

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEPTUNE GENERICS, LLC,
Petitioner,

v.

AVENTIS GENERICS S.A.,
Patent Owner.

IPR2019-00136
Patent 5,847,170

Before TINA E. HULSE and TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)

On February 21, 2019, Petitioner requested a conference call seeking permission to file a Reply to Patent Owner’s Preliminary Response. Paper 9 (“Preliminary Response”). More specifically, Petitioner requested authorization to file a Reply addressing Patent Owner’s arguments for denial of institution under 35 U.S.C. §§ 325(d) and 314(a), and to address an allegedly incorrect legal standard for obviousness advanced in the Preliminary Response.

A conference between the Board (Judges Majors and Hulse) and the parties’ counsel took place on February 28, 2019.¹ At the conference, Petitioner contended it should be permitted to respond to Patent Owner’s arguments under §§ 325(d) and 314(a) because, among other things, Patent Owner has mischaracterized the similarities between the prior art and obviousness challenges raised in the present Petition versus the challenges presented by Mylan in a prior petition for *inter partes* review (IPR2016-00627), and because Patent Owner’s argument relies on Board decisions that post-date the filing of the Petition. Petitioner further contended that Patent Owner misstates the law on obviousness insofar as the Preliminary Response allegedly conflates “unexpected results” and the “reasonable expectation of success.” According to Patent Owner, Petitioner should have foreseen the §§ 325(d) and 314(a) arguments raised in the Preliminary Response, and addressed them more thoroughly in the Petition.

After considering the parties’ contentions made during the conference, we concluded that good cause exists for Petitioner’s request, and we authorized the filing of a Reply to the Preliminary Response. 37 C.F.R.

¹ A court reporter was also present, and the Board requested that a transcript of the conference be filed as an exhibit with the Board when available.

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§ 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”). Petitioner did foresee that Patent Owner would raise §§ 325(d) and 314(a) issues. Paper 1 (“Petition”) 77–78, n.3. But we are persuaded Petitioner could not have foreseen Patent Owner’s particular arguments on those issues and, thus, Petitioner should be given an opportunity to respond to those arguments now. Moreover, having a meaningful response from Petitioner on those arguments will help the Board determine whether denial of the Petition under §§ 325(d) and/or 314(a) is (or is not) appropriate. Although the Board is familiar with the law of obviousness, and capable of determining whether the law’s requirements have been misstated, Petitioner may (though need not) explain in the Reply how Patent Owner has allegedly misstated the law and cite to authority Petitioner would like to bring to the Board’s attention on that topic.

It is

ORDERED that Petitioner’s request to file a Reply to Patent Owner’s Preliminary Response in IPR2019-00136 is *granted*;

FURTHER ORDERED that Petitioner’s Reply shall be limited to responding to Patent Owner’s arguments for denial of the Petition under §§ 325(d) and/or 314(a), and the Reply may also address whether Patent Owner’s Preliminary Response misstates the law under 35 U.S.C. § 103; and

FURTHER ORDERED that Petitioner’s Reply shall be filed no later than March 7, 2019, and shall be limited to five pages;

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