

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

**PETITIONER'S MOTION TO CONSOLIDATE
REEXAMINATION WITH INTER PARTES REVIEW**

37 C.F.R. § 42.122(a)

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I. RELIEF REQUESTED

Argentum Pharmaceuticals LLC (“Petitioner”) respectfully requests the PTAB to consolidate *ex parte* Reexamination No. 10/058,634 (“Reexam”) with the present *inter partes* review (“IPR”) of U.S. Patent No. RE38,551 (“’551 patent”), pursuant to 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a).

II. STATEMENT OF MATERIAL FACTS

1. On November 23, 2015, Petitioner filed its petition against all claims of the ’551 patent on several grounds. Ground 3A asserted obviousness of claims 1-9 over Kohn 1991¹ and Silverman,² and Ground 3B asserted obviousness of dependent claims 10-13 over Kohn 1991, Silverman, and the ’729 patent.³ The petition cited additional background prior art in support of Grounds 3A-3B, including the ’301 patent⁴ and LeGall.⁵ *See* Pet. 46-47. Two expert declarations were filed with the petition. Ex. 1002 (Wang Decl.); Ex. 1003 (Heathcock Decl.).

2. On March 25, 2016, Petitioner filed a reexamination request for claims 1-13

¹ Kohn et al., *Preparation and Anticonvulsant Activity of a Series of Functionalized α -Heteroatom-Substituted Amino Acids*, 34 J. Med. Chem. 2444 (1991).

² Silverman, R. B., *The Organic Chemistry of Drug Design and Drug Action*, Academic Press (1992).

³ U.S. Patent No. 5,378,729.

⁴ U.S. Patent No. 5,654,301.

⁵ Philippe LeGall, 2-Substituted-2-acetamido-N-benzylacetamides. Synthesis, Spectroscopic and Anticonvulsant Properties (Dec. 1987).

of the '551 patent. Ex. 1045. The request proposed two grounds of rejection: (1) obviousness-type double patenting (“ODP”) of claims 1-13 over the '301 patent in view of the '729 patent and Kohn 1991; and (2) ODP of claims 1-13 over the '301 patent in view of the '729 patent and LeGall. Petitioner’s request included the same two expert declarations by Drs. Wang and Heathcock filed in the IPR.

3. On May 9, 2016, the Central Reexamination Unit (“CRU”) conducted a telephonic interview with the Patent Owner’s counsel pursuant to the *Pilot Program for Waiver of Patent Owner’s Statement*. Ex. 1046 at 3. Patent Owner refused to waive its right to file claim amendments and a statement under 35 U.S.C. § 304, thus preventing the simultaneous issuance of an Office action. *Id.*

4. On May 23, 2016, the Board instituted the IPR against all claims on Grounds 3A and 3B. Patent Owner’s response and motion to amend are due August 15, 2016. Paper 20 at 7.

5. On June 16, 2016, the CRU ordered the reexamination of claims 1-13, finding a substantial new question of patentability based on the '301 patent, the '729 patent, Kohn 1991, and LeGall. Ex. 1047 at 8. Patent Owner’s § 304 statement and amendments are due August 16, 2016, followed by a two-month period for Petitioner to file a reply to such statement. *Id.* at 10.

III. ARGUMENT

A. The Board Has Authority to Consolidate the IPR and the Reexam under 35 U.S.C. § 315(d)

Under 35 U.S.C. § 315(d), “[n]otwithstanding . . . chapter 30,” “if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.” *See also* 37 C.F.R. § 42.122(a). The Board thus “has the discretion to consolidate a review proceeding with a pending . . . reexamination that involves the same patent.” 77 Fed. Reg., 48,680, 48,697 (Aug. 14, 2012). A consolidated reexam/IPR will proceed as “a single *inter partes* review proceeding,” *i.e.*, a “merged proceeding.” *Id.* at 48,697–48,698.

Patent Owner may argue that the Board is powerless to consolidate in this case because ODP is not a ground initially petitionable in IPR. That is incorrect. Upon consolidation, the Board may address the ODP grounds in a final IPR written decision. Section 318(a) does not limit the “patentability” issues the Board may decide in a final decision. For this reason, the Board has properly held that proposed new claims are unpatentable under grounds *other than* §§ 102 and 103 and prior art *other than* patents and printed publications. *See, e.g., Smith & Nephew, Inc. v. ConvaTec Techs.*, IPR2013-00102, at 53-54 (PTAB May 29, 2014) (deciding § 112(a) written description issue); *Ariosa Diagnostics v. Isis Innovation*

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