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Paper 10
Date: March 17, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC,
Petitioner,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00204
Patent RE38,551 E

Before FRANCISCO C. PRATS and JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges.*

BONILLA, *Administrative Patent Judge*.

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

On March 8, 2016, a conference call was conducted between respective counsel for the parties and Judges Prats and Bonilla. A court reporter also was present on the call.[1] Petitioner requested the conference call to address an issue regarding information that Petitioner contends is in Patent Owner's possession and constitutes routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). Specifically, Petitioner contends that Patent Owner possesses, but has not served, relevant information that is inconsistent with a position advanced by Patent Owner in its Preliminary Response (Paper 9) as it relates to a reference, i.e., the LeGall Thesis (Ex. 1008), relied upon in certain challenges raised in the Petition (Paper 2).

In its Preliminary Response, Patent Owner asserts, *inter alia*, that Petitioner fails to show that the LeGall Thesis is a "printed publication" and qualifies as prior art under 35 U.S.C. § 102. Paper 9, 17–23 (citing *Activis Inc. v. Research Corp. Techs., Inc.*, IPR2014-01126, Paper 21(or 22), slip op. at 13 (PTAB Jan. 9, 2015) (determining that the LeGall Thesis does not qualify as a "printed publication" under § 102(b))). During the call, Petitioner pointed to Exhibit 1004 in the record, which is "Plaintiffs' and Defendents' Joint Statement of Uncontested Facts" ("Joint Statement") filed on October 26, 2015, in a district court proceeding involving Patent Owner as a plaintiff and the patent challenged here, i.e., *UCB, Inc. and Research Corp. Techs., Inc. v. Accord Healthcare, Inc.*, C.A. No. 13-1206 (D. Del). Paragraph 87 in that Joint Statement states that "for purposes of this [district

[1] Patent Owner, who arranged the court reporter, shall file a copy of a transcript of the call as an exhibit in due course. This Order summarizes statements made during the conference call. A more detailed record may be found in the transcript.

court] litigation, the LeGall thesis was publicly accessible more than one year before the earliest priority date for the '551 patent and constitutes printed publication within the meaning of 35 U.S.C § 102(b)." Ex. 1004 ¶ 87.

During the conference call, Petitioner stated that it had reason to believe, in view of the Joint Statement, that Patent Owner possessed relevant documents establishing the public accessibility of the LeGall Thesis, and specifically transcripts of depositions taken during the district court proceeding (not made of record in that case), as well as other unnamed documents. Patent Owner responded that it has not failed to serve any information inconsistent with a position advanced in its Preliminary Response, including its position that Petitioner has failed to meet its burden to establish that the LeGall Thesis qualifies as prior art.

As noted by Petitioner, both parties must serve routine discovery to each other, including relevant information that is inconsistent with a position advanced by the party during the proceeding. Under 37 C.F.R. § 42.11, both parties also have a duty of candor and good faith to the Office during the course of a proceeding, such as in relation to routine discovery, and especially regarding "information that is inconsistent with a position advanced by the party" under § 42.51(b)(1)(iii). At this time, we have insufficient information to conclude that Patent Owner has failed to meet its duty of candor and good faith in this regard. Thus, we are not persuaded to compel further routine discovery at this time.

During the call, Petitioner also requested the same information as additional discovery under § 42.51(b)(2). We decline to authorize such additional discovery at this preliminary stage. We have yet to determine

whether to institute a trial here, i.e., whether "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition" in view of a number of grounds raised in the Petition, of which only some rely on the LeGall Thesis (Paper 2 at 2). 35 U.S.C. § 314. We will consider information presented and cited in the Petition and the Preliminary Response, as already before us, when making that determination.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is not authorized to file a motion to compel routine discovery under § 42.51(b)(1)(iii), nor a motion to request additional discovery under § 42.51(b)(2), prior to a determination by the panel on institution.

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