

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERGREEN THERAGNOSTICS, INC.,

Petitioner,

v.

ADVANCED ACCELERATOR APPLICATIONS S.A.,

Patent Owner.

Case PGR2021-00002

U.S. Patent No. 10,596,278

**PATENT OWNER RESPONSE TO PETITIONER'S EXPLANATION OF
PARALLEL PETITIONS**

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I. Evergreen’s PGR2021-00002 Petition Should Be Denied For Improper Parallel Petitioning if the PGR2021-00001 Petition Is Instituted

Evergreen has filed two separate petitions challenging the ’278 patent: (1) PGR2021-00001 (the “Protocol petition,” relying on the Protocol document as a putatively-anticipatory reference, and also relying on the Maus article and various ancillary references to argue obviousness, and (2) PGR2021-00002 (the “Maus petition”), relying primarily on the Maus article as the principal basis for both anticipation and obviousness arguments. Recognizing that institution of multiple petitions challenging a single patent is disfavored, Evergreen filed an “Explanation” paper in hopes of justifying this extraordinary request. But Evergreen has made no persuasive showing justifying the institution of multiple petitions. The Board should decline to institute the Maus petition if the Board institutes the Protocol petition, and vice-versa.

The PTO’s November 2019 Consolidated Trial Practice Guide (“TPG”)¹ outlines a straightforward principle: one petition is typically sufficient to challenge the claims of a patent, and exceptions to that rule should be scarce. As the Board recognizes, multiple petitions not only place a substantial burden on the Board but also the patent owner. The PTO’s TPG states that:

Based on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more

¹ <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=> (last visited December 26, 2020) (“Trial Practice Guide”)

petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b). In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

Id. at 59. The TPG also affirms that, while circumstances may justify instituting more than one petition, it “should be rare” for a petitioner to need two petitions. *Id.*

Accordingly, the Board has repeatedly denied instituting parallel petitions challenging the same patent. *See Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01470, Paper 7 (PTAB Feb. 11, 2020); *see also Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01630, Paper 13 (PTAB Apr. 2, 2020); *Apple Inc. v. Seven Networks, LLC*, IPR2020-00281, Paper 10 (PTAB Aug. 14, 2020); *Volkswagen Grp. Of Am., Inc., v. Carucel Investments, L.P.*, IPR2019-01106, Paper 8 (PTAB Dec. 2, 2019); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01220, Paper 19 at 4 (PTAB Jan. 30, 2020); *Nalox-1 Pharms., LLC v. Opiant Pharms., Inc.*, IPR2019-00696, Paper 10 at 8–14 (PTAB Oct. 1, 2019). This is not a “rare” case; as explained below, Evergreen’s excuses for instituting multiple petitions are inadequate.

II. Evergreen’s “Explanation” Does Not Meet Any of the Exceptions Outlined in the Trial Practice Guide.

The TPG itself outlines the “rare” conditions that justify multiple petitions:

[1] when the patent owner has asserted a large number of claims in litigation or [2] when there is a dispute about priority date requiring arguments under

multiple prior art references. In such cases two petitions by a petitioner may be needed, although this should be rare.

Trial Practice Guide at 59. Neither exception applies here.

First, neither Advanced Accelerator Applications, S.A. nor its parent corporation has asserted any patent claims against Petitioner in any litigation. This exception is therefore entirely inapplicable. Regardless, Petitioner asserts that “filing a single petition” is “complicated by the number of claims (25) in the ’278 patent.” Paper 3 at 4. Not so. In *Apple Inc. v. Seven Networks, LLC*, the Board denied institution of multiple petitions, noting that “twenty challenged claims” is “not a large number of claims to address in multiple grounds against.” IPR2020-00281, Paper 10 (PTAB Aug. 14, 2020). In fact, the Board has denied institution where a petitioner has challenged *more* claims than are at issue here. *See Nalox-1 Pharms.*, IPR2019-00696, Paper 10 at 6–14 (denying institution of parallel petitions challenging thirty claims). The Board’s prior practice shows that twenty-five claims is not a “large number” that might justify instituting parallel proceedings.

Second, there is no dispute about the ’278 patent’s priority date. Instead, there is a dispute regarding whether Petitioner has demonstrated that the Protocol is prior art. Under this circumstance multiple petitions are discouraged. In *Square, Inc. v. 4361423 Canada Inc.*, the Board explained that the TPG’s exception regarding a “dispute about priority date” does “not convey that whenever a priority issue is

involved, Petitioner is entitled to file two petitions against the same claims of the same patent.” IPR2019-01630, Paper 13 at 9-10 (PTAB Apr. 2, 2020).

Recognizing these deficiencies, Evergreen attempts to create a new exception by arguing that there would have been insufficient space to address unpatentability under both the Protocol and Maus references in one petition. Paper 3 at 3. But petitioners frequently assert multiple challenges resting upon different base references in one petition. *See Volkswagen Grp. Of Am., Inc. v. Amerachem Holdings, LLC*, IPR2014-01557, Paper 13 at 3-5 (PTAB Mar. 16, 2015) (petitioner asserting obviousness grounds based on different primary references); *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2017-00620, Paper 13 at 5 (PTAB July 6, 2017) (same). Evergreen’s only support for abandoning this principle is a conclusory statement that “word limitations” would make it “not possible,” which carries no weight. *Id.* Evergreen admits that the Protocol petition substantially overlaps arguments based on Maus. Paper 3 at 3-4 (the Protocol petition still “uses Maus as a secondary reference” regarding all of its obviousness arguments). This concession further belies Petitioner’s argument that it would have been impossible to address both references in a single petition. *See Nalox-1 Pharms., LLC v. Opiant Pharms., Inc.*, IPR2019-00696, Paper 10 at 11 (PTAB Oct. 1, 2019) (denying multiple institutions where “Petitioner’s arguments in the Davies Petition largely rely on the teachings in Wyse, just as they do in the Wyse Petition”).

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