

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIQUIDIA TECHNOLOGIES, INC.,
Petitioner,

v.

UNITED THERAPEUTICS CORPORATION,
Patent Owner.

IPR2021-00406
Patent 10,716,793 B2

Before ERICA A. FRANKLIN, CHRISTOPHER M. KAISER,
and DAVID COTTA, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Request for Authorization
to File Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

On November 18, 2021, Judges Franklin, Cotta, and Kaiser held a conference call with counsel for both parties to discuss Petitioner's email request for authorization to file a motion to submit supplemental information. A partial transcript of the conference call was made by a court reporter, and that transcript will be entered in the record of this proceeding in due course. For the reasons discussed below, we deny Petitioner's request.

PETITIONER'S REQUEST

Petitioner challenges claims 1–8 of U.S. Patent No. 10,716,793 on grounds that rely on, *inter alia*, Exhibits 1007 and 1008, which Petitioner asserts are prior art to the '793 patent. Paper 2, 30–68. In its Response to the Petition, Patent Owner argues that Petitioner has not proven that Exhibits 1007 and 1008 are prior art because Petitioner has not shown that they were publicly accessible at an early enough date. Paper 29, 11–18. In particular, Patent Owner argues that Petitioner has not shown that Exhibits 1007 and 1008 were received, catalogued, and indexed sufficiently by a library to show that a person of ordinary skill in the art could have located them. *Id.* During the conference call, Petitioner identified the information it would like to submit as supplemental information: date-stamped copies of the documents in Exhibits 1007, 1008, and 1010 allegedly showing that, contrary to Patent Owner's arguments, those exhibits were publicly accessible.

ANALYSIS

It has been more than one month since we instituted trial in the present proceeding. Accordingly, any motion to submit supplemental information that Petitioner might file at this point would be governed by Rule 42.123(b). That rule provides that, when “[a] party seek[s] to submit supplemental information more than one month after the trial is instituted,” that party’s motion “must show why the supplemental information reasonably could not have been obtained earlier,” as well as “that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b).

During the conference call, Petitioner argued that, at the time it prepared and filed the Petition, the libraries from which these exhibits could be obtained were closed due to the COVID-19 pandemic. Petitioner argued that, at that time, it was able to obtain only electronic copies of these exhibits lacking some of the indicia of library receipt and indexing that might have appeared on paper copies (and that allegedly do appear on the versions of these exhibits Petitioner seeks to submit as supplemental information). During the conference call, Petitioner stated that the university libraries from which it obtained the copies of these exhibits that accompanied the Petition did not reopen until the beginning of the present academic year in the autumn of 2021.

Even assuming that Petitioner could prove all the facts it alleged during the conference call, we still are not persuaded that Petitioner could make a sufficient case for us to grant a motion to submit supplemental information under Rule 42.123(b). First, although there is some uncertainty surrounding the precise meaning of “the beginning of the academic year,” that phrase clearly does not stretch far enough to cover Petitioner’s failure to

obtain the information it seeks to submit until after Patent Owner filed its Response on November 10, 2021. This is demonstrated nowhere more clearly than in the testimony of Sylvia Hall-Ellis, Ph.D., Petitioner’s declarant, who stated that “[t]he institutions that [she] would have gone to to get a date-stamped . . . copy of [the alleged prior art]” generally “reopened to the public on a limited basis to faculty and staff around the 1st of June and to the public in general in mid-August.” Ex. 2043, 252:15–23. The evidence thus supports Petitioner’s ability to have obtained this information at nearly any time since our institution of trial on August 11, 2021, and possibly even before that. Indeed, during the conference call with the parties, Petitioner did not allege otherwise. Under these circumstances, Petitioner would not be able to demonstrate persuasively in a motion that “the supplemental information reasonably could not have been obtained earlier,” as required by Rule 42.123(b).

Second, even assuming Petitioner could not reasonably have obtained date-stamped copies of Exhibits 1007, 1008, and 1010 from the particular libraries where it eventually obtained them at any time before it did so, Petitioner may well have been able to obtain date-stamped copies from other libraries. Dr. Ellis testified that, in searching for date-stamped versions of Exhibits 1007, 1008, and 1010, she contacted only a small number of the libraries that carried the journals from which those exhibits came. Ex. 1036 ¶¶ 54 (Ex. 1010 available from 82 libraries), 65 (Ex. 1008 available from 1,168 libraries), 74 (Ex. 1007 available from 282 libraries); Ex. 2043, 50:1–51:4 (Dr. Ellis testifying that she contacted three libraries of the 82 that carried the journal from which Exhibit 1010 was taken), 197:9–199:4 (Dr. Ellis testifying that she contacted three libraries of the 1,168 that carried the journal from which Exhibit 1008 was taken). The small sample of

libraries contacted by Petitioner's declarant further supports a conclusion that Petitioner would not be able to demonstrate that "the supplemental information reasonably could not have been obtained earlier," as required by Rule 42.123(b).

For at least the foregoing reasons, Petitioner would be unable to meet its burden to show that the supplemental information it seeks to submit reasonably could have been obtained earlier. Thus, any motion Petitioner might file to submit this supplemental information would be futile. Accordingly, we deny Petitioner's request for authorization to file such a motion.

REPLY EVIDENCE

In the course of the discussion during the conference call, Petitioner requested guidance regarding whether it could properly submit as reply evidence the same information it seeks to submit as supplemental information. We note that our rules and Consolidated Trial Practice Guide govern the proper scope of a Petitioner's Reply to a Patent Owner's Response to a Petition and any accompanying rebuttal evidence submitted in support of a reply. 37 C.F.R. § 42.23; Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), at 73–75, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>. We take no position on the degree to which any evidence Petitioner might seek to file along with its Reply may or may not comply with this governing authority.

It is

ORDERED that Petitioner's request for authorization to file a motion to submit supplemental information is *denied*.

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