

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-01248
Patent RE38,551 E

Before FRANCISCO C. PRATS, JACQUELINE WRIGHT BONILLA, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review and Motion for Joinder
35 U.S.C. § 314, 37 C.F.R. §§ 42.108 and 42.122

Petitioner Mylan Pharmaceuticals, Inc. filed a Petition requesting an *inter partes* review of claims 1–13 of U.S. Patent No. RE38,551 E (Ex. 1001, “the ’551 patent”). Paper 2. Along with the Petition, Petitioner filed a Motion for Joinder requesting that we join that it as a party to *Argentum Pharmaceuticals LLC v. Research Corporation Technologies, Inc.*, IPR2016-00204 (“Argentum IPR”). Paper 3 (“Joinder Mot.”).

As stated in the Motion for Joinder, Petitioner previously filed a “substantial copy” of the Petition in the Argentum IPR in *Mylan Pharmaceuticals, Inc. v. Research Corporation Technologies, Inc.*, IPR2016-01101 (“prior Mylan IPR”). Joinder Mot. 1–2. In the prior Mylan IPR, Petitioner also filed “a motion to join IPR2016-00204 as to instituted Grounds 3A–3B” in the Argentum IPR. *Id.*

As stated by Petitioner, the current Petition is also a “substantial copy” of the Petition in the Argentum IPR, with the exception of certain “modifications.” *Id.* at 2. Those modifications include the “contingent reliance on the expert declaration of Dr. Lars J.S. Knutsen (Ex. 1102)” and “submission of conclusive evidence of the public availability of the LeGall thesis.” *Id.*

As discussed in an Order we issued after Petitioner filed its current Petition, in a conference call with Petitioner and other relevant Petitioners,¹ Petitioner agreed to assert only arguments and evidence of record in IPR2016-00204 in this case, and to not rely on any additional evidence raised in the Petition or Motion for Joinder. Paper 6, 3. Based on that

¹ Argentum Pharmaceuticals LLC is Petitioner in Case IPR2016-00204, Breckenridge Pharmaceutical, Inc. is Petitioner in Case IPR2016-01242, and Alembic Pharmaceuticals, Ltd. is Petitioner in Case IPR2016-01245.

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agreement, and because Petitioner is so limited in this case, the Petition essentially becomes identical to the Petition that Petitioner already filed in the prior Mylan IPR (IPR2016-01101).

Institution of an *inter partes* review is subject to the Board's discretion. *See* 37 C.F.R. § 42.108(b). By statute, “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). For the reasons discussed above, the current Petition presents the same prior art and arguments previously presented by the same Petitioner in IPR2016-01101. Accordingly, we exercise our discretion to deny institution of *inter partes* review in this case under 35 U.S.C. § 325(d).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the '551 patent.

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