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 REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71



TABLE OF CONTENTS

I. INTRODU	JCTION	1
II. LEGAL S	STANDARD	2
III. ARGUM	ENT	2
A.	The Supreme Court's decision in SAS did not require the Board to institute trial on the additional grounds	2
B.	Grounds 2 and 3 fail to satisfy threshold statutory requirements	4
V CONCLUSION		6

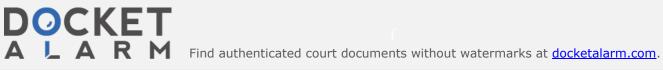


i

TABLE OF AUTHORITIES

Cases

Palo Alto Networks, Inc. v. Juniper Networks, Inc., IPR2013-00369 (PTAB Feb. 14, 2014)	2
SAS Institute Inc. v. Iancu, 584 U.S, 138 S. Ct. 1348 (2018) (April 24, 2018)	, 4, 6
SAS Institute, Inc. v. ComplementSoft, LLC, IPR2013-00226, (PTAB August 12, 2013)	6
Star Fruits S.N.C. v. United States, 393 F.3d 1277 (Fed. Cir. 2005)	2
Statutes	
35 U.S.C. § 102(a)	5
35 U.S.C. § 311(b)	2, 4, 5
35 U.S.C. § 312(a)(3)	5
35 U.S.C. § 316	6
35 U.S.C. § 318	3, 4
Rules	
37 C.F.R. § 42.1(b)	6
37 C.F.R. § 42.71(c)	1, 2
37 C.F.R. § 42.71(d)	1. 2



I. INTRODUCTION

United Therapeutics Corporation ("Patent Owner") respectfully requests, under 37 C.F.R. § 42.71(c) and (d), that the Patent Trial and Appeal Board ("Board") reconsider its decision instituting trial on additional grounds because that decision is based on a misinterpretation of SAS Institute Inc. v. Iancu, 584 U.S. _____, 138 S. Ct. 1348 (2018) and improperly institutes review based on references that are not patents or printed publications under 35 U.S.C. § 311(b). Specifically, the Board entered an Order on April 30, 2018 (Paper 42, hereinafter "Order") modifying the Decision Instituting *Inter Partes* Review of U.S. Patent No. 9,358,240 ("the '240 patent"), entered January 11, 2018 (Paper 10, hereinafter "Decision"). The Decision instituted trial as to whether claims 1–9 of the '240 patent would have been obvious over Voswinckel, Patton, and Ghofrani (Ground 1). The Order modifies the Decision to institute trial as to whether claims 1-9 of the '240 patent would have been obvious over two additional grounds:

- 1) Voswinckel, Patton, and the OptiNeb Manual (Ground 2); and
- 2) Voswinckel, Ghofrani, and the EU Community Register (Ground 3). In so doing, the Board interpreted *SAS* to require a final written decision on all grounds in a petition. Order, 2. Yet *SAS* requires a final written decision not on all grounds, but rather on all challenged *claims*, which will be achieved without instituting trial on the additional grounds. In addition, and as an independent basis



for rehearing, the two additional grounds rely on two new references that are not prior art patents or printed publications, contrary to 35 U.S.C. § 311(b), and thus cannot be the subject of a final written decision.

II. LEGAL STANDARD

A party may request rehearing of a Board institution decision. 37 C.F.R. § 42.71(d). "The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d). The Board will review the previous decision for an abuse of discretion. 37 C.F.R. § 42.71(c). "An abuse of discretion may be indicated 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." *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 39, 2–3 (PTAB Feb. 14, 2014) (citing *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005)).

III. ARGUMENT

A. The Supreme Court's decision in SAS did not require the Board to institute trial on the additional grounds

In the Order, the Board modifies the Decision to institute on all grounds identified in the Petition "[p]ursuant to the holding in SAS." Order, 2. The holding in SAS, however, did not impose any such requirement. Rather, SAS held that "the



DOCKET

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.

