Paper 58, Filed: June 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TWI PHARMACEUTICALS INC.,

Petitioner,

v.

MERCK SERONO SA,

Patent Owner.

IPR2023-00049 (Patent 7,713,947 B2)

Before ULRIKE W. JENKS, ZHENYU YANG and TINA HULSE,
Administrative Patent Judges.

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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Petitioner TWi Pharmaceuticals Inc. ("Petitioner") respectfully submits this Reply to Paper 28, Patent Owner's Response ("*PO's Resp.*"), and in further support of Paper 1, its Petition ("*Petition*").

I. The Challenged Claims Are Anticipated By The Bodor Art.

Bodor discloses all elements of the challenged claims. (*See* Ex. 1047, Greenberg Rebuttal Decl. ¶ 15.)

A. The Bodor Art Is "By Another."

Patent Owner's assertion that the named inventors of the challenged patent also conceived the relevant disclosure in Bodor is legally insufficient, inconsistent with its position during prosecution and not born out by the evidence.

First, Patent Owner's argument that Bodor is not prior art under 35 U.S.C. § 102(b) (*PO's Resp.* 8 n.3) fails because the challenged claims are due a priority date no earlier than December 18, 2009. As explained in the Petition, the challenged claims (added by amendment dated December 18, 2009, Ex. 1003, 405–423) recite a regimen in which the maintenance period dose can be ***equal*** to the induction period dose. (*Petition* 10–11.) Every previous filing (including provisional Ser. No. 60/638,669 (Ex. 1003, 301–332 at 309), EP 04106909 (Ex. 1003, 268–299 at 276), PCT/WP2005/056954 (Ex. 1003, 333–364 at 340–41), Ser. No. 11/722,018 (*Id.*), and all earlier amendments) all required that the total dose in the maintenance period be ***less than, not equal to*** the total dose in the induction period. These claims in the

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