

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AGILA SPECIALTIES INC. and  
MYLAN PHARMACEUTICALS INC.,  
Petitioner,

v.

CUBIST PHARMACEUTICALS, INC.,  
Patent Owner.

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Case IPR2015-00144  
Patent 8,058,238 B2

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Before BRIAN P. MURPHY, JON B. TORNQUIST, and  
TINA E. HULSE, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER

*Granting Motion to Correct Accorded Filing Date*  
*37 C.F.R. §§ 42.5(b) and 42.6(b)(2)(i)*

## I. BACKGROUND

On October 23, 2014, at 11:26 p.m. (Eastern Time), Petitioner began the process of filing a petition requesting *inter partes* review of U.S. Patent No. 8,058,238 (the '238 patent). Mot. 7; Ex. 1043 ¶ 7 (Declaration of Adriana Serrano). During the course of the submission process, Petitioner asserts that it encountered technical problems with the Board's Patent Review Processing System (PRPS). Mot. 7; Ex. 1043 ¶¶ 4, 8–9. In particular, Petitioner asserts that on at least one occasion PRPS became unresponsive, requiring Petitioner to close the browser window and re-log into PRPS. Mot. 7; Ex. 1043 ¶ 8.

Although a complete electronic petition was not submitted on October 23, 2014, Petitioner asserts that prior to 12:00 a.m. on October 24, 2014, it was able to file the petition, information for lead and back-up counsel, information related to the real parties in interest, and powers of attorney. Mot. 7; Ex. 1043 ¶¶ 7–8. Petitioner further asserts that prior to 11:59 p.m. October 23, 2014, it submitted the filing fee of \$42,400, “hit the ‘pay’ button,” and “hit the ‘submit’ button,” but later received notification from PRPS that the filing date accorded to the petition was October 24, 2014. Mot. 7; Ex. 1043 ¶ 9.

Petitioner then sought to file the petition and exhibits with the Board by Priority Mail Express. Mot. 3; Ex. 1043 ¶ 10. To this end, Petitioner had the documents printed, delivered to the San Francisco International Airport Post Office, and stamped with a filing date of October 23, 2014.<sup>1</sup> Mot. 3;

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<sup>1</sup> Pursuant to 37 C.F.R. § 1.10(a), any correspondence received by the USPTO that was submitted using Priority Mail Express “will be considered filed with the USPTO on the date of deposit with the USPS.”

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Ex. 1043 ¶¶ 11–12; Ex. 1039 (reflecting an October 23, 2014 mailing date and an 11:50 p.m. sales receipt). With the paper filings, Petitioner included a motion requesting that the Board accept paper filing of the petition and exhibits. Ex. 2002; Ex. 1043 ¶ 11. Petitioner did not serve this motion on Patent Owner. Reply 1–2.

On November 13, 2014, the Board accorded the petition a filing date of October 24, 2014. Paper 6. On December 1, 2014, Petitioner filed a Motion to Correct Accorded Filing Date (Paper 11, “Mot.”), on December 8, 2014, Patent Owner filed an Opposition to the motion (Paper 13, “Opp.”), and on December 18, 2014, Petitioner filed a Reply (Paper 16, “Reply”).

## II. APPLICABLE RULES AND GUIDANCE

Under the Board’s Trial Practice and Procedure rules, “[u]nless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the Web site of the Office.” 37 C.F.R. § 42.6(b)(1). Guidance on the Web site of the Office instructs that paper filing is available only when both PRPS and the Board’s email address are unavailable:

Paper filing via Priority Mail Express® (formerly known as EXPRESS MAIL®), or by means at least as fast and reliable as Priority Mail Express, is authorized only if both PRPS and the Board’s email address (Trials@uspto.gov) are unavailable.

See <http://www.uspto.gov/ip/boards/bpai/prps.jsp> at A2.

To the extent paper filing is authorized, 37 C.F.R. § 42.6(b)(2) sets out the requirements for such a filing:

(2)(i) *Filing by means other than electronic filing.* A document filed by means other than electronic filing must:

(A) Be accompanied by a motion requesting acceptance of the submission; and

(B) Identify a date of transmission where a party seeks a filing date other than the date of receipt at the Board.

(ii) Mailed correspondence shall be sent to: Mail Stop PATENT BOARD, Patent Trial and Appeal Board, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

Pursuant to 37 C.F.R. § 42.6(e), “[e]ach document filed with the Board, if not previously served, must be served simultaneously on each opposing party.”

### III. ANALYSIS

Petitioner does not contend that both PRPS and the Board’s email address were unavailable on October 23, 2014. Nor does Petitioner contend that it properly served the motion to accept paper filing on Patent Owner. *See* Reply 1–2. Petitioner asserts, instead, that these requirements should be waived by the Board because Petitioner, at all times, used reasonable diligence and good faith in attempting to submit the petition, both electronically and via paper filing. Mot. 8.

Patent Owner contends that the Board does not have the authority to waive the service requirement for the motion requesting acceptance of the paper filing and, even if it could, the facts of this case do not support waiving the service requirement or the Board’s guidance relating to paper filings. Opp. 1–3, 6. We address these arguments in turn.

#### *1. Board Authority to Waive the Service Requirement*

Pursuant to 37 C.F.R. § 42.5(b), “[t]he Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.” Despite the apparent broad authority to waive requirements found in part 42, including the paper filing requirements of 37 C.F.R. § 42.6(b)(2), Patent Owner asserts that Petitioner’s failure to serve the

motion to accept paper filing pursuant to 37 C.F.R. § 42.6 cannot be waived in this case because it is a statutory requirement. Opp. 2. Patent Owner's argument is set forth below:

Pursuant to 35 U.S.C. § 312(a), “[a] petition filed under section 311 may be considered only if,” *inter alia*, “the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner . . . .” 35 U.S.C. § 312(a)(5). These statutorily required “documents” include “such other information as the Director may require by regulation.” 35 U.S.C. § 312(a)(4). The regulations, incorporated by reference in the statute, require that “[a] document filed by means other than electronic filing must . . . [b]e accompanied by a motion requesting acceptance of the submission.” 37 C.F.R. § 42.6(b)(2)(i), (i)(A); 37 C.F.R. § 42.104 (stating that petition must comply with 37 C.F.R. § 42.6). Thus, 35 U.S.C. § 312(a)(5) requires that a petitioner serve on the patent owner any motion requesting acceptance of a paper petition.

Opp. 2.

The thrust of Patent Owner's argument is that, because regulations regarding the type of information required for a complete petition are referenced in the statute, ancillary regulations related to the form and method of filing documents must also have the force of statute. *Id.* at 2–3 (“Thus, the Board is prohibited by statute from instituting *inter partes* review based on . . . Agila's paper petition, which did not meet the statutory service requirements.”). We do not agree.

Section 312(a)(5) requires that a petitioner provide copies of any of the documents required under paragraph (4). Paragraph (4) states that a petition may be considered only if “the *petition* provides such other information as the Director may require by regulation.” 35 U.S.C. § 312(a)(4) (emphasis added). The question, then, is whether the motion to

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