

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

J. Kyle BASS and Erich SPANGENBERG,
Petitioners,

v.

ALPEX PHARMA SA,
Patent Owner.

Case IPR2016-00245
Patent 8,440,170 B2

Mailed: December 4, 2015

Before DAVID SCHMERFELD, *Trial Paralegal*.

NOTICE OF FILING DATE ACCORDED TO PETITION
AND
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review in the above proceeding has been accorded the filing date of November 24, 2015.

A review of the petition identified the following defects:

(i) **Improper usage of claim charts.** The petition's claim charts improperly contain argument. On page 21 of the petition, the claim chart states: "[T]he 'blue colored mannitol inclusions' were commercially

available at the time of the invention and known to be useful as claimed. (Ex. 1002, ¶ 16).” Exhibit 1002 is a declaration. *See VMware, Inc. v. Elecs. & Telecomms. Research Inst.*, Case IPR2014-00901, slip op. at 2 (PTAB July 14, 2014) (Paper 7) (declarant’s conclusion stated in a claim chart constitutes improper argument).

(ii) **Defective exhibits.** All of the exhibits do not contain page numbering, *see* 37 C.F.R. § 42.63(d)(2)(i) (each page of paper exhibit must be uniquely numbered in sequence), and the first page of Exhibit 1016 is not labeled, *see* 37 C.F.R. § 42.63(d)(2)(ii) (exhibit label must be affixed to lower right corner of first page of exhibit).

Petitioners must correct the defects within **FIVE BUSINESS DAYS** from this notice. Failure to correct the defects may result in an order to show cause as to why the Board should institute the trial. No substantive changes (e.g., new grounds) may be made to the petition.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is limited to setting forth the reasons why the requested review should not be instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012), which is available on the Board Web site at <http://www.uspto.gov/PTAB>.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

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The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “ORDER Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under “Representative Orders, Decisions, and Notices.”

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in the Patent Review Processing System (PRPS), accessible from the Board Web site at <http://www.uspto.gov/PTAB>. To file documents, users must first obtain a user ID and password by registering with PRPS. Information regarding how to register with and use PRPS is available at the Board Web site.

If there are any questions pertaining to this notice, please contact David Schmerfeld at 571-272-7184 or the Patent Trial and Appeal Board at 571-272-7822.

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