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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 No. 6,407,213

PATENT OWNER'S REQUEST FOR REHEARING

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Genentech, Inc. (“Genentech”) respectfully requests, pursuant to 37 C.F.R. § 42.71(d), that the Board reconsider its May 8, 2018 decision (“May Institution Decision”) instituting *inter partes* review of previously-denied grounds in light of the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

Genentech recognizes the extremely high burden placed on movants seeking reconsideration and does not take this step lightly. Indeed, in the over 30 IPRs that have been filed by parties seeking to invalidate patents in Genentech’s Herceptin portfolio, this is the first motion for reconsideration that Genentech has filed. Genentech requests rehearing because, based on the unique facts presented by this and the numerous prior IPRs which have been instituted regarding U.S. Patent No. 6,407,213 (“the ’213 patent”), Genentech believes that the institution of Petitioner Boehringer Ingelheim Pharmaceuticals, Inc.’s (“Boehringer’s”) non-meritorious, previously-denied grounds rises to the level of an abuse of discretion that unfairly prejudices Genentech and does not comply with the Administrative Procedure Act (“APA”). Upon rehearing, Genentech requests that the Board vacate the May Institution Decision and deny Boehringer’s request for *inter partes* review of the ’213 patent in its entirety.

I. INTRODUCTION

On August 31, 2017, Boehringer filed two IPR petitions challenging numerous claims of the '213 patent: IPR2017-02032 (*i.e.*, the present petition) and IPR2017-02031. These two petitions were the *ninth and tenth* IPR petitions filed against the '213 patent.¹

Boehringer copied four grounds in its IPR2018-02031 petition from IPR2016-01693 (Mylan), IPR2017-01374 (Celltrion), and IPR2017-01488 (Pfizer), and copied five grounds in its IPR2017-02032 petition from IPR2017-01694 (Mylan), IPR2017-01373 (Celltrion) and IPR2017-01489 (Pfizer)—yet Boehringer strategically chose *not* to seek joinder with those earlier-filed proceedings.²

¹ The previous petitions include: IPR2016-01693 and IPR2016-01694, filed by Mylan Pharmaceuticals, Inc. (“Mylan”); IPR2017-01373 and IPR2017-01374, filed by Celltrion, Inc. (“Celltrion”); IPR2017-01488 and IPR2017-01489, filed by Pfizer, Inc. (“Pfizer”); and IPR2017-02139 and IPR2017-02140, filed by Samsung Bioepis Co., Ltd. (“Samsung”).

² After Boehringer filed its two petitions challenging the '213 patent, Samsung filed two petitions (IPR2017-02139 and IPR2017-02140), which copied the grounds in Pfizer's petitions (IPR2017-01488 and IPR2017-01489). Unlike Boehringer, Samsung sought joinder to Pfizer's previously-filed petitions, which the Board granted. (IPR2017-02139 (Paper 11); IPR2017-02140 (Paper 11).)

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