

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner,

v.

HORIZON THERAPEUTICS, INC.,
Patent Owner.

Case IPR2015-01117
Patent 8,642,012 B2

Before TONI R. SCHEINER, DEBORAH KATZ, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

ERRATA
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

An error was made on page 19 of our Decision on Institution (Paper 13) in that the '979 patent, although relied on in the body of the decision, was inadvertently omitted from the header of Section II.F. The error is corrected as follows:

F. Claims 6 and 11—Asserted Obviousness over Brusilow '91, Sherwin, Shiple, [and] Kasumov, and the '979 patent

Claims 6 and 11 depend from claims 1 and 8, respectively, and recite that the PAA prodrug is HPN-100.

Petitioner acknowledges that none of Brusilow '91, Sherwin, or Shiple discloses HPN-100 as the nitrogen scavenging drug.

However, Petitioner argues that it would have been obvious to substitute HPN-100 for NaPBA in Brusilow '91's method because Kasumov discloses that NaPBA may be toxic at high doses (Pet. 34 (citing Ex. 1015, 10, 13)), and because the '979 patent also discloses HPN-100, and teaches that such drugs are useful to treat patients with diseases of nitrogen accumulation.

Petitioner's contentions appear to be supported adequately on this record, and we are persuaded that Petitioner has demonstrated a reasonable likelihood of showing that claims 6 and 11 would have been obvious over Brusilow '91, Sherwin, Shiple, Kasumov, and the '979 patent.

A similar error was made on page 21 of our Decision on Institution, in that the '979 patent was inadvertently omitted from the Order in Section IV. The error is corrected as follows:

IV. ORDER

It is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to claims 1–12 of U.S. Patent No. 8,642,012 B2 on the following grounds of unpatentability:

Claims 1, 3, 4, 7, 8, 10, and 12 under 35 U.S.C. § 103 as unpatentable over Brusilow '91, Sherwin, Comte, and Shiple;

claim 5 under 35 U.S.C. § 103 as unpatentable over Brusilow '91, Sherwin, Shiple, and Fernandes;

claims 2 and 9 under 35 U.S.C. § 103 as unpatentable over Brusilow '91, Sherwin, Shiple, and the '647 patent; and

claims 6 and 11 under 35 U.S.C. § 103 as unpatentable over Brusilow '91, Sherwin, Shiple, [and] Kasumov, and the '979 patent.

It is

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision; and

FURTHER ORDERED that no other grounds of unpatentability are authorized for this *inter partes review* other than those identified above.

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