

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.
Petitioner,

v.

UNITED THERAPEUTICS, CORP.
Patent Owner.

Case IPR2017-01621 and IPR2017-01622
Patents 9,358,240 B2 and 9,339,507 B2

Before LORA M. GREEN, ERICA A. FRANKLIN, and DAVID COTTA,
Administrative Patent Judges.

COTTA, *Administrative Patent Judge.*

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

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

I. ANALYSIS

A conference call was held, in the above-listed proceedings, on Friday, February 23, 2018, between counsel for Petitioner, counsel for Patent Owner, and Administrative Patent Judges Green, Franklin, and Cotta. The call was held to discuss Petitioner's request for authorization to file: 1) a motion to submit supplemental information pursuant to 37 C.F.R. 42.123(a), and 2) a motion for additional discovery under 37 C.F.R. 42.51(b)(2).

Prior to the call, at the request of the Panel, Petitioner summarized the factual basis for its proposed motions. In an email dated February 14, 2018, Petitioner stated that its proposed motion to submit supplemental information under 37 C.F.R. 42.123(a) would address “[t]wo documents related to a proceeding in Maryland state court between one of the named inventors and Patent Owner, in which the inventor disputed the inventorship and ownership of the involved patent,” and “[a] declaration from the prosecution history of a parent patent application that includes as an attachment correspondence between certain named inventors and the prosecuting attorney in which inventorship of the challenged patents is discussed.” Ex. 3004. Petitioner stated that the declaration includes redactions. *Id.* Petitioner explained that its proposed motion for additional discovery under 37 C.F.R. 42.51(b)(2) would seek to obtain a version of that declaration wherein certain redactions were removed. *Id.* On the conference call, Petitioner asserted that the supplemental information and discovery are relevant to the issue of whether the named inventors of the challenged patents differ from that of the Ghofrani reference such that Ghofrani qualifies as prior art under 35 U.S.C. § 102(a).

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

Patent Owner argued that we should deny authorization to file both motions. With respect to the motion to submit supplemental information, Patent Owner represented that the information at issue did not implicate any of the authors of Ghofrani who are not identified as inventors of the challenged patents, and did not involve the 17 patient study disclosed in Ghofrani. Patent Owner further asserted that the dispute referenced in Petitioner's request did not relate to who should be named as an inventor, but rather how the inventors should be compensated. Patent Owner noted that the complaint in the Maryland state court action had been dismissed, and that the declaration was submitted in connection with a patent application that involved different claims than are at issue in the challenged patents. Accordingly, Patent Owner contends that the information is not "relevant to a claim for which the trial has been instituted," as is required by 37 C.F.R. 42.123(a)(2). With respect to discovery of the unredacted declaration, Patent Owner additionally contends that those redactions relate to the Patent Owner's litigation positions.

Having considered the parties' respective positions, we authorize Petitioner to file the requested motions. While Patent Owner may have raised legitimate concerns regarding the relevance of the proposed supplemental information and the information sought through additional discovery, we will be better able to evaluate the positions of each party upon briefing.

Accordingly, it is:

ORDERED that Petitioner is authorized to file, in each proceeding: 1) a motion to submit supplemental information pursuant to 37 C.F.R. 42.123(a), and 2) a motion for additional discovery under 37 C.F.R.

IPR2017-01621 (Patent 9,358,240 B2)

IPR2017-01622 (Patent 9,339,507 B2)

42.51(b)(2). Petitioner shall address both motions in a single consolidated pleading not to exceed ten (10) pages. The motions shall be filed within ten (10) calendar days of the mailing date of this order;

FURTHER ORDERED that Patent Owner is authorized to file a single ten (10) page opposition to both motions. Patent Owner's opposition shall be filed within fourteen (14) calendar days of Petitioner's filing of their motions; and

FURTHER ORDERED that Petitioner is not authorized, at this time, to file a Reply to Patent Owner's Opposition.

IPR2017-01621 (Patent 9,358,240 B2)
IPR2017-01622 (Patent 9,339,507 B2)

PETITIONER:

Michael K. Nutter
Andrew R. Sommer
WINSTON & STRAWN LLP
mnutter@winston.com
asommer@winston.com

PATENT OWNER:

Stephen B. Maebius
George Quillin
FOLEY & LARDNER LLP
smaebius@foley.com
gquillin@foley.com

Shaun R. Snader
UNITED THERAPEUTICS CORP.
ssnader@unither.com

Douglas Carsten
Richard Torczon
Robert Delafield
Veronica Ascarrunz
WILSON, SONSINI, GOODRICH & ROSATI
dcarsten@wsgr.com
rtorczon@wsgr.com
bdelafield@wsgr.com
vascarrunz@wsgr.com