

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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ARGENTUM PHARMACEUTICALS LLC,  
Petitioner,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,  
Patent Owner.

Case No. IPR2016-00204

Patent No. RE 38,551

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

Consolidation here would violate the statutory provision governing the scope of IPR proceedings because all of the bases of alleged unpatentability at issue in the *ex parte* reexamination are outside the scope of permissible grounds for an *Inter Partes* Review (“IPR”). Petitioner has identified no instance where the Board has consolidated an IPR with an *ex parte* reexamination, and for good reason. An *ex parte* proceeding is fundamentally incompatible with an *inter partes* review, and is particularly so here. Consolidating the *ex parte* reexamination would fundamentally change the reexamination proceeding from examinational to adjudicatory, and would unlawfully abridge Patent Owner’s statutory right to conduct the reexamination proceeding with no participation by the reexamination requester, the same party as the petitioner in the present proceeding. In addition to the statutory hurdles, consideration of any of Petitioner’s “consolidation factors” counsels against consolidation here. The Motion should be denied.

**I. Consolidating the *Ex Parte* Reexamination and the IPR for RE 38,551 Would Violate 35 U.S.C. § 311(b)**

Consolidation of *ex parte* Reexamination No. 90/013,709 with the present *Inter Partes* Review would introduce unpatentability grounds outside the proper scope of IPR proceedings, as defined by 35 U.S.C. § 311(b). Section 311(b) explicitly limits IPR proceedings to grounds “that could be raised under section 102 or 103,” and thus excludes “judicially-created” doctrines such as obviousness-type double patenting (“OTDP”). *See, e.g., AbbVie Inc. v. Mathilda and Terence*

*Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1372-73 (Fed. Cir. 2014) (explaining OTDP is a “court-created doctrine” that stems from § 101’s prohibition on obtaining more than one patent on the same invention); *Eli Lilly & Co. v. Barr Labs., Inc.*, 222 F.3d 973, 985 (Fed. Cir. 2000) (noting OTDP is a “judicially-created doctrine” and that “no explicit statutory basis exists” for it). Because all of the alleged bases of unpatentability in the ’709 reexamination proceeding are based on OTDP (*see* Paper 30, pp. 1–2; Paper 27, p. 3; Ex. 2031, 5:19–6:2; Ex. 1045, pp. 19–20), and because OTDP is not within the scope of § 311(b) (*see* Paper 27, p. 3), any consolidation of the reexamination with the present IPR proceeding would necessarily violate the express scope of the statute.

The authority granted to the PTAB under § 318(a) to “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d)” does not mandate a different result. Section 318(a) does not provide any authority to violate § 311(b). Petitioner’s assertion that “an original claim of a patent can be held unpatentable under ODP in a final IPR written decision” notwithstanding § 311(b) (Paper 30, p. 4) is wholly unsupported and is directly contradicted by the very cases Petitioner cites. Both *Smith* and *Ariosa* are fully consistent with § 311(b) in addressing the patentability of *amended* claims on grounds other than § 102 and §103. *See Smith & Nephew, Inc. v. ConvaTec Technologies, Inc.*, IPR2013-00102, Paper 87 at 50–

54 (P.T.A.B. May 29, 2014); *Ariosa Diagnostics v. Isis Innovation Limited*, IPR2012-00022, Paper 166 at 47–53 (P.T.A.B. Sept. 2, 2014). Section 311(b) is directed to the grounds under which “claims of a patent” may be challenged and therefore does not restrict patentability determinations with respect to proposed *amended* claims, for which the Board is entrusted with full review of patentability. 35 U.S.C. §§ 316(d), 318(a). In contrast, § 311(b) limits the Board’s review of the “claims of a patent,” which have already undergone a patentability determination by the Examiner, to grounds “that could be raised under section 102 or 103.”

Granting Petitioner’s Motion here would amount to an end-run around the explicit statutory provisions set forth in § 311(b) for the grounds under which a patentability challenge may be raised. In filing § 103 challenges in the present IPR proceeding and OTDP claims in the reexamination proceeding, Petitioner was fully aware of the explicit scope of IPR proceedings set forth in § 311(b). *See* Petition at 20, n.2. Petitioner’s attempt to now use § 315(d) as a loophole to bypass § 311(b) should be rejected.

## **II. Consolidating the *Ex Parte* Reexamination and the IPR for RE 38,551 Would Violate the Statute Governing Conduct of the Reexamination**

Consolidating the *ex parte* reexamination with the present IPR proceeding would also violate the statute governing conduct of the reexamination proceeding, and would unlawfully abridge Patent Owner’s statutory rights. The statute governing *ex parte* reexamination clearly provides for examination without

participation of the requester, the presentation of claim amendments as a matter of right, and for appeal to the Patent Trial and Appeal Board (PTAB) and the Federal Circuit only by the patent owner, with no participation by the requester. In particular, the active participation of the requester ends with a reply to a patent owner's statement, if filed.<sup>1</sup> See 35 U.S.C. §§ 304, 305; see also 37 C.F.R. § 1.550(g) (stating “[t]he active participation of the *ex parte* reexamination requester ends with the reply,” and “no further submissions on behalf of the reexamination requester will be acknowledged or considered”); 37 C.F.R. § 1.560(a) (precluding participation by reexamination requesters in interviews with examiners). Thereafter, the reexamination is conducted *ex parte* in accordance with “the procedures established for initial examination,” under which the patent owner is “permitted to propose any amendment to his patent and a new claim or claims thereto.” 35 U.S.C. § 305. Only the patent owner may appeal to the PTAB and the Federal Circuit; the requester has no right to appeal a reexamination determination. 35 U.S.C. § 306.

The conduct of IPR proceedings before the PTAB stands in sharp contrast. The statute governing *inter partes* review provides for an adjudicatory proceeding

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<sup>1</sup> Under 35 U.S.C. § 304, the filing of a patent owner statement is optional, and if none is filed, then the requester may not file a reply.

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