

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GNOSIS S.P.A., GNOSIS BIORESEARCH S.A., AND GNOSIS U.S.A., INC.  
Petitioners

v.

SOUTH ALABAMA MEDICAL SCIENCE FOUNDATION  
Patent Owner

---

Case IPR2013-00118  
U.S. Patent No. 6,673,381

**PATENT OWNER'S NOTICE OF FILING PETITION FOR WRIT OF  
CERTIORARI WITHIN THE TIME ALLOWED UNDER SUP. CT. R. 13**

Notice is hereby given that South Alabama Medical Science Foundation (“Patent Owner”) will file a petition for writ of certiorari before the Supreme Court of the United States, appealing from the Court of Appeals for the Federal Circuit’s decision in *S. Ala. Med. Sci. Found. v. Gnosis S.p.A.*, 808 F.3d 823 (Fed. Cir. 2015) (“*SAMSF I*”), affirming the Final Written Decision of the Patent Trial and Appeal Board (“PTAB”) entered on June 20, 2014 (Paper 64). The time for appeal—that is, appeal to the Supreme Court—has not expired. Patent Owner’s petition for writ of certiorari will be filed before July 25, 2016 in accordance with Sup. Ct. R. 13.

Patent Owner’s appeal arose from IPR No. 2013-00118. On December 17, 2015, a divided panel of the Federal Circuit issued a precedential decision upholding the PTAB’s Final Written Decision (Paper 64) finding all claims-at-issue invalid. A 2-1 majority upheld the PTAB’s invalidity rulings on the basis that the factual findings were supported by “substantial evidence.” The dissent indicated that the “clear error” standard should have been applied given the nature of *inter partes* review (“IPR”) proceedings, which were intended to be an alternative for district court proceedings. *SAMSF I*, 808 F.3d at 828 (Newman, J., dissenting) (referring to her dissent in the companion case *Merck & Cie v. Gnosis S.p.A.*, 808 F.3d 829, 839-40 (Fed. Cir. 2015) (“*Merck I*”), where application of the “clear error” standard instead of the “substantial evidence” standard would have changed the outcome of the appeal).

On January 19, 2016, Patent Owner petitioned the Federal Circuit for an *en banc* rehearing arguing, *inter alia*, that the panel majority should have applied a “clear error” standard of review to the PTAB’s factual findings instead of the more deferential “substantial evidence” standard. On April 26, 2016, the Federal Circuit denied Patent Owner’s petition for *en banc* rehearing. *S. Ala. Med. Sci. Found. v. Gnosis S.p.A.*, No. 2014-1778, slip op. at 2 (Fed. Cir. Apr. 26, 2016) (“*SAMSF IP*”) (per curiam).<sup>1</sup> In rejecting Patent Owner’s petition, Judges O’Malley, Wallach, and Stoll concurred while observing that application of the “substantial evidence” standard of review is “seemingly inconsistent with the purpose and content of the [America Invents Act (‘AIA’)]” and that “a substantial evidence standard of review makes little sense in the context of an appeal from an IPR proceeding.” *Id.*, concurrence at 1 (O’Malley, J., *et al.*, concurring) (concurring for the same reasons as stated in the denial of *en banc* rehearing in the companion case *Merck & Cie v. Gnosis S.p.A.*, No. 2014-1779, concurrence at 2 (Fed. Cir. Apr. 26, 2016) (“*Merck IP*”) (O’Malley, J., *et al.*, concurring). However, according to the concurring opinion, the question regarding the appropriate standard of appellate review was more appropriately addressed by Congress or the Supreme Court, given the Supreme Court’s decision in *Dickinson v. Zurko*, 527 U.S. 150 (1999). *Merck II*, concurrence

---

<sup>1</sup> Slip opinion and mandate included as Attachment 1 and Attachment 2, respectively.

at 2, 6-7 (O'Malley, J., *et al.*, concurring). In a dissenting opinion, Judge Newman likewise recognized the inapplicability of the “substantial evidence” standard of review for appeals from IPR proceedings. *SAMSF II*, dissent at 1-2 (Newman, J., dissenting).

Further, three other judges of the Federal Circuit (Chief Judge Prost and Judges Moore and Reyna) previously have agreed with the premise underlying the issue to be presented by Patent Owner, namely, that IPRs are a surrogate for district court proceedings and should be treated as such. *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1297, 1300 (Fed. Cir. 2015) (Prost, C.J., *et al.*, dissenting), *cert. granted*, *Cuozzo Speed Techs., LLC v. Lee*, 2016 U.S. LEXIS 632 (U.S. Jan. 15, 2016) (No. 15-446).

The issues to be raised by Patent Owner’s certiorari petition will include whether the Federal Circuit should apply a “clear error” standard of review to the PTAB’s factual findings in IPRs rather than the “substantial evidence” standard given the purpose of the AIA. The petition will present a substantial question that has a reasonable likelihood of being granted because: (1) there is a split within the Federal Circuit over whether the “substantial evidence” standard should apply to IPR reviews given the purpose and content of the AIA; (2) it will address an issue that is predicated on a topic presently before the Supreme Court in *Cuozzo Speed Techs., LLC v. Lee*—namely, whether IPR proceedings were intended to function as

surrogates for district court litigation; and (3) it will have implications for virtually all appeals to the Federal Circuit from IPR final decisions.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.