



# THINK FORWARD

## Never Late Is Better: PTAB Denies Petitioners Motion In IPR After Missing Filing Deadline By Minutes

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June 14, 2016

On May 23, 2016, the Patent Trial and Appeal Board (PTAB) issued a decision denying motions to change a filing date accorded and denying institution of inter partes review in two cases, IPR2016-00281 (IPR281) and IPR2016-00282 (IPR282), filed by Teva Pharmaceuticals USA, Inc. against patents owned by Monosol RX, LLC.

Monosol filed a patent infringement suit against Teva in 2014 after Teva sought to market a generic version of Monosol's opiate addiction treatment drug, Suboxone. The parties agreed the complaint was served on December 3, 2014, setting the statutory bar date for IPR281 and IPR282 as December 3, 2015. The petitions for these IPR cases, however, were accorded a filing date of December 4, 2015.

In motions to change the filing date, Teva claimed to have begun uploading documents for the petitions to the PTAB's Patent Review Processing System (PRPS) around 9:45 p.m. on December 3, 2015. While typical filings of this nature take around twenty minutes, Teva asserted that the system was experiencing technical difficulties, including freezing and rejecting payments, which delayed the filing process. Teva did not receive confirmation of the two petition filings until 12:01 a.m. and 12:09 a.m. December 4, 2015.

Teva argued that but for the delay caused by the PTAB system, the filings would have been completed prior to midnight of December 3, 2015. The Board, unpersuaded by Teva's lack of objective evidence, said it was not aware of any technical issues with the processing system that night. "Waiting until the last minute — without explanation — is ill advised and had petitioner not done so, any alleged delays caused by 'technical issues' would have been moot," it added. In addition to the lack of objective evidence of any fault in the PTAB system, the Board was unimpressed with the delayed service of the petitions on Monosol. FedEx did not receive hard copies from Teva to serve to Monosol until 3:02 a.m. on December 4 and the Board was displeased both with Teva's incorrect service certification date and the subsequent lack of acknowledgement of this incorrect date of service.

The Board, in its decision denying Teva's motions and denying institution of the IPRs, clarifies that a petition will not be accorded a filing date until the petition satisfies the following: (1) the content of the petition complies with 37 C.F.R. § 42.104; (2) the fee to institute has been paid, see 37 C.F.R. §§ 42.15(a), 42.103(b); and (3) the petition and relevant documents have been served on the patent owner. 37 C.F.R. § 42.106(a). Here, the Board noted Teva lacked a petition, fees and service by the required date.

The Board is unlikely to make exceptions to the filing deadline rules for IPR petitions, at least in circumstances where the petitioner is also a defendant in a civil action relating to the same patents as the IPR petitions. The PTAB does provide that if the PRPS is down during normal business hours,

practitioners are encouraged to phone the help line at 571-272-7822 . If PRPS continues to be down during normal business hours, any petition or other paper can be e-mailed to [Trials@uspto.gov](mailto:Trials@uspto.gov) or filed via Express Mail with the appropriate identifying information and motion to accept the submissions. More details can be found at <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0>.

The cases are Teva Pharmaceuticals USA Inc. v. MonoSol RX LLC, case numbers IPR2016-00281 and IPR2016-00282, before the Patent Trial and Appeal Board.

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