

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STEADYMED LTD.,
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,
Patent Owner.

Case IPR2016-00006
Patent 8,497,393 B2

Before LORA M. GREEN, JONI Y. CHANG, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

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

On April 5, 2017, a conference call was conducted among counsel for Petitioner, SteadyMed LTD (“SteadyMed”), counsel for Patent Owner, United Therapeutics Corporation (“UTC”), and Judges Chang and Harlow. A court reporter was also present.¹ The purpose of the call was to address SteadyMed’s request for authorization to file a motion requesting action by the Board with regard to U.S. Patents Nos. 9,604,901 B2 (“the ’901 patent”) and 9,593,066 B2 (“the ’066 patent”). In particular, SteadyMed seeks cancelation of the claims of the ’901 and ’066 patents as not being patentably distinct from the claims of the ’393 patent.

We entered a Final Written Decision (Paper 82) under 35 U.S.C. § 318(a), holding claims 1–22 of the ’393 patent unpatentable, on March 31, 2017. Prior to entry of that Decision, the ’901 patent and the ’066 patent issued from continuing applications to the ’393 patent. Neither the ’901 patent nor the ’066 patent is an involved patent in the instant *inter partes* review. See Paper 1, 1 (SteadyMed requests an *inter partes* review as to claims 1–22 of the ’393 patent, not the claims of the ’066 patent and the ’901 patent). Therefore, SteadyMed’s request to cancel the claims of non-involved patents—namely, the claims of the ’901 patent or the ’066 patent—is *denied*. See 35 U.S.C. § 311(b) (“[a] petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent”).

¹ The parties are reminded that a transcript of the call is to be filed as an exhibit to this proceeding.

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Accordingly, SteadyMed's request for authorization to file a motion requesting action by the Board concerning the '901 and '066 patents is *denied*.

It is

ORDERED that SteadyMed's request for authorization to file a motion requesting action by the Board concerning the '901 and '066 patents is *denied*.

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