

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LABORATOIRE FRANCAIS DU FRANCTIONNEMENT ET DES  
BIOTECHNOLOGIES S.A.,  
Petitioner,

v.

NOVO NORDISK HEALTHCARE AG,  
Patent Owner.

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IPR2017-00028  
Patent 9,102,762 B2

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Before ERICA A. FRANKLIN, SUSAN L. C. MITCHELL, and  
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Terminate, Dismiss, and Vacate  
*37 C.F.R. §§ 42.71 and 42.72*

Laboratoire Francais du Fractionnement et des Biotechnologies S.A. (“Petitioner”) moves to terminate and dismiss this *inter partes* review because a final written decision has not been entered as to all grounds in the Petition. Petitioner’s Motion to Terminate, Dismiss, and Vacate (Paper 98, “Mot.”) 1, 12. Petitioner also moves to vacate the Final Written Decision that we issued on April 5, 2018, which disposed of a subset of grounds in the Petition upon which an *inter partes* review was originally instituted, and all interlocutory decisions in this proceeding. *Id.* at 12. According to Petitioner, “any final determination issued now would be outside the Board’s statutory limits and in excess of its jurisdiction” and “the Board can no longer issue a final determination addressing all grounds raised in the petition as required by *SAS*.” *Id.* (citing *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2140–42 (2016)).

Novo Nordisk Healthcare AG (“Patent Owner”) responds that [Petitioner] LFB seeks to have its petition dismissed as if it never filed it in the first place and escape the effect of its loss on the originally instituted grounds, a clearly prejudicial result to Patent Owner Novo Nordisk. Setting aside the the equities of [Petitioner] LFB’s motion (which clearly favor Novo Nordisk), the motion has no basis in the law and should be denied in its entirety.

Patent Owner’s Opposition to Petitioner LFB’s Motion to Terminate, Dismiss, and Vacate (Paper 100, “Opp.”) 1–2.

As explained below, we have jurisdiction here and will proceed to a final written decision on the remaining grounds now before us.

### *Background*

A review of the procedural posture of this proceeding provides context for determining the relative merits of the parties’ positions. On

April 11, 2017, we instituted an *inter partes* review for challenged claims of U.S. Patent No. 9,102,762 B2 (“the ’762 patent”), based upon only a subset of the grounds presented in the Petition. Paper 7, 5 (all grounds), 23 (instituted grounds). The *inter partes* review did not include certain grounds based on Eibl ’023,<sup>1</sup> for which we determined Petitioner had not demonstrated a reasonable likelihood of prevailing. *Id.* at 20–22. We also determined that Petitioner had not demonstrated a reasonable likelihood of prevailing with respect to its anticipation challenge based on Tolo.<sup>2</sup> *Id.* at 18. A trial was conducted on the grounds on which we instituted trial. This institution and trial on only a subset of the grounds set forth in the Petition was consistent with Board practice at the time. In our Final Written Decision, issued on April 5, 2018, we concluded that Petitioner had not shown by a preponderance of the evidence that claims 1–15 of the ’762 patent were unpatentable under 35 U.S.C. § 103 on the grounds upon which we instituted the *inter partes* review. Paper 53, 41.

After our Final Written Decision was entered, but during the time in which Petitioner could still file a Request for Rehearing, the United States Supreme Court issued its opinion in *SAS Institute, Inc. v. Iancu* requiring that all claims challenged in a petition must be included in any trial. *See SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1354–60 (2018) (“*SAS*”) (holding that 35 U.S.C. § 318(a) requires a final written decision addressing all of the claims challenged in a petition). Shortly thereafter, the Office issued guidance stating that “[i]f the PTAB institutes a trial, the PTAB will

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<sup>1</sup> Eibl, WO 2004/011023 A1; Feb. 5, 2004 (Ex. 1008, “Eibl ’023”); Ex. 1009 (English Translation).

<sup>2</sup> Tolo et al., WO 99/64441; Dec. 16, 1999 (Ex. 1006, “Tolo”).

institute on all challenges raised in the petition.” *Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) (“Office Guidance”) (available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>).

At the request of Petitioner, we held a conference call with the parties and granted Petitioner a three-week extension and more pages for its Request for Rehearing “to address all issues, including matters discussed in the Final Written Decision, *SAS*, and the previously non-instituted grounds.” Paper 54, 4. In deciding the Request for Rehearing, we stated “we find no reason to modify our analysis or conclusions in the FWD with respect to the Tolo Grounds.” Paper 60, 8. However, in view of *SAS* and the Office Guidance, we also stated that “it is appropriate to grant rehearing to now institute on the previously non-instituted grounds.” *Id.* at 9. Therefore, on August 7, 2018, we instituted a supplemental trial focusing on the Tolo anticipation ground and the Eibl ’023 grounds that we did not consider in our prior Final Written Decision. *Id.* at 11. The parties filed supplemental briefs, and we held a supplemental oral hearing addressing these grounds on February 6, 2019. *See* Paper 67 (Patent Owner’s Supplemental Rehearing Response); Paper 81 (Petitioner’s Supplemental Reply); Paper 101 (Transcript for Supplemental Oral Hearing).

#### *Analysis*

Petitioner asserts that we have no jurisdiction to render a final written decision on the remaining grounds for which we instituted trial on August 7, 2018 because 35 U.S.C. § 316(a)(11) requires that a final determination be entered in an *inter partes* review no later than one year after institution unless extended by not more than six months for good cause. Mot. 4–5;

*see* 35 U.S.C. § 316(a)(11) (requiring regulations setting forth the prescribed time limits for issuing a final written decision). Petitioner asserts that issuing a final written decision now would be *ultra vires* because “[t]he 12–18 month limit is not a mere legislative suggestion nor mere housekeeping; rather, exceeding the time limit contravenes the statute’s purpose and goal, and deprives the Board of the authority to further adjudicate the merits.” *Id.* at 4, 7. Petitioner concludes:

In sum, the statutory scheme and legislative history establish that the Board was never intended to have unfettered ability to ignore the 12–18 month deadline and issue final determinations whenever it wants. The intertwined provisions regarding the deadline and the application of estoppel, as well as Congress’s clear desire to avoid the open-ended timelines of prior PTO proceedings and to stay parallel litigation, unambiguously show the deadline imposed by § 316(a)(11) is jurisdictional and bars post-deadline final determinations by the Board.

The Board issued its rehearing decision on Aug. 7, 2018, granting in-part [Petitioner’s] request and instituting review on the previously non-instituted grounds. Paper 60, 9. This was an institution decision. Accordingly, pursuant to 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c), the Board had 12 months (Aug. 7, 2019)—or 18 months with good cause (Feb. 7, 2020)—to issue a final determination. We are now well past those deadlines, without a final resolution.

Mot. 11–12.

The Final Written Decision on the originally instituted challenges, Petitioner asserts, cannot be considered a final written decision because it “did not address all grounds raised by petitioner” as required by *SAS*. *Id.* at 12. Petitioner asserts that the issued Final Written Decision should be vacated and this proceeding terminated “since the Board can no longer issue

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