

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WATSON LABORATORIES, INC.
Petitioner,

v.

UNITED THERAPEUTICS, CORP.
Patent Owner.

Case IPR2017-01621
Patents 9,358,240 B2

Before TONI R. SCHEINER, ERICA A. FRANKLIN, and DAVID
COTTA,¹ *Administrative Patent Judges.*

COTTA, *Administrative Patent Judge.*

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

¹ Please note that the panel for this proceeding has changed, with Judge Scheiner replacing Judge Green.

I. INTRODUCTION

Watson Laboratories, Inc. (“Petitioner” or “Watson”) filed a Petition requesting an *inter partes* review of claims 1–9 of U.S. Patent No. 9,358,240 B2 (Ex. 1001, “the ’240 patent”). Paper 1 (“Pet.”). United Therapeutics Corp. (“Patent Owner” or “UTC”) filed a Preliminary Response to the Petition opposing institution. Paper 6 (Prelim. Resp.). On January 11, 2018, after consideration of the Petition and Preliminary Response, we entered a Decision granting institution of *inter partes* review. Paper 10 (“Dec.”). On January 25, 2018, Patent Owner filed a Request for Rehearing (Paper 14, “Req. Reh’g”) seeking reconsideration of our Decision.

For the reasons stated below, Patent Owner’s Request for Rehearing is denied.

II. ANALYSIS

Standard of Review

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be found if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes we misapprehended or overlooked. 37 C.F.R. § 42.71(d).

Background

Petitioner challenged claims 1–9 of the ’240 Patent under 35 U.S.C. § 103(a) as obvious over the combination of Voswinckel (Ex. 1003, “Voswinckel”), Patton (Ex. 1012, “Patton”), and Ghofrani (Ex. 1005, “Ghofrani”). We instituted *inter partes* review based on this ground. Dec. 38–39. We declined to institute *inter partes* review based on two additional grounds that relied upon different combinations of art. *Id.*

Patent Owner’s Request for Rehearing focuses on our determination that Petitioner provided sufficient evidence that Ghofrani was the work of another to institute *inter partes* review. Ghofrani is a journal article published in the June 2005 issue of *Herz*. Ex. 1005. Ghofrani lists as authors two persons identified on the face of the ’240 patent as inventors (Robert Voswinckel and Werner Seeger) as well as three non-inventors (Hossein Ardeschir Ghofrani, Frank Reichenberger, and Friedrich Grimminger). Ex. 1001, Ex.1005. The ’240 Patent lists as inventors five persons who are not listed as authors of Ghofrani (Horst Olschewski, Robert Roscigno, Lewis J. Rubin, Thomas Schmel, and Carl Sterritt). *Id.* Petitioner asserts that Ghofrani is a prior art printed publication under 35 U.S.C. § 102(a). Pet. 15-16. Patent Owner contends that Ghofrani does not qualify as prior art because it is not the work of “another.” Prelim. Resp. 21–24; Req. Reh’g 2–11.

Our Decision identified two factual disputes relating to the issue of whether Ghofrani constitutes the work of another with respect to the ’240 patent: 1) the extent to which Ghofrani represents the work of the five non-author inventors, and 2) the extent to which the three non-inventor authors contributed to the portion of Ghofrani relied upon by Petitioner. Dec. 13–

14. Viewing the declaratory evidence “in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review,” as required by 37 C.F.R. 42.108(c), we found that Petitioner’s evidence was sufficient to support institution. *Id.* Patent Owner’s Request for Rehearing challenges our findings with respect to both of the factual disputes we identified. Req. Reh’g. 2–11.

Legal Principles

“A [reference] is [considered] ‘to another’ when the ‘inventive entities’ are different.” *In re Fong*, 378 F.2d 977, 980 (CCPA 1967). A reference may be considered “by another” with respect to a patent even though they share common authors and/or inventors. *See In re Land*, 368 F.2d 866, 881 (CCPA 1966) (holding that individual applications to Land and to Rogers were prior art with respect to joint application to Land and Rogers). The determination of whether the disclosure in a reference is the work of another focuses on the authorship of the portions of the reference relied upon as prior art. *Riverwood Int’l Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1356 (Fed. Cir. 2003) (“What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity.”).

Contribution of Non-Author Co-Inventors

In our Decision, we found that a genuine issue of material fact exists regarding the extent to which Ghofrani represents the work of the five non-author inventors. Dec. 13–14. We analyzed the declarations provided by the Patent Owner and concluded that “[t]he declarations from the Ghofrani authors leave some ambiguity as to whether and to what extent the five

persons who were listed as inventors of the '240 patent, but who were not listed as authors of Ghofrani, contributed to the relevant portion of Ghofrani.” *Id.* at 13. In particular, we found ambiguity in Dr. Seegar’s statement that the work described in the relevant portion of Ghofrani “originated with Dr. Voswinckel and myself, *in view of* our work with the other inventors listed on the '240 patent.” *Id.* at 13–14 (citing Ex. 2020 ¶ 7) (emphasis added).

We continue to find ambiguity in Dr. Seegar’s statement. The phrase “in view of” is commonly understood to mean “taking into consideration” or “in consideration of.” Ex. 3005. Particularly when viewed “in the light most favorable to the petitioner,” Dr. Seegar’s testimony does not establish that the authorship entity for the relevant passage of Ghofrani is the same as the inventorship entity of the '240 patent (or any of its individual claims). Put another way, paragraph 7 of the Seegar Declaration could mean that the work of all of the inventors together merely informed, served as a starting point, provided inspiration, or even acted as a counter example for the work that “originated with Drs. Seegar and Voswinckel.” None of these interpretations would serve to disqualify Ghofrani as prior art.

Patent Owner argues that to disqualify Ghofrani as a prior art reference, “the patent owner needs only to provide declarations from non-inventor co-authors of the reference stating that they did not contribute to the relevant portion of the reference.” Req. Reh’g 4. We disagree. The inquiry as to whether a reference is the work of “another” is not limited to the contribution of the non-inventor co-authors. Rather, the inquiry is whether the inventive entities are the same for the relevant portion of Ghofrani and for the challenged claims of the '240 patent. *Fong*, 378 F.2d at 980; *Land*,

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