

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARO PHARMACEUTICALS U.S.A., INC.,
Petitioner,

v.

APOTEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01446
Patent 7,049,328 B2

Before JEFFREY N. FREDMAN, ZHENYU YANG, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Limit the Petition
37 C.F.R. §§ 42.1(b), 42.71

The Institution Decision in this case instituted trial on all of the challenged claims (i.e., claims 1, 2, 4–17, and 19), but not all of the challenged grounds.¹ Paper 7. By Order dated July 2, 2018, we modified the Institution Decision to institute trial on “all of the grounds presented in the Petition” (Paper 2). Paper 50.

¹ As we explained in the Institution Decision, although the Petition challenged claim 3, Patent Owner subsequently disclaimed that claim. We dismissed the Petition as to claim 3. Paper 7, 2 n.1.

As authorized in our Order (Paper 50), the parties filed a Joint Motion to Limit the Petition. Paper 52. Specifically, the parties request that the Board remove the grounds based on MIMS 1998 and Agarwal 2000 under 35 U.S.C. §§ 102(b) and 103(a). *Id.* at 2. Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this consolidated proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, we *grant* the Joint Motion to Limit the Petition. As such, the following grounds of unpatentability are removed from dispute in this proceeding:

Reference	Basis	Claims Challenged
MIMS 1998	§ 102(b)	1, 2, 4–11, 13–17, 19
Agarwal 2000	§ 102(b)	1, 2, 4–11, 13–17, 19
MIMS 1998	§ 103(a)	1, 2, 4–17, 19
Agarwal 2000	§ 103(a)	1, 2, 4–17, 19

Accordingly, it is:

ORDERED that the Joint Motion to Limit the Petition is *granted*;

and

FURTHER ORDERED that the Petition is limited to the following claims and grounds of unpatentability:

References	Basis	Claims Challenged
Hoffbrand 1998	§ 102(b)	1, 2, 4–11, 13–17, 19
Olivieri Abstract 1995	§ 102(b)	1, 2, 4–11, 13–17, 19
Olivieri 1995	§ 102(b)	1, 2, 4–11, 13–17, 19
Hoffbrand 1998	§ 103(a)	1, 2, 4–17, 19
Olivieri Abstract 1995	§ 103(a)	1, 2, 4–17, 19
Olivieri 1995	§ 103(a)	1, 2, 4–17, 19

IPR2017-01446
Patent 7,049,328 B2

PETITIONER:

Huiya Wu
Robert V. Cerwinski
Sara Fink
GOODWIN PROCTER LLP
hwu@goodwinlaw.com
rcerwinski@goodwinlaw.com
sfink@goodwinlaw.com

PATENT OWNER:

W. Blake Coblentz
Aaron S. Lukas
COZEN O'CONNOR
WCoblentz@cozen.com
ALukas@cozen.com