
From: Alexander E. Gasser <agasser@skiermontderby.com>
Sent: Thursday, June 6, 2019 1:16 AM
To: Precedential_Opinion_Panel_Request
Cc: DMinion@Venable.com; DConde@Venable.com; WSolander@Venable.com; MRRoberts@Venable.com; Jevtana_team
Subject: Subject: IPR2019-00136, Neptune Generics, LLC v. Aventis Pharma S.A.; Request for Precedential Opinion Panel
Attachments: Final Request for Rehearing.pdf

To the Board:

Based on my professional judgment, I believe that the Board panel Decision Denying Institution (IPR2019-00136, Paper 15) is contrary to 35 U.S.C. § 325(d). Based on my professional judgment, I also believe the Board panel decision is contrary to the following decisions of the United States Court of Appeals for the Federal Circuit governing obviousness determinations for new chemical compounds: *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280 (Fed. Cir. 2012) and *Takeda Chem. Indus. Ltd. v. Alphapharma Pty., Ltd.*, 492 F.3d 1350 (Fed. Cir. 2007); and the following precedents of the Board: *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, Paper 8 (Dec. 15, 2017) (informative).

The Board panel's Decision Denying Institution rests on the mistaken and erroneous belief and finding that Petitioner's obviousness challenge filed against a patent's claims directed to a new chemical compound is "substantially similar" to a previous petition filed by a different petitioner, where institution was denied based on the lack of evidence presented in support of the lead compound selected, even though the instant Petition denied under 325(d) presented:

- a different lead compound and different reasons for selecting the lead compound than the prior petition;
- a different lead reference applied to both select and modify the different lead compound than the prior petition applied to select and modify its different lead compound;
- two different primary references in support of modifications to its lead compound than the prior petition applied in support of modifications for its different lead compound;
- different arguments and motivations for applying the only reference in common between the two petitions; and
- a different expert declarant starting with a different lead compound, that applied different primary references to make different modifications for different reasons than were presented in the previous petition.

Based on my professional judgment, I also believe that this case requires an answer to a precedent-setting question of exceptional importance:

Whether "substantially similar" under 35 U.S.C. § 325(d) can be invoked for discretionary denial of institution in a new chemical compound obviousness challenge, where the both the

lead compound, and two of the three primary references applied to select and modify the lead compound, are different than the lead compound and primary references presented in a previous petition and have never been presented to or considered by the Patent Office.

Petitioner therefore respectfully requests that the Board convene a Precedential Opinion Panel to consider the accompanying rehearing request (timely filed earlier this evening), and all other matters that it chooses to consider.

Respectfully submitted,

/s/ Alexander E. Gasser

Reg. No. 48,760

ATTORNEY OF RECORD FOR PETITIONER NEPTUNE GENERICS, LLC

Cc: All Counsel of Record

Alexander E. Gasser | SKIERMONT DERBY LLP
1601 Elm Street, Suite 4400, Dallas, Texas 75201
P: 214.978.6600 | F: 214.978.6601 | skiermontderby.com

This message is the property of SKIERMONT DERBY LLP and may contain privileged information or attorney work product. If this message has been delivered to you by mistake, then do not copy or deliver this message to anyone. Instead, destroy it and notify me by reply e-mail.

IPR2019-00136