

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, JACQUELINE WRIGHT BONILLA, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

On April 4, 2016, a conference call was conducted between respective counsel for the parties and Judges Prats, Bonilla, and Paulraj. A court reporter also was present on the call.¹ Petitioner requested this second conference call to address, once again, 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 filed and/or served, relevant information that is inconsistent with a position advanced by Patent Owner in its Preliminary Response (Paper 9) as it relates to 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. During the call, Petitioner discussed Exhibit 2025, a 1335-page transcript from a trial in a district court litigation involving Patent Owner as a plaintiff and the patent challenged here. Petitioner stated that Patent Owner included Exhibit 2025 in Patent Owner's Exhibit List filed here on March 17, 2016 (Paper 11) and served Exhibit 2025 on Petitioner on that date, i.e., after Patent Owner filed its Preliminary Response, but did not file the exhibit with the Board.

Petitioner requests authorization to file Exhibit 2025, or at least certain pages of the exhibit, which, according to Petitioner, present

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.

information inconsistent with statements in Patent Owner's Preliminary Response (Paper 9) and, therefore, correspond to routine discovery under § 42.51(b)(1)(iii). Petitioner also requests authorization to file a motion to compel routine discovery under § 42.51(b)(1)(iii) of a deposition transcript (discussed in Ex. 1028, 13) and documents produced through a subpoena (discussed in Ex. 1027, 9–11) from the district court trial.

Patent Owner objects to the filing of Exhibit 2025 at this stage, as well as the production of other requested documents, stating that Petitioner has the burden to present its case in its Petition and cited exhibits. Patent Owner represents, again, that it has not failed to serve any information inconsistent with a position advanced in its Preliminary Response, including its position that Petitioner fails to meet its burden to establish that the LeGall Thesis qualifies as prior art.

After hearing from both parties, we determined that briefing on the issue of routine discovery was warranted. During the call, we authorized Petitioner to file, no later than Monday, April 11, 2016, a 5-page motion to file Exhibit 2025 (in full or part) and/or compel routine discovery in relation to other documents discussed above.

In its motion, Petitioner has the burden to show that, notwithstanding Patent Owner's representations to the contrary, the documents at issue contain specific information inconsistent with an explicit position advanced by Patent Owner in this case. 37 C.F.R. § 42.52(a), §42.20(c). The motion is limited to the documents described above, and should address the following two issues: (1) why and on what basis, prior to a decision on institution, but after the filing of the Petition and Preliminary Response, we should compel the filing or service of the requested documents under

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relevant statutes and rules; and (2) whether Petitioner could have obtained such documents before the filing a Petition.

We further authorize Patent Owner to file a 5-page opposition no later than Monday, April 18, 2016.

It is

ORDERED that Petitioner's request for authorization to file a motion to compel routine discovery is granted to the extent described above;

FURTHER ORDERED that Petitioner's motion must be 5 pages or less and must be filed no later than Monday, April 11, 2016; and

FURTHER ORDERED that Patent Owner is authorized to file a 5-pages or less opposition to Petitioner's motion no later than Monday, April 18, 2016.

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