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Paper 54
Entered: February 24, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GALDERMA S.A.; GALDERMA LABORATORIES, INC.; GALDERMA LABORATORIES LP; GALDERMA RESEARCH & DEVELOPMENT SNC; NESTLÉ SKIN HEALTH, INC.; NESTLÉ SKIN HEALTH S.A.; and NESTLÉ S.A.,
Petitioner,

v.

MEDY-TOX, INC.,
Patent Owner.

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PGR2019-00062
Patent 10,143,728 B2

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Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and TIMOTHY G. MAJORS, *Administrative Patent Judges.*

PAULRAJ, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
*37 C.F.R. § 42.5*

We hereby provide notice of a potential *sua sponte* ground of unpatentability with regard to the proposed substitute claims included with Patent Owner's Revised Motion to Amend (Paper 30). *See Nike, Inc. v. Adidas AG,* 955 F.3d 45, 51 (Fed. Cir. 2020) (holding that the Board may *sua sponte* identify a patentability issue for a proposed substitute claim). Although the circumstances are "rare" in which the Board may itself raise a patentability issue on proposed substitute claims, such circumstances exist here. *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, IPR2018-00600, Paper 67 at 13 (PTAB July 6, 2020) (precedential) (explaining that the Board may, in rare circumstances, raise a ground of unpatentability not raised by the parties). As explained below, the issue is "readily identifiable" from the proposed substitute claim language alone. *Id.* And, in furtherance of the "integrity of the patent system," it is appropriate for the Board to notify the parties that the claims are potentially indefinite for including a trademark, so that the parties may address the matter at oral argument and, if necessary, in subsequent briefing. *Id.* at 13–16 (explaining that advance notice and an opportunity to respond is required).

In particular, proposed independent claim 19 includes a recitation of the trademark "BOTOX®" that potentially renders the claims indefinite. As noted in the Manual of Patent Examining Procedure (MPEP):

> The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim. . . . If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph.

MPEP § 2173.05(u). Here, by reciting "BOTOX®," it appears that the proposed substitute claims intend to refer to a particular product to which the claimed botulinum toxin composition is compared.

The parties should be prepared to address this patentability issue during the oral hearing. *See Nike*, 955 F.2d at 54 (noting that, in order to provide sufficient notice and opportunity to respond to a *sua sponte* patentability issue, the Board may either request supplemental briefing or request that the parties be prepared to discuss the issue during the oral hearing). If deemed necessary, the Board may order supplemental briefing following the hearing.

It is so ORDERED.

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