

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STEADYMED LTD.,
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,
Patent Owner.

Case IPR2016-00006
Patent 8,497,393 B2

Before LORA M. GREEN, JONI Y. CHANG, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

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

On January 3, 2018, a conference call was conducted among counsel for Petitioner, Steady Med LTD (“Steady Med”), counsel for Patent Owner, United Therapeutics Corporation (“UTC”), and Judges Harlow, Chang, and Green. A court reporter was also present.¹ The purpose of the call was to address Steady Med’s request for authorization to file a motion requesting action by the Board concerning U.S. Patent Application Nos. 15/423,011, 15/423,021, and 15/455,300 (“the continuation applications”), which are continuations of the application that issued as U.S. Patent No. 8,497,393 B2 (“the ’393 patent”).

We entered a Final Written Decision under 35 U.S.C. § 318(a), holding claims 1–22 of the ’393 patent unpatentable, on March 31, 2017. Paper 82. The United States Court of Appeals for the Federal Circuit entered Judgment affirming the Final Written Decision on November 14, 2017. Ex. 3001. The Board’s Final Written Decision, the Federal Circuit’s Judgment, and the estoppel provision of 37 C.F.R. § 42.73(d)(3)(i) are each of record in the file history for each of the continuation applications. *See, e.g.*, U.S. Patent Application No. 15/423,011, Third Party Submission, filed July 21, 2017; *id.* at Miscellaneous Incoming Letter, filed November 16, 2017. Accordingly, because the Examiner has been made aware of our Final Written Decision and the Federal Circuit Decision regarding the unpatentability of claims 1–22 of the ’393 patent, as well as the prohibition

¹ A transcript of the call has been filed as Exhibit 2063 to this proceeding. The transcript details the full discussion, which will not be repeated in this Order.

IPR2016-00006
Patent 8,497,393 B2

against UTC taking action inconsistent with the judgement of unpatentability as to those claims (37 C.F.R. § 42.73(d)(3)(i)), it is not necessary for us to take further action under 37 C.F.R. § 42.73 regarding the continuation applications.

Therefore, Steady MEd's request for authorization to file a motion requesting action by the Board concerning the continuation applications is *denied*.

It is

ORDERED that Steady MEd's request for authorization to file a motion requesting action by the Board concerning U.S. Patent Applications Nos. 15/423,011, 15/423,021, and 15/455,300 is *denied*.

IPR2016-00006
Patent 8,497,393 B2

PETITIONER:

Stuart E. Pollack
Lisa A. Haile
DLA Piper LLP
stuart.pollack@dlapiper.com
lisa.haile@dlapiper.com
steadymed-ipr@dlapiper.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
Katherine Hasper
WILSON, SONSINI, GOODRICH & ROSATI
dcarsten@wsgr.com
rtorczon@wsgr.com
bdelafield@wsgr.com
khasper@wsgr.com