

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INITIATIVE FOR MEDICINES, ACCESS & KNOWLEDGE (I-MAK), INC.,
Petitioner,

v.

GILEAD PHARMASSET LLC,
Patent Owner.

IPR2018-00123
Patent 8,735,372 B2

Before TONI R. SCHEINER, GRACE KARAFFA OBERMANN, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Initiative for Medicines, Access & Knowledge (I-MAK), Inc. (“Petitioner”) filed a Petition (Paper 2 (“Pet.”)) to institute an *inter partes* review of claims 1 and 2 of U.S. Patent No. 8,735,372 B2 (Ex. 1001 (“the ’372 patent”)). Gilead Pharmasset LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Having considered the Petition, the Preliminary Response, and the evidence of record, and applying the standard set forth in 35 U.S.C. § 314(a), which requires that Petitioner demonstrate a reasonable likelihood that it would prevail with respect to at least one challenged claim; we *denied* Petitioner’s request and did not institute an *inter partes* review. Paper 7, 12 (“Decision” or “Dec.”).

Petitioner filed a Request for Rehearing (Paper 8 (“Reh’g Req.”)), requesting reconsideration of the Decision denying institution of *inter partes* review. Petitioner contends that we “misapprehended or overlooked that Sofia (Ex. 1012) is a printed publication.” Reh’g Req. 1.

We have considered Petitioner’s Request for Rehearing, and, for the reasons set forth below, Petitioner’s Request is *denied*.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision . . . may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. 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, opposition, or a reply.

See Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 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. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. DISCUSSION

Petitioner contends that “Patent Owner has never disputed that Sofia is a printed publication as of September 2007” and that “[t]he Board also did not dispute that Sofia was a printed publication” in “related matters [IPR2018-00119 and IPR2018-00121] where Sofia is also of record.” Reh’g Req. 1. Petitioner further maintains that our finding “that Sofia is not a printed publication . . . stands alone and contradicts both Patent Owner’s implicit concessions and the Board’s previous findings that it is.” *Id.*

Petitioner also files new exhibits (Exs. 1014–1017) with the Request and states that it “will seek leave to submit . . . [further] supplemental evidence.” *Id.* Petitioner relies on the newly submitted exhibits to support Petitioner’s assertion—first raised in its Request—that “Sofia was published on Patent Owner’s own website by at least October 5, 2007” (Reh’g Req. 1 (citing Ex. 1014)) or to document its efforts, subsequent to our Decision, to obtain such evidence or a stipulation by Patent Owner (Ex. 1015–1017).

As explained in the Decision, Petitioner failed to meet the threshold showing required for purposes of institution where there was neither evidence indicating that Sofia was published in print or electronic form, nor a showing as to the facts and circumstances of its putative disclosure as a poster necessary to identify it as a printed publication. Dec. 8–11.

Petitioner’s contention that Patent Owner implicitly conceded Sofia’s status as a printed publication, by not contesting the issue in the Preliminary Response, is misplaced. A patent owner is under no obligation to file a preliminary response, and a failure to raise an issue in a preliminary response does not establish a waiver or an admission of fact. On the contrary, Petitioner bears the burden of proof from the onset of sufficiently establishing facts to demonstrate a likelihood of prevailing at trial with respect to at least one challenged patent claim. Here, the Petition failed to direct us to evidence that shows sufficiently that Sofia constitutes a printed publication—any absence of argument or evidence in the Preliminary Response does not improve the showing made in the Petition. *See, e.g., Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity” by reference to the record “the evidence that supports the grounds for the challenge to each claim”)).

Petitioner’s further contention that the Board’s failures to dispute that Sofia is a printed publication in earlier IPR2018-00119 and IPR2018-00121, in effect, constitutes implied findings by the Board that it is a printed publication (Reh’g Req. 1), is offered without any supporting legal authority (*see generally id.*). The law of the case doctrine, however, is instructive in that while it “expresses the practice of courts generally to refuse to reopen

what has been decided,” *Messinger v. Anderson*, 225 U.S. 436, 444 (1912), it “is limited to issues that were actually decided, either explicitly or by necessary implication, in the earlier litigation,” *Toro Co. v. White Consol. Indus., Inc.*, 383 F.3d 1326, 1335 (Fed. Cir. 2004). In the prior proceedings cited by Petitioner, Sofia was determined to be unavailable as prior art because it was later in time than a priority application. IPR2018-00119, Paper 7, 10–12; IPR2018-00121, Paper 10, 11–12. That determination in the prior proceedings, however, is not a finding that Sofia was a printed publication, nor is it contrary to finding that it is not a printed publication.

As to Petitioner’s further arguments, a request for rehearing is not an opportunity to develop new arguments or direct us to new or additional evidence. Petitioner’s contentions and arguments grounded on newly submitted Exhibits 1015–1017 are, accordingly, untimely. If Petitioner wanted us to consider this, and any further, evidence in determining whether Petitioner made a threshold showing that Sofia is a prior art *printed publication*, it was incumbent on Petitioner to make those arguments and point us to that evidence in the Petition.

On this record, Petitioner neither persuades us that we overlooked or misapprehended any matter, nor sufficiently shows that denying *inter partes* review of claims 1 and 2 represents an abuse of discretion.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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