

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PHARMACOSMOS A/S,
Petitioner,

v.

LUITPOLD PHARMACEUTICALS. INC.,
Patent Owner.

Cases¹ IPR2015-01490; Patent 7,754,702 B2
IPR2015-01493; Patent 8,431,549 B2

Before TONI R. SCHEINER, LORA M. GREEN, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are authorized to use this style heading when filing a single paper in the both proceedings, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

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A conference call was held on Wednesday, March 9, 2016, among Lisa Kole, representing Petitioner; George Quillin, representing Patent Owner; and Administrative Patent Judges Green, Scheiner, and Paulraj. Patent Owner requested the call in order to meet its obligation to confer with Board before filing a motion to amend, as required by 37 C.F.R. § 42.121.

Initially, we note that as the moving party, Patent Owner “has the burden of proof to establish that it is entitled to the requested relief.” *See* 37 C.F.R. § 42.20(c). Rule 42.20(c) places the burden on the patent owner to show a patentable distinction on each proposed substitute claim over the prior art. While not required to prove that the claims are patentable over every item of prior art known to a person of ordinary skill, the patent owner is required to explain why the claims are patentable over the prior art of record. *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1307–8 (Fed. Cir. 2015) (affirming the Board’s denial of a motion to amend claims where the patent owner failed to establish the patentability of the substitute claims over the prior art of record); *see also Masterimage 3D, Inc. v. RealD, Inc.*, Case IPR2015-00040, slip op. at 1–2 (PTAB July 15, 2015) (Paper 42) (explaining that prior art of record includes any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review, as well as material art in the prosecution of the patent). In particular, such prior art is material if it addresses the limitation added by the proposed substitute claim. *Id.* at 3 (“Because a proposed substitute claim is considered after the corresponding patent claim is determined

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unpatentable, Patent Owner's addition of a limitation to render the claim as a whole patentable places the focus, initially, on the added limitation itself."

For the convenience of the parties, we also include the following additional guidance. Generally, a challenged claim can be replaced by only one claim, and a motion to amend should, for each proposed substitute claim, specifically identify the challenged claim which it is intended to replace. Proposed substitute claims are only "proposed" claims, and are not added to the patent unless a corresponding motion to amend claims has been granted by the Board. We point the parties' attention to the following orders for additional guidance regarding the requirements for a motion to amend: *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027 (PTAB) (Paper 26) and *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,766–67 (Aug. 14, 2012) (Section II.G. Motions to Amend), with regard to the requirements of motions to amend.

Patent Owner sought additional guidance from the panel. Specifically, Patent Owner inquired as to whether it could statutorily disclaim certain claims, or whether it needed previous authorization from the Board. We noted that it could statutorily disclaim any claim, whether trial had been instituted on that claim, or not, at any time. In that regard, we direct the parties attention to 37 C.F.R. § 1.321(a), which provides for disclaimer of a claim by a patentee.

Patent Owner also inquired whether deleting members of a Markush group would be considered to be a narrowing amendment, and whether

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written description support would have to be pointed out in the disclosure as originally filed for such an amendment.

In response, we noted that deleting members of a Markush group would be considered a narrowing amendment. Moreover, Patent Owner should still point out written description support for the proposed substitute claim, including a proposed substitute claim in which a member of a Markush group has been deleted, can be found in the disclosure as originally filed. We cautioned Patent Owner, however, that it should not focus on where support for the new limitation can be found; but that it should point to where written description support occurs in the originally filed disclosure for any proposed substitute claim *as a whole*. In addition, Patent Owner must point out and discuss how the proposed substitute claims are supported by the originally filed disclosure in the body of the motion. In that regard, we noted that a claim filed with the original disclosure is part of that original disclosure, and such original claims may be used to demonstrate that a proposed substitute claim is supported by the disclosure as originally filed.

Patent Owner additionally asked whether it could provide a list of exhibits and authorities that were referenced in the motion. Patent Owner also inquired whether it could provide also a claim tree of the original claims, as well as the proposed substitute claims. We responded that Patent Owner could provide the list of exhibits and authorities and/or the claim tree(s), and we would not count that against Patent Owner's page limit for the motion to amend.

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Finally, Patent Owner noted that we had instituted trial on claim 16 in IPR2015-01493, but not claim 15, on which claim 16 depends. Given that dependency, Patent Owner was unclear how it should present any possible amendments to claim 16.

We noted that because a dependent claim incorporates all the limitations from the claims upon which it depends, Petitioner's challenge of the dependent claim will also encompass the parent claims. As we noted in our Institution Decision, "[a]lthough the Petition does not specifically include independent claim 1 as part of [the] anticipation challenge [based on van Zyl-Smit], we must nonetheless consider whether the limitations of the independent claim are satisfied before turning to the dependent claims." Paper 11, 11. Claim 16 depends upon claim 15, which in turn depends upon claim 1. The fact that we failed to institute trial on claim 15 in IPR2015-01493 was, therefore, an oversight. Claim 15 should also have been included in the challenge based on anticipation by van Zyl-Smit. Thus, we should have stated that trial is instituted on claims 1–5, 9, 15, 16 and 19 under 35 U.S.C. § 102(b) as anticipated by van Zyl-Smit. We note that there is little prejudice to Patent Owner by that clarification, as claim 16 necessarily includes all the limitations of claim 15.

Accordingly, it is:

ORDERED that the requirement "to confer" pursuant to 37 C.F.R. § 42.121(a) has been satisfied; and

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