

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DERMIRA, INC.,
Petitioner,

v.

PUREPHARM, INC.,
Patent Owner.

Case IPR2015-01594
Patent 8,252,316 B2

Before LORA M. GREEN, DEBORAH KATZ, and ZHENYU YANG,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

ORDER

*Staying Examination of Reissue Application No. 15/148,510
35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3, 42.122*

On May 6, 2016, Purepharm, Inc. (“Patent Owner”) filed reissue application 15/148,510 (“the ’510 reissue application”) for U.S. Patent No. 8,252,316 B2 (“the ’316 patent”). *See* Paper 23. On May 23, the Board held a telephonic conference at the request of Patent Owner. Counsel for both parties and members of the panel attended the conference. The purpose of the conference was to discuss what course of action the panel should take in this *inter partes* review proceeding (“IPR”) given the filing of the ’510 reissue application. After reviewing the record in this IPR and in the ’510 reissue application, we determine that, under the circumstances, it is appropriate to stay examination the ’510 reissue application.

DISCUSSION

During the May 23 conference, Patent Owner sought to file a motion to stay this IPR. Petitioner opposed such a request. Instead, Petitioner proposed that we either treat the reissue application as a request for adverse judgement, or stay the reissue application, rather than this IPR.

In an IPR, cancellation of claims such that no instituted claim remains in the trial is construed as a request for adverse judgment. 37 C.F.R. §42.73(b). Claims 1–8 of the ’316 patent are involved in this IPR. In the preliminary amendment filed in the ’510 reissue application, Patent Owner seeks to cancel those claims and replace them with a new set of claims, claims 9–16. Ex. 3001, 3–4. Under 35 U.S.C. § 252, however, the surrender of the original claims do not take effect until the reissued patent is issued. Because the ’510 reissue application has not been examined, the cancellation of claims 1–8 of the ’316 patent has not taken effect. As a result, we do not construe Patent Owner’s claim amendment in the ’510 reissue application as a request for adverse judgment. The circumstances, however, warrant staying the ’510 reissue application.

The Director has authority to stay a reissue proceeding pursuant to 35 U.S.C. § 315(d), which provides:

(d) Multiple Proceedings.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an *inter partes* review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

Under 37 C.F.R. § 42.122(a), the Board may enter an order to effect a stay:

Multiple proceedings. Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

In addition, the Board may exercise exclusive jurisdiction within the Office over an application underlying a patent involved in an IPR. 37 C.F.R. § 42.3(a). When doing so, the Board may take various action, including staying that application.

Here, staying examination of the '510 reissue application is the proper course of action. Conducting examination of the '510 reissue application concurrently with this IPR would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Indeed, according to Patent Owner, new proposed claims 9–16 in the '510 reissue application “are the same as claims 1–8 but for [an] added limitation in claim 11.” Ex. 3001, 5. Should examination of the '510 reissue application begin, the Office may allow claims 9–16, thereby changing the scope of the instituted claims while the Board is conducting this IPR.

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Based upon the facts in this proceeding and in the '510 reissue application, we conclude it is necessary to stay examination of the '510 reissue application pending the completion or termination of this proceeding.

ORDER

Accordingly, it is

ORDERED that pursuant to our authority arising under 35 U.S.C. § 315(d), and 37 C.F.R. §§ 42.3(a), 42.122(a), examination of reissue application 15/148,510 is hereby stayed pending the completion or termination of this *inter partes* review proceeding;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in reissue application 15/148,510, and no further papers shall be filed in that application while this stay remains in place; and

FURTHER ORDERED that all time periods in reissue application 15/148,510 will be restarted upon lifting of the stay.

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