

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC.,
Petitioner,

v.

MONOSOL RX, LLC,

Patent Owner.

Case IPR2016-00281 (Patent 8,603,514 B2)
Case IPR2016-00282 (Patent 8,017,150 B2)¹

Before ERICA A. FRANKLIN, TINA E. HULSE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motions to Change the Filing Date Accorded and
Denying Institution of *Inter Partes* Reviews
37 C.F.R. §§ 42.71 and 42.108

¹ This Decision relates to and shall be filed in each referenced case.

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I. INTRODUCTION

Teva Pharmaceuticals USA, Inc. (“Petitioner”) filed a petition to institute an *inter partes* review of claims 1–3, 9, 15, 62–65, 69–73, and 75 of U.S. Patent No. 8,603,514 B2 (Ex. 1001, “the ’514 patent”). Case IPR2016-00281 (“IPR281”), Paper 1. Petitioner also filed a petition to institute an *inter partes* review of claims 1, 4–10, and 13–18 of U.S. Patent No. 8,017,150 B2 (Ex. 1001, “the ’150 patent”). Case IPR2016-00282 (“IPR282”), Paper 1. Each petition was accorded a filing date of December 4, 2015. IPR281, Paper 3; IPR282, Paper 3.

By Order dated February 18, 2016, we authorized Petitioner to file a motion requesting the filing date accorded to each petition to be changed from December 4, 2015, to December 3, 2015. IPR281, Paper 8, 3; IPR282, Paper 7, 3. On February 29, 2016, Petitioner filed in each case a “Motion to Correct Filing Date”² (collectively, “Motions”). IPR281, Paper 10 (“Mot.”); IPR282, Paper 9. As authorized, Patent Owner filed Oppositions to the Motions (IPR281, Paper 12 (“Opp.”); IPR282, Paper, 11), and Petitioner filed Replies to those Oppositions to the Motions (IPR281, Paper 14

² We note that it is undisputed that the petitions were each accorded a filing date that reflects the date that the petition filings, payment, and service, albeit defective, were completed. Thus, the issue is not simply whether to “correct” any error. Rather, the issue is whether Petitioner is entitled to the benefit of a filing date that is earlier than our regulations describe. Therefore, although Petitioner styled the Motions as requests to “Correct” the filing date accorded to the petitions, we treat them as requests to “Change” that date.

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(“Reply”); IPR282, Paper 13).³ Patent Owner subsequently filed a timely Preliminary Response in each case. IPR281, Paper 16; IPR282, Paper 15.

II. MOTIONS TO CHANGE FILING DATES ACCORDED

The parties agree that because Petitioner was served with a complaint on December 3, 2014, asserting infringement of the patents at issue, the statutory bar date for IPR281 and IPR282 is December 3, 2015. *See* 35 U.S.C. § 315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.”); 37 C.F.R. § 42.101(b); Mot. 1–2, 6; Opp. 1. Petitioner acknowledges that the December 4, 2015 filing date accorded to the petitions reflects the date that the Petitioner completed filing the petitions, including paying the fees and attempting service on the Patent Owner. Mot. 4–5.

Nevertheless, Petitioner requests that we change the filing date accorded in each case from December 4, 2015, to December 3, 2015, because the petitions and exhibits were uploaded on December 3, 2015, and payment was attempted, but not completed on that date due to “technical issues.” *Id.* at 1. In support of its contentions, Petitioner relies upon the declarations of Ms. Eleanor Yost, an attorney at the law firm of Goodwin

³ With respect to the Motions, Oppositions, and Replies, Petitioner and Patent Owner certify that “word-for-word identical” papers and declaratory exhibits were filed in IPR281 and IPR282, although the paper and exhibit numbers may differ. In the remaining portions of this Decision, we include citation only to paper and exhibit numbers in IPR281.

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Procter LLP, and Ms. Linda Rogers, a legal assistant supervised by Ms. Yost. Mot. 1–2; Ex. 1041 ¶ 1; Ex. 1042 ¶ 1. Patent Owner opposes Petitioner’s request and relies upon the declarations of Mr. Daniel Doran, the Docketing Manager for Hoffmann & Baron, LLP, and Mr. Michael I. Chakansky, a partner at that law firm. Opp. 2, n.3; Ex. 2006 ¶ 1; Ex. 2007 ¶ 1.

PRPS filing

Petitioner asserts that at approximately 9:45 p.m. EST on December 3, 2015, Ms. Rogers logged into the Patent Review Processing System (“PRPS”) and began uploading documents for a petition in another case, Case IPR2015-00280 (“IPR280”). Mot. 2. The Motions explain that, based on their experience, Ms. Yost and Ms. Rogers believed that they would be able to complete the filings in that case, as well as start and complete the filings in IPR281 and IPR282, prior to midnight. *Id.*

According to Petitioner, however, Ms. Rogers found that the PRPS system “repeatedly froze” during the upload process for IPR280. *Id.* Petitioner asserts that during the upload process, Ms. Rogers observed that the “spinning wheel” that normally appears during the upload process did so “for an unusual length of time (sometimes several minutes), and then eventually stop[ped] spinning, resulting in a ‘frozen’ screen that prevented her from taking any action (including closing the browser window or opening new windows).” *Id.* at 3. To remedy that issue, Ms. Rogers and Ms. Yost decided to “force-close the browser, re-open the browser, re-login to PRPS and attempt to resume the filing.” *Id.* Upon doing so, Petitioner asserts that Ms. Rogers was “met with a ‘padlock’ graphic and an error message,” requiring her to select a menu option to “unlock” the session and

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begin uploading the documents again. *Id.* According to Petitioner, the alleged ““freezing,’ re-starting, and unlocking process added a significant amount of time to the filing” process for IPR280. *Id.*

Petitioner asserts that at approximately 11:00 p.m., Ms. Yost initiated “a separate, parallel PRPS session” on a different computer and began filing the petition in IPR281. *Id.* at 3–4. Petitioner asserts that she “experienced the same freezing errors in connection with several different documents (sometimes more than once for the same document).” *Id.* at 4. According to Petitioner, Ms. Rogers began filing the petition in IPR282 after completing the petition filing in IPR280 at approximately 11:11 p.m. *Id.*

Petitioner asserts that the petitions and exhibits in both IPR281 and IPR282 were successfully uploaded to the PRPS server on December 3, 2015. *Id.* Petitioner asserts that, prior to midnight, Ms. Yost and Ms. Rogers attempted to submit payments for those IPRs, but that the “PRPS system rejected the payments without explanation.” *Id.* at 4 (citing Ex. 1041 ¶¶ 27–29; Ex. 1042 ¶ 18; Exs. 1044–45, 1047–1051 (PRPS failed payment receipts)). According to Petitioner, at midnight, i.e., on December 4, 2015, payment was accepted for IPR281 and Ms. Yost clicked “submit” and received a filing notification at 12:01 a.m. *Id.* at 4–5. Petitioner asserts that the payment was accepted for IPR282 at 12:04 a.m., and after clicking “submit,” Ms. Rogers received a filing notification at 12:09 a.m. *Id.* at 5.

Service

Petitioner acknowledges that “[t]he petitions and supporting documents were tendered to FedEx® at 3:02 am on Friday, December 4, 2015.” Mot. 5. Petitioner acknowledges also that “Ms. Yost neglected to appreciate that the Certificates of Service . . . still said December 3, and

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