

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APOTEX INC.  
Petitioner,

v.

UCB BIOPHARMA SPRL,  
Patent Owner.

---

Case IPR2019-00400  
Patent 8,633,194

---

**PATENT OWNER'S SUR-REPLY PURSUANT TO ORDER [PAPER 15]**

**TABLE OF CONTENTS**

**I. INTRODUCTION .....1**

**II. INSTITUTION SHOULD BE DENIED UNDER § 325(d). .....1**

A. Petitioner Fails to Explain How Its Arguments, or Its Prior Art,  
Differs From The Examiner’s Rejections During Prosecution. .... 1

B. The Board Can, and Should, Consider Declarations Submitted During  
Prosecution and the Examiner’s Reliance On Them.....2

**III. INSTITUTION SHOULD BE DENIED UNDER § 314(a).....4**

**IV. PATENT OWNER HAS PREVIEWED ITS SUBSTANTIVE  
ARGUMENTS BUT CAN, AND WILL, FULLY ADDRESS THE  
MERITS IF INSTITUTION IS GRANTED.....4**

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Actavis LLC v. Abraxis Bioscience LLC</i> , IPR2017-01103, Paper 7 (PTAB Oct. 10, 2017).....	3
<i>Apotex Inc. v. Celgene Corp.</i> , IPR2018-00685, Paper 8 (PTAB Sept. 27, 2018).....	3
<i>Hologic, Inc. v. Biomérieux, Inc.</i> , IPR2018-00567, Paper 9 (PTAB Aug. 4, 2018).....	3
<i>Intel Corp. v. Godo Kaisha IP Bridge 1</i> , IPR2018-00753, Paper 11 (PTAB Oct. 9, 2018).....	2
<i>Koios Pharms. LLC v. medac Gesellschaft für klinische Spezialpräparate mbH</i> , IPR2016-01370, Paper 13 (PTAB Feb. 8, 2017).....	3
<i>Quanergy Systems, Inc. v. Velodyne Lidar, Inc.</i> , IPR2018-00256, Paper 14 (PTAB May 25, 2018) .....	3
<i>Valve Corp. v. Electronic Scripting Products, Inc.</i> , IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) .....	4
<b>Statutes</b>	
35 U.S.C. § 314(a) .....	4
35 U.S.C. § 325(d) .....	1
<b>Other Authorities</b>	
Patent Trial and Appeal Board, <i>Trial Practice Guide Update</i> (August 2018).....	1
U.S. Patent No. 8,633,194.....	1, 3

## I. INTRODUCTION

Section 325(d) empowers the Board to decline institution when “*the same or substantially the same prior art or arguments were presented previously.*” See Patent Trial and Appeal Board, *Trial Practice Guide Update* (August 2018) at 11 (emphasis added). The Board should exercise such discretion here given Petitioner’s decision to ignore the prosecution of U.S. Patent No. 8,633,194. The POPR explained how the Petition repeated substantially the same arguments raised in prosecution rejections, albeit based on art the Examiner only “considered” and did not “discuss,” yet made no attempt to address the Examiner’s reasons for withdrawing these rejections, including his consideration of an inventor declaration. Petitioner’s Reply fails to cure these defects and the Board should deny institution.

## II. INSTITUTION SHOULD BE DENIED UNDER § 325(d).

### A. Petitioner Fails to Explain How Its Arguments, or Its Prior Art, Differs From The Examiner’s Rejections During Prosecution.

Petitioner spends nearly half of its Reply trying to prove that its references are not cumulative to the Examiner’s prior art. See Reply at 2-7. This distinction misses the mark and improperly attempts to reduce the first four *Becton Dickinson* factors to the single question of whether the art is cumulative.

Petitioner’s argument centers around distinguishing prior art “discussed” during prosecution from prior art that is merely “considered.” Reply at 2. To the extent such a distinction matters for these purposes, it merely affects the weight

attributed to the prosecution discussion or consideration, as the Board has previously exercised its discretion not to institute solely because prior art references were similarly only “considered”. POPR at 9 *citing Neil Ziegmann, N.P.Z., Inc. v. Stephens*, IPR2015-01860, Paper 11 at 7, 9-10 (PTAB Feb. 24, 2016).

Moreover, consistent with multiple of the *Becton Dickinson* factors, the underlying reasons why the references were discussed during prosecution should also be considered. *See, e.g., Intel Corp. v. Godo Kaisha IP Bridge 1*, IPR2018-00753, Paper 11 at 14-15, 18-20 (PTAB Oct. 9, 2018). Patent Owner spent nearly half of its petition comparing these reasons (*see* POPR at 8-12, 13-22), yet Petitioner provides no meaningful response to this detailed explanation at all.

**B. The Board Can, and Should, Consider Declarations Submitted During Prosecution and the Examiner’s Reliance On Them.**

In an attempt to explain away its decision to ignore the Examiner’s reasons for allowing the claims, and reliance on an inventor declaration in so doing, (*see* POPR at 22-25), Petitioner makes no attempt to address the issues on the merits and, instead, conjures two new PTAB rules. *See* Reply at 7-8. There is no precedent for these rules and they should not be adopted now. Moreover, institution should be denied because Petitioner *still* has not distinguished or explained how it can overcome the inventor declaration evidence that the Examiner considered and found fatal to the same arguments Petitioner presents now. *See* POPR at 22-23.

First, Petitioner attempts to persuade the Board it need not consider

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.