

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 Motion to Consolidate
35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a)

I. Introduction

As authorized by our Order (Paper 27), Argentum Pharmaceuticals LLC (“Petitioner”) filed a Motion to Consolidate this *inter partes* review (“IPR”) proceeding with pending *ex parte* reexamination Control No. 90/013,709, also requested by Petitioner concerning the same challenged patent at issue here, U.S. Patent No. RE38,551 (“the ’551 patent”). Paper 30 (Petitioner’s Motion to Consolidate Reexamination with *Inter Partes* Review; “Motion to Consolidate” or “Motion”).

As also authorized by the same Order (Paper 27), Research Corporation Technologies, Inc. (“Patent Owner”) filed an Opposition to the Motion. Paper 32 (Patent Owner’s Opposition to Petitioner’s Motion to Consolidate Reexamination with *Inter Partes* Review, “Opposition”).

II. DISCUSSION

As acknowledged by both parties, we have discretion to, among other things, consolidate an IPR with another proceeding before the Office, such as a reexamination, if both proceedings involve the same patent. Motion 3 (citing 35 U.S.C. § 315(d); 37 C.F.R § 42.122(a)); Opposition 6. As part of that discretion, we are not prohibited from allowing multiple proceedings involving the same patent to continue separately before the Office.

As stated in Petitioner’s Motion, Petitioner’s request for the reexamination raised two grounds of rejection of claims 1–13 of the ’551 patent under the doctrine of obviousness-type double patenting (“OTDP”) based on U.S. Pat. No. 5,654,301 (“the ’301 patent”),¹ a reference

¹ Kohn et al., U.S. Patent No. 5,654,301, issued on Aug. 5, 1997 (“the ’301 patent”) (Ex. 1019).

not raised in a ground at issue in the IPR (Paper 19, 3–4, 23–24), in combination with other art raised in grounds in the Petition in this IPR. Specifically, Petitioner proposed two OTDP grounds of rejection based on the '301 patent, in view of the '729 patent² and Kohn 1991³ in the first ground, and in view of the '729 patent and the LeGall thesis⁴ in the second ground. Motion 1–2; Paper 27, 2–3. The Central Reexamination Unit (“CRU”) granted the request on June 16, 2016. Motion 2.

By contrast, this panel instituted the IPR based on two different grounds raised in the Petition (Paper 2), i.e., that (1) claims 1–9 of the '551 patent would have been obvious over Kohn 1991 and Silverman,⁵ and (2) claims 10–13 would have been obvious over Kohn 1991, Silverman, and the '729 patent. Paper 20 (Decision to Institute), 23–24. In this IPR, we declined to institute review based on any ground raised by Petitioner that relied on the LeGall thesis. *Id.* at 8–12.

Thus, the IPR and reexamination proceedings address different issues (obviousness under 35 U.S.C. § 103(a) versus the judicially created doctrine of OTDP), as well as different combinations of primary references (Kohn

² Kohn et al., U.S. Patent No. 5,378,729, issued on Jan. 3, 1995 (“the '729patent”) (Ex. 1009).

³ Kohn et al., *Preparation and Anticonvulsant Activity of a Series of Functionalized α -Heteroatom-Substituted Amino Acids*, 34 J. MED. CHEM. 2444–52 (1991) (“Kohn 1991”) (Ex. 1012).

⁴ Philippe LeGall, *2-Substituted-2-acetamido-N-benzylacetamides. Synthesis, Spectroscopic and Anticonvulsant Properties* (Dec. 1987) (“the LeGall thesis”) (Ex. 1008).

⁵ Silverman, *The Organic Chemistry of Drug Design and Drug Action*, Academic Press (1992) (“Silverman”) (Ex. 1013).

1991 versus the '301 patent) with secondary references (e.g., Silverman in the IPR). On that basis alone, the legal and factual considerations in the two proceedings differ significantly. In view of those differences, we are not persuaded that consolidation will simplify the issues to be decided, notwithstanding an overlap of certain documents and some aspects of an obviousness analysis in both cases. Motion 7–8.

Petitioner suggests that a “high likelihood of prejudice to Petitioner and the public, versus the little-to-no likelihood of prejudice to Patent Owner, weighs in favor of consolidation.” *Id.* at 9. We disagree with that assessment. As an initial matter, Petitioner initiated both proceedings—Patent Owner did not. Moreover, Petitioner asks us to consolidate this IPR with the *ex parte* reexamination in a manner that benefits Petitioner and disadvantages Patent Owner.

For example, as part of the requested “consolidated” IPR, Petitioner asks us: (i) to allow it to pursue two OTDP grounds in an IPR, a proceeding that otherwise is limited by statute (35 U.S.C. § 311(b)) to grounds based on 35 U.S.C. §§ 102 or 103; (ii) to consider, again, the prior art status of a reference (the Le Gall thesis), which this panel already addressed when declining to institute review based on that reference; and (iii) to allow Petitioner to actively participate procedurally in the IPR, and any appeal of a final written decision in the case as needed, in a manner that it cannot do as a requester in the *ex parte* reexamination. *See, e.g.*, Opposition 3–5 (contrasting the examinational versus adjudicatory nature of the two proceedings); Motion 9 (asking us to place the reexamination on the one-year timeline of the IPR).

Above and beyond those considerations, as noted by our colleagues, an *ex parte* reexamination proceeding differs in notable respects from an *inter partes* review, which is adjudicatory in nature. *See Ford Motor Co. v. Signal IP, Inc.*, IPR2015-00860, slip op. at 3 (PTAB Nov. 17, 2015) (Paper 14). The two types of proceedings arise under different statutes and are governed by different rules and statutory deadlines. *Id.* Thus, “there is an inherent tension in attempting to unify proceedings that [] are intended to be distinct in type from one another.” *Id.* Considering that inherent tension, as well as the specific facts and circumstances at issue here, we decline to exercise our discretion to consolidate this IPR with the co-pending reexamination involving the ’551 patent.

We are mindful of Petitioner’s concern regarding the prevention of “inconsistent outcomes” in the two proceedings. Motion 5. To address this concern, the parties shall file as an exhibit in this IPR a copy of any action, decision, or other substantive paper issued by the CRU involving the ’551 patent, along with a non-argumentative one-page notice regarding the filing. In addition, either party may contact the Board, by initiating a conference call with the panel after conferring with the other party, in relation to any other matter in the reexamination that a party would like to bring to our attention. The parties also shall file any decision, order, or other substantive paper issued by the Board in this IPR in the corresponding co-pending reexamination.

III. ORDER

It is

ORDERED that Petitioner’s Motion to Consolidate is *denied*;

FURTHER ORDERED that the parties shall file as an exhibit in this

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