

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTAVIS LLC,
Petitioner,

v.

ABRAXIS BIOSCIENCE LLC,
Patent Owner.

Case IPR2017-01101
Patent 7,820,788 B2

Before JEFFREY N. FREDMAN, RAMA G. ELLURU, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Petitioner Actavis LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–12 (the “challenged claims”) of U.S. Patent No. 7,820,788 B2 (Ex. 1001, “the ’788 patent”). Patent Owner Abraxis Bioscience, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims of the ’788 patent. Therefore, we institute an *inter partes* review for claims 1–12 of the ’788 patent.

B. Related Proceedings

Petitioner indicates that the ’788 patent was asserted in *Abraxis BioScience, LLC v. Actavis LLC*, 2:16-cv-09074-JMV-MF (D.N.J. April 6, 2016), and in *Abraxis BioScience, LLC v. Cipla Ltd.*, 2:16-cv-09074-JMV-MF (D.N.J. Dec. 7, 2016). Pet. 4–5; Paper 4, 2. Petitioner has also filed three additional requests for *inter partes* review of other patents owned by Abraxis, two of which are related to the ’788 patent: IPR2017-01100 (involving U.S. Patent No. 8,853,260 B2); IPR2017-01103 (involving U.S.

IPR2017-01101
Patent 7,820,788 B2

Patent No. 7,923,536 B2); and IPR2017-01104 (involving U.S. Patent No. 8,138,229 B2). Pet. 5.

C. The '788 Patent (Ex. 1001)

The '788 patent involves methods of formulating pharmaceuticals with carriers to “reduce one or more side effects.” Ex. 1001, 3:55–62. Such methods specifically involve formulating taxol (paclitaxel), an agent active against carcinomas, (*id.* at 4:31–33), with albumin, a protein found in human plasma (*id.* at 5:7–18).

The '788 patent specifically prefers that the composition “have a particle or droplet size less than about 200 nanometers” (*id.* at 9:52). The '788 patent states that:

While the ratio of protein to pharmaceutical agent will have to be optimized for different protein and pharmaceutical agent combinations, generally the ratio of protein, e.g., albumin, to pharmaceutical agent is about 18:1 or less (e.g., about 15:1, about 10:1, about 5:1, or about 3:1). More preferably, the ratio is about 0.2:1 to about 12:1. Most preferably, the ratio is about 1:1 to about 9:1.

Id. at 11:60–67. The '788 patent also prefers a formulation “essentially free of cremophor” because “cremophor typically is used as a solvent for paclitaxel, and is associated with side effects that can be severe” (*id.* at 12:1–6).

D. Illustrative Claims

Of the challenged claims, claim 1 is the sole independent claim of the '788 patent. The remaining challenged claims 2–12 depend directly or indirectly from claim 1. Claim 1 is illustrative of the challenged claims and recites:

1. A pharmaceutical composition for injection comprising paclitaxel and a pharmaceutically acceptable carrier, wherein the pharmaceutically acceptable carrier comprises albumin, wherein the albumin and the paclitaxel in the composition are formulated as particles, wherein the particles have a particle size of less than about 200 nm, and wherein the weight ratio of albumin to paclitaxel in the composition is about 1:1 to about 9:1.

Ex. 1001, 38:17–24.

E. The Asserted Grounds of Unpatentability

Petitioner contends that the challenged claims are unpatentable based on the following grounds and asserted references. Pet. 1–4, 6.

References	Basis	Claims Challenged
Desai ¹	§ 102(b)	1–9, 11–12
Desai	§ 103(a)	1–12
Desai, Kadima, ² and Liversidge ³	§ 103(a)	1–12

Petitioner relies also on the Declaration of Cory Berkland, Ph.D. Pet. 1–60; *see* Ex. 1002.

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest

¹ WO 99/00113 A1, published Jan. 7, 1999 (Ex. 1006, “Desai”).

² WO 00/06152 A1, published Feb. 10, 2000 (Ex. 1004, “Kadima”).

³ US 5,399,363, issued Mar. 21, 1995 (Ex. 1005, “Liversidge”).

reasonable interpretation approach, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We determine that the following claim language needs to be discussed.

1. “*the weight ratio of albumin to paclitaxel in the composition*”

Petitioner offers an interpretation of the claim phrase “the weight ratio of albumin to paclitaxel in the composition” and “the ratio (w/w) of albumin to the paclitaxel in the pharmaceutical composition” as “at least the albumin-paclitaxel ratio in the starting ingredients used to make the composition.” Pet. 18, 20 (citing Ex. 1002 ¶ 53). Petitioner states a “skilled artisan reading [the ’788 patent’s] examples would understand that the ‘ratio of albumin to paclitaxel’ was based on the amounts used to make the composition.” Pet. 19 (citing Ex. 1002 ¶ 36).

Patent Owner disagrees, and offers an interpretation that the “claimed ratio term should be construed to mean the weight ratio of albumin-to-paclitaxel in the *finished* pharmaceutical composition for injection.” Prelim. Resp. 10 (emphasis added). Patent Owner states

the claim requires that the ratio be of the albumin to paclitaxel “in the composition,” and that “composition” is plainly the “pharmaceutical composition for injection”—*i.e.*, the finished pharmaceutical product. (*Id.*, claim 1). . . . Thus, based on the plain claim language, the ratio refers to the claimed finished pharmaceutical product, not the albumin and paclitaxel starting materials prior to the formation of the nanoparticles.

Prelim. Resp. 11. Patent Owner notes “the prosecution history confirms this construction. . . . The Examiner . . . understood that the 9:1 ratio was

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.