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Paper 76
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC. and
AMNEAL PHARMACEUTICALS LLC,
Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00547
Patent 7,765,107 B2

Before JACQUELINE WRIGHT BONILLA, BRIAN P. MURPHY, and JON B. TORNQUIST, *Administrative Patent Judges.*

BONILLA, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Jazz Pharmaceuticals, Inc. ("Patent Owner") filed a Request for Rehearing following our Final Written Decision, which determined that claims 1–6 of U.S. Patent No. 7,765,107 B2 (Ex. 1001, "the '107 patent") were unpatentable. Paper 70 ("Decision" or "Dec."); Paper 71 ("Rehearing Request" or "Req. Reh'g"). Par Pharmaceutical, Inc. and Amneal Pharmaceuticals LLC (together "Petitioner") filed a Response to Patent Owner's Rehearing Request. Paper 74 ("Opp."). Patent Owner seeks reconsideration of the Board's determination that claims 1–6 of the '107 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Advisory Committee Art (Exs. 1003–1006, collectively "the ACA"). Req. Reh'g 1–2. Patent Owner argues that the Board misapprehended or overlooked certain evidence when construing the following claim limitations: "wherein said request data contain information identifying the patient," and "wherein said request data contain information identifying . . . credentials of the medical doctor." *Id.* at 2–8. Petitioner opposes the Rehearing Request. Opp. 2–6.

Having considered the parties' submissions concerning Patent Owner's Rehearing Request, Patent Owner's request is *denied*.

II. STANDARD OF REVIEW

A party who requests rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* "A Request for Rehearing is not an opportunity

to re-argue old arguments." *Histologics, LLC v. CDX Diagnostics, Inc.*, Case IPR2014-00779, slip op. at 4 (PTAB Oct. 16, 2014) (Paper 9). With the aforementioned principles in mind, we address the rehearing arguments presented by Patent Owner.

III. ANALYSIS

Independent claims 1 and 4 of the '107 patent each recite a method step for determining, using a computer processor, current and anticipated patterns of potential prescription abuse based on prescription request data from a doctor, "wherein said request data contain information identifying the patient, [GHB as] the drug prescribed, and credentials of the medical doctor." Ex. 1001, 8:51–59, 9:61–10:5 (the "identifying" element). In its Response during trial, Patent Owner argued that exemplary embodiments described in the '107 patent limited the recited "information" in the "identifying" element by requiring specific types of information to be read into that element. Paper 46 ("PO Resp.") 29–36. We considered Patent Owner's arguments, construed the different aspects of the "identifying" element with particular reference to the '107 patent specification, explained our reasoning, and stated that the "identifying" element was not limited to the types of information proposed by Patent Owner "nor requires all of that information." Dec. 18–21.

Patent Owner's Rehearing Request argues that we overlooked portions of the '107 patent specification and certain extrinsic evidence, in the form of expert testimony, that was cited by Patent Owner in its Response to the Petition. Req. Reh'g 1–8. Patent Owner then repeats its argument that the "identifying" element *requires* specific types of information to be read into the claim element. *Id*. at 3–8. We do not agree that we

misapprehended or overlooked the evidence identified by Patent Owner in its Response and Rehearing Request. Rather, Patent Owner's Rehearing Request is an attempt to reargue a position rejected in our Decision.

Our Decision construing the "identifying" element includes extensive citation to, and discussion of, Patent Owner's arguments and evidence. Dec. 18–21. Our claim construction analysis begins by explicitly and repeatedly acknowledging Patent Owner's arguments and evidence, including the exact specification excerpts and expert testimony of Dr. DiPiro and Dr. Valuck on which Patent Owner's Rehearing Request relies regarding the "information identifying the patient" and the "credentials of the medical doctor" language. *Id*. at 18 (citing PO Resp. 29–33; Ex. 1001, 4:14–28, 8:4–5, 39–42, 10:50–53; Ex. 2044, 97:11–98:5, 99:18–100:10; Ex. 2046 ¶¶ 39–44); *id*. at 18–19 (citing PO Resp. 30; Ex. 1001, 4:26–28, 8:4–5; Ex. 2044, 97:11–23, 99:18–100:10); *id*. at 20–21 (citing PO Resp. 33–36; Ex. 1001, 2:28–30, 47–48; 4:12–6:4, 8:4–7, 40–43, 9:54–56, Figs. 2A–C, 9; Ex. 2044, 181:1–23; Ex. 2046 ¶¶ 45–49); *see also* Req. Reh'g 3–8 (providing a subset of the above-mentioned citations).[1]

We did not "overlook" the above-mentioned evidence, including certain testimony by Dr. DiPiro and Dr. Valuck, nor consider only Figure 9 of the '107 patent specification regarding the identify of patients, as Patent

[1] Patent Owner cited to the Abstract of the '107 patent in support of its proposed claim construction. PO Resp. 32–33, 35–36; Req. Reh'g 5, 7. With regard to the "identifying" element, the Abstract merely states that "[i]nformation is kept in the database regarding all physicians allowed to prescribe the sensitive drug, and all patients receiving the drug." Ex. 1001, Abstract. The Abstract, therefore, provides only general guidance for construing the "identifying" element.

Owner argues. *See* Req. Reh'g 3–6. For example, rather than limiting our analysis to Figure 9, we stated 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 zip code," as proposed by Patent Owner, means that a prescription fails to contain "information identifying the patient," as recited in the claims.

Dec. 19 (emphasis added); *see also id*. (citing Ex. 1001, 8:4–5).

We made clear that the controlling description of the specification outweighed Patent Owner's argument and supporting evidence that specific types of information are required to be read into the "identifying" element of the claims. *Id.* ("*Thus*, we construe prescription 'request data contain information identifying the patient' to refer to information identifying a patient, which may include the type of information presented in the enrollment form of Figure 9 and noted by Patent Owner (PO Resp. 29–30), but is not limited to that information *nor requires all of that information*." (emphasis added)). We also cited to all of the expert testimony on which Patent Owner relied for its claim construction, as an indication that we considered the testimony. *Id.* at 18–19 (citing Ex. 2044, 97:11–98:5, 99:18–100:10; Ex. 2046 ¶¶ 39–44).

We did the same for the "information identifying . . . credentials of the medical doctor" language, concluding that:

> The specification does not suggest that failing to include on the prescription one or more pieces of information from the list of a "medical doctor's name, license number, DEA number, and physician specialty," as proposed by Patent Owner, means that a

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