

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.,
Petitioners,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.
Patent Owner

Case IPR2016-00204¹
Patent RE38,551 E

**PETITIONER RESPONSE TO
PATENT OWNER'S IDENTIFICATION OF
PETITIONERS' ARGUMENTS AND EVIDENCE REGARDING SCOPE
AND FORM OF PETITIONER REPLY**

¹ Case IPR2016-01101, Case IPR2016-01242, and Case IPR2016-01245
have been joined with this proceeding.

I. PATENT OWNER ARGUMENT JUSTIFYING CITATION TO LEGALL

See Resp. 51-58, 53 (citing Ex.2036 ¶¶305-309); Ex. 2036 ¶¶305 (disagreeing “with Dr. Wang’s conclusion [Ex.1002 ¶132] . . . that R,S BAMP is the ‘closest prior art’”); Ex.1002 ¶132 (“the closest prior art is racemic lacosamide, as disclosed in LeGall”); Ex.2036 ¶¶307-09; Resp. 47, 51-58. Resp. 41 (“Eli Lilly was well aware of . . . Petitioner’s so-called ‘racemic lacosamide’ having a methoxymethyl moiety at the α -carbon, but showed no interest in either compound. *See* Ex.2068; Ex.2036 ¶¶272, 293.”). *See* Resp. 52 (arguing that “a POSA would have had no reason to expect” lacosamide to exhibit particular properties, including “high potency”); Ex.1050, at 158, 159, 208-216 (same); Resp. 54 (“skepticism”).

II. PATENT OWNER ARGUMENT JUSTIFYING CITATION TO ’301 PATENT

Resp. 28-29 (arguing a POSA “would not have changed the methoxyamino to a methoxymethyl as Petitioner proposes”); *id.* at 36 (“a POSA would not have reasonably expected success in substituting methoxyamino with methoxymethyl”); Pet. 46-47 (“methoxymethyl is specifically claimed at the α -carbon position in the ’301 patent”); *id.* at 19-21; Resp. 52-54 (unexpected results, citing Exs. 2036 and 2038); Resp. 58-60 (commercial success and identifying ’301 patent as blocking patent); Resp. 59 (characterizing size of genus of ’301 patent).

III. PATENT OWNER ARGUMENT JUSTIFYING RELIANCE ON KEPPRA

E.g., Resp. 57 (asserting that certain properties “were not exhibited by any other single prior art AED”) (citing Ex.2038 ¶¶70–76, 96-99); Resp. 6-8, 51-58 (secondary considerations) (citing Exs.2036 and 2038); Ex.1048, at 235-239.

IV. PETITIONER COMPLIED WITH RULES REGARDING WORD COUNT

Patent Owner complains about the citation form “Ex.##” but cites no PTAB rule. Petitioner’s citation format conforms with the analogous Federal Circuit rule. *See* Fed. Cir. R. 28 (f) (requiring appendix citations to be “as short as possible consistent with clarity and must follow the numbering format specified in Federal Circuit Rule 30(b)(4)(E), e.g., ‘Appx134,’ ‘Appx3-17’ or ‘SAppx1185’”).

Patent Owner itself changed its citation format (from “¶ #” to “¶#”) to eliminate spaces in its Patent Owner Response. *Compare* Patent Owner Preliminary Response at 3, 12, 20, 25, 43, 46, 49, 55, *with* Patent Owner Response at *passim* (over 100 instances of no space between “¶” and number).

Patent Owner cites to images, but Petitioner “may rely on the word count of the word-processing system used to prepare the paper.” 37 C.F.R. § 42.24(d). Petitioner was 70 words under the limit. *See* Reply, Certificate of Word Count (“5,530 words”). Patent Owner’s own image would, if deconstructed, cause the Response to exceed its word limit. *See* Resp. 11. Further, the images do not add text to the brief but merely act as citations to portions of exhibits in the record.

Dated: December 9, 2016

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CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of December 2016, the foregoing

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was served by electronic mail on the following counsel of record for Patent Owner:

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