

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKORN, INC.,
Petitioner,

v.

SENJU PHARMACEUTICAL CO., LTD, MITSUBISHI
CHEMICAL CORPORATION,
Patent Owner.

Case IPR2015-01205
Patent 6,114,319

Held: September 7, 2016

BEFORE: DEBORAH KATZ, JACQUELINE WRIGHT
BONILLA, and GRACE KARAFFA OBERMANN,
Administrative Patent Judges.

The above-entitled matter came on for hearing on Wednesday,
September 7, 2016, commencing at 10:03 a.m., at the U.S. Patent
and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

Case IPR2015-01205
Patent 6,114,319

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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P R O C E E D I N G S

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JUDGE KATZ: Okay. I think we'll get started. Good morning. This is an oral argument for inter partes review number 2015-01205. The petitioner is Akorn, Inc., and patent owners are Senju Pharmaceutical Company Limited and Mitsubishi Chemical Corporation. I am Judge Katz. Judge Bonilla is on my right and Judge Obermann is on my left.

And before we get started, I would like to point out a few housekeeping things. The hearing is open to the public, and a full transcript of it will become part of the public record, just so you know. Each party has been accorded 45 minutes in total to present their arguments. Petitioner will go first followed by the patent owner. There is no motion to amend in this case. So the petitioner carries the burden and may reserve rebuttal time.

Counsel should not interrupt the other side when making objections. And if you have objections, you can discuss them during your argument but not -- please don't interrupt the other side.

When you refer to an exhibit when you are presenting your argument, please indicate that in numbers, either the slide number, the exhibit number, the page number, the line number, whatever you are referring to so that the record is complete because the transcript will obviously only have what you say. So please don't just gesture.

1 So now if counsel for petitioner, if you could introduce
2 yourself and those with you, please.

3 MS. ELLISON: Good morning, Your Honor. I'm
4 Eldora Ellison from Sterne, Kessler, Goldstein & Fox. I have
5 with me my backup counsel, Chandrika Vira and Sana Hussain.

6 JUDGE KATZ: Thank you. And for patent owners,
7 please introduce yourself.

8 MR. KAPPOS: Good morning, Your Honors. I'm John
9 Kappos from O'Melveny & Myers, and I represent Senju
10 Pharmaceuticals, Mitsubishi Chemical and Alcon, the licensee
11 under the '319 patent. And I'm joined today by my partner, Filko
12 Prugo and Barry Copeland from the legal department at Alcon.

13 JUDGE KATZ: Thank you. So petitioner, would you
14 like to reserve time?

15 MS. ELLISON: Yes, Your Honor. I would like to
16 reserve ten minutes for rebuttal.

17 JUDGE KATZ: So I will set this at 35 minutes and
18 note that you have ten minutes. Whenever you are ready, I'll start
19 the clock when you let me know.

20 MS. ELLISON: May it please the Board, I would also
21 like to split the argument with my backup counsel, Chandrika
22 Vira, if you don't mind. I will address the prima facie case and
23 I'll spend about 25 minutes doing that, and she will address
24 objective indicia and spend about ten minutes. And that will
25 leave us ten minutes for rebuttal.

1 So we, of course, have prepared demonstratives. If you
2 would like paper copies, we have those available to you and can
3 give them to you if you would like to have paper copies.

4 JUDGE KATZ: Sure.

5 MS. ELLISON: Yes, if we may approach the bench.
6 So we have provided on slide 2 an overview of our arguments
7 which is that all of the challenged claims would have been
8 unpatentable for obviousness over a combination the '848 patent,
9 which is also known as Kimura, and the Ding reference. Ding
10 discloses emulsions and the '848 patent discloses suspensions of
11 difluprednate, difluprednate being the active ingredient here. We
12 also will address Senju's objective indicia arguments.

13 Turning to slide 3, we've set forth the independent
14 claims. There are two of them, claims 1 and 18. Our opponents
15 have not made any separate arguments regarding patentability of
16 any of the dependent claims. So all of the dependent claims fall
17 together with these independent claims. Claim 18 is more narrow
18 in scope than claim 1 and thus falls within claim 1. So most of
19 the arguments have been directed specifically to claim 18 since
20 that will of course also address claim 1.

21 What you see is a claim composition. And it's
22 important to remember that the claims are directed to
23 compositions because many of our opponent's arguments pretty
24 much act like these claims are method claims, but they are not.
25 They are composition claims directed to a difluprednate emulsion

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