

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKER BIOMARINE AS
Petitioner

v.

NEPTUNE TECHNOLOGIES AND BIORESSOURCES INC.
Patent Owner

CASE IPR2014-00003

U.S. Patent No. 8,278,351

PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,278,351

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107, the Patent Owner, Neptune Technologies and Bioresources Inc. (the "Patent Owner" or "Neptune"), timely submits this Preliminary Response to the Petition for *Inter Partes* Review (the "Petition") of U.S. Patent No. 8,278,351 ("the '351 Patent"), filed by Aker Biomarine AS (the "Petitioner") on October 1, 2013 and seeking the cancellation of claims 1-94 of the '351 Patent (the "patented claims").

In an effort to concoct rejections of the patented claims, Petitioner provides an exhaustive list of close to eighty references and/or expert declarations which have either been previously considered by the United States Patent and Trademark Office (the "Office") during the prosecution of the '351 Patent or are cumulative with information previously presented to, and considered by, the Office. Yet, as discussed herein, it is undisputed that *none* of these references expressly disclose all elements of any patented claim. Instead, Petitioner resorts to a theory of inherency, which requires that the prior art "*necessarily*" includes the unstated limitation. See *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002). Petitioner fails to meet this standard as its inherency argument is based on a series of flawed "recreation" experiments, which significantly deviate from the prior art, in the hopes of obtaining more favorable results. Petitioner's arguments are further based on testing results which are largely hit or miss. In many samples, the claimed phospholipid and many other claim elements were not detected. In order to establish inherency, the evidence must make clear that the missing descriptive matter is *necessarily*

present in the item of prior art.¹ Accordingly, the inconsistency of the testing results is fatal to Petitioner's theory of inherency.²

Petitioner adopts a similarly flawed and cursory theory of obviousness with respect to the patented claims. Specifically, Petitioner's obviousness rejections employ the very reasoning the Federal Circuit has criticized as insufficient and "fraught with hindsight bias," failing to "explain how specific references could be combined, which combination(s) of elements in specific references would yield a predictable result, or how any specific combination would operate or read on the asserted claims." See *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012). The obviousness arguments are based on various convoluted combinations of no less than ten references, none of which alone, or in combination, disclose all elements of the patented claims. A significant number of these references do not even relate to krill, or teach away from the use of krill, and/or are antithetical to the notion of human use, as their extractions involve highly toxic solvents intended merely for laboratory analysis.

Accordingly, each of the proposed grounds of rejection in the Petition is based on

¹ *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346-47 (Fed. Cir. 2009).

² "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Bettcher Indus. v. Bunzl USA, Inc.*, 661 F.3d 629, 639 (Fed. Cir. 2011) (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)).

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