

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.

Petitioner,

v.

GENENTECH, INC.

Patent Owner.

U.S. Patent No. 6,407,213

Inter Partes Review No. IPR2017-02032

**PETITIONER'S REQUEST FOR PARTIAL REHEARING OF THE BOARD'S
DECISION "INSTITUTION OF *INTER PARTES* REVIEW"**

I. Introduction

The Board denied institution of *inter partes* review of U.S. Patent 6,407,213 (“the ’213 patent”) based on Grounds 1-5—grounds that the Board (and even Patent Owner) admits are meritorious in that they are already at issue in other instituted IPRs. The Board found persuasive Patent Owner’s argument that, among other issues, denying these grounds would preserve the Board’s and Patent Owner’s resources. The Board also explained that Petitioner could have sought joinder with the previously instituted IPRs, but since it instead chose to file its own challenges to the ’213 patent, Petitioner lost its chance to argue the patentability of the ’213 patent claims on these grounds.

It is respectfully submitted that the Board’s decision is contrary to the purpose of IPR proceedings. The Board’s decision is also in tension with a recently issued decision from the Federal Circuit in which the Court acknowledged that parties may challenge the validity of a single patent on the same basis.

While the Board did institute IPR on one other ground (Ground 6), the Board’s decision leaves claim 72 of the ’213 patent unchallenged on any ground in this proceeding. Petitioner therefore requests a rehearing of the Board’s decision not to institute Grounds 1-5.

II. The Board’s Discretion Should Not Be Used to Deny Institution of Meritorious Grounds

The Board has recently designated several cases regarding its discretion not to institute a post grant review, including IPR and CBM, under 35 U.S.C. § 325(d) as “informative.” *Unified Patents, Inc. v. Berman*, IPR2016-01517, Paper 10 (PTAB 2016), denying institution based on art that had been overcome during prosecution; *Hospira, Inc. v. Genentech, Inc.*, IPR2017-00739, Paper 16 (PTAB 2017) (same); *Cultec, Inc. v. Stormtech LLC*, IPR2017-00777, Paper 7 (PTAB 2017) (same); *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586 (PTAB 2017) (same); *Kayak Software Corp. v. International Business Machines, Corp.*, CBM2016-00075 (PTAB 2016) (same).¹

In all of these cases, the grounds that were denied institution had been previously considered by the Office and been found wanting on the merits. This case is entirely different. The grounds that the Board denied institution have already been

¹ The Board has designated other cases on this topic “Informative.” Those other cases are not relevant here because they concern a petitioner filing a second petition with similar grounds to a first petition filed by that same petitioner. In *Unified Patents, Inc. v. PersonalWeb Techs., LLC*, IPR2014-00702, Paper 13 (PTAB July 24, 2014), the Board denied IPR based on a meritorious ground, but, unlike this case, that ground had already been seen to completion in the PTAB and was on appeal to the Federal Circuit at the time that the Board denied institution.

found by the Board to be meritorious, and as noted by the Board, form the basis for institution in IPR2017-01374 and IPR2017-01488. This denial therefore raises issues and implicates policies not present when the Board exercises its discretion to deny grounds that were already adjudged not to be meritorious. Specifically, the denial of institution in this case on the specified grounds has the potential to leave claims in force when those claims have already been found likely to be unpatentable.

The IPR process is designed to strengthen the patent system by weeding out weak patents and reaffirming the validity of strong patents. Having previously found that at least one claim of the '213 patent is likely to be found unpatentable under Grounds 1-5, the Board should make sure that it sees these grounds to completion with a fully developed record. Denying institution on Grounds 1-5 in Petitioner's petition gives rise to the possibility that if the parties to the other IPRs settle, these grounds will not get fully developed; indeed, the Board may never rule on the patentability of the '213 patent on these grounds. This is particularly problematic with respect to claim 72, which is not challenged on any ground currently instituted in this proceeding and, in the event of settlement of the other IPRs, may be left in force despite having been found likely to be unpatentable based on grounds raised by Petitioner.

For Petitioner, and the entire interested public, this presents real world consequences. Any later litigation between Patent Owner and Petitioner that

involves a product that is accused of infringing the '213 patent will have to analyze both infringement and validity of the '213 patent. Because of the realities of patent litigation concerning biologic products, which is governed by the Biologic Price Competition and Innovation Act, any litigation that may include the '213 patent could also include many other patents. *See, e.g., Genentech Inc. v. Pfizer, Inc.*, No. 17-165-GMS (D. Del) (BPCIA litigation concerning forty patents). This type of litigation, with multiple patents at issue, is costly to the parties and to the public. The Board here has a chance to simplify future litigation, and can do so consistent with its mandate by instituting Grounds 1-5. (“What the bill does...is very simple. It says the Patent Office will make an administrative determination before the years of litigation as to whether this patent is a legitimate patent so as not to allow the kind of abuse we have seen.” 157 Cong. Rec. S5437 (statement of Sen. Schumer during Senate consideration of H.R. 1249).)

The Federal Circuit has recently acknowledged that one party should not be precluded from arguing a meritorious ground simply because another party had previously raised that ground. In *Dell v Accelaron*, 884 F.3d 1364 (Fed. Cir. March 19, 2018), the court considered an appeal from a PTAB decision that was made on remand from an earlier Federal Circuit appeal. In the original final written decision, the Board had considered evidence that the petitioner raised for the first time during the oral hearing, and found the claims unpatentable. The patent owner appealed,

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