

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERGREEN THERAGNOSTICS, INC.

Petitioner

– vs. –

ADVANCED ACCELERATOR APPLICATIONS SA

Patent Owner.

PGR2021-00002

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

**EXPLANATION OF MULTIPLE PETITIONS
CHALLENGING THE SAME PATENT IN ACCORDANCE
WITH THE JULY 2019 UPDATED PATENT TRIAL GUIDE**

Petitioner, Evergreen Theragnostics, Inc., respectfully submits this Paper in support of its Petition for Post Grant Review of all claims (claims 1-25) of U.S. Patent No. 10,596,278 (“the ’278 patent”). Petitioner has concurrently filed a Petition for Post Grant Review of claims 1-25 of the ’278 patent (PGR2021-00001) relying on different prior art. Pursuant to the Patent Trial and Appeals Board’s Trial Practice Guide Update released in July 2019, Petitioner provides this separate paper to identify the difference between its two petitions and need to file separate petitions regarding the ’278 patent. Petitioner requests that the Board use its discretion to institute both petitions.

I. RANKING OF PETITIONS

Petitioner requests that, if the Board uses its discretion to institute the petitions, the Board consider the merits of each petition beginning with the other petition which uses Strosberg and the accompanying Protocol as the primary reference (PGR2021-00001), followed by this petition (PGR2021-00002).

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE BOTH PETITIONS

Petitioner has identified two (2) anticipatory references, *i.e.*, (1) Strosberg (Ex. 1011) and its accompanying Protocol (Ex. 1012); and (2) Maus (Ex. 1009). Each petition relies on one of the anticipatory references as the primary prior art reference for the unpatentability analysis. This petition relies on Maus as the

primary prior art reference, and PGR2021-00001 relies on Strosberg/Protocol as the primary prior art reference

Because unpatentability is based primarily on either of two anticipatory references, and considering the word limitations for petitions, it is not possible to thoroughly and completely address unpatentability using both Strosberg/Protocol and Maus as primary references.

Moreover, Petitioner has used an expert witness to establish that Strosberg/Protocol was published more than 1 year before the earliest filing date to which the '278 patent could claim priority. Therefore, Strosberg/Protocol is prior art to the '278 patent under 35 U.S.C. §102(a). The publication date of Strosberg/Protocol (January 12, 2017), however, is relatively close to the date that is one year before the '278 priority date (July 25, 2018), and Petitioner does not know if Patent Owner will dispute the prior art status of Strosberg/Protocol. If Petitioner were to file a single petition for Post Grant Review relying on both (1) Strosberg/Protocol as a primary art reference and (2) Maus as a primary art reference, and Strosberg/Protocol was later determined to not be prior art, there would be insufficient space in the petition to thoroughly and completely address unpatentability on Maus, which is unquestionably prior art. For this reason, the petitions do not use exactly the same art even with regard to obviousness combinations. While the Strosberg petition (PGR2021-00001) uses Maus as a

secondary reference regarding some obviousness arguments, the Maus petition (PGR2021-00002) does not rely on Strosberg/Protocol for unpatentability.

Additionally, filing a single Petition, relying on both Strosberg/Protocol and Maus as primary references is further complicated by the number of claims (25) in the '278 patent. The larger number of claims precludes being able to provide a thorough and detailed analysis of why each claim is unpatentable based on Strosberg/Protocol as a primary prior art reference and then separately on Maus as a primary prior art reference.

Finally, where there were issues that needed to be addressed only once (such as the improper dependency of claim 24), that issue was included only in the initial petition (PGR2021-00001).

The differences between the arguments in the two petitions is noted in tabular format below:

PGR2021-00001	PGR2021-00002
Prior Art Grounds: Claims 1-5, 8-22 and 24-25 are anticipated by (or would have been obvious) over Strosberg/Protocol; only obviousness is asserted against the other 3 claims	Prior Art Grounds: Claims 1, 8-17 and 19 are anticipated by (or would have been obvious over) Maus; only obviousness is asserted against the other claims
Obviousness arguments over all claims based on Strosberg/Protocol including Maus as a secondary reference	Obviousness arguments on all claims with various art used as secondary reference; Strosberg/Protocol is not used as a reference
9 total grounds based on number of claims and additional dependent limitations	14 total grounds given the different primary reference and fewer claims asserted to be anticipated
Claim 24 also is invalid for improper dependency	Improper dependency argument is not included as duplicative of other petition

The enumerated Grounds rely on two different anticipatory references as primary prior art references, necessitating different grounds using different art in the two petitions. Furthermore, due to the large number of claims, Petitioner required two petitions to adequately address why the claims of the '278 patent are unpatentable. Accordingly, the Board should exercise its discretion to institute both this Petition and the Petition for PGR2021-00001).

Dated: October 2, 2020

/s/ C/ Kyle Musgrove

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