

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
Patent 8,278,351 B1

**PETITIONER AKER BIOMARINE AS'S MOTION FOR REHEARING
UNDER 37 C.F.R. § 42.71**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450**

I. INTRODUCTION

On March 24, 2014, the Patent Trial and Appeal Board (“Board”) instituted this *inter partes* review of certain claims of U.S. Patent No. 8,278,351 (“the ’351 patent”) on two grounds: (1) anticipation of claims 1, 3-6, 9, 12, 13, 19-24, 26-29, 32, 35, 36, and 42-46 by Beaudoin I; and (2) obviousness of claims 1-6, 9, 12, 13, 19-29, 32, 35, 36, and 42-46 over the combination of Fricke, Bergelson, Yasawa, Itano, and the WHO Bulletin. Paper 22 at 28. Although the Board instituted an *inter partes* review of every other claim subject to Aker BioMarine AS’s (“Aker”) petition¹ based on anticipation of those claims by Beaudoin I, the Board “decline[d] to institute an *inter partes* review of claims 2 and 25 under 35 U.S.C. § 102(b) as anticipated by Beaudoin I.” *Id.* Because Beaudoin I also discloses every limitation of claims 2 and 25, and because the Board’s decision to the contrary rests upon legal error, Aker respectfully requests that the Board reconsider its refusal to institute a review of claims 2 and 25 as anticipated by Beaudoin I.

Claims 2 and 25 of the ’351 patent, which are generally directed to a krill extract, state that “the extract has a total phospholipid concentration in an amount

¹ Aker’s petition originally requested review of claims 1-94 of the ’351 patent, but the Board granted the parties’ joint motion to limit the claims to those identified above. Paper 21.

of about 40% w/w, wherein about represents $\pm 10\%$.” Ex. 1001. As found by the Board in its decision instituting this *inter partes review*, “about 40% w/w, wherein about represents $\pm 10\%$ ” means “from 30% to 50%.” Paper 22 at 17. In its petition, Aker explained that claims 2 and 25 were anticipated by Beaudoin I because Table 14 in that reference expressly “discloses $54.1 \pm 6.1\%$ phospholipids and polar material w/w in Fraction I extracts, which falls within or touches the claimed ranges.” Paper 4 at 20; Paper 22 at 17. The Board declined to review claims 2 and 25 on this ground, however, stating that “[w]hile it is possible that $54.1 \pm 6.1\%$ included 48% to 50%, which would have fallen within the recited range,” the Board was not persuaded that the amount disclosed in Table 14 of Beaudoin I “necessarily included such an amount.” Paper 22 at 17.

The Board committed two legal errors in declining to review claims 2 and 25 for anticipation by Beaudoin I. First, the Board incorrectly applied the standard for inherent anticipation in requiring that Beaudoin I must “necessarily include[]” the claimed phospholipid concentration. In doing so, the Board overlooked that Beaudoin I *explicitly discloses* a phospholipid concentration within the claimed range, and therefore anticipates claims 2 and 25 under controlling precedent. Paper 4 at 20. Second, the Board’s decision contravenes *In re Best*, 562 F.2d 1252 (C.C.P.A 1977). The Board adopted Aker’s argument that because “the processes described in the ’351 patent and . . . the prior art [Beaudoin I] are virtually

indistinguishable,” as a result so, too, “would be the resulting extracts.” Paper 4 at 12; Paper 22 at 13. Accordingly, a *prima facie* case of anticipation (and obviousness) has been established and the burden shifted to Neptune to produce evidence as to why the resulting compositions would be different. *See Best*, 562 F.2d at 1255. Here, Neptune presented *no evidence or even argument* that Beaudoin I results in compositions containing phospholipid concentrations outside the ranges claimed by claims 2 and 25. Thus, the Board should have found that Beaudoin I anticipates those claims.

The Board has previously granted requests for rehearing of a decision not to institute an *inter partes* review on select grounds where it committed legal error in declining to review those grounds. In this case, the Board decision rests on two legal errors. For at least these reasons, the Board should institute a review of claims 2 and 25 as anticipated by Beaudoin I.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(d), “[a] party . . . may file a request for rehearing[,] . . . specifically identify[ing] all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” On rehearing, the Board reviews a previous decision “for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion may be established by showing that the [Board] made a clear error of judgment in

weighing relevant factors or exercised its discretion based upon an error of law or clearly erroneous factual findings.” *Novo Nordisk of N. Am., Inc. v. Genentech, Inc.*, 77 F.3d 1364, 1367 (Fed. Cir. 1996) (citation omitted).

The Board previously has granted a request for rehearing because its refusal to institute review on anticipation grounds was legally erroneous in light of existing precedent. For example, in *Illumina, Inc. v. Trustees of Columbia University*, the Board originally declined to institute review for anticipation because the Board did not believe that a second reference was “incorporated by reference” in the primary reference. IPR2013-00006, slip op. at 2-5 (Patent Tr. & App. Bd. May 10, 2013). On rehearing, the Board “agree[d] ... that [it] erred in not instituting” for anticipation in light of Federal Circuit precedent. *Id.* at 3-5; *see also Illumina, Inc. v. Trustees of Columbia Univ.*, IPR2013-00011, slip op. at 3-5 (Patent Tr. & App. Bd. May 10, 2013).

III. ARGUMENT

Beaudoin I anticipates claims 2 and 25. The Board’s determination to the contrary was based on two legal errors: (1) despite Beaudoin I’s express disclosure of phospholipid concentrations in the claimed range, the Board failed to follow the Federal Circuit’s controlling precedent in *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340 (Fed. Cir. 2012), and instead applied the standard for inherent anticipation; and (2) the Board failed to follow controlling precedent,

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