UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHIGENIX, INC.
Petitioner

v.

IMMNUNOGEN, INC.
Patent Owner

Case IPR2014-00676
Patent 8,337,856 B2

IMMUNOGEN, INC.'S MOTION TO PRESERVE THE RECORD PENDING APPEAL

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Patent Trial and Appeal Board
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I. Introduction

Patent Owner ImmunoGen, Inc. respectfully requests that the Board preserve the entire record of IPR2014-00676, including preserving Exhibits 2347 and 2348 as sealed documents, until any and all appeal rights have been exhausted.[1] The Board authorized Patent Owner to file this motion in a December 4, 2015 email. Petitioner's counsel has advised ImmunoGen that it will not oppose this motion.

II. Procedural Background

The Board entered its Final Written Decision in this IPR on October 27, 2015 (Paper 39). In the Final Written Decision at page 30, the Board granted Patent Owner's Motion to Seal Exhibits 2437 and 2438, filed June 18, 2015 (Paper 31). And in a November 27, 2015 email, the Board authorized Patent Owner to file a motion to expunge Exhibits 2347 and 2348 so as to preserve their confidentiality. But, in a November 23, 2015email to the Board, Petitioner's counsel stated, "Petitioner is evaluating its options for filing an appeal." And Petitioner has not yet responded to a query Patent Owner posed to it in a November 25, 2015 email asking whether Petitioner would be filing an appeal of this IPR. In a December 3, 2015 email, Patent Owner asked the Board for procedural guidance regarding preserving the record pending appeal, and in a December 4, 2015 email, the Board

[1] Nothing in this motion should be construed as a concession that the Petitioner has a right to appeal the Board's Final Written Decision in this IPR.

authorized Patent Owner to file the present motion to preserve the record pending appeal. Following the exhaustion of any and all appeal rights, Patent Owner intends to again seek expungement of Exhibits 2437 and 2438 so as to preserve their confidentiality.

III. Argument

Patent Owner requests that the Board preserve the record in its entirety, and in doing so, maintain exhibits 2347 and 2348 under seal, until the exhaustion of any and all appeal rights. Sealed confidential information that is subject to a protective order will ordinarily become public 45 days after final judgment in a trial unless a motion to expunge is filed. 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012); *see also* 37 C.F.R. § 42.56. Here, the date that is 45 days after entry of final judgment is December 11, 2015. However, a Party has until 63 days from the date of the Final Written Decision to file a notice of appeal. 37 C.F.R. § 90.3(a)(1). Here, the deadline for filing a notice of appeal is December 29, 2015.

The Federal Rules of Appellate Procedure and the Federal Circuit Rules require that the record be retained by the Board pending appeal. Specifically, Federal Circuit Rule 17(a) states that "[t]he agency must retain the record and send to [the Federal Circuit] a certified list or index," and Federal Circuit Rule 17(b)(1) states that this information must be sent to the court "[n]o later than 40 days after receiving the notice of appeal. " Federal Circuit Rule 17(e), titled "Preserving a

Protective Order on Appeal," further requires that "[a]ny portion of the record that was subject to a protective order in an agency remain[] subject to that order unless otherwise ordered."

Recognizing the reasonableness of maintaining an undisturbed record in the event of an appeal, other Board panels have preserved a final IPR record pending the outcome of any appeal that is taken. *See Illumina, Inc. v. Columbia Univ.*, IPR2012-00006, Paper 133 at 3 (P.T.A.B. Apr. 25, 2014); *Int'l Bus. Machs. Corp. v. Intellectual Ventures II LLC*, IPR2014-00587, Paper 59 at 2 (P.T.A.B. Nov. 20, 2015). For example, in *Illumina, Inc. v. Columbia Univ.*, the parties were permitted to file information under seal such that the record contained both public and non-public versions of this information. *Illumina, Inc. v. Columbia Univ.*, IPR2012-00006, Paper 133 at 2 (P.T.A.B. Apr. 25, 2014) (citing to Paper 83). There, the parties requested that the record be preserved pending the outcome of a possible appeal, including preserving all sealed documents in a non-public form. *Id.* (citing to Paper 131). The Board granted the parties' request that the record be preserved pending appeal, preventing the removal or disclosure to the public of confidential information filed under seal. *Id.* at 3.

To comply with the mandates of the Federal Circuit, it is prudent to maintain the record as-is pending any possible appeal (*i.e.*, without removing or disclosing to the public information filed under seal). And here, as in *Illumina, Inc. v.*

Columbia Univ., Patent Owner seeks to prevent disclosure to the public of confidential information in the record. Preserving the record in its entirety is particularly important here because Patent Owner cannot predict in advance which issues Petitioner might raise in any attempt to appeal the Board's Final Written Decision. If the record is not preserved in its entirety, the Court of Appeals for the Federal Circuit may not be able to fully consider the issues of this case if an appeal is sought. Thus, removing documents from the record or disclosing Patent Owner's confidential information to the public at this juncture would be prejudicial to the Patent Owner.

Accordingly, Patent Owner respectfully requests that the Board preserve the entire IPR record as-is pending exhaustion of any and all appeal rights, i.e., without removing documents or disclosing to the public of information filed under seal (*viz.*, Exhibit 2347 and 2348) until any and all appeal rights are exhausted.

Respectfully submitted,
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Eldora L. Ellison/

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