

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALERITAS, INC. and VALERITAS HOLDINGS, INC.,
Petitioner,

v.

ROCHE DIABETES CARE, INC.,
Patent Owner.

IPR2019-00552 and IPR2019-00553¹
Patent 6,736,795 B2

Before JON B. TORNQUIST, WESLEY B. DERRICK, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

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

¹ This Order address issues common to both cases; therefore, we issue a single Order to be entered in each case. The parties are not authorized to use this style heading.

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On May 6, 2019, a conference call was held involving counsel for the respective parties and Judges Tornquist, Derrick, and Harlow. The purpose of the conference call was for Petitioner to seek authorization to file a reply to Patent Owner's Preliminary Response in IPR2019-00552 and in IPR2019-00553 (Paper 6 in each proceeding). Patent Owner opposed.

During the conference call, Petitioner argued that we should authorize a reply to address claim construction issues relating to the phrase "container . . . accommodated by [a] casing" and to two means-plus-function limitations, i.e., "delivering means" and "pressure reducing means." Petitioner contended that there is good cause for considering a reply, because Petitioner could not have anticipated the arguments made by Patent Owner regarding the claim construction issues. Petitioner also contended error in Patent Owner's claim construction positions.

Patent Owner contended that its arguments and claim construction positions were foreseeable, contrary to Petitioner's contention, and that a reply is not warranted.

Our rules do not authorize a petitioner to file a reply to a preliminary response. Rather, a petitioner seeking leave to file a reply must make a showing of good cause. 37 C.F.R. § 42.108(c). Based on the facts of this case and the arguments presented during the call, the panel does not find Petitioner has established that further briefing would be helpful or is warranted under the good cause standard.

Petitioner is required to set forth how the challenged claims are to be construed. 37 C.F.R. § 42.104(3). Petitioner now seeks to present additional arguments with respect to claim terms, or closely related claim

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terms, that were addressed in the Petition. Petitioner does not persuasively explain, however, why it could not have anticipated Patent Owner's arguments related to the identified claim terms, which Patent Owner represents rely solely on the intrinsic record of the challenged patent. Moreover, the Board is capable of reviewing the present record, including the intrinsic record, and construing the claims. Thus, Petitioner's request to file a reply to Patent Owner's Preliminary Response in both IPR2019-00552 and IPR2019-00553 is *denied*.

ORDER

Accordingly, it is:

ORDERED that Petitioner's request to file a reply to Patent Owner's Preliminary Response is *denied*.

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PETITIONER:

Sanjay K. Murthy
John Hemmer
Maria Doukas
MORGAN, LEWIS & BOCKIUS LLP
sanjay.murthy@morganlewis.com
john.hemmer@morganlewis.com
maria.doukas@morganlewis.com

PATENT OWNER:

Michael Hawkins
Thomas H. Reger II
Craig Deutsch
Sangki Park
FISH & RICHARDSON P.C.
hawkins@fr.com
reger@fr.com
deutsch@fr.com
spark@fr.com