

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
REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71(d)**

Petitioner's Request for Rehearing Under 37 C.F.R. § 42.71(d) (Paper 21; "Request" or "Req.") fails to set forth any reason sufficient to justify modification of the Board's Decision (Paper 19; "Decision" or "Dec.") that the "contentions and evidence cited by Petitioner do not rise to the level of 'threshold evidence' that justifies going forward with a trial on any ground that relies on the LeGall thesis as 'printed publication' prior art" (Dec., p. 12). The Request is replete with new arguments, and utterly fails to identify in the Petition "the place where each matter was previously addressed" as required by 37 C.F.R. § 42.71(d). The Request makes no effort to do so, and tellingly omits this clause of the rule (*see* Req. at 2), instead including only a single cite to a page in the Petition having nothing to do with the public accessibility of the LeGall Thesis (*see* Req., pp. 2, 5). The Request should be denied.

I. Legal Standard

The burden rests with Petitioner to show that the Decision should be modified because of an abuse of discretion. 37 C.F.R. §§ 42.71(c), (d). A request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, *and the place where each matter was previously addressed in a motion, opposition, or a reply.*" 37 C.F.R. § 42.71(d) (emphasis added). Thus, a petitioner seeking to modify an institution decision "must specifically identify" not only the matters believed to be "misapprehended or

overlooked,” but *also* “where each matter was previously addressed” in the petition. *Id.* In applying § 42.71(d), the Board has repeatedly held that “[a] request for rehearing is not an opportunity to present new arguments not previously presented in the Petition.” *E.I. DuPont De Nemours and Co. v. Furanix Techs. B.V.*, IPR2015-01838, Paper 20, p. 4 (PTAB May 24, 2016); *see also ServiceNow, Inc. v. Hewlett-Packard Co.*, IPR2015-00707, Paper 14, pp. 2, 8–10 (PTAB Nov. 2, 2015); *Electronic Frontier Foundation v. Personal Audio, LLC*, IPR2014-00070, Paper 28, pp. 4–5 (PTAB May 29, 2014); *TRW Automotive US LLC v. Magna Elecs., Inc.*, IPR2014-00258, Paper 18, p. 5 (PTAB Aug. 27, 2014). When Petitioner presents new arguments for the first time in a request for rehearing, the Board “could not have ‘misapprehended or overlooked’ [the] new arguments because Petitioner failed to include them in its Petition.” *Koito Mfg. Co., Ltd. v. Adaptive Headlamp Techs., Inc.*, IPR2016-00079, Paper 14, p. 4 (PTAB June 15, 2016).

As explained below, the “roadmap theory” in Petitioner’s Request is replete with new arguments and relies on evidence that is different from the evidence cited in the Petition. Since the Board could not have “misapprehended or overlooked” the new “roadmap theory,” the Request fails to establish an abuse of discretion. *See* 37 C.F.R. § 42.71(c).

II. The “Roadmap Theory” is a New Theory Presented for the First Time in the Request for Rehearing

The Petition presented three arguments to show that the LeGall Thesis qualifies as a printed publication.¹ Pet., pp. 22–23; *see also* Dec., pp. 10–12. The “roadmap theory” in the Request is nowhere to be found in the Petition, but rather was copied (right down to the case cites) from the earlier-denied petition in IPR2014-01126 (*See* Ex. 2030, pp. 34–36).² Given that the “roadmap theory” is a new theory not included in the Petition, it is unsurprising that the Request has only a single citation to the Petition itself.³

¹ (1) “Patent Owner has now admitted that LeGall qualifies as prior art;” (2) the University of Houston has denied Petitioner’s request for information regarding public access to the LeGall Thesis; and (3) other University of Houston’s theses were allegedly generally accessible to the public. Pet., pp. 22–23; Dec., p. 10.

² The “roadmap theory” that Petitioner now tries to import was fully reviewed and disregarded by the Board as “not provid[ing] competent evidence to qualify the LeGall thesis as a ‘printed publication’ under § 102(b).” *Actavis, Inc. v. Research Corp. Techs., Inc.*, IPR2014-01126, Paper 22, p. 13 (PTAB Jan. 9, 2015).

³ The single citation is in footnote 2 on page 5 of the Request, and cites to a page in the Petition having nothing to do with the public accessibility of the LeGall Thesis.

Each of the five components of the alleged “roadmap” (Req., pp. 3, 9) includes new arguments not presented in the Petition, and relies on evidence different from the evidence cited in the Petition. Each component is addressed below.

A. Components 1) and 2) - Scientific Articles Citing the LeGall Thesis

The Request argues that three articles (Exs. 1010, 1016, and 1017) “explicitly cite” to the LeGall Thesis by the author’s name and location, and that “courts have accepted this type of evidence as sufficient to provide a roadmap to the prior art reference,” citing to the *Bruckelmyer* and *Cornell University* cases. Req., pp. 5–6. The Request additionally argues that a footnote in a 1988 article by LeGall (Ex. 1016) “expressly instructs the public and members of the relevant scientific community to read LeGall’s thesis to obtain ‘[a]dditional structure proof and experimental and spectra data.’” Req., p. 6. No such arguments were presented in the Petition in the present proceeding; instead they were copied into the Request from the earlier-denied petition in IPR2014-01126.

The Petition in the present proceeding relied on different articles, each of which cites to a thesis *other than the LeGall Thesis*. See Paper 9, pp. 21–22. In particular, rather than citing to Exs. 1010, 1016, and 1017, the Petition’s argument relied on Exs. 1029–1032, none of which was argued (i) to cite to the LeGall Thesis (as none of them does so) or (ii) to provide any sort of “roadmap” to the

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