UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,

Petitioner

v.

HORIZON THERAPEUTICS, LLC,

Patent Owner

Case IPR 2016-00829

Patent 9,095,559

PATENT OWNER'S REQUEST FOR REHEARING OF THE DECISION TO INSTITUTE TRIAL

37 C.F.R. 42.71(c)

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I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71(c) Horizon Therapeutics, LLC ("Horizon" or "Patent Owner") respectfully requests a rehearing in response to the Decision, Institution of *Inter Partes* Review of U.S. Patent No. 9,095,559 ("Decision") (Paper No. 13).

On September 30, 2016, the Board authorized the institution of this *inter partes* review ("IPR") of claims 1-15 of U.S. Patent No. 9,095,559 ("the '559 patent") on the two grounds presented in the petition: (1) obviousness of claims 1, 2, 4, 5, 7-10, 12, and 13 over Blau, Simell and the '859 Publication and (2) obviousness of claims 3, 6, 11, 14, and 15 of the '559 patent over Blau, Simell, the '859 Publication and Brusilow '84. *See* Decision at 18. Patent Owner respectfully requests reconsideration of the Board's decision to institute on both grounds.

This Request for Rehearing on behalf of the Patent Owner is filed within 14 days of the Decision (Paper No. 13) and is timely under 37 C.F.R. § 42.71.

II. LEGAL STANDARDS

Pursuant to 37 C.F.R. § 42.71(d), a request for rehearing "must specifically identify 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."

"When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). "An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Stevens v. Tamai*, 366 F.3d 1325, 1330 (Fed. Cir. 2004) (citing *Eli Lilly & Co. v. Bd. Of Regents of the Univ. of Wash*., 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)). "A decision based on an erroneous view of the law . . . 'invariably constitutes an abuse of discretion.'" *Atl. Research Mktg. Sys. v. Troy*, 659 F.3d 1345, 1359 (Fed. Cir. 2011) (citing *United States v. Bradshaw*, 281 F.3d 278, 291 (1st Cir. 2002).

III. BASIS FOR RELIEF REQUESTED

The Patent Owner requests reconsideration of both grounds of the Decision to institute IPR of claims 1-15 of the '559 patent because the Board erred as a matter of law in instituting review in reliance on expert testimony in place of prior art.

IV. ARGUMENT

The Board committed an abuse of discretion in instituting IPR in this case because its obviousness analysis erroneously relies on the testimony of Petitioner's expert, Dr. Vaux, to supply a claim element that is absent from the prior art.

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