

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*.

DECISION
Petitioner's Motion for Supplemental Information
37 C.F.R. § 42.123(a)

On May 10, 2016 a conference call was conducted among counsel for Petitioner, SteadyMed LTD (“SteadyMed”), counsel for Patent Owner, United Therapeutics Corporation (“UTC”), and Judges Green, Chang, and Harlow. During that call, SteadyMed requested authorization to file a motion to submit supplemental information, in the form of two declarations, attesting to the accuracy of the English translation of Japanese Patent Application No. JP 56-122328A, published September 25, 1981 (“Kawakami”) (Ex. 1006). UTC indicated in response that it opposed neither SteadyMed’s request for authorization to file the motion to submit supplemental information, nor the motion itself. We authorized SteadyMed to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123 during the conference call, and memorialized that authorization in a written order (Paper 24). SteadyMed filed the instant motion to submit supplemental information on May 11, 2016 (Paper 23).

As the moving party, SteadyMed bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if the following requirements are met: (1) a request for authorization to file such motion is made within one month of the date the trial was instituted; and (2) the supplemental information must be relevant to a claim for which trial has been instituted.

SteadyMed sought authorization to file its motion via correspondence dated May 6, 2016, which is within one month of the institution date in this proceeding of April 8, 2016 (Paper 12). In addition, the supplemental

information SteadyMed seeks to submit is relevant to the patentability of claims 6, 10, 15, 21, and 22, on which trial has been instituted under § 103(a) in view of Moriarty, Phares, Kawakami, and Ege (Paper 12). Specifically, the declarations of Mr. Boris Levine (Ex. 1019), and Mr. James Dowdle (Ex. 1020) that SteadyMed wishes to submit allegedly confirm that Ex. 1007 is an accurate translation of Kawakami, and are, therefore, relevant to the patentability of claims 6, 10, 15, 21, and 22 in view of Moriarty, Phares, Kawakami, and Ege. *See Taiwan Semiconductor v. DSS Technology Management, Inc.*, Case IPR No. 2014-01030, slip op. at 3 (PTAB Feb. 3, 2015) (Paper 11) (granting motion to submit supplemental information regarding accuracy of translation of Japanese prior art reference).

We also are persuaded that SteadyMed has met its burden because the supplemental information SteadyMed seeks to submit does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability. Rather, the proffered declarations constitute additional evidence that allegedly confirms the accuracy of the English translation of Kawakami, as presented in Exhibit 1007. *See id.*

Accordingly, it is

ORDERED that SteadyMed's motion to submit Exhibits 1019 and 1020 as supplemental information under 37 C.F.R. § 42.123(a) is granted.

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