

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COALITION FOR AFFORDABLE DRUGS VI LLC,

Petitioner,

v.

CELGENE CORPORATION

Patent Owner

Case IPR2015-01096

Patent 6,315,720

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

TABLE OF CONTENTS

	<u>Page</u>
I. STATEMENT OF RELIEF REQUESTED	1
II. LEGAL STANDARD	1
III. PTAB OVERLOOKED AND/OR MISAPPREHENDED EVIDENCE AND ARGUMENT SHOWING THAT PETITIONER FAILED TO CARRY ITS BURDEN ON CLAIM 10	2
IV. CONCLUSION	4

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner Celgene Corporation

(“Celgene”) submits this Request for Rehearing in response to the Final Written Decision entered October 26, 2016 (Paper 73) (“Final Decision”) by the Patent Trial and Appeal Board (“PTAB”) regarding U.S. Patent No. 6,315,720 (“the ’720 patent”).

I. Statement of Relief Requested

In the Final Decision, the PTAB held that the claims of the ’720 patent are unpatentable as obvious over Thalomid PI (Ex. 1006) in view of Cunningham (Ex. 1009), and further in view of Keravich (Ex. 1018), Zeldis (Ex. 1012), and Mundt (Ex. 1024). *See* Final Decision at 34.

In doing so, the PTAB overlooked and/or misapprehended Celgene’s evidence and argument showing that claim 10 of the ’720 patent would not have been obvious. Accordingly, Celgene respectfully requests that the PTAB vacate its decision with respect to claim 10, and confirm the patentability of that claim.

II. Legal Standard

“A party dissatisfied with a decision may file a single request for rehearing” that “specifically identif[ies] 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).

III. PTAB Overlooked and/or Misapprehended Evidence and Argument Showing that Petitioner Failed to Carry its Burden on Claim 10

Celgene respectfully submits that the PTAB overlooked and/or misapprehended Celgene's evidence and argument showing that Petitioner failed to carry its burden of proving claim 10 of the '720 patent obvious. As explained in the Patent Owner Response (Paper 40, "Response"), claim 10 requires obtaining the results of genetic testing from patients. *See* Response at 45-46.

The PTAB held that this claim would have been obvious allegedly because "genetic testing was a known diagnostic procedure as of the effective filing date," and because a geneticist spoke at an FDA Meeting where thalidomide was discussed. *See* Final Decision at 27-28.

While the PTAB noted Celgene's argument that the "references of record do not disclose or suggest genetic testing" (*id.* at 27), the PTAB did not address, and therefore overlooked, Celgene's evidence and argument in the Response demonstrating that the references of record did "disclos[e] various other types of tests,"—but *not* genetic testing—which "undermines Dr. Fudin's opinion that [genetic] testing was 'common.'" *See* Response at 46; *see also* Ex. 1006 at 2,10, 11-12; Ex. 1018 at 1722; Ex. 1012 at 319, 322; Ex. 2059 ¶¶99; Ex. 2060 ¶¶101-02 (cited in Response at 46). The PTAB also did not address, and therefore overlooked, the controlling case law in Celgene's Response, which holds that

Dr. Fudin's unsupported opinion that genetic testing was common, is entitled to little weight, if any. *See* Response at 46.

Instead, the PTAB improperly placed the burden on Celgene, finding that Celgene allegedly "did not dispute that genetic testing was known in the art for obtaining diagnostic information." Final Decision at 27. In doing so, Celgene respectfully submits that the PTAB misapprehended Celgene's argument and misapplied the relevant law. *First*, Celgene did, in fact, dispute that genetic testing was either known in the art or "common." *See* Response at 45-46. *Second*, the burden was on Petitioner to prove that genetic testing was known, not on Celgene to prove that genetic testing was not known. As explained in the Response, Petitioner did not provide any evidence showing that genetic testing would be used, let alone that it would have been common. *See id.*

Further, the PTAB misapprehended Petitioner's evidence regarding the geneticist's statement at the FDA meeting. *See* Final Decision at 28 (citing Ex. 1013 at 137). Petitioner relied solely on a single passage of that statement (*see* Paper 52 at 25-26) that focuses on the geneticist acting as a clinical teratologist that might counsel patients on the risks of exposure. *See* Ex. 1013 at 137. Notably, the cited passage says *nothing* about genetic testing, nor does it suggest such testing. *See id.* Thus, Petitioner's evidence does not support its argument that claim 10 would have been obvious.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.