

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.

Petitioner

v.

UNITED THERAPEUTICS CORP.

Patent Owner

Patent No. 9,358,240

Issue Date: June 7, 2016

Title: TREPROSTINIL ADMINISTRATION BY INHALATION

Inter Partes Review No. 2017-01621

**PATENT OWNER REPLY TO PETITIONER'S RESPONSE TO
REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71**

TABLE OF CONTENTS

I. INTRODUCTION..... 1

II. ARGUMENT..... 1

A. Petitioner cannot manufacture a genuine issue of material fact with speculation 1

B. There is no legal requirement to analyze inventorship in order to disqualify Ghofrani as prior art “by another.” 4

III. CONCLUSION..... 5

TABLE OF AUTHORITIES

Cases

Applied Materials Inc. v. Gemini Research Corp.,
835 F.2d 279 (Fed. Cir. 1987)5

Emerachem Holdings, LLC v. Volkswagen Group of America, Inc.,
859 F.3d 1341 (Fed. Cir. 2017)2, 3

Ex parte Kroger,
Appeal No. 442-62 (BPAI November 22, 1982).....4

In re Katz,
687 F.2d 450 (CCPA 1982)1, 4

Nelson Prods., Inc. v. Bal Seal Eng’g, Inc.,
IPR2014-00573 (PTAB September 29, 2014).....3, 4

Varian Med. Sysys. v. Wm. Beaumont Hosp.,
IPR2016-00163 (PTAB May 4, 2017).....3, 5

Regulations

37 C.F.R § 42.108(c).....2

I. INTRODUCTION

The Patent Trial and Appeal Board’s conclusion that Ghofrani was the work of another (Decision, 14) was premised on an incorrect legal standard. Petitioner’s speculation and inapposite authority do not remedy this error.

II. ARGUMENT

A. Petitioner cannot manufacture a genuine issue of material fact with speculation

Patent Owner filed four sworn declarations from Ghofrani authors, both a named inventor and other authors, showing that Ghofrani is not prior art. Yet Petitioner argues that the authorship of a separate reference, Voswinckel, “contradict[s]” the declarations. Response, 4,6. Thus, Petitioner is arguing—based entirely on its own speculation about Voswinckel—that the four sworn declarations are untrue.

Petitioner’s speculation that Voswinckel’s authorship is inconsistent with Ghofrani’s cannot create a genuine issue of material fact as a matter of law. *In re Katz*, 687 F.2d 450, 455 (CCPA 1982) (“[J]oint inventorship cannot be inferred in the face of sworn statements to the contrary”). First, Ghofrani contains material concededly absent from Voswinckel, which makes Voswinckel’s authorship of little to no value in evaluating Ghofrani’s authorship. *See, e.g.*, Petition, 29. Second, even if Petitioner has raised a peripheral question about the naming of authors on Voswinckel, that does not contradict the authors’ testimony about who

“*contributed*” the relevant subject matter of Ghofrani. Ex. 2020, ¶ 7 (this material “was contributed” by Voswinckel and Seeger); Ex. 2026 at ¶ 5, Ex. 2027 at ¶ 5, and Ex. 2028 at ¶ 5 (Ghofrani, Reichenberger, and Grimminger “did not contribute” to this material). At best, Petitioner has raised a question about why certain authors were included on Voswinckel, but Petitioner has not presented a sufficient basis to dispute Patent Owner’s corroborated testimony about who contributed the relevant portion of Ghofrani. Thus, the Board was not obliged by 37 C.F.R. § 42.108(c) to resolve this issue in favor of Petitioner.

Furthermore, the Seeger Declaration directly addressed Petitioner’s speculation and establishes that the determination of authorship in Voswinckel is not a determination of inventorship. Ex. 2020, ¶¶10-11. Contrary to Petitioner’s assertion (Response, 5-6), the Board’s institution decision provides no indication that the Board considered this portion of the Seeger Declaration in view of Petitioner’s arguments.

Petitioner relies on *Emerachem Holdings, LLC v. Volkswagen Group of America, Inc.*, 859 F.3d 1341 (Fed. Cir. 2017), for the proposition that the four declarations are insufficient to disqualify Ghofrani as prior art because *Emerachem* supposedly requires contemporaneous documentary evidence to support the testimony of an interested party (*i.e.*, the inventor). Response, 4-5. But *Emerachem* did not require contemporaneous documentary evidence. In

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.