From:	Trials
To:	Michelle O"Brien; LSilva@foley.com; Trials
Cc:	BOST-F-UMass327IPR@foley.com; BOST-F-UMass513IPR@foley.com; MLowrie@foley.com; LShine@foley.com; TJ Murphy; Joanna Cohn; 327IPR; SMaebius@foley.com
Subject:	RE: IPR Nos. 2018-00778, 2018-00779
Date:	Wednesday, August 29, 2018 10:46:13 AM

Counsel:

Petitioner's request for leave to file a Reply to Patent Owner's Preliminary Response is denied. The panel does not require further briefing, and no conference call is necessary at this time. Counsel for Patent Owner is cautioned against submitting substantive arguments by email. See https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/patent-trial-and-appeal-board-end (stating the parties should not use the Trials@uspto.gov email address for substantive communications to the Board).

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
Direct: 571-272-5366

From: Michelle O'Brien <mobrien@marburylaw.com>
Sent: Tuesday, August 28, 2018 12:49 PM
To: LSilva@foley.com; Trials <Trials@USPTO.GOV>
Cc: BOST-F-UMass327IPR@foley.com; BOST-F-UMass513IPR@foley.com; MLowrie@foley.com; LShine@foley.com; TJ Murphy <TJMurphy@MARBURYLAW.COM>; Joanna Cohn <JCohn@MARBURYLAW.COM>; 327IPR <327IPR@MARBURYLAW.COM>; SMaebius@foley.com
Subject: RE: IPR Nos. 2018-00778, 2018-00779

Petitioner is writing in response to Patent Owner's email. Petitioner has been conferring with Patent Owner regarding the issues raised in the email below and was going to seek a short reply to address these issues, if necessary. Given Patent Owner's improper email, which includes argument, Petitioner would like an opportunity to be heard on at least the second issue so the record is complete, should the Board desire. Petitioner is available for a call with the Board at the Board's convenience.

Kind regards,
Michelle E. O'Brien
Reg. No. 46,203
Lead Counsel for Petitioner

From: LSilva@foley.com [mailto:LSilva@foley.com]
Sent: Tuesday, August 28, 2018 10:47 AM
To: 'trials@uspto.gov'

Cc: BOST-F-UMass327IPR@foley.com; BOST-F-UMass513IPR@foley.com; MLowrie@foley.com; LSilva@foley.com; LShine@foley.com; TJ Murphy; Joanna Cohn; 327IPR; Michelle O'Brien; SMaebius@foley.com
Subject: IPR Nos. 2018-00778, 2018-00779

Dear Board:

On Sunday, August 19, 2018, the Patent Owner received the attached email from the Petitioner, asserting that Patent Owner made two misstatements in its Preliminary Responses in the above-referenced IPRs, and requesting that the Patent Owner contact the Board. The first alleged misstatement concerns whether the Petitioner has brought invalidity counterclaims in the co-pending litigation between the parties. The second alleged misstatement is that Patent Owner did not disclose in its Preliminary Responses certain prosecution arguments made in 2005 (years after the patents in these IPRs issued).

Regarding the first, The Patent Owner did state in its Preliminary Responses that L'Oreal has filed its invalidity counterclaims in the co-pending litigation. That statement was an error. L'Oreal has not yet answered the Complaint in that case. However, the error was inadvertent, and the point being made in the Preliminary Responses was that all of the arguments Petitioner made in Petitions can be made in the co-pending litigation. (*See* IPR2018-00778 Paper 7 at 52; IPR2018-00779 Paper 7 at 52.) That is true.

Also, the statement does not concern any invalidity argument being made. It appears in the sovereign immunity sections at the end of the Preliminary Responses where the Patent Owner is explaining that it would intend to move to dismiss in the future if the trials are instituted. (*See id.*) Nonetheless, although the statement is not material to any issue before the Board, Patent Owner is sending this email to identify the error.

The other issue raised in Petitioner's email is already before the Board. Petitioner claims in its email that the Patent Owner argued during the prosecution of a different patent in 2005 that prior art "compositions" were outside of the claimed concentration range. But, in both Petitions, Petitioner argued that during prosecution (in 2001) the Patent Owner distinguished prior art based on the concentration in "compositions," and the Patent Owner explained in the Preliminary Responses why this did not support Petitioner's proposed claim construction. (*See, e.g.,* IPR2018-00778 Paper 2 at 35-36 ("Thus, the applicant argued that the pending claims were patentable over Hartzshtark because the concentration of adenosine in the Hartzshtark ***compositions*** were higher than the concentration recited in the claims."); *Id.* Paper 7 at 18 ("[T]o the extent that the applicant could have distinguished the reference based on epidermal versus dermal layer as well as concentration, the prosecution as a whole nevertheless strongly supports giving dermal its ordinary meaning.").)

The Petitioner did not cite this prosecution from 2005, presumably because the issue was already before the Board. Even so, the Preliminary Responses address the argument, and provide many other reasons why the Petitioner's proposed claim construction is contrary to the plain language of the claims, and it is inconsistent with the specification and the prosecution history.

It appears that the Petitioner is seeking to advance additional arguments outside of its Petitions, and

possibly to secure a telephone conference to that end. The Patent Owner believes that neither of the above issues merited the Board's attention, but has raised them here in an effort to address the Petitioner's email with minimal inconvenience to the Board or disruption to these proceedings. The Patent Owner does not believe that additional argument would be proper, or that a telephone conference would be a productive use of the Board's time.

Sincerely,

Lucas I. Silva

Counsel for Patent Owner

Lucas I. Silva

Foley & Lardner LLP
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Boston, MA 02199-7610
P 617.342.4021

View My Bio
Visit Foley.com

Silva, Lucas I.

From: Michelle O'Brien <mobrien@marburylaw.com>
Sent: Sunday, August 19, 2018 6:04 PM
To: Lowrie, Matt; Maebius, Steve; Silva, Lucas I.; BOST - F - UMass 513 IPR
Cc: Linda Kenah; TJ Murphy
Subject: IPR2018-00778 and IPR2018-00779

Counsel,

Our review of Patent Owner's Preliminary Response filed in both IPR2018-00778 and IPR2018-00779 ("POPRs") reveals misstatements which Patent Owner needs to bring to the attention of the Board. Specifically, Patent Owner alleged that "Petitioner has brought invalidity counterclaims in the co-pending litigation, and all of the arguments made in its Petition could be made in that litigation." In fact, as you know, Petitioner has not served any invalidity contentions or counterclaims in the co-pending litigation. Accordingly, we expect that you will notify the Board of the misstatements immediately.

Furthermore, your duty of candor (37 C.F.R. §42.11(a)) requires you to bring to the Board's attention positions that were argued by Patent Owner in continuation applications claiming priority to the '327 and '513 patents, which are contrary to the positions Patent Owner now takes in the POPRs. For example, in U.S. Patent Application No. 10/680,370, Patent Owner amended the claims to include the limitation "wherein the adenosine analog concentration applied to the dermal cells is about 10^{-4} M to 10^{-7}" and argued that the concentration of ATP in a prior art ***composition*** (the '649 patent) was outside the claimed concentration range of adenosine analog "***applied to the dermal cells***." (*See* Amendment dated June 13, 2005, page 7.) We note that this position is contrary to Patent Owner's position in the POPRs that the claimed concentration is the concentration that reaches the dermal cells, rather than the concentration in the composition. Our review of the POPRs reveals that these contrary positions were not identified. As such, your duty of candor requires that you bring this inconsistency to the Board's attention at this time.

Regards,
Michelle

Michelle E. O'Brien, Esq.
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mail (info@marburylaw.com) immediately.
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