

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC. and
AMNEAL PHARMACEUTICALS LLC,
Petitioners,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00551
Patent 8,457,988 B1

Before JACQUELINE WRIGHT BONILLA, BRIAN P. MURPHY, and
JON B. TORNQUIST, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Jazz Pharmaceuticals, Inc. (“Patent Owner”) filed a Request for Rehearing following our Final Written Decision determining all challenged claims of U.S. Patent No. 8,457,988 B1 (Ex. 1001, “the ’988 patent”) to be unpatentable. Paper 70 (“Decision” or “Dec.”); Paper 71 (“Rehearing Request” or “Req. Reh’g”). Par Pharmaceutical, Inc. and Amneal Pharmaceuticals LLC (together “Petitioner”) filed a Response to Patent Owner’s Rehearing Request. Paper 73 (“Opp.”). Patent Owner seeks reconsideration of the Board’s determination that claims 1–15 of the ’988 patent are unpatentable for obviousness over the Advisory Committee Art (Exs. 1003–1006, collectively “the ACA”). Req. Reh’g 1. Patent Owner argues that the Board misapprehended or overlooked certain evidence when (i) determining that Korfhage does not teach away from the use of distributed database systems, and (ii) construing the following claim limitation: “the prescription requests containing information identifying narcoleptic patients, the prescription drug, and various credentials of the any and all medical doctors.” *Id.* at 1–2. Petitioner opposes the Rehearing Request. Opp. 2–9.

Having considered the parties’ submissions concerning Patent Owner’s Rehearing Request, Patent Owner’s request is *denied*.

II. STANDARD OF REVIEW

A party who requests rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an

opposition, or a reply. *Id.* “A Request for Rehearing is not an opportunity to re-argue old arguments.” *Histologics, LLC v. CDX Diagnostics, Inc.*, Case IPR2014-00779, slip op. at 4 (PTAB Oct. 16, 2014) (Paper 9). With the aforementioned principles in mind, we address the rehearing arguments presented by Patent Owner.

III. ANALYSIS

A. *Our Consideration of Korfhage and Dr. Bergeron’s Testimony*

Patent Owner asserts that the Board “overlooked and/or misapprehended” Patent Owner’s argument and expert testimony that the Korfhage reference teaches away from the use of “distributed databases,” as recited in claims 2 and 10. Req. Reh’g 2–3; Dec. 56–59. Our Decision explained that Korfhage “suggests that a single query can operate over the distributed database computers to accommodate user preference ‘to view the system as accessing a single logical database in response to a query, even when the system must consult multiple physical databases.’” Dec. 57 (quoting Ex. 1037 at 276). We explicitly considered Patent Owner’s submission that Korfhage teaches away from the use of distributed databases because of “problems” that may arise. *Id.* at 57–58 (“Patent Owner further argues that Korfhage teaches away from using distributed databases because Korfhage discloses that ‘three **major problems** arise’ when attempting to have a single query operate over multiple physical databases.”) (citing PO Resp. 59 (which cited Dr. Bergeron’s declaration testimony, Ex. 2047 ¶¶ 62–65)). We considered, but were not persuaded by, Patent Owner’s and

Dr. Bergeron’s interpretation of Korfhage, including any supposed teaching away:

We also agree with Petitioner that Korfhage does not teach away from the use of distributed databases systems, particularly given the acknowledgement of Dr. Bergeron that Korfhage offered solutions to the problems identified.

Id. at 59 (citing Ex. 1037, 276–77; Ex. 1054, 317:13–320:12).

We did not overlook or misapprehend Patent Owner’s argument and evidence, rather, we declined to credit them in view of the text of Korfhage, Dr. Valuck’s testimony, and Dr. Bergeron’s deposition testimony. Dec. 56–59. The pages of Korfhage cited and quoted in our Decision disclose multiple factors “driving information systems to the use of distributed document sets and distributed processing,” and set up “[t]hree major problems” only to discuss “simple solution[s],” a position supported by Dr. Valuck. Dec. 57–59 (citing Ex. 1007 ¶ 157; Ex. 1037 at 276–77). Under cross-examination by Petitioner’s counsel, Dr. Bergeron readily acknowledged that Korfhage’s discussion of data redundancy and matching document evaluation “problems” were paired with disclosed solutions, which undercut his declaration testimony (Ex. 2047 ¶¶ 56–65) relied upon by Patent Owner. Ex. 1054, 317:13–320:12. Our Decision credits Dr. Bergeron’s deposition testimony, which acknowledges the distributed

database system solutions disclosed in Korfhage, rather than the speculative new problems hypothesized in his declaration and Patent Owner's Response.

For example, Patent Owner argued that if the prior art ACA system for distributing Xyrem were to be run on a distributed database of the type suggested by Korfhage, such a system

might create a false indication of duplicate prescriptions that could prevent a patient from receiving her prescription drug. Ex. 2047 ¶ 64. On the other hand, if the duplicate prescription data is "eliminat[ed]" because a pharmacist believes it was caused by data redundancy, then a potential abuse situation would be overlooked. *Id.*

PO Resp. 60. We did not find such testimony persuasive, or particularly credible, in view of Korfhage's express disclosures, Dr. Valuck's testimony, and Dr. Bergeron's deposition testimony. Dec. 57–59 (citing Ex. 1007 ¶ 157; Ex. 1037, 276–77; Ex. 1054, 317:13–320:12; Ex. 2047 ¶ 57–59). Patent Owner's argument is not persuasive given that the ACA drug distribution system was designed to allow a pharmacist to identify and resolve duplicate prescriptions before deciding whether to distribute the drug to a patient (or delete a duplicate caused by data redundancy). Ex. 1003, 184:24–185:7; Ex. 1005, 314 ¶ 6. We also were persuaded by Dr. Valuck's testimony that it would have been obvious for one of ordinary skill to modify the ACA system "such that the data stored in the central data repository was distributed across multiple databases, as disclosed by Korfhage in order to accommodate cost, efficiency, and the number of

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