

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 June 22, 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 Both parties requested the call to address proposed motions for each party.

Prior to the call, by e-mail correspondence sent to the Board on June 13, 2016, Petitioner requested authorization to file: (1) a motion to consolidate this *inter partes* review (“IPR”) proceeding with a pending *ex parte* reexamination Control No. 90/013,709 requested by Petitioner concerning the same challenged patent at issue here; (2) under 37 C.F.R. § 42.123(a), as supplemental information, pages of a trial transcript from a district court litigation concerning the challenged patent here; (3) a motion for discovery under 37 C.F.R. § 42.51(b) “relating to prior art relevant to the ground upon which trial was instituted”; and (4) as other supplemental information, “any relevant information obtained from discovery, if such discovery is permitted.”

In the same e-mail correspondence, Patent Owner requested authorization to file: (1) an opposition to Petitioner’s Request for Rehearing (Paper 21) of our Decision to Institute (Paper 19) in this case; and (2) a motion to terminate *ex parte* reexamination Control No. 90/013,709 mentioned above.

During the call, in relation to the proposed motion to consolidate this IPR with the reexamination, the parties noted that Petitioner’s request for the

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.

reexamination, filed on March 25, 2016, raised two grounds of rejection under the doctrine of obviousness-type double patenting (“OTDP”) based on U.S. Pat. No. 5,654,301 (“the ’301 patent”), not raised in a ground at issue here, in combination with other art raised in grounds in the Petition in this IPR. Specifically, Petitioner proposed two OTDP grounds of rejection based on the ’301 patent, in view of the ’729 patent² and Kohn 1991³ in the first ground, and in view of the ’729 patent and the LeGall thesis⁴ in the second ground.

During the call, we pointed out that the Examiner granted the request for the *ex parte* reexamination on June 16, 2016, without issuing an Office Action in the case. In view of that status, we indicated to the parties that Petitioner’s request for a motion to consolidate may be premature at this time, but we would take the matter under advisement.

After considering the matter further, we authorize Petitioner to file its requested motion to consolidate the two proceedings. As noted during the call, however, we are not inclined as an initial matter to consolidate matters here, not least of which because the reexamination at issue raises grounds based on OTDP, which cannot be the basis of a ground in an IPR, and *ex parte* reexamination differs procedurally from IPRs generally, particularly as

² Kohn et al., U.S. Patent No. 5,378,729, issued on Jan. 3, 1995 (“the ’729 patent”) (Ex. 1009).

³ Kohn et al., *Preparation and Anticonvulsant Activity of a Series of Functionalized α -Heteroatom-Substituted Amino Acids*, 34 J. MED. CHEM. 2444–52 (1991) (“Kohn 1991”) (Ex. 1012).

⁴ Philippe LeGall, *2-Substituted-2-acetamido-N-benzylacetamides. Synthesis, Spectroscopic and Anticonvulsant Properties* (Dec. 1987) (“the LeGall thesis”) (Ex. 1008).

it relates to Petitioner's involvement in the reexamination and the parties' ability to appeal to the Board a decision by the Examiner in the reexamination.

That said, however, to give us an opportunity to fully address the merits of Petitioner's position, we authorize Petitioner to brief the issue of consolidation further in a motion no longer than 10 pages, and authorize Patent Owner to respond in an opposition to that motion, in a paper no longer than 10 pages. We do not authorize a reply to the opposition.

Petitioner also requested, as supplemental information under § 42.123(a), certain pages of a trial transcript from a related district court litigation. Petitioner clarified during the call that those transcripts are the same transcripts it attempted to obtain as discovery in this case prior to institution, in an effort to establish that the Le Gall thesis qualified as prior art. Paper 13 (Petitioner's Motion to Compel Discovery of Inconsistent Information and to File Exhibit 2025). We denied that Motion prior to institution (Paper 18), and determined in our Decision to Institute that Petitioner did not establish sufficiently in its Petition that the Le Gall thesis qualified as "printed publication" prior art. Paper 19, 8–12. In our Decision to Institute, we instituted a trial based on grounds that did not rely on the Le Gall thesis. *Id.* at 12–22, 23–24.

In addition to the above request, Petitioner also indicated in the call that it requested other discovery and related supplemental information as it pertained to the public accessibility of the Le Gall thesis. Petitioner argued that it anticipated, in a Response yet to be filed, that Patent Owner would argue a reasonable expectation of success as relevant to non-obviousness based on information in the Le Gall thesis.

We indicated in the call that any request for discovery based on what Patent Owner might argue in a Response was premature. We denied Petitioner's request for discovery, as well as any request to file supplemental information, as related to the public accessibility of Le Gall thesis.

Patent Owner also requested authorization to file a 10-page opposition to Petitioner's Request for Rehearing of our Decision to Institute, which Petitioner filed on June 6, 2016. Paper 21. During the call, we authorized Patent Owner to file the opposition within two weeks of the call, i.e., by July 6, 2016. We do not authorize a reply to that opposition.

Patent Owner further requested authorization to file a motion to terminate the *ex parte* reexamination, citing 35 U.S.C. § 315(d). We decline to grant that request at this time. We are not persuaded that the filing and granting of the *ex parte* reexamination request constitutes a type of harassment that justifies terminating a proceeding that will address grounds of rejection based on ODTP and different art, i.e., the '301 patent, not at issue in the current IPR.

Accordingly, it is:

ORDERED that Petitioner is authorized to file, by Wednesday, July 13, 2016, a 10-page motion to consolidate the current IPR with *ex parte* reexamination Control No. 90/013,709;

FURTHER ORDERED that Patent Owner is authorized to file, by Wednesday, July 20, 2016, a 10-page opposition to Petitioner's motion to consolidate the current IPR with the *ex parte* reexamination;

FURTHER ORDERED that Patent Owner is authorized to file, by Wednesday, July 6, 2016, a 10-page opposition to Petitioner's Request for

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