

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIQUIDIA TECHNOLOGIES, INC.,
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,
Patent Owner.

IPR2021-00406
Patent 10,716,793 B2

Before ERICA A. FRANKLIN, CHRISTOPHER M. KAISER,
and DAVID COTTA, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

On March 1, 2022, Judges Franklin, Cotta, and Kaiser held a conference call with counsel for both parties to discuss Patent Owner’s email request for authorization to submit rebuttal evidence with its Sur-Reply. A transcript of the conference call was made by a court reporter, and that transcript will be entered in the record of this proceeding in due course. For the reasons discussed below, we deny Patent Owner’s request.

BACKGROUND

Petitioner challenges claims 1–8 of U.S. Patent No. 10,716,793 on grounds that rely on, *inter alia*, Exhibits 1007 and 1008, which Petitioner asserts are prior art to the ’793 patent. Paper 2 (Petition), 30–68. In its Response to the Petition, Patent Owner argues that Petitioner has not proven that Exhibits 1007 and 1008 are prior art because Petitioner has not shown that they were publicly accessible at an early enough date. Paper 29 (Patent Owner Response), 11–18. In particular, Patent Owner argues that Petitioner has not shown that Exhibits 1007 and 1008 were received, catalogued, and indexed sufficiently by a library to show that a person of ordinary skill in the art could have located them. *Id.* In connection with its Reply to Patent Owner’s Response, Petitioner submitted evidence in addition to that submitted with the Petition. Exs. 1087–1132. Petitioner argues that this evidence, considered together with the evidence submitted with the Petition, supports the public accessibility of Exhibits 1007 and 1008. Paper 44, 1–9.

Patent Owner has the right to file a Sur-Reply to Petitioner’s Reply, but, under 37 C.F.R. § 42.23(b), the Sur-Reply “may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of

any reply witness.” Here, Patent Owner seeks relief beyond what Rule 42.23(b) permits, by requesting authorization to submit additional evidence with its Sur-Reply that rebuts the evidence Petitioner submitted with its Reply.

ANALYSIS

As noted above, Rule 42.23(b) does not, in general, permit Patent Owner to submit evidence along with its Sur-Reply, except for “deposition transcripts of the cross-examination of any reply witness.” Although Patent Owner could not identify during the conference call the specific evidence it would seek to submit along with its Sur-Reply, it represented that the evidence in question would not be limited to deposition transcripts authorized by Rule 42.23(b). Thus, to grant Patent Owner the relief it seeks, we would need to waive the provisions of Rule 42.23(b).

We are permitted to “waive or suspend a requirement of [our rules].” 37 C.F.R. § 42.5(b). In deciding whether to do so, we construe our rules “to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* § 42.1(b). In particular, we note the requirement that “the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review.” 35 U.S.C. § 316(a)(11). In accordance with these requirements, our rules provide for the closure of the evidentiary record with the Petitioner’s Reply, with the only subsequent additions being any cross-examination Patent Owner conducts of Petitioner’s Reply witnesses. Neither the requirement to resolve disputes within twelve months nor the requirement to resolve proceedings in a speedy and inexpensive manner would be served by waiving the requirements of Rule 42.23(b) here for Patent Owner to submit

its rebuttal evidence, followed by Petitioner filing the equivalent of a Sur-Reply commenting upon the new evidence submitted by Patent Owner.

In addition, there is no clear need for additional evidence on the issue of the public accessibility of Exhibits 1007 and 1008. Petitioner is permitted some “limited opportunities . . . to present new evidence [after the Petition], including . . . in a reply to the patent owner response,” as long as that new evidence is “responsive to the prior briefing.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, at 14 (PTAB Dec. 20, 2019) (precedential). “The opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition.” *Id.* at 15. Here, Petitioner has submitted new evidence with the Reply, and the parties dispute whether the evidence represents a change from the Petition’s theory of public accessibility. Papers 47, 49. Ultimately, we will consider only properly submitted evidence that satisfies *Hulu*’s requirements and from that evidence determine whether Petitioner shows sufficiently that the exhibits in question were publicly accessible. It is unclear how any additional evidence submitted by Patent Owner—as opposed to Patent Owner’s arguments for ignoring Petitioner’s evidence, giving Petitioner’s evidence little weight, or finding a lack of public accessibility in light of Petitioner’s evidence, all of which Patent Owner is already permitted to assert in its Sur-reply—would assist in resolving the issue of public accessibility. This lack of clarity also weighs against granting Patent Owner’s request for relief from Rule 42.23(b).

Moreover, during the conference call, we asked Patent Owner to describe the nature of the evidence it seeks to submit along with the Sur-Reply and how that evidence might help show a lack of public accessibility,

but Patent Owner answered only by listing vague types of evidence that might be submitted. Thus, we are unable to consider whether the specific evidence that Patent Owner seeks to submit would help resolve the public accessibility issue in its favor. This also weighs against granting Patent Owner's request.

Thus, to summarize, there is no right to submit additional evidence with Patent Owner's Sur-Reply; Rule 42.23(b) provides precisely the opposite. To the extent that we are permitted to waive Rule 42.23(b), we may do so only in the interest of resolving this proceeding in a just, speedy, and inexpensive manner. Waiving the rule would work at cross-purposes to two of those three factors, and might threaten our ability to resolve this *inter partes* review within one year of institution. As to the remaining factor, in the absence of a clear explanation of what the evidence in question is, what that evidence might show, how that evidence might support Patent Owner's position, or why Patent Owner's already-existing opportunity to provide arguments rather than evidence is insufficient, we cannot say that providing Patent Owner the opportunity it seeks to present additional evidence is necessary in order to promote the just resolution of this proceeding. Accordingly, we are not persuaded that we should waive the limits imposed on the Sur-Reply by Rule 42.23(b).

It is

ORDERED that Patent Owner's request for authorization to submit evidence with its Sur-Reply beyond the limits placed on that evidence by 37 C.F.R. § 42.23(b) is *denied*.

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