UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner

v.

BOEHRINGER INGELHEIM INTERNATIONAL GMBH,
Patent Owner.

Case IPR2016-01566
Patent 9,173,859 B2

PETITIONER MYLAN PHARMACEUTICALS INC.'S MOTION FOR REHEARING UNDER 37 C.F.R. § 42.71

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REGULATIONS

Petitioner Mylan Pharmaceuticals Inc. respectfully requests rehearing of the Board's February 3, 2017 decision denying *inter partes* review of claims 1–22 (collectively the "Challenged Claims") of U.S. Patent No. 9,173,859 (the "'859 patent") as obvious based on Petitioner's Ground 3.[1] (Paper 15 at 2). Rehearing is warranted because the Board's decision was based on an incorrect legal standard for obviousness.[2]

I. INTRODUCTION

Under Federal Circuit precedent, the Challenged Claims are presumed obvious because the claimed linagliptin dosages (2.5 mg and 5.0 mg) fall squarely within the prior art range disclosed in the '510 Publication (Ex. 1003), and Patent Owner did not meet its burden to overcome this presumption. *See Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 737–38 (Fed. Cir. 2013) (Patent Owner has burden of overcoming obviousness presumption "where there is a range disclosed in the prior art, and the claimed invention falls within that range."). For at least this

[1] The Board denied *inter partes* review of claims 1–22 as obvious over the '510 Publication (Ex. 1003) and Glucophage Label (Ex. 1004) (Ground 1) and of claims 14 and 20 as anticipated by the '510 Publication (Ground 2). (Paper 15 at 9, 13). Petitioner does not seek rehearing of the Board's decision on Grounds 1 and 2.

[2] On February 17, 2017 Petitioner requested rehearing in IPR2016-01563 (the "Companion IPR") concerning the '859 patent's parent, U.S. Patent No. 8,673,927. The '927 and '859 patents share the same specification and each claims methods of administering specified dosages and/or dosage ranges of linagliptin and metformin.

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