

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC, PAR PHARMACEUTICAL,
INC., and WOCKHARDT BIO AG,
Petitioners,

v.

JAZZ PHARMACEUTICALS, INC.
Patent Owner

Case IPR2015-00547¹
Patent: 7,765,107

**PETITIONERS RESPONSE TO PATENT OWNER REQUEST FOR
REHEARING PURSUANT TO 37 C.F.R. § 42.71(d)**

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¹ Case IPR2015-01820 has been joined with this proceeding.

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I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Pursuant to the Board's e-mail authorization on September 6, 2016 (*see* Exhibit 1062), Petitioners Amneal Pharmaceuticals LLC and Par Pharmaceutical, Inc. (collectively, "Petitioners") submit this opposition to Patent Owner's Request for Rehearing Pursuant to 37 C.F.R. § 42.71(d) (Paper 71).

Patent Owner's Request does not provide a proper basis for rehearing, but instead merely reiterates Patent Owner's rejected arguments and evidence to import certain limitations into the claims. The Board's Final Decision (Paper 70) explicitly acknowledged and correctly refuted these arguments and evidence based on the governing intrinsic evidence, in holding claims 1–6 of U.S. Patent No. 7,765,107 ("the '107 patent") unpatentable as obvious over the Advisory Committee Art (Exs. 1003–1006) (the "ACA"). Patent Owner's Request for Rehearing should therefore be denied.

II. LEGAL STANDARD

In a request for rehearing, the dissatisfied party "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d). "The burden of showing a decision should be modified lies with the party challenging the decision." *Id.*

III. PATENT OWNER HAS FAILED TO PROVE THAT THE BOARD OVERLOOKED OR MISAPPREHENDED ANY EVIDENCE THAT SHOULD MODIFY ITS FINAL CLAIM CONSTRUCTIONS.

“A Request for Rehearing is not an opportunity to re-argue old arguments” *Histologics, LLC v. CDX Diagnostics, Inc. et al.*, IPR2014-00779, slip op. at 4 (PTAB Oct. 16, 2014) (Paper 9) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012)). Yet that is precisely what Patent Owner’s Request seeks to do here. Patent Owner simply re-argues that exemplary embodiments of “information identifying the patient” and “credentials of the medical doctor” should limit the claims—arguments that the Board squarely addressed and rejected. And while Patent Owner highlights certain specification excerpts and/or expert testimony, the Board already considered and refuted that evidence in its Final Decision. (*Id.*) The proper course for Patent Owner here “is to appeal, not to file a request for rehearing to re-argue issues that have already been decided.” *SAP Am., Inc. v. Versata Dev. Grp., Inc.*, CBM2012-00001, slip op. at 5 (PTAB Sept. 13, 2013) (Paper 81).

A. “wherein said [prescription] request data contain information identifying the patient”

Patent Owner first argues that the Board overlooked portions of the specification “separate and apart from Figure 9” and certain expert testimony on information “to identify the narcoleptic patient,” which Patent Owner uses to justify its limiting construction of “wherein said [prescription] request data contain

information identifying the patient.” (Request at 4–5 (citing Ex. 1001 at 4:26–28; Ex. 2046 at ¶¶ 43–44; Ex. 2044 at 97:11–98:5, 99:18–100:10).) This is incorrect.

To the contrary, the Final Decision’s claim construction analysis for this term begins by explicitly and repeatedly acknowledging Patent Owner’s arguments and evidence, including the exact specification excerpt and expert testimony of Dr. DiPiro and Dr. Valuck on which Patent Owner’s Request relies. (Final Decision at 18 (citing Ex. 2046 at ¶¶ 39–44; Ex. 1001 at 4:14–28; Ex. 2044 at 97:11–98:5, 99:18–100:10); *id.* at 19 (citing Ex. 1001 at 4:26–28; Ex. 2044 at 97:11–23, 99:18–100:10).) The Board did not “overlook” this evidence and consider only Figure 9 of the specification, as Patent Owner suggests. (*See* Request at 3.) It simply disagreed with Patent Owner on what this evidence means for claim construction.

Confirming that the final claim construction was not based solely on the rejection of Patent Owner’s arguments as to Figure 9, the Final Decision states that “*nothing* in the specification suggests that excluding one or more pieces of information in the list of a ‘patient’s name, social security number, date of birth, sex, and complete address information, including city, state, and zipcode,’ as proposed by Patent Owner, means that a prescription fails to contain ‘information identifying the patient,’ as recited in the claims.” (Final Decision at 19 (emphasis added).) The Board made clear that this controlling understanding of the specification refuted Patent Owner’s arguments and supporting evidence to import any such limitations

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