally speaking, new evidence (including declarations) may be submitted with every paper related to the revised MTA, except sur-replies. Specifically, both Petitioner's opposition to the revised MTA and Patent Owner's reply to that opposition may be accompanied by new evidence that

responds to issues raised in the preliminary guidance (if provided) or in the corresponding revised MTA or opposition. Petitioner's sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.

Once likely declarants are known, the parties should confer as to dates for scheduling all depositions related to the revised MTA after the relevant papers will be filed. The Board expects parties to make their declarants available for such depositions promptly, and to make their attorneys available to take and defend such depositions; any unavailability will not be a reason to adjust the schedule for briefing on a revised MTA absent extraordinary circumstances.

If Petitioner submits a declaration with its opposition to the revised MTA, or Patent Owner submits a declaration with its reply to that opposition, the party should typically make such declarant available for deposition within 1 week after filing that declaration. As needed, the parties may wish to agree to shortened periods for making objections and serving supplemental evidence prior to a deposition. *See* 37 C.F.R. §§ 42.53(d)(2), 42.64(a) and (b). In the absence of such an agreement, the parties shall schedule such depositions in advance of a due date for serving supplemental evidence. If, after receiving supplemental evidence, a party believes in good faith that the supplemental evidence requires further cross-examination of a declarant, the party should contact the Board for a conference call. Again, it is incumbent upon the parties to work cooperatively to schedule depositions of their declarants. Thus, the Board strongly encourages the parties to meet and confer as soon as practicable (including before anticipated declarations are submitted, if possible) to coordinate schedules.

Because Patent Owner's reply and Petitioner's sur-reply as to the revised MTA are due near or after motions to exclude are due, the parties might not have an opportunity to object to evidence submitted with the reply or sur-reply and file a motion to exclude such evidence before the oral hearing. *See* 37 § C.F.R. 42.64. Thus, if needed, a party may seek authorization to file a motion to exclude reply or surreply evidence after the oral hearing or may make an oral motion to exclude and argue such a motion at the oral hearing.

B. DUE DATES

This Order sets due dates for the parties to take action by DUE DATE RMTA1 and after. The parties may stipulate different dates for DUE DATES RMTA1, RMTA2, 5, and 6 (earlier or later, but no later than DUE DATE 7). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate an extension of DUE DATES 4, 7, and 8.

In stipulating different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (§ 42.64(b)(2)), to conduct cross-examination (§ 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony.

1. DUE DATE RMTA1

Petitioner may file an opposition to Patent Owner's revised MTA. Petitioner's opposition to the revised MTA may only respond to issues raised in the revised MTA or the preliminary guidance (if provided).

2. DUE DATE 4

Either party may file a request for oral argument (may not be extended by stipulation).

3. DUE DATE RMTA2

Patent Owner may file a reply to Petitioner's opposition to the revised MTA. Patent Owner's reply to the opposition may only respond to issues raised in the opposition.

4. DUE DATE 5

Either party may file a motion to exclude evidence (37 C.F.R. § 42.64(c)).

5. DUE DATE 6

Either party may file an opposition to a motion to exclude evidence.

Either party may request that the Board hold a pre-hearing conference.

6. DUE DATE 7

Either party may file a reply to an opposition to a motion to exclude evidence.

Petitioner may file a sur-reply to Patent Owner's reply to the opposition to the revised MTA. Petitioner's sur-reply may only respond to issues raised in the reply to the opposition.

7. DUE DATE 8

The oral argument (if requested by either party) shall be held on this date. Approximately one month prior to the argument, the Board will issue an order setting the start time of the hearing and the procedures that will govern the parties' arguments.

REVISED DUE DATE APPENDIX

DUE DATE RMTA1 ..... February 27, 2024

Petitioner's opposition to Patent Owner's revised motion to amend

DUE DATE 4..... March 5, 2024

Request for oral argument (may not be extended by stipulation)

DUE DATE RMTA2 ..... March 19, 2024

Patent Owner's reply to opposition to revised motion to amend

DUE DATE 5 ..... March 26, 2024

Motion to exclude evidence

DUE DATE 6 ..... April 2, 2024

Opposition to motion to exclude

Request for prehearing conference

DUE DATE 7 ..... April 8, 2024

Reply to opposition to motion to exclude

Petitioner's sur-reply to reply to opposition to revised motion to amend

DUE DATE 8 ..... April 12, 2024

Oral argument (if requested)

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