

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTAIRE PHARMACEUTICALS, INC.,
Petitioner,

v.

PARAGON BIOTECK, INC.,
Patent Owner.

Case PGR 2015-00011
Patent 8,859,623 B1

JOINT MOTION TO PRESERVE THE RECORD PENDING APPEAL

I. JOINT REQUEST TO PRESERVE THE RECORD FOR APPEAL

The parties to this action jointly request that the record of Case No. PGR2015-00011 be preserved pending a possible appeal, including preservation of all sealed documents in non-public form. Other Board panels have granted similar requests. *See Illumina, Inc. v. Columbia Univ.*, IPR2012-00006, Paper 133 at 3-4 (P.T.A.B. Apr. 25, 2014); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00128, Paper 93 at 2-3 (P.T.A.B. Sep. 10, 2014); *LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, Paper 77 at 2 (P.T.A.B. Dec. 19, 2014). The Board authorized this motion in an e-mail dated December 23, 2016.

Sealed confidential information subject to a protective order will ordinarily become public 45 days after final judgment in a trial unless a motion to expunge is filed. 77 Fed. Reg. 48761; *see also* 37 C.F.R. § 42.56. Here, the date 45 days after final judgment was entered is December 29, 2016. However, the Parties have until 63 days from the final written decision (i.e., until January 17, 2017¹) to file a notice of appeal. *See* Paper 48; 37 C.F.R. § 90.3(b)(1) (“A timely request for rehearing will reset the time for appeal or civil action to no later than sixty-three (63) days after action on the request.”).

¹ Because the 63-day mark falls on January 16, 2017, the deadline for filing a notice of appeal is January 17, 2017.

The Federal Rules of Appellate Procedure and the Federal Circuit Rules require that the record be retained by the Board pending appeal. Specifically, Federal Circuit Rule 17(a) states that “[t]he agency must retain the record.” Federal Circuit Rule 17(d), titled “Access of Parties and Counsel to Original Record,” also requires that the parties and their counsel have access to both the sealed and unsealed portions of the record “[w]hen a petition for review or notice of appeal is filed.” No notice of appeal has yet been filed, and the deadline for filing a notice of appeal, as noted above, is January 17, 2017.

Moreover, Petitioner submits that the information that was filed under seal in this IPR was discussed at length in its brief (*see, e.g.*, Paper 36 at 4-10). Petitioner submits that if the record is not preserved in its entirety including any sealed portions, and an appeal is taken, the Federal Circuit may not be able to fully consider the issues raised by Petitioner during the *inter partes* review, which would cause prejudice to Petitioner.

While Paragon does not believe the information under seal is material to any issues that may reasonably arise on appeal, Paragon does not oppose this motion.

After the final disposition of the appellate process, the parties intend to file a motion to expunge the confidential information from the record, and have preliminarily agreed on the information that should be expunged. Accordingly, if the Board grants this motion, the parties will contact the Board within ten business

days after the conclusion of any appeal proceeding, or if no appeal is taken, within ten business days after the deadline to file an appeal, and request authorization to file a motion to expunge confidential information.

II. IF THE BOARD DENIES THIS MOTION, THE PARTIES REQUEST ADDITIONAL TIME TO FILE A MOTION TO EXPUNGE

As sealed information is normally released to the public 45 days after final written decision, a motion to expunge should ordinarily be filed before that time. 77 Fed. Reg. 48761; 37 C.F.R. § 42.56. In this case, the deadline to file a motion to expunge is December 29, 2016. In the event that the Board denies the present motion after December 29, 2016, the parties request additional time to file a motion to expunge.

Dated: December 23, 2016

Respectfully submitted,

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/Michael T. Rosato/ (with permission)
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Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **JOINT MOTION TO PRESERVE THE RECORD PENDING APPEAL** is being served on counsel of record by filing this document via USPTO End to End system.

Dated: December 23, 2016

Respectfully submitted,

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