

Baxter Healthcare Corp., Apatech v. Millenium Biologix: Denying Request for Rehearing the Order that Petitioner's Reply Evidence will not be Considered IPR2013-00582, 590

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: A petitioner's reply that raises a new issue or belatedly presents evidence will not be considered.

In its [Decision](#), the Board denied Petitioner's Request for Rehearing of the Board's Order in which the Board indicated that it would not consider Petitioner's Reply evidence (Exhibit 1134 ¶¶ 49-61, Exhibit 1135, and Exhibits 1143-1171) in issuing its Final Written Decisions in each of IPR2013-00582 and IPR2013-00590. The Reply evidence was submitted along with Petitioner's Reply, but was not included with the original Petition as filed.

It was Petitioner's view that the Reply evidence was not necessary to support the prima facie case set forth in the Petition. Instead, according to Petitioner, the Reply evidence was only presented in direct response to arguments set forth in Patent Owner's Response. Hence, according to Petitioner, the Board had misapprehended or overlooked the Reply evidence when it decided that the Reply evidence would not be considered. Moreover, Petitioner alleged consideration of the Reply evidence by the Board would not unfairly prejudice Patent Owner.

The Board decided that Petitioner's Reply belatedly presented evidence. In doing so, the Board made particular mention of the fact that Petitioner, in its Petition, had elected to rely on the inherent anticipation argument in its expert's declaration without supporting experimental evidence. According to the Board, the Reply evidence went beyond merely rebutting arguments set forth in Patent Owner's Response, and thus was new evidence that could have been presented at the time the Petition was filed.

Basically, it was the Board's position that Petitioner should have reasonably expected that Patent Owner would attempt to rebut Petitioner's inherent anticipation argument, and thus should have presented the Reply evidence with the Petition in the first place. Of interest was the Board's comment that the experimental evidence could either have been presented with the original Petition or, alternatively, Petitioner could have "requested authorization to file supplemental information in support of its Petition after Patent Owner's Response was served and filed."

Baxter Healthcare Corp., Apatech, Inc., and Apatech Limited v. Millenium Biologix, LLC,

IPR2013-00582 and IPR2013-00590

Paper 39: Decision on Petitioner's Request for Rehearing

Dated: October 30, 2014

Patents: RE41,251 and 6,585,992

Before: Michelle R. Osinski, Scott E. Kamholz, and Brian P. Murphy

Written by: Osinski

© 2025 Faegre Drinker Biddle & Reath LLP. All Rights Reserved.

National Law Review, Volume IV, Number 309

Source URL: <https://natlawreview.com/article/baxter-healthcare-corp-apatech-v-millennium-biologix-denying-request-rehearing-order->