

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVITA MEDICAL LIMITED,
Petitioner,

v.

RENOVACARE SCIENCES CORP.,
Patent Owner.

Case IPR2017-01243
Patent 9,610,430 B2

Before BART A. GERSTENBLITH, JAMES A. WORTH, and
ROBERT L. KINDER, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

ORDER

Summarizing Conference Call and
Resetting Notice of Filing Date Accorded to Petition and Time for Filing
Patent Owner Preliminary Response (Paper 3)
37 C.F.R. § 42.5

On June 19, 2017, a conference call was held between counsel for Petitioner Avita Medical Limited, counsel for Patent Owner Renovacare Sciences Corp., and Administrative Patent Judges Gerstenblith, Worth, and Kinder. Patent Owner requested the conference to address two concerns: (1) that, in the Petition (Paper 1), Petitioner denies the priority claim recited in U.S. Patent No. 9,610,430 B2 (“the ’430 patent”) on the one hand, but relies upon the priority claim in challenging the ’430 patent as a pre-America Invents Act (“AIA”) patent, on the other hand; and (2) that there was an issue with service of the Petition.

With respect to the ’430 patent’s priority claim, counsel for Petitioner agreed to discuss with Petitioner whether it would stipulate to the effective filing date of the ’430 patent in order to avoid a potential problem with the timing of filing its Petition. Specifically, the Petition was filed on the day the ’430 patent issued. If the ’430 patent were not entitled to its priority claim, a petition seeking *inter partes* review of the ’430 patent could not be filed until after the expiration of the nine-month period set forth in 35 U.S.C. § 311(c)(1). *See* 37 C.F.R. § 42.102(a)(1) (“If the patent is a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act, the date that is nine months after the date of the grant of the patent[.]”).

Via an email response on June 22, 2017, counsel for Petitioner indicates that “Petitioner stipulates that the effective filing date for all claims of U.S. Patent No. 9,610,430 is September 11, 2006.”¹ Petitioner’s stipulation obviates the potential problem discussed above.

¹ Petitioner’s email also indicates that it is in follow-up to the conference call “and as instructed by the Board.” We note for clarity that the instruction we gave Petitioner’s counsel, with respect to the effective filing date, was for

With respect to service of the Petition, counsel for Patent Owner represented that the document it received, identifying itself as the Petition, is not identical to the document filed as Paper 1. The Certificate of Service accompanying Paper 1 states that “a copy of this Petition . . . was served in its entirety.” Paper 1, Attachment A at 1. If Patent Owner is correct, then the Certificate of Service is incorrect.

We suggested that counsel meet and confer to determine whether the document filed as Paper 1 was served on Patent Owner. In lieu of that, counsel for Petitioner represented that Petitioner would serve Paper 1 after the conference call. We indicated that such service would restart the clock for the timing of Patent Owner’s Preliminary Response.

Via an email response on June 19, 2017, counsel for Petitioner represents that it served its “Petition for Inter Partes Review” on Patent Owner “today” and filed a copy of the Certificate of Service as well.² Accordingly, as discussed on the conference call, the Petition will be accorded a new filing date of June 19th, and the Notice of Filing Date Accorded Petition (Paper 3) will be deemed to have been issued on June 19, 2017. As such, the timing for Patent Owner’s Preliminary Response, as described in Paper 3, will run from June 19, 2017. Thus, Patent Owner may

counsel to email the Board to let us know *whether* Petitioner would agree to stipulate. There was no instruction that Petitioner was *required* to stipulate.

² As with the email described previously, Petitioner’s June 19th email indicates that it is to inform the Board that the Petition was served “as instructed by the Board during today’s conference call.” We note for clarity that the instruction we gave Petitioner’s counsel, was to file a copy of the new Certificate of Service if Petitioner chose to proceed anew with service of Paper 1 as opposed to determining whether Paper 1 had, in fact, been served.

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file a preliminary response to the Petition no later than three months from June 19, 2017.

It is hereby:

ORDERED that Petitioner shall file its stipulation as to the '430 patent's effective filing date in the PTAB E2E system by June 29, 2017;

FURTHER ORDERED that the Petition will be accorded a filing date of June 19, 2017;

FURTHER ORDERED that the Notice of Filing Date Accorded to Petition (Paper 3) will be deemed to have been issued on June 19, 2017, and

FURTHER ORDERED that Patent Owner may file a preliminary response to the Petition no later than three months from June 19, 2017.

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³ If Petitioner desires Dr. Xie to be listed as counsel for Petitioner, as indicated in the Petition, Petitioner should update its counsel information in the PTAB 2E2 system to include her as well as Dr. Ball.