

IN THE 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 No. IPR2016-00204

Patent No. RE 38,551

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
COMPEL DISCOVERY AND TO FILE EXHIBIT 2025**

Petitioner’s Motion presents no reason to deviate from the Board’s prior Order (Paper 10) declining to compel routine or additional discovery. Petitioner’s Motion is based wholly on the erroneous premise that the Patent Owner Preliminary Response (“POPR”) contains “factual assertions” regarding the status of the LeGall Thesis as a printed publication. Mot. at 1. But Patent Owner has not taken any *substantive* position on whether the LeGall Thesis is a printed publication, challenging only the *sufficiency* of Petitioner’s evidence. Therefore, evidence alleged to address the substantive question of whether the LeGall Thesis is a printed publication cannot be “inconsistent information” under 37 C.F.R. § 42.51(b)(1)(iii). Moreover, there is no authority—and Petitioner cites to none—permitting Petitioner to *file* evidence beyond that in the petition prior to institution.

In addition, Petitioner includes “material facts” addressing the merits of the printed publication question (Mot. at 1-2),¹ in a transparent attempt to improperly supplement the petition in violation of the statute. *See* 35 U.S.C. § 314(a).

I. Patent Owner Has Not Advanced a Substantive Position on Whether the LeGall Thesis Is a Printed Publication

Petitioner has not—and cannot—point to any *substantive* position Patent Owner has advanced on whether the LeGall Thesis is a printed publication. Applying PTAB case law, page 20 of the POPR (*see* Mot. at 1, 4) explains that the

¹ Notably, Petitioner cites no support for alleged “material fact” “4.” *See* Mot. at 2.

trial stipulation, drafted to streamline the issues at trial, does not preclude the Board from assessing whether Petitioner’s evidence is sufficient, and that the conclusory language of the stipulation itself “is not probative of the underlying facts” concerning public accessibility of the LeGall Thesis. Page 22 of the POPR (*see* Mot. at 1) explains that the articles identified by Petitioner were authored by students (*other than* LeGall), or their advisors, providing a ready explanation for access to those students’ theses, confirming that the thesis citations “provide no evidence” “of how the LeGall Thesis was in fact indexed, cataloged or shelved.”

The POPR’s challenge to the sufficiency of Petitioner’s evidence of public accessibility is not “tantamount to an affirmative argument that the [thesis is] not [a] printed publication[.]” *Nvidia Corp. v. Samsung Elecs. Co., Ltd.*, IPR2015-01316, Paper 9, p. 3 (PTAB Oct. 28, 2015) (internal quotations omitted); *see also Hughes Network Sys., LLC v. Calif. Inst. of Tech.*, IPR2015-00059, Paper 34, p. 7 (PTAB Dec. 30, 2015). “The distinction is important which, if not made, leads to an unreasonably broad scope of routine discovery.” *Nvidia*, Paper 9, p. 3.

In *Nvidia*, the Board denied Petitioner’s request for authorization to file a motion to compel under 37 C.F.R. § 42.51(b)(1)(iii), seeking documents *in patent owner’s possession* allegedly “inconsistent” with patent owner’s position in its Preliminary Response on the issue of public accessibility. *Nvidia*, Paper 9, p. 2. The Preliminary Response asserted that “Petitioner . . . has not provided any

evidence” as to whether and how the references were made available to the public. *Id.*, Paper 7, p. 6. The Board concluded that the Preliminary Response challenged the *sufficiency* of Petitioner’s evidence, and denied discovery on that basis: “the documents Petitioner seeks are not inconsistent with a position taken in the Preliminary Response and need not have been served as routine discovery.” *Id.*, Paper 9, p. 3. As in *Nvidia*, the POPR in the present proceeding does not take a substantive position on whether the LeGall Thesis is a printed publication, challenging only the *sufficiency* of Petitioner’s evidence. *See* POPR, pp. 17-23. Such “[a]rguments pointing to a deficiency in petitioner’s case do not impose an obligation on the part of [patent owner] to provide evidence supplementing that provided by [petitioner].” *Hughes*, Paper 34, p. 7.

II. The Statute and Rules Preclude the Filing of Supplemental Information Prior to the Board’s Institution Decision

The statute requires the Board to decide whether to institute trial based on “the information presented in the petition.” 35 U.S.C. § 314(a). A petitioner must, *in its petition*, present “credible evidence” to satisfy its burden of a threshold showing of public accessibility of an asserted reference. *See Hughes*, Paper 34, p. 4; *see also Apple Inc. v. DSS Tech. Mgmt., Inc.*, IPR2015-00369, Paper 14, p. 5 (PTAB Aug. 12, 2015). In light of this statutory requirement, the regulations provide only for *service* of routine discovery under 37 C.F.R. § 42.51(b)(1)(iii). The *filing* of evidentiary objections, supplemental evidence, and supplemental

information related to the merits is permitted only *after institution*. See 37 C.F.R. §§ 42.64(b), 42.123.

Under this integrated statutory and regulatory framework, only where a petitioner has first satisfied its statutory burden in the petition, and only after trial institution, may a petitioner request to submit supplemental information regarding the public accessibility of an asserted reference. See *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013–00369, Paper 37, pp. 2-3 (PTAB Feb. 5, 2014) (granting motion to submit supplemental information regarding public accessibility of references when “the information presented in the Petition . . . made a threshold showing that [the references] are ‘printed publications’”); see also *Apple Inc. v. Virnetx Inc.*, IPR2015-00810, Paper 17 (PTAB Nov. 2, 2015) (same). There is no reason, or authority, to deviate from this framework here.

Consideration of “pre-institution discovery on . . . the issue of real party in interest” (Mot. at 4) is not to the contrary. In the *Zerto* case cited by Petitioner (Mot. at 3-4), the Board considered evidence obtained from such discovery prior to institution in conjunction with the Patent Owner Preliminary Response, a filing authorized by the statute and the regulations. 35 U.S.C. § 313; 37 C.F.R. § 42.107. Prior to institution, the Board properly considers information served under discovery when filing the information is authorized by the regulations, and does not otherwise violate the statute.

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