UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILA SPECIALTIES INC.
and Mylan Pharmaceuticals Inc.,
Petitioners,

v.

CUBIST PHARMACEUTICALS, INC.,
Patent Owner

Patent No. 8,058,238

Case IPR2015-00144

PETITIONER'S REPLY TO OPPOSITION TO MOTION TO CORRECT ACCORDED FILING DATE
Under 37 C.F.R. §§ 1.10, 42.20 and 42.22

TABLE OF AUTHORITIES

CASES

STATUTES

OTHER AUTHORITIES

RULES

On pages 1-2 of the opposition, Patent Owner ("Cubist") argues that the petitioner ("Agila") failed to satisfy the non-waivable statutory requirements for filing a petition for inter partes review. The statutory requirements for a petition are set in 35 U.S.C. §312. The statute does not set a mode for filing a petition, much less any procedure to follow for alternative filing.

The statute requires that "the petition provide[] such other information as the Director may require by regulation" and that such information be served on the patent owner. §312(a)(4) & (a)(5). The rule on inter partes review petition content is 37 C.F.R. §42.106, which incorporates 37 C.F.R. §42.6 by reference. Section 42.6(b)(2)(i)(A) states that "A document filed by means other than electronic filing must…[b]e accompanied by a motion requesting acceptance of the submission[.]" The plain meaning of the rule is that the motion is not part of the document in question because the motion accompanies that document. While the Director could have required that the motion be part of the document, the plain language of the rule imposes no such requirement. In short, Agila did not fail to meet a statutory requirement for filing the petition itself.

On pages 2-3, Cubist advises that Agila, in turning to an alternative mode of filing after experiencing electronic filing difficulties, failed to serve the accompanying motion on Cubist. Agila regrets the error and acknowledges that consideration of the motion would require Board action to permit late service.

Agila notes, however, that Cubist did not point to any actual prejudice arising from the late service and further notes that any possible prejudice was rendered moot when the Board authorized the present motion, which was properly served.

On pages 3-4, Cubist argues that Agila should have tried filing by email before filing in paper, relying on a web posting for authority. Ex. 1003. The rules do not state an email-first requirement. It is the rules, not a web page, that govern. 35 U.S.C. §2(b)(2)(B) (requiring notice and comment rule making); 44 U.S.C. §1507 (according constructive notice for properly published rules); 5 U.S.C. §552(a)(1) (voiding the effect of a requirement not so published). Agila notes that the Practice Guide also states no such requirement. 77 Fed. Reg. 48756, 48758 (2012). Again, the Director during the rule making period could have created a different process, but did not do so. In any case, the web-notice requirement is Board-created and thus waivable. Cubist has cited no prejudice from the paper filing. Any prejudice to the Board was removed when Agila uploaded all documents. *Cf. SAP America, Inc., v. Arunachalam*, IPR2013-00194, Paper 72 at 5 (PTAB 2014) (imposing paper filing as a sanction). There is no possible prejudice to the Board, Cubist or the public.

On page 5, Cubist argues that the accompanying motion was improper because the Board had not authorized it in advance. The Board rule requires prior authorization, but does not require the authorization to be in an order. §42.20(b).

In this case, the prior authorization was provided in another rule: §42.6(b)(2)(i)(A). In any case, again, Cubist has identified no cognizable prejudice.

On page 8, Cubist argues that it is prejudiced, but the prejudice it identifies—having to defend its claims in an inter partes review—is not a legally cognizable prejudice, a point made in the motion and not rebutted by Cubist. By contrast, the prejudice to Agila is considerable if its efforts are frustrated by enforcement of technical requirements apart from the merits when there is no prejudice. This is not a case where a party has made an ongoing series of mistakes, warranting some sanction. See, e.g., *SAP America* at 4. Agila did everything possible to file the petition within the rules given the compatibility issue with PRPS. Moreover, even if some Board response were appropriate, dismissal of the proceeding would be wholly disproportionate. *Gerritsen v. Shirai*, 979 F.2d 1524, 1527-28 (Fed. Cir. 1992) (vacating default judgment for abuse of discretion).

On page 8, Cubist misapprehends the prejudice to the public. Inter partes review was established as a mechanism for providing inexpensive patentability review on the merits in an expert forum as an alternative to burdening the district courts. Pushing this contest back into a district court for a minor, non-prejudicial, waivable technicality rather than proceeding to a decision on the merits cannot be reconciled to the interests of justice or a concern for the public good.

Under any standard, correction of the accorded filing date should be granted.

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