

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.

Case IPR2018-00125
Patent 8,633,309 B2

Before ERICA A. FRANKLIN, GRACE KARAFFA OBERMANN, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Initiative for Medicines, Access & Knowledge (I-MAK), Inc., requests reconsideration of the Board’s decision (Paper 9, “Dec.”) denying institution of *inter partes* review of claims 1–12 of U.S. Patent No. 8,633,309 B2 (Ex. 1001, “the ’309 patent”). Paper 10 (“Req. Reh’g). For the reasons discussed below, we deny the request for rehearing.

II. DISCUSSION

When rehearing a decision on a petition, 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., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d).

The Board did not overlook or misapprehend Petitioner’s arguments; the Board considered them, but was not persuaded by them. We briefly address Petitioner’s contentions below.

Analysis

Petitioner specifically requests rehearing of the Board’s denial of institution regarding the asserted ground of obviousness over Sofia ’634¹ and Congiatu.² Req. Reh’g 1. The Board denied institution of that asserted

¹Sofia et al., WO 2008/121634 A2, published Oct. 9, 2008 (“Sofia ’634”). Ex. 1005.

²C. Congiatu et al., *Novel Potential Anticancer Naphthyl Phosphoramidates of BVdU: Separation of Diastereoisomers and Assignment of the Absolute*

ground under 35 U.S.C. § 325(d). Dec. 12–18. Petitioner argues that Congiatu and the Declaration of Dr. Fortunak (Ex. 1002) are not cumulative to the evidence of record during prosecution, and directly rebut the Examiner’s unsupported sole reason for allowance. Req. Reh’g 2–7.

Congiatu

Petitioner argues that “the Board overlooked several of Congiatu’s teachings that are not present in Sofia ‘634 and are thus materially additive over the evidence that was of record during prosecution.” *See* Req. Reh’g 2–7. However, Petitioner’s request for rehearing fails to identify where in the Petition those additional teachings of Congiatu were addressed. *See* 37 C.F.R. § 42.71(d). Moreover, Petitioner’s arguments regarding Congiatu, that it relied on in the Petition, were expressly noted in the Decision as similar to Petitioner’s arguments regarding Sofia ’634. Dec. 16–17.

Dr. Fortunak’s Declaration

Petitioner argues that “the Board also erroneously misapprehended and overlooked Dr. Fortunak’s expert testimony.” *See* Req. Reh’g 5–6. To the contrary, the Board considered Dr. Fortunak’s declaration and accorded it appropriate weight. First, contrary to Petitioner’s contention, the fact that the Decision pointed out that Dr. Fortunak’s statement regarding unexpected results (Ex. 1002 ¶ 124) was verbatim to Petitioner’s argument (Dec. 16–17) does not mean the Board ignored Dr. Fortunak’s statement. Second, contrary to Petitioner’s contention that the Board did not cite any evidence contradicting Dr. Fortunak’s opinions, the Board cited extensively to the prosecution history – including the Reasons for Allowance – of the ’309

Configuration of the Phosphorus Center, J. MED. CHEM. 49, 452–55 (2006) (“Congiatu”). Ex. 1006.

patent. *See* Dec. 12–18. Finally, the fact that the Board noted that Dr. Fortunak’s statement regarding unexpected results (Ex. 1002 ¶ 124) was made “without citing evidentiary support” (Dec. 17) does not mean that the Board dismissed Dr. Fortunak’s opinions. *See* Req. Reh’g 5–6.

Petitioner further contends that the Board dismissed “Dr. Fortunak’s un rebutted expert testimony” in citing Patent Owner’s “conclusory attorney argument” of unexpected results. Req. Reh’g 6. To the contrary, the Board considered Dr. Fortunak’s testimony and found it unpersuasive, and further found no sufficient basis to reconsider the Examiner’s allowance of the ’309 patent. As we explained in the Decision, the Examiner’s reasons for allowance were based on test results disclosed in the specification of the ’309 patent and not mere attorney argument. *See* Dec. 12–18.

Notice of Allowance

Petitioner contends that “the Board misapprehended the Examiner’s finding in the Notice of Allowance that, ‘Applicant has discovered that the Sp enantiomer of the claimed compound is unexpectedly more potent in inhibiting HCV replication.’” Req. Reh’g 6–7, citing Dec. 14. To the contrary, the Board carefully considered the prosecution history and the examiner’s reasons for allowance. Furthermore, the Board found that Dr. Fortunak’s declaration and Petitioner’s arguments regarding the Congiatu reference were not sufficiently persuasive to justify a reconsideration of the Examiner’s decision. *See* Dec. 12–18.

III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion in denying institution on the basis of 35 U.S.C. § 325(d) as to the asserted

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ground of obviousness over Sofia '634 and Congiatu. Accordingly,
Petitioner's request for rehearing is *denied*.

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