

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02032
Patent 6,407,213 B1

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Boehringer Ingelheim Pharmaceuticals, Inc. (“Petitioner”) filed a Petition for an *inter partes* review of claims 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71–73, 75–78, 80, and 81 of U.S. Patent No. 6,407,213 B1 (“the ’213 patent,” Ex. 1001). Paper 1 (“Pet.”). Petitioner challenged those claims under five obviousness grounds and one anticipation ground. Pet. 4. In a Decision, we instituted an *inter partes* review on the anticipation ground but denied the obviousness grounds. Paper 17 (“Dec.”). Petitioner filed a Request for Partial Rehearing of the Decision. Paper 21 (“Reh’g Req.”).

For the following reasons, we grant Petitioner’s request.

STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

DISCUSSION

In the Petition, Petitioner asserts the following grounds of unpatentability:

Ground	Claim(s)	Basis	Reference(s)
1	1, 2, 25, 29, 63, 66, 67, 71–73, 75–78, 80, 81	§ 103	Queen 1989 ¹ and Protein Data Bank (PDB database)
2	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71–73, 75–78, 80, 81	§ 103	Queen 1990 ² and PDB database
3	75–77	§ 103	Queen 1989, PDB database, and Tramontano ³
4	75–77	§ 103	Queen 1990, PDB database, and Tramontano
5	4, 62, 64, 69	§ 103	Queen 1989, PDB database, and Kabat 1987 ⁴
6	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 73, 75–78, 80, 81	§ 102	The '101 patent ⁵

Pet. 4.

¹ Queen et al., *A Humanized Antibody that Binds to the Interleukin 2 Receptor*, 86 PRO. NAT'L ACAD. SCI. 10029–33 (1989) (Ex. 1034).

² Queen et al., International Publication No. WO 90/07861 A1, published July 26, 1990 (Ex. 1050).

³ Tramontano et al., *Framework Residue 71 is a Major Determinant of the Position and Conformation of the Second Hypervariable Region in the VH Domains of Immunoglobulins*, 215 J. MOL. BIOL. 175–82 (1990) (Ex. 1051).

⁴ Kabat et al., *Sequences of Proteins of Immunological Interest* 4th Ed., Tabulation and Analysis of Amino Acid and Nucleic Acid Sequences of Precursors, V-Regions, C-Regions, J-Chain, T-Cell Receptor for Antigen, T-Cell Surface Antigens (National Institutes of Health, Bethesda, Md.) (1987) (Ex. 1052).

⁵ U.S. Patent No. 5,530,101, issued June 25, 1996 (Ex. 1136).

In the Decision, we institute an *inter partes* review to determine whether the '101 patent anticipate 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 73, 75–78, 80, and 81. Dec. 14. We, however, denied Petitioner's challenges on the five obviousness grounds. *Id.* at 8. We explained:

As Patent Owner correctly points out, Grounds 1–5 asserted in the Petition “are essentially identical to those already instituted in” IPR2017-01373 and IPR2017-01489. Prelim. Resp. 12–13. Petitioner filed this Petition before we issued the decisions instituting *inter partes* reviews in IPR2017-01373 and IPR2017-01489. Thus, Petitioner could have sought to join the pending IPRs. Yet, it did not do so. *See* 37 C.F.R. § 42.122. The time for requesting joinder has since expired. *See id.* As such, we exercise our discretion under § 325(d) and deny the Petition with respect to Grounds 1–5.

Id.

In its rehearing request, Petitioner argues that we previously instituted *inter partes* reviews on Grounds 1–5 in IPR2017-01373 and IPR2017-01489. Reh'g Req. 1. According to Petitioner, we should not use our discretion to deny meritorious grounds. *Id.* at 3. In addition, Petitioner points out that our Decision leaves claim 72 unchallenged. *Id.* at 1, 3.

After Petitioner filed its rehearing request, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, --- S. Ct. - ----, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). The Office issued a Guidance on the Impact of SAS on AIA Trial Proceedings. *See* <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

We grant Petitioner's partial rehearing request and institute an *inter parte* review on all of the challenged claims and all of the grounds presented in the Petition.

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to change the schedule beyond that permitted by stipulation under the scheduling order or submit further briefing, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Partial Rehearing is granted;

FURTHER ORDERED that an *inter partes* review is instituted on the following grounds:

1. claims 1, 2, 25, 29, 63, 66, 67, 71–73, 75–78, 80, and 81 as obvious over the combination of Queen 1989 and PDB database;
2. claims 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71–73, 75–78, 80, and 81 as obvious over the combination of Queen 1990 and PDB database;
3. claims 75–77 as obvious over the combination of Queen 1989, PDB database, and Tramontano;
4. claims 75–77 as obvious over the combination of Queen 1990, PDB database, and Tramontano;

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