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Date Filed: June 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMERIGEN PHARMACEUTICALS LIMITED,  
Petitioner

v.

JANSSEN ONCOLOGY, INC.,  
Patent Owner

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Case IPR2016-00286  
Patent 8,822,438 B2

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**PATENT OWNER'S REQUEST FOR RECONSIDERATION  
PURSUANT TO 37 C.F.R. § 42.71(c)**

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Patent Owner Janssen Oncology, Inc. (“Janssen”) hereby requests rehearing pursuant to 37 C.F.R. § 42.71(c) of the Board’s decision to institute an *inter partes* review of claims 1-20 of U.S. Patent No. 8,822, 438 (“the ‘438 patent”) (Paper No. 14) (“Decision”) on the basis that:

(1) the Decision overlooks the petitioner’s failure to proffer any evidence on the necessary element of administering a “therapeutically effective amount of prednisone,” as well as petitioner’s repeated admissions that this element, as properly construed by the Board to require an anti-cancer effective amount of prednisone, is neither taught nor suggested by the prior art; and

(2) the Decision fails to appropriately credit the Patent Office’s prior finding of commercial success, instead inappropriately crediting petitioner’s declaration refuting that finding, notwithstanding the statutory prohibition against instituting an *inter partes* review based on anything other than prior art patents and publications.

As a result of these errors, the Board fails to properly apply the standard set forth in 35 U.S.C. § 314(a). Accordingly, the Board should grant rehearing and decline to institute *inter partes* review of claims 1-20 of the ‘438 patent.

## **I. SUMMARY**

The inventors of the ‘438 patent discovered that the combination of administering a therapeutically effective amount of prednisone together with a

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