

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACRUX DDS PTY LTD. & ACRUX LIMITED
Petitioner,

v.

KAKEN PHARMACEUTICAL CO., LTD. And VALEANT
PHARMACEUTICALS INTERNATIONAL, INC.,
Patent Owner.

Case IPR2017-00190
Patent 7,214,506 B2

Before ERICA A. FRANKLIN, SUSAN L. C. MITCHELL, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Acrux DDS PTY Ltd. And Acrux Limited (collectively, “Petitioner”) requested a conference call with the panel to seek authorization to file a motion to stay prosecution of Patent Owner’s Reissue Application No. 15/405,171, filed January 12, 2017, pending resolution of this *inter partes* proceeding. Petitioner indicated that Patent Owner will oppose such a request. A conference call was held on June 13, 2017, between respective counsel for the parties and Judges Mitchell, Franklin, and Pollock, to discuss Petitioner’s request. Petitioner engaged a court reporter to record the conference call. Petitioner confirmed that it promptly will file the transcript in the record when it is available.

Petitioner stated that the claims at issue in the reissue application are similar to the claims at issue in this *inter partes* proceeding, which may cause inconsistent outcomes, a duplication of effort by the Office, and unnecessary effort by the parties, if the two proceedings go forward in parallel. Although Patent Owner agreed that at least two claims in the reissue application are very similar to claims at issue in this *inter partes* proceeding, Patent Owner stated that many of the dependent claims are patentably distinct from the claims at issue in this *inter partes* proceeding and do not implicate a possible inconsistent outcome with any decision in this proceeding, nor require duplicative effort of the Office or the parties. Patent Owner also indicated that it would be prejudiced by a delay in the reissue application process as it anticipates ANDA litigation in the coming year and staying the reissue application process would unduly delay resolution of the patentability of claims in the reissue proceeding.

During the conference call, we granted Petitioner’s request for authorization to file a motion to stay Patent Owner’s reissue proceeding.

ORDER

It is

ORDERED that the Petitioner's request for authorization to file a motion to stay Reissue Application No. 15/405,171 is *granted*;

FURTHER ORDERED that the Petitioner's motion to stay is limited to five pages in length and must be filed no later than 10 calendar days from the entry of this order;

FURTHER ORDERED that Patent Owner's opposition is limited to five pages in length and must be filed no later than 10 calendar days from the filing of Petitioner's motion to stay;

FURTHER ORDERED that Petitioner may file a reply limited to three pages in length no later than 5 calendar days from the filing of Patent Owner's opposition to the motion to stay; and

FURTHER ORDERED that Petitioner will file in the record the transcript of the conference call when available.

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Patent 7,214,506 B2

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