

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, JACQUELINE WRIGHT BONILLA, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

In our Decision on Institution in this case (Paper 19; “Decision” or “Dec.”), we instituted an *inter partes* review of claims 1–13 of U.S. Patent No. RE38,551 E (Ex. 1001, “the ’551 patent”) based on two grounds raised in the Petition filed by Argentum Pharmaceuticals LLC (“Petitioner”). Dec. 3–4, 23–24 (instituting on two out of eight raised grounds). We did not institute on either of two grounds raised by Petitioner based on the LeGall thesis.¹ *Id.* at 3–4, 8–12. Petitioner did not persuade us that it had provided a “threshold showing” that the LeGall thesis was sufficiently publicly accessible to qualify as a “printed publication” under 35 U.S.C. § 102(b). *See Apple, Inc. v. DSS Tech. Mgmt., Inc.*, Case IPR2015-00369, slip op. 5 (PTAB Aug. 12, 2015) (Paper 14); Dec. 8–12.

Petitioner has filed a Request for Rehearing. Paper 21 (“Request” or “Req. Reh’g”). In its Request, Petitioner asserts that we abused our discretion in the Decision in relation to the two grounds (“Grounds 1A and 1B”) that rely on the LeGall thesis. Req. Reh’g 1. Petitioner contends that we overlooked or misapprehended arguments and evidence raised in the Petition regarding the public accessibility of the LeGall thesis, as well as a recently issued decision by the Federal Circuit in *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1350 (Fed. Cir. 2016) (“*Blue Calypso*”). *Id.* at 2–3.

Research Corporation Technologies, Inc. (“Patent Owner”) filed an Opposition to Petitioner’s Request. Paper 28 (“Opposition” or “Opp.”).

¹ Philippe LeGall, *2-Substituted-2-acetamido-N-benzylacetamides. Synthesis, Spectroscopic and Anticonvulsant Properties* (Dec. 1987) (“the LeGall thesis”) (Ex. 1008).

Patent Owner contends that Petitioner inappropriately raises new arguments for the first time in its Request and fails to identify in the Petition “the place where each matter was previously addressed” as required by 37 C.F.R.

§ 42.71(d). Opp. 1–9.

II. STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing that the decision should be modified, and “[t]he request 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, an opposition, or a reply.”

37 C.F.R. § 42.71(d).

III. ANALYSIS

We agree with Patent Owner that Petitioner’s Request raises new arguments for the first time and fails to identify “the place where each matter was previously addressed” in its Petition or other relevant paper, as required under § 42.71(d).

For example, the only place the Request cites to the Petition (or any other motion, opposition, or reply paper submitted by Petitioner) is in footnote 2 of the Request, which refers to page 4 of the Petition. Req. 5 n.2 (citing Pet. 4). Otherwise the Request fails to indicate any place where a matter raised in the Request “was previously addressed” in a relevant paper filed by Petitioner before institution.

In the Petition, Petitioner addressed public accessibility of the LeGall thesis on pages 22–23 and 57. Pet. 22–23, 57; *see also id.* at 13–14, 24–34, 58–59 (arguing what the LeGall thesis disclosed or suggested). As

discussed in our Decision, in those pages, Petitioner asserted that the LeGall thesis constituted prior art under 35 U.S.C. § 102(b) because: (1) “Patent Owner has now admitted that LeGall qualifies as prior art” (citing Ex. 1004 ¶ 87); (2) the University of Houston (where the thesis is located) has denied Petitioner’s request for information regarding public access to the thesis (citing Ex. 1028, 5–6, 11, 15–16); and (3) evidence indicates “that the University of Houston’s theses were generally accessible to the public” in the relevant time frame. Pet. 22–23 (citing Ex. 1029, 42–43 nn.8, 11, 20; Ex. 1029, 1135 nn.21, 28; Ex. 1030, 157–158; Ex. 1031, 649 n.9); Dec. 10–12.

In its arguments in the Petition regarding public accessibility of the LeGall thesis (Pet. 22–23, 57), Petitioner did not mention, discuss, or cite evidence that Petitioner now relies upon in its Request—i.e., three scientific papers, i.e., Exhibits 1016 (LeGall 1988), 1017 (Kohn 1993), and 1010 (Choi 1995), a University of Houston “blank Special Collections request form” described on pages 9 and 10 of Exhibit 1028, or Dr. Heathcock’s testimony in paragraph 81 of his Declaration (Ex. 1003). Req. 3, 5–9. We cannot have not misapprehended or overlooked arguments that Petitioner did not make. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see also* Opp. 2 (citing, for example, *ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00707, slip op. 2, 8–10 (PTAB Nov. 2, 2015) (Paper 14)).

Other than provide new arguments, Petitioner essentially reargues certain positions, which we have addressed in our Decision, e.g., the argument that we should presume a negative inference from the University of Houston’s failure to produce certain documents in response to a Texas

Public Information Act request. Pet. 22–23; Dec. 11; Req. 9–10. As Patent Owner points out, mere disagreement with our assessment of presented arguments and evidence is not a proper basis for a rehearing. Opp. 8–9 (citing, for example, *Google Inc. v Grandeye Ltd.*, Case IPR2013-00546, slip op. 5–6 (PTAB Jan. 13, 2015) (Paper 34)).

In its Request, Petitioner also discusses *Blue Calypso* in relation to its argument regarding a “roadmap for one of skill in the art to arrive at LeGall and confirm its public accessibility.” Req. 2–5 (citing *Blue Calypso*, 815 F.3d at 1350). Petitioner does not persuade us that *Blue Calypso*, as new case law, dictates that we erred in our Decision. Petitioner does not persuade us that the “adequate roadmap” discussion in *Blue Calypso* justifies Petitioner raising multiple new arguments for the first time in its Request, when it could have raised (and had reason to raise) such arguments in view of applicable case law existing before institution. Req. 3–5 (citing other case law); Opp. 6. Other than to cite and quote a sentence from *Blue Calypso*, all arguments Petitioner raises in its Request either could have been, and were not, argued in the Petition, or were raised and squarely addressed in our Decision.

Petitioner does not persuade us that we abused our discretion in declining to go forward on two grounds based on the LeGall thesis, especially when we did institute a trial in relation to all challenged claims on different grounds. Petitioner does not persuade us that we misapprehended or overlooked any matter in our Decision.

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