

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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CANFIELD SCIENTIFIC, INC.,  
Petitioner,

v.

MELANOSCAN, LLC,  
Patent Owner.

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Case IPR: 2017-02125  
Patent No. 7,359,748

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**PETITIONER'S MOTION TO DEEM REPLY AND SUPPORTING  
EXHIBITS TIMELY-FILED**

## **TABLE OF AUTHORITIES**

### **Page(s)**

#### **Cases**

*Amerigen Pharmaceuticals Limited v. Janssen Oncology, Inc.*,  
IPR2016-00286, Paper 86 (PTAB Jan. 17, 2018) .....2

*Pacific Market International, LLC v. Ignite USA, LLC*,  
IPR2014-00561, Paper 40 (PTAB May 12, 2015) .....4

#### **Other Authorities**

37 C.F.R. 42.5(c)(3) .....1, 2

Pursuant to 37 C.F.R. 42.5(c)(3), Petitioner Canfield Scientific, Inc. asks that the Board deem Petitioner's Reply and supporting exhibits to be timely filed in the interests of justice. In support, Petitioner offers the declaration of its lead counsel, Julianne M. Hartzell, (Ex. 1048).

## **I. Introduction**

Patent Owner cited to the declaration of its inventor, Dr. Rhett Drugge in its Patent Owner Response. Exhibit 1048 (Hartzell Declaration at ¶ 2). Petitioner sought to cross examine the inventor. *Id.* at ¶ 3. To accommodate the inventor's schedule, the parties stipulated to an extension to file Petitioner's Reply until October 1, 2018. (Paper 26). Dr. Drugge's cross examination occurred on September 20, 2018 and the parties agreed to entry of the Default Protective Order on that day. Exhibit 1048 at ¶¶ 3-4; Paper 29. Patent Owner provided confidentiality designations to Petitioner on Friday September 28, 2018. Ex. 1048 at ¶ 4. Late in the evening on October 1, 2018, Petitioner believed it was ready to timely file its documents, but in finalizing the word count certification, it became apparent to Petitioner that the word count software was not counting footnotes. Ex. 1048 at ¶ 5. This necessitated not only revisions to the Reply, but because of the Patent Owner's confidentiality designations, it also required the creation of both a confidential and redacted versions of the final brief. *Id.* at ¶¶ 5-6. Petitioner began filing Petitioner's Reply (confidential and redacted version), nine exhibits supporting the reply (including confidential and redacted versions of two of those

exhibits), and a motion to seal. *Id.* at ¶ 7. As the result of the delay occasioned by the need to redact the revised document to comply with sPatent Owner's requests to seal certain information from the deposition transcript of Patent Owner's witness, Petitioner's filing was not completed until minutes after midnight. *Id.* at ¶ 7. Receipts for the filings were received by Petitioner between 12:04 and 12:13 a.m. on October 2, 2018. *Id.* The documents were then served on counsel, the last of which was sent at 12:29 a.m. on October 2, 2018. *Id.* at ¶ 8. There is no statutory bar related to filing of the Reply.

In its Reply (Paper 33), Petitioner addresses a number of issues raised in the Patent Owner's Response (Paper 23) including arguments directed to correcting the standard of obviousness applied by Patent Owner. *See, e.g.*, Ex. 1048 at ¶ 9.

## **II. Petitioner's Reply should be deemed timely in the interests of justice**

Pursuant to 37 C.F.R. 42.5(c)(3), a late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice. This rule must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *Amerigen Pharmaceuticals Limited v. Janssen Oncology, Inc.*, IPR2016-00286, Paper 86 at p. 45 (PTAB Jan. 17, 2018). In considering the totality of the circumstances to determine whether the interest of justice support excusing a late action, the Board looks to whether the non-filing party suffered any prejudice as a result of the late filing and may consider if a statutory bar applies. *Id.* In this case, Petitioner is aware of no

prejudice to the Patent Owner, and Petitioner respectfully submits the interests of justice would be served by excusing the short, inadvertent filing delay.

The interests of justice would not be served by exclusion of the Reply and accompanying exhibits for a short filing delay. Here, the delay of 4 minutes in Petitioner's filing of the confidential and redacted versions of its Reply and the subsequent delay of up to 13 minutes in its filing of supportive documents has not likely caused any prejudice to the Patent Owner. Patent Owner stated that it has been prejudiced, but declined to identify any specific prejudice suffered and did not respond to Petitioner's offer to try to remedy any such prejudice. Ex. 1048 at ¶ 11. The Patent Owner has now served its objections to the evidence cited in the Reply and Petitioner consents to any extension necessary to consider such objections timely if the Reply is deemed filed on October 1. *Id.* at ¶ 12. Patent Owner has similarly served Petitioner shortly after the filing deadline without prejudice to, or objection by, the Petitioner. *Id.* at ¶ 10 (noting Patent Owner's filing of its *Opposition* at 11:59 p.m. Eastern and service upon Petitioner at 12:14 a.m. Eastern). Under these circumstances, it does not appear that the Patent Owner has suffered any prejudice. But to the extent that Patent Owner requires a one day extension on any upcoming deadline responsive to the Reply, Petitioner has no objection because the interests of justice would be served.

There is no statutory bar related to the deadline for the Reply. The Reply substantively addresses the factual and legal contentions in the Patent Owner's

Response, including Petitioner's view that the Patent Owner incorrectly applies the law of obviousness in several instances. *Id.* at ¶ 9. Petitioner's Reply provides arguments directly relevant to the merits of the issues raised in Patent Owner's Response and the Board would benefit from considering those arguments in reaching its decision on the merits. Denying this motion would deprive Petitioner of its ability to respond to Patent Owner's arguments, resulting in prejudice to Petitioner that outweighs any harm from the delay in filing.

The Board has previously considered this issue in connection with the late filing of a reply in *Pacific Market International, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 40 at pp. 4-5 (PTAB May 12, 2015). In that case, the Board agreed that the minutes-long delay in filing the Reply causes essentially no prejudice to the patent owner and would potentially result in severe prejudice to the petitioner. The Board agreed that the interests of justice justify granting the motion because doing so enables both parties to present the most complete set of arguments and evidence in the record, while avoiding undue prejudice to either party. Petitioner asks that the Board here also find that the interests of justice require granting the Motion to allow Petitioner to present arguments and evidence responsive to Patent Owner's Response.

### **III. Conclusion**

In the interests of justice, Petitioner asks that the Board deem the filing of its Reply and supporting exhibits be timely.

Respectfully submitted,

October 12, 2018

/ / *Julianne M. Hartzell*, Reg. #44,748

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**CERTIFICATE OF FILING AND SERVICE**

The undersigned hereby certifies that, pursuant to 37 CFR §§ 42.6(e), copies of the foregoing “PETITIONER’S MOTION TO DEEM ITS REPLY TIMELY-FILED” is being filed via the Patent Trial and Appeal Board’s End to End (PTAB E2E) system and is being served today, October 12, 2018, by electronic mail on counsel for the Patent Owner:

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