

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MONOSOL RX, LLC
Petitioner

v.

ICOS CORPORATION
Patent Owner

IPR2017-00412
Patent No. 6,943,166

**PATENT OWNER'S OPPOSITION TO PETITIONER'S REQUEST FOR
REHEARING**

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I. Mere Disagreement with the Outcome is Insufficient

Petitioner's Request for Rehearing ("Request") is premised on disagreement with the Board's finding that the Petition improperly rests on general guidance and alleged "common sense." (*See* Req. at 4; Dec. at 9.) The Request necessarily fails because "it is not an abuse of discretion to have performed an analysis or reached a conclusion with which Petitioner disagrees." *Sophos, Inc. v. Finjan, Inc.*, IPR2015-01022, Paper 9 at 3-4 (PTAB Jan. 28, 2016). Even if the Request was not so flawed, denial would still be appropriate based on the numerous reasons in Patent Owner's preliminary response (Paper 9) and the Board's decision (Dec. at 8-11). The deficiencies are in the Petition, not in the Board's understanding or analysis.

II. The Board Did Not Overlook Dr. Williams's Declaration

Monosol falsely asserts that the Board "failed to address [Dr. Williams's (Ex. 1010)] declaration entirely in its analysis." (Req. at 3, 4.) Not only did the Decision expressly cite Ex. 1010, the Decision cites the Petition where it relied on Ex. 1010. (*See e.g.*, Dec. at 4 (citing Ex. 1010), 8 (citing Pet. at 15, 22, 27, and 38).) Nor would it have been an abuse of discretion to give more weight to the prior art than to the conclusory Williams Declaration. *See Velandier v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (no abuse of discretion in giving little weight to broad conclusory expert statements); *Daicel Corp. v. Celanese Int'l Corp.*, IPR2014-01514, Paper 15 at 8 (PTAB June 26, 2015) (persuasiveness of expert

testimony assessed in light of other factual evidence); (Paper 9 at 17, 25, 33).

Instead of specifying what was allegedly overlooked, the Request rehashes the flawed Williams declaration without identifying where the arguments were previously raised in the Petition. This failure is sufficient reason alone to deny the Request. 37 C.F.R. §42.71(d). Nevertheless, nothing was overlooked:

1. Petitioner’s argument regarding “market pressure . . . and the design need to avoid side effects,” (Req. at 3, citing Pet. at 10) was addressed in the Decision on pages 8 and 9, citing the Petition, including page 10. These conclusory arguments are also not *specific* guidance overlooked that would cause one of ordinary skill to limit the tadalafil dose to 20 mg per day. (Paper 9 at 25-26.)

2. The Request quotes Dr. Williams’s declaration at ¶¶166 and 167 regarding “obvious to try” and further asserts that the Decision “does not address the obvious to try argument at all.” (Req. at 4, 12.) This is false. The Board *specifically* addressed this argument (“Petitioner argues that the claimed range would have been obvious to try”), considered Dr. William’s assertions regarding “reasonable, response guided titration steps” and “finite number of identified, predictable solutions,” and found it all unpersuasive. (Dec. at 8-9.) The Decision even quotes *In re O’Farrell*, an “obvious to try” case. (*Id.*) Regardless, the Request does not cure the Petition’s failure to address expectation of success. (Paper 9 at 30.)

3. The Request argues that the Board’s finding of a lack of specific, persuasive

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