

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
IPR2015-01495; Patent 8,895,612 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 three 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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IPR2015-01495; Patent 8,895,612 B2

A conference call was held on Friday, October 6, 2015 among Lisa Kole, representing Petitioner; George Quillin representing Patent Owner; and Judges Green, Scheiner, and Paulraj. Patent Owner requested the call to discuss authorization to file a certificate of correction relating to the claims.

In particular, Patent Owner noted that in claim 26 of U.S. Patent No. 7,754,702 B2, as well as claim 12 of U.S. Patent No. 8,895,612 B2, “n” should be defined as 10^3 , rather than 103. Patent Owner also stated that it wished to rewrite dependent claim 28 of U.S. Patent No. 7,754,702 B2, as well as dependent claim 12 of U.S. Patent No. 8,431,549 B2, in independent form.

When asked whether it objected to the filing of the certificate of correction, Petitioner noted that when it asked Patent Owner earlier in the week what corrections it was seeking, Patent Owner declined to state what it would be seeking to correct. Thus, Petitioner stated that it would need some time to review the requested corrections. Petitioner noted also that there are other ways to correct the claims in the context of the proceeding, such as through the filing of a motion to amend. Finally, Petitioner also expressed concern as to the rewriting of several claims in independent form. Patent Owner responded that, as to correcting “103” to read “ 10^3 ,” Petitioner has already treated the claim language as referring to “ 10^3 ” in the Petitions.

We reminded both Patent Owner and Petitioner that the parties should confer and attempt to resolve issues with each other first before requesting a

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conference call. Moreover, we agreed with Petitioner that rewriting a dependent claim in independent form would more appropriately be the subject matter of a motion to amend, rather than that the use of a certificate of correction.

Patent Owner was authorized to file a five (5) page motion, limited to requesting authorization to file a certificate of correction to change “103” to “10³” in claim 26 of US Patent No. 7,754, 702, as well as claim 12 of US Patent No. 8,895,612. The motion is due no later than October 20, 2015. Petitioner is authorized, but not obligated, to file a five (5) page opposition, no later than October 30, 2015. In addition, Petitioner should promptly notify us if it decides not to oppose Patent Owner’s motion requesting authorization to file a certificate of correction.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file to file a five (5) page motion requesting authorization to file a certificate of correction, the motion is due no later than October 20, 2015;

FURTHER ORDERED that Petitioner is authorized to file a five (5) page opposition, no later than October 30, 2015; and

FURTHER ORDERED that Petitioner should promptly notify us if it does not intend to oppose Patent Owner’s motion requesting authorization to file a certificate of correction.

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