

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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HOPEWELL PHARMA VENTURES, INC.,  
Petitioner,

v.

MERCK SERONO S.A.,  
Patent Owner.

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Case IPR2023-00480  
Patent 7,713,947

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**PATENT OWNER'S SUPPLEMENTAL BRIEF**

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**OTHER AUTHORITIES**

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The USPTO’s published guidance is that the work of a subset of named inventors is *not* prior art. MPEP § 2132.01 states, “*at least one joint inventor’s* disclosure of his or her own work within the year before the application filing date cannot be used against the application as prior art.” (emphasis added). *See also* MPEP §§ 2136.05(b), 715.01(c), 716.10. The Board should not revisit that guidance here because, even under Petitioner’s view, undisputed evidence shows Dr. De Luca contributed to the regimen the Serono inventors disclosed to Dr. Dandiker, including Dr. Munafo’s testimony (Ex. 2053, ¶¶18, 21) and inventorship of the Challenged Patents. Petitioner offers no reason the 2003 disclosure from the same Serono project would have inventorship different from the challenged claims.

The Federal Circuit agrees. *Applied Materials Inc. v. Gemini Rsch. Corp.* held an application by McNeilly and Benzing was *not* prior art to a patent by McNeilly, Benzing, and Locke, “[e]ven though [they] have been conceived by different inventive entities.” 835 F.2d 279, 281 (Fed. Cir. 1988). *Allergan, Inc. v. Apotex Inc.* explained “[t]he relevant inquiry” for whether a paper by Brandt and VanDenburgh was prior art to a patent by VanDenburgh and Woodward “must be whether the Brandt references ...were solely Dr. VanDenburgh’s work and hers alone.” 754 F.3d 952, 969 (Fed. Cir. 2014).

*In re Land*, cited by Petitioner, is distinguishable because there was “no indication that the portions of the references relied on disclose anything they did

jointly.” 368 F.2d 866, 881 (C.C.P.A. 1966). And *Riverwood Int’l Corp. v. R.A. Jones & Co.* merely recognized that, if patent owner won a petition to correct inventorship, there would be no difference in inventive entities. 324 F.3d 1346, 1356-57 (Fed. Cir. 2003). Federal Circuit cases after *In re Land* clarified that, at least where there is *some* relationship between the challenged invention and the asserted art, the work of a subset of the named inventors is not prior art. *Applied Materials*, 835 F.2d at 280 (McNeilly & Benzing invented apparatus while working with Locke on method); *Allergan*, 754 F.3d at 966 (VanDenburgh co-authored paper while designing clinical trials that led to VanDenburgh & Woodward patent). Here, there is no question the Serono inventors’ regimen disclosed in 2003 relates to the challenged patents: both resulted from Serono’s cladribine for MS project that included Dr. De Luca. *E.g.*, Ex. 2053, ¶¶18-22. Case law does not require showing each named inventor made an inventive contribution to the asserted art to disqualify it. Even if it did, Patent Owner’s evidence is sufficient, particularly given the rule of reason standard for corroboration and Petitioner’s burden to establish prior art. Sur-Reply 4-7.

The Board should not question USPTO policy and Federal Circuit law in this case, where Petitioner offered no evidence of a difference in inventive entities.

Respectfully submitted,                    /Emily R. Whelan/  
Emily R. Whelan (Reg. No. 50,391)

**CERTIFICATE OF SERVICE**

I hereby certify that on July 10, 2024, I caused a true and correct copy of the following materials:

- Patent Owner's Supplemental Brief

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