

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERIGEN PHARMACEUTICALS LIMITED,
Petitioner

v.

JANSSEN ONCOLOGY, INC.,
Patent Owner

Case IPR2016-00286
Patent 8,822,438 B2

Before LORA M. GREEN, RAMA G. ELLURU, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

A conference call in the above proceeding was held on February 16, 2016, amongst respective counsel for Petitioner, Amerigen Pharmaceuticals, Ltd., and Patent Owner, Janssen Oncology, Inc., and Judges Green, Elluru, and Kalan. Patent Owner requested the call to seek authorization to file a motion to exclude the declaration of Petitioner's expert ("declaration") and related arguments in the petition addressing the commercial success of U.S. Patent No. 8,882,438. In the alternative, if the Board did not grant Patent Owner's request to file a motion to exclude the declaration and related arguments, Patent Owner requested authorization to submit a new declaration of its own with its preliminary response to address Petitioner's commercial success arguments.

During the teleconference, Patent Owner argued that the declaration on commercial success referred to documents that were not prior art patents and printed publications, and was improper under 35 U.S.C. § 311(b). This provisions reads as follows: "[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents and printed publications." Thus, Patent Owner contended that the declaration and related arguments on commercial success should be excluded. In the alternative, Patent Owner argued that if the Board were going to consider commercial success at the Decision on Institution stage, it should have opportunity "in the interests of justice" to submit new testimonial evidence in support of its preliminary response to address Petitioner's arguments relating to commercial success.

We denied Patent Owner's request for authorization to file a motion for the following reasons. We may or may not address commercial success

in our Decision on Institution, which is merely a preliminary decision if we institute trial. Furthermore, the underlying factual considerations in a 35 U.S.C. § 103 obviousness analysis include secondary considerations of nonobviousness, such as commercial success. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). There is no authority for excluding Petitioner’s arguments and evidence addressing commercial success at the petition stage. Moreover, as Petitioner notes, the petition is the first and last chance for a petitioner to present its case. Subsequent to an institution of trial, a petitioner can only submit responsive argument and evidence. In addition, under our current rules, a patent owner may not submit new testimonial evidence in support of its preliminary response. If we do institute a trial, Patent Owner may submit testimonial evidence in support of its Response.

IT IS:

ORDERED that Patent Owner’s request for authorization to file a motion to exclude Petitioner’s declaration and related arguments addressing commercial success, or in the alternative, to submit testimonial evidence in support of its preliminary response, is denied.

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