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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARGENTUM PHARMACEUTICALS LLC,
Petitioner,

v.

CIPLA LTD.,
Patent Owner.

Case IPR2017-00807
Patent 8,168,620 B2

Before JAMES T. MOORE, ZHENYU YANG, and
KRISTI L. R. SAWERT, *Administrative Patent Judges.*

SAWERT, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Argentum Pharmaceuticals LLC ("Petitioner") filed a Petition for an *inter partes* review of claims 1, 4–6, 24–26, 29, and 42–44 of U.S. Patent No. 8,168,620 B2 ("the '620 patent," Ex. 1001). Paper 2 ("Pet."). The Board instituted an *inter partes* review of claims 1, 4–6, 24–26, 29, and 42–44 on the ground of obviousness over Hettche,[1] Phillips,[2] and Segal,[3] and on the ground of obviousness over Hettche, Phillips, Segal, and the Flonase Label.[4] Paper 11 ("Instit. Dec."), 27. The Board declined to institute an *inter partes* review of claims 1 and 25 on Petitioner's proposed ground of anticipation by Segal. *Id.* at 14. Petitioner now files a Request for Rehearing on that ground. Paper 13 ("Rehearing Request" or "Reh'g Req."). For the following reasons, we deny Petitioner's Rehearing Request.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters it believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id*. When rehearing a decision on petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of

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[1] Helmut Hettche, U.S. Patent No. 5,164,194 (Nov. 17, 1992) ("Hettche"). Ex. 1007.

[2] Gordon H. Phillipps, et al., U.S. Patent No. 4,335,121 (Jun. 15, 1982) ("Phillipps"). Ex. 1009.

[3] Catherine A. Segal, Int'l Publication No. WO 98/48839 (Nov. 5, 1998) ("Segal"). Ex. 1012.

[4] FLONASE® (fluticasone propionate) Nasal Spray, 50 mcg Product Information (Dec. 1998) ("Flonase Label"). Ex. 1010.

discretion occurs when a "decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment." *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. DISCUSSION

Petitioner requests rehearing the decision declining to institute review on the ground of anticipation by Segal. Petitioner contends that the Board misapplied the applicable law and misapprehended the prior art in finding that Segal "literally discloses more than 800 million combinations within its broad genus," rather than the 54 combinations cited in the Petition. Reh'g Req. 1 (quoting Instit. Dec. 13). In particular, Petitioner asserts that the Board's finding "disregard[s] the express preferences set forth in Segal's specification" and ignores the "preferred embodiments" identified in Segal's claims. *Id.* at 1–2. Petitioner also asserts that this finding led the Board to incorrectly determine that Segal does not anticipate the challenged claims. *Id.* at 2.

A. The Scope of Segal's Disclosure

In declining institution of an *inter partes* review of claims 1 and 25 over Segal, the Board found that Petitioner had not shown sufficiently, for the purpose of institution, that an ordinarily skilled artisan would immediately envision from Segal's disclosure the combination of fluticasone propionate and azelastine, as recited in the challenged claims. Instit. Dec. 11. Specifically, the Board was not persuaded by Petitioner's assertion that Segal discloses the combination of fluticasone propionate and azelastine as one of "at most 54 discrete compositions." *Id.* at 11–13 (citing Pet. 19).

The Board explained that Petitioner arrived at the "54 discrete components" number by improperly multiplying the number of anti-inflammatory agents recited in claim 2 by the number of antihistamines recited in claim 4 (i.e., 6 x 9 = 54). *Id.* at 13. The Board was not persuaded by this analysis, in part, because claim 4 of Segal depends from claim 1, instead of claim 2. *Id.*

In its Request for Rehearing, Petitioner asserts that Segal does, in fact, disclose a "small[] genus of 54 compositions." Reh'g Req. 7. Petitioner points out that Segal discloses 6 preferred topical anti-inflammatory agents, of which fluticasone propionate is one. *Id.* at 8 (citing Ex. 1012, 2:23–26, 5 (claim 2)). Petitioner also points out that Segal identifies azelastine as one of 9 preferred antihistamines. *Id.* (citing Ex. 1012, 3:19–20, 5 (claim 4)). Petitioner contends that the Board "erred by not finding that Segal discloses merely 54 readily envisioned compositions." *Id.* at 7.

We remain unpersuaded that Segal discloses a limited genus of "at most 54" compositions, Pet. 19, such that the claimed composition would be immediately envisioned by an ordinarily skilled artisan. Although Segal discloses 6 topical anti-inflammatory agents and 9 antihistamines, Segal also discloses 4 vasoconstrictors, 3 antiallergic agents, 1 anticholinergic agent, 3 anesthetics, 3 mucolytic agents, 3 leukotriene inhibitors, and 1 neuraminidase inhibitor. *See* Instit. Dec. 11–12 (citing Ex. 1012, 2:23–26, 3:3–9, 5 (claims 1 and 2)). Petitioner fails to explain persuasively how Segal expresses a preference for the particular combination of a topical anti-inflammatory agent and an antihistamine over the other possible combinations encompassed in Segal's broad disclosure. *See In re Petering*, 301 F.2d 676, 681 (CCPA 1962) (affirming finding of anticipation where

prior art set forth a "pattern of . . . specific preferences in connection with [a] generic formula" so as to "constitute[] a description of a definite and limited class of compounds"). Thus, we are not persuaded that Segal discloses "merely 54 readily envisioned compositions," as Petitioner contends. Reh'g Req. 7.

Also in its Request for Rehearing, Petitioner alleges that the Board erred by failing to consider Segal's disclosure of 6 preferred anti-inflammatory agents and 9 antihistamines as a "*starting point* for an anticipation analysis under § 102." Reh'g Req. 10 (emphasis added). We are not persuaded that the Board erred, because that "starting point" is in our view likely the product of hindsight. *See In re Ruschig*, 343 F.2d 965, 974 (CCPA 1965) (criticizing "the mechanistic dissection and recombination of the components of the specific illustrative compounds in every chemical reference containing them, to create hindsight anticipations with the guidance of an applicant's disclosures").

Specifically, the Petition highlighted claims 2 and 4 of Segal to create a genus of "at most 54" compositions encompassing the combination of fluticasone propionate and azelastine, Pet. 18–19, but did not address all other compositions recited in Segal's other claims, i.e., claim 3 (four vasoconstrictors), claim 5 (three antiallergic agents), claim 6 (one anticholinergic agent), claim 7 (three anesthetics), claim 8 (three mucolytic agents), claim 9 (three leukotriene inhibitors), and claim 10 (one neuraminidase inhibitor). Ex. 1012, 5–6. Petitioner did not adequately explain in the Petition why those compositions should be disregarded.

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