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Paper 72
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00554
Patent 7,668,730 B2

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

MURPHY, *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 determining all challenged claims of U.S. Patent No. 7,668,730 B2 (Ex. 1001, "the '730 patent") to be unpatentable. Paper 68 ("Decision" or "Dec."); Paper 69 ("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 71 ("Opp."). Patent Owner seeks reconsideration of the Board's determination that claims 1–11 of the '730 patent are unpatentable for obviousness 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 limitation: "the prescription requests containing information identifying patients, the prescription drug, and various credentials of the any and all medical doctors." *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 2 of the '730 patent recite a method step for receiving prescription requests "containing information identifying patients, the prescription drug, and various credentials of the any and all medical doctors." Ex. 1001 8:45–48, 9:11–14 (the "identifying" element).[1] In its Response, Patent Owner argued that exemplary embodiments described in the '730 patent limited the "identifying" element by requiring specific types of information to be read into the "identifying" element. PO Resp. 30–36. We considered Patent Owner's arguments, construed the "identifying" element with particular reference to the '730 patent specification, explained our reasoning, and stated that the "identifying" element is 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 the Board overlooked portions of the '730 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 3–8. Patent Owner then repeats its argument that the "identifying" element *requires* specific types of information to be read into the claim element. *Id.* We do not agree that we misapprehended or overlooked the evidence identified by Patent Owner in its Response and

[1] Independent claims 7–11 contain similar elements. Ex. 1001, 9:52–55, 10:23–26, 10:57–60, 11:28–30, 12:16–19.

Rehearing Request. Rather, Patent Owner's Rehearing Request is an attempt to reargue the 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 excerpt and expert testimony of Dr. DiPiro and Dr. Valuck on which Patent Owner's Rehearing Request relies regarding the "information identifying patients" language. *Id.* at 18 (citing PO Resp. 30–33; Ex. 2046 ¶¶ 39–44; Ex. 1001 at 4:8–22; 8:4–5, 8:40–44, 10:20–23; Ex. 2044 at 97:11–98:5, 99:18–100:10); *id.* at 18–19 (citing PO Resp. 31; Ex. 1001 at 4:20–22, 8:4–5, Fig. 9; Ex. 2044 at 97:11–23, 99:18–100:10).[2] We did not "overlook" this evidence or consider only Figure 9 of the '730 patent specification regarding the identification of patients. *See* Req. Reh'g 3. We further stated that, rather than limiting our analysis to Figure 9,

> *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

[2] Patent Owner cited to the Abstract of the '730 patent in support of its proposed claim construction. PO Resp. 33, 36; Req. Reh'g 5, 8. 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.

> fails to contain 'information identifying the patient,' as recited in the claims.

Dec. 19 (emphasis added).

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 requests [for GHB] containing information identifying patients' to refer to information identifying a patient, which may include [Patent Owner's specifically listed information], 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 (citing Ex. 2044, 97:11–98:5, 99:18–100:10; Ex. 2046 ¶¶ 39–44). We did the same for the "information identifying . . . any and all medical doctors" 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 prescription fails to contain information regarding "various credentials," as recited in the claims.

Id. at 20–21 (citing PO Resp. 33–36; Ex. 1001, 2:22–24, 2:41–42, 4:7–8, 4:8–14, 4:18–20, 4:20–22, 4:7–5:67, 8:4–7, 8:40–44, 10:20–23, Figs. 2A–C

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