

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ARGENTUM PHARMACEUTICALS LLC  
Petitioner

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.  
Patent Owner

Patent No. RE38,551

Issue Date: July 6, 2004

Title: ANTICONVULSANT ENANTIOMERIC AMINO ACID DERIVATIVES

---

*Inter Partes* Review No. IPR2016-00204

---

**MOTION TO COMPEL DISCOVERY OF INCONSISTENT  
INFORMATION AND TO FILE EXHIBIT 2025**

In its Patent Owner Preliminary Response (“POPR”), Patent Owner advanced demonstrably inaccurate and misleading factual arguments. Patent Owner stated that the trial stipulation concerning LeGall as prior art was “drafted to streamline issues at trial” and “is not probative of the underlying facts” of LeGall’s public accessibility. POPR, Paper No. 9 at 20. Patent Owner contended that certain “facts” about student access to LeGall “provide a ready and common-sense explanation” of why the evidence does not establish LeGall as prior art. *Id.* at 22.

These quintessential factual assertions are contradicted by uncontroverted statements and testimony Patent Owner resists providing to the Board. *See* Ex. 2025 at 44 (stating that “we got the proof and now they admit” that LeGall is prior art). Unsupported by statute or rule, Patent Owner’s position contravenes its duty of candor. To be sure, the IPR petition meets the “reasonable likelihood” standard for demonstrating LeGall as prior art and establishing one or more claims as unpatentable. Even so, Patent Owner, under the statute or rules, cannot advance factual assertions inconsistent with information it has in its possession and simultaneously refuse to provide Petitioner and the Board with that information.

## **I. Statement of Material Facts**

**1.** Patent Owner and/or its counsel are in possession of the documents listed in the e-mail dated December 22, 2015. Ex. 1038. **2.** The non-public transcript of the deposition of John Lehner, dated December 5, 2014, contains testimony regarding

the public accessibility of LeGall. Ex. 1028, 0013. **3.** In response to a subpoena, the University of Houston (“University”) provided non-public documents and information to Patent Owner regarding the public accessibility of LeGall and other similar University theses. Ex. 1027, 0009-11. **4.** LeGall was deposited in the University library at least one year prior to March 15, 1996. **6.** From 1988 to March 15, 1996, the University provided forms for public visitors with which a visitor could request a copy of a University thesis, such as LeGall, by author name and/or title. Ex. 1028, 0009-10. **7.** LeGall is cited by author name and University affiliation in at least three publicly-available publications. Ex. 1016, p. 279; Ex. 1017, p. 3360; Ex. 1010, p. 7013. **8.** The University has a financial interest tied to U.S. Patent No. RE38,551 and has refused to release the Lehner deposition transcript on the grounds that releasing it would cause the University’s revenue stream to be lost or severely diminished. Ex. 1028, 0006, 0015.

## **II. Discovery and Filing of the Requested Documents is Authorized**

First, “[p]arties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.” 37 C.F.R. § 42.11. The Board can sanction noncompliance, including for “[a]dvancing a misleading or frivolous argument” and for the “[m]isrepresentation of a fact.” *Id.* § 42.12(a)(2)-(3). A party does not comply with its duty of candor if it intentionally withholds from the Board information directly refuting a position it

advocates. *See also* Order, Paper No. 10 at 3 (Mar. 17, 2016) (identifying duty of candor and good faith). Here, Patent Owner’s affirmative factual representations in its POPR do not comply with its duty of candor, and therefore the Board has the power to require the filing of the inconsistent information. Contrary to the POPR’s factual assertion about its prior art stipulation, two trial witnesses confirmed the public availability of LeGall. *See* Ex. 2025, at 102, 683. The University asserted that (a) Lehner’s deposition testimony and (b) the records indicating check-out dates for LeGall “would cause the University competitive harm,” which must mean that the testimony confirms LeGall’s status as prior art. *See* Ex. 1028, at 5, 15.

Second, the applicable statutes do not exclude the consideration of facts that contradict the veracity of statements in a POPR. *See* 35 U.S.C. § 314. While a petition cannot be saved by supplementation, the statutes do not mandate the Board to turn a blind eye to information that contradicts factual assertions in a POPR. *See id.* Indeed, unlike in § 314, when Congress wanted to specifically restrict the Office’s authority, it did so by using the word “only.” *See, e.g.,* 35 U.S.C. § 6(c) (“Only the . . . Board may grant rehearings.”); *id.* § 311(b) (limiting IPR grounds “only on a ground . . . under 102 or 103”); *id.* § 317(b) (limiting access to settlements “only to Federal Government agencies”). Consistent with this, the Board has sought and considered information addressing the veracity of statements in the petition before the institution decision. *See, e.g., Zerto, Inc. v. EMC Corp.,*

IPR2014-01254, Paper 15 (Nov. 25, 2014) (granting a discovery request). Under the Patent Owner's theory, the Board could not consider pre-institution discovery on relevant issues, including the issue of real party in interest.

Third, although initially disputed by Patent Owner, *see* Exs. 1038-1043, the rules authorize discovery of inconsistent information during a "proceeding," 37 C.F.R. § 42.51(b)(1)(iii), which includes a "preliminary proceeding," *i.e.*, prior to institution, *id.* § 42.2. The Board can provide "a proper course of conduct . . . for any situation not specifically covered" by the rules. *Id.* § 42.5. Thus, even beyond its power to sanction under § 42.12, the Board may reasonably authorize the filing of inconsistent information. *See Chevron, U.S.A. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 842 (1984). Because discovery ensures accurate decision-making by the Board, it would be nonsensical, unjust, and against public policy to allow discovery of inconsistent information under § 42.51(b)(1)(iii) and yet preclude the Board from considering that information. *See* 77 Fed. Reg. 48,756, 48761 (Aug. 14, 2001) (describing specific examples of inconsistent information).

### **III. The Documents Are "Inconsistent Information," §42.51(b)(1)(iii).**

First, Exhibit 2025 is clearly inconsistent with Patent Owner's contention that the trial stipulation concerning LeGall is "not probative" of whether LeGall was publicly accessible. *See* POPR at 20. Trial counsel mentioned actual "proof" that caused Patent Owner's admission, Ex. 2025 at 44, and two witnesses confirmed

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.