Trials@uspto.gov
571-272-7822

Paper 34
Date: August 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC, MYLAN PHARMACEUTICALS INC., BRECKENRIDGE PHARMACEUTICAL, INC., and ALEMBIC PHARMACEUTICALS, LTD.,[1]
Petitioners,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00204, Case IPR2016-01101, Case IPR2016-01242, Case IPR2016-01245, Case IPR2016-01248[2]
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

---

[1] Argentum Pharmaceuticals LLC is Petitioner in Case IPR2016-00204, Mylan Pharmaceuticals Inc. is Petitioner in Cases IPR2016-01101 and IPR2016-01248, Breckenridge Pharmaceutical, Inc. is Petitioner in Case IPR2016-01242, and Alembic Pharmaceuticals, Ltd. is Petitioner in Case IPR2016-01245.

[2] This Order addresses issues that are relevant in all four cases. Thus, we exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

On August 9, 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.[3] Counsel for Petitioner Breckenridge Pharmaceutical, Inc. ("Petitioner Breckenridge") requested the call on behalf of itself, Petitioner Mylan Pharmaceuticals Inc., ("Petitioner Mylan"), and Alembic Pharmaceuticals, Ltd. ("Petitioner Alembic") (collectively "the later Petitioners"). The later Petitioners requested the call to discuss their pending motions in respective cases (*see supra* text accompanying note 1) to join as parties to the *inter partes* review instituted in IPR2016-00204 (Paper 19) involving Petitioner Argentum Pharmaceuticals LLC ("Petitioner Argentum") and Patent Owner Research Corporation Technologies, Inc. ("Patent Owner").

During the call, the later Petitioners indicated that they filed "me-too" Petitions and intended to simply follow along in an "understudy" role to activity by Petitioner Argentum during the trial in IPR2016-00204. The later Petitioners agreed that they will rely on arguments and evidence provided by Petitioner Argentum in the case, and will not seek (a) additional briefing or pages, (b) to submit new evidence, such as declaration testimony, (c) additional time for cross-examination of witness or time during an oral hearing, or (d) to alter the trial schedule set out in our Scheduling Order (IPR2016-00204, Paper 20) or as appropriately agreed upon between Petitioner Argentum and Patent Owner during trial (*id*.).

[3] 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.

During the call, Patent Owner initially indicated that it opposed the Motions for Joinder filed by the later Petitioners. Patent Owner pointed out that Petitioner Mylan, in IPR2016-01248, cited to additional evidence in its Motion for Joinder that is not of record in IPR2016-00204. In response, the later Petitioners, including Petitioner Mylan, agreed to assert arguments and evidence of record in IPR2016-00204 only, and not rely on any additional evidence raised in Petitions or Motions for Joinder filed by the later Petitioners. Patent Owner indicated that it would not oppose joinder of the later Petitioners under those circumstances.

That said, Patent Owner indicated that it intended to file Patent Owner Preliminary Responses to all three Petitions filed by the later Petitioners. Patent Owner asserted that intervening case law, decided after we issued our Decision on Institution in IPR2016-00204, was relevant to a decision on institution in the other cases. We questioned Patent Owner about the need for Preliminary Responses in this instance, namely because we already have instituted trial in IPR2016-00204, the later Petitioners would serve in an understudy role in the case, and Patent Owner could make arguments regarding intervening case law in its Patent Owner Response in IPR2016-00204. Thus, it appeared to us that Patent Owner actually was requesting an opportunity to file an Opposition to the Motion for Joinder filed by the later Petitioners in each case, regardless of the "me-too" status of the Petitions in question.

Upon consideration of the positions of all parties during the call, we authorized Patent Owner to file a 15-page paper in each of IPR2016-01101, IPR2016-01248, IPR2016-01242, and IPR2016-01245 in lieu of a full

Preliminary Response in each case. In relation to each paper, we authorized Patent Owner to address the intervening case law issue it raised during the call, as well as allow Patent Owner to refer to its Patent Owner Preliminary Response and our Decision on Institution in IPR2016-00204 (Papers 9 and 19), effectively allowing Patent Owner to incorporation by reference arguments or information in those papers, notwithstanding 37 C.F.R. § 42.6(a)(3). Patent Owner shall style the papers as "Patent Owner Abbreviated Preliminary Response and Opposition to Petitioner's Motion for Joinder." Those papers are due by Friday, August 19, 2016. During the call, we indicated that we did not authorize Petitioners to file a reply to those papers, and clarified that Patent Owner will not file any other Patent Owner Preliminary Response in the respective cases.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file, by Friday, August 19, 2016, a 15-page paper styled "Patent Owner Abbreviated Preliminary Response and Opposition to Petitioner's Motion for Joinder" in each of IPR2016-01101, IPR2016-01248, IPR2016-01242, and IPR2016-01245, as discussed above; and

FURTHER ORDERD that no party is authorized to file any additional paper prior to a decision on institution in the respective cases, absent a request by the party and subsequent authorization by the Board.

PETITIONER:

Matthew J. Dowd
Justin W. Crotty
ANDREWS KURTH LLP
MatthewDowd@andrewskurth.com
justincrotty@andrewskurth.com

PETITIONER:

Steven W. Parmelee
Michael T. Rosato
Jad A. Mills
WILSON SONSINI GOODRICH & ROSATI
sparmelee@wsgr.com
mrosato@wsgr.com
jmills@wsgr.com

PETITIONER:

Matthew L. Fedowitz
Daniel R. Evans
MERCHANT & GOULD P.C.
mfedowitz@merchantgould.com
devans@merchantgould.com

PETITIONER:

Jeffer Ali
Gary J. Speier
CARLSON, CASPERS, VANDENBURGH,
LINDQUIST & SCHUMAN, P.A.
JAli@carlsoncaspers.com
gspeier@carlsoncaspers.com

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.