

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GNOSIS S.p.A., GNOSIS BIORESEARCH S.A., AND  
GNOSIS U.S.A., INC.

Petitioners

v.

MERCK & CIE  
Patent Owner

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Case IPR2013-00117  
Patent 6,011,040

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Before MICHAEL P. TIERNEY, JACQUELINE WRIGHT BONILLA, and  
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER  
Lifting Stay of Concurrent Reexamination  
*37 C.F.R. § 42.122(a)*

On February 3, 2015, a conference call was conducted among counsel for Patent Owner and Judges Tierney, Bonilla, and Kamholz. Although invited to participate in the call, Counsel for Petitioner did not attend. The purpose of the call was to address concerns of Patent Owner, Merck & Cie, regarding a stay in reexamination Control No. 90/011,935, which involves U.S. Patent No. 6,011,040 (“the ’040 patent”) (Ex. 1004), the patent at issue in the current proceeding.

Petitioner, Gnosis S.p.A., Gnosis Bioresearch S.A., and Gnosis U.S.A., Inc., filed a Petition to institute an *inter partes* review of certain claims of the ’040 patent. Paper 2. Thereafter, in an Order dated April 3, 2013, we ordered a stay in co-pending *ex parte* reexamination Control No. 90/011,935 involving the ’040 patent. Paper 10. As noted in that Order, original claims 1–22 of the ’040 patent, as well as newly added dependent claims 23–63, were subject to the reexamination. *Id.* at 1.

Subsequently, in the current case, in a Final Decision dated June 20, 2014, the Board concluded that Petitioner had shown by a preponderance of the evidence that claims 8, 9, 11, 12, 14, 15, and 19–22 of the ’040 patent were unpatentable. Paper 71, 3, 45–46. Patent Owner since has filed a Notice of Appeal regarding our Final Decision with the U.S. Court of Appeals for the Federal Circuit, and that appeal currently is pending. Papers 72 and 73.

Patent Owner has requested that the Board lift the April 3, 2013 stay. During the call, Patent Owner stated that while the reexamination involves overlapping claims, Patent Owner has not amended any of original claims 1–

IPR2013-00117  
Patent 6,011,040

22 of the '040 patent, newly added dependent claims 23–63 are narrower in scope than the original claims, and the Examiner in the reexamination has issued a final rejection. In the event that we lift the stay, Patent Owner further agreed it would not amend any of original claims 1–22 going forward. Patent Owner also represented that the '040 patent is set to expire in January 2017. Patent Owner requested the opportunity to reach resolution of the reexamination while the '040 patent still has patent term.

In this instance, for the reasons stated by Patent Owner during the call, we are persuaded that a reasonable rationale exists for lifting the stay of *ex parte* reexamination Control No. 90/011,935.

Accordingly, it is

ORDERED that the stay of *ex parte* reexamination Control No. 90/011,935 involving the '040 patent is lifted.

IPR2013-00117  
Patent 6,011,040

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