UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOPEWELL PHARMA VENTURES, INC.,
Petitioner

v.

MERCK SERONO S.A.,
Patent Owner

Case IPR2023-00480
U.S. Patent No. 7,713,947

PETITIONER HOPEWELL PHARMA VENTURES, INC.'S POST-HEARING BRIEF

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A reference is "by another" if not *all* inventors are the same between "the portions of the reference relied on as prior art, and the subject matter of the claims in question." *Riverwood v. Jones*, 324 F.3d 1346, 1356 (Fed. Cir. 2003).

"Land and Rogers individually [were] separate legal entities from Land and Rogers as joint inventors." *In re Land*, 368 F.2d 866, 881 (C.C.P.A. 1966). Because the *individual* Land and Rogers patents were to *different* inventive entities than Rogers and Land *jointly*, both individual patents were §102(e) art "by another." *Id.*; *see also* M.P.E.P. 2136.04; *Duncan Parking v. IPS*, 914 F.3d 1347, 1357 (Fed. Cir. 2019) (citing *In re Land*); and *Ex Parte Abe,* No. 2010-000029, at 3-5 (B.P.A.I. June 29, 2012). Similarly, in *In re Fong,* 378 F.2d 977 (C.C.P.A. 1967), a patent to Miller, Whitfield, and Wasley was §102(e) art to an application to Miller, Whitfield, Wasley, Fong, and Brown. In *Google v. IPA Techs.*, a reference from Martin, Cheyer, and Moran was §102(a) art to patents to Martin and Cheyer. 34 F.4th 1081, 1084 (Fed. Cir. 2022). There, "[i]f Dr. Moran was *not* a co-inventor of the [] reference, [it] was not prior art because it was made by the same inventive entity as the '115 and '560 patents and not 'by others.'" *Id.* In *Horizon v. Alchem*, a patent to Golombik and Tidmarsh was §102(a) art to the challenged patent listing only Tidmarsh. 2021 WL 5315424 at *3-4 (Fed. Cir. 2021). Similarly, a patent naming solely Plachetka was §102(e) art to a patent to Plachetka and three others. *Dr. Reddy's v. Horizon*, IPR2018-00272, Paper 74, at

17 (P.T.A.B. Sept. 9, 2019). Merck cites *In re DeBaun,* 687 F.2d 459 (C.C.P.A. 1982), and *In re Mathews*, 408 F.2d 1393 (C.C.P.A. 1969), but both cases involved identical inventive entities to disqualify prior art (*viz.,* DeBaun alone or Mathews alone). *See also LSI v. Regents*, 43 F.4th 1349, 1356-57 (Fed. Cir. 2022). So did *In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982): Dr. Katz *alone* invented the relied-upon disclosures and was the sole patent applicant. Likewise, *Applied Materials v. Gemini* is consistent in holding that identity of inventorship between the relied-upon portion of a reference and the challenged patent is required to disqualify a reference as prior art. 835 F.2d 279, 281 (Fed. Cir. 1987).

Merck fails to identify *any* authority holding that art is disqualified if it describes an invention of a subset of the inventors. *Allergan v. Apotex* is of no avail. There, the Federal Circuit held that Allergan failed to prove the cited art "represent[s] the work of the inventors *themselves*;" the Court did *not* hold that the work of a subset of inventors was disqualified as prior art. 754 F.3d 952, 968-969 (Fed. Cir. 2014). Merck's position is also inconsistent with *MaxLinear*, where a reference from a subset of inventors of the challenged claim was §102(e) art. *MaxLinear v. Cresta*, IPR2015-00594, Paper 90, at 16-24 (P.T.A.B. Aug. 15, 2016). Merck failed to carry its burden to prove De Luca made an inventive contribution to Bodor; Bodor is therefore prior art under §102(a)/(e). *See In re Carreira*, 532 F.2d 1356, 1359 (C.C.P.A. 1976).

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PETITIONER HOPEWELL PHARMA VENTURES, INC.'S POST-HEARING BRIEF** was served in its entirety on July 10, 2024, upon the following parties via electronic mail:

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