

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUEVOLUTION A/S,
Petitioner,

v.

CHEMGENE HOLDINGS APS,
Patent Owner.

Case IPR2017-01599
Patent 8,168,381 B2

Before SUSAN L. C. MITCHELL, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

Claims 1, 3, 5, 6, 10–15, 17, 23–26, 31, 34, 37, 44, and 45
Shown to Be Unpatentable
35 U.S.C. §§ 314, 318(a) and 37 C.F.R. §§ 42.4(a), 42.73

ORDERS

Denying-In-Part Petitioner's Motion to Exclude (Paper 36)
37 C.F.R. § 42.64(c)

I. INTRODUCTION

A. Overview

Nuevolution A/S (“Petitioner”) filed a Corrected Petition to institute *inter partes* review of claims 1, 3, 5, 6, 10–15, 17, 23–26, 31, 34, 37, 44, and 45 of U.S. Patent No. 8,168,381 B2 (Ex. 1001, “the ’381 patent”). Paper 8 (“Petition” or “Pet.”). Chemgene Holdings APS (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 10 (“Prelim. Resp.”). On January 11, 2018, we instituted trial to review the patentability of claims 1, 3, 5, 6, 10–15, 17, 23–26, 31, 34, 37, 44, and 45 on four of the seven grounds advanced in the Petition. Paper 16 (“Inst. Dec.”).

In light of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we later instituted trial on the remaining three grounds presented in the Petition (“the additional grounds”) and ordered the parties to confer to discuss whether changes to the schedule and/or additional briefing (beyond what was already filed or authorized) were necessary to address the additional grounds. Paper 25. On May 10, 2018, the parties responded via email, informing the Board that no changes to the schedule were necessary, that Patent Owner requested its Preliminary Response (Paper 10) be considered as part of the trial proceedings because Patent Owner intended to rely on its arguments in that paper related to the additional grounds, and that Petitioner requested an enlargement of the word limit for its Reply Brief to Patent Owner Response to address the additional grounds. Paper 26, 2–3. We granted each of those unopposed requests. *Id.* We also granted the parties’ request that the Board consider and make part of the trial proceedings the supplemental pre-institution claim construction briefing that was authorized. Paper 14 (Petitioner’s Reply to Patent Owner’s Preliminary Response) and Paper 15 (Patent Owner’s Sur-Reply); Paper 26, 2–3.

During the trial, Patent Owner filed a Response. Paper 22 (“Resp.”). Petitioner filed a Reply to Patent Owner’s Response. Paper 29 (“Reply”). Patent Owner asked for authorization to file a motion to strike the Reply for alleged non-compliance with 37 C.F.R. § 42.23(b). We did not grant authorization, but permitted the parties to submit supplemental briefing on the issue. Papers 30–32. And, per Patent Owner’s request, we authorized argument on that issue at the oral hearing, and we indicated the Board would consider such briefing and oral argument in assessing whether the Reply exceeded the scope permitted under Rule 42.23(b). *Id.* Patent Owner filed a Contingent Motion to Amend (Paper 21), to which Petitioner filed an Opposition (Paper 27).¹ Petitioner also filed a Motion to Exclude Evidence. Paper 36. Patent Owner opposed that motion, and Petitioner replied. Paper 39; Paper 40.

Both parties requested oral argument (Paper 37; Paper 38), which we scheduled for September 18, 2018 (Paper 41). On September 12, Patent Owner submitted an unopposed request to withdraw its Motion to Amend and to withdraw its request for oral argument (Paper 42 (Sept. 12, 2018 Notice of Stipulation and Proposed Order)), which we granted (Paper 43). On September 14, 2018, Patent Owner responded via email to the Board’s Order (confirming that the September 18 Oral Argument would proceed (Paper 44)), and stated Patent Owner was ceding its allotted time and had elected not to appear at the Oral Argument. Ex. 3001; Paper 45 (“Tr.”), 3:13–18. On September 18, 2018, we held Oral Argument (which Patent

¹ Several days before the scheduled Oral Argument, Patent Owner made an unopposed request to withdraw its Motion to Amend. Paper 42 (Sept. 12, 2018 Notice of Stipulation and Proposed Order). We granted Patent Owner’s request. Paper 43.

Owner did not attend) and the transcript has been entered into the record.
See Tr.

The '381 patent includes two independent claims (and several dependent claims) that recite methods of synthesizing encoded molecules, which are described in detail below. Petitioner's challenges addressed in this Final Written Decision turn in large part on whether the asserted prior art discloses the synthesis of encoded molecules — via the addition of a molecule fragment, a linker, and an oligonucleotide identifier — in the *same* reaction well. Patent Owner agrees this is what independent claims 1 and 5 require, but the prior art discloses only that such molecules are synthesized in multiple *different* reaction wells. *See, e.g.*, Prelim. Resp. 3, 8–10, 16–17, 21–26, 45–46; Paper 15, 1, 7; Resp. 11–27, 55–58. Petitioner, on the other hand, argues that a “well” is not limited to any specific physical container or vessel such that the claims embrace synthesis of particular encoded molecules in one container, or in many, if the desired reactions occur and the desired molecules are made. *See, e.g.*, Paper 14, 3–4; Reply 1–5. Petitioner alternatively argues that even if the claims require synthesis of particular encoded molecules in the *same* reaction well and this means a single container (e.g., a well on a microtiter plate), this is disclosed in the asserted prior art. *See, e.g.*, Pet. 11–13, 36–37; Reply 1, 7–26. We further address the arguments and evidence on these points below.

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. As explained below, we conclude that Petitioner has established by a preponderance of the evidence in this trial record that claims 1, 3, 5, 6, 10–15, 17, 23–26, 31, 34, 37, 44, and 45 of the '381 patent are unpatentable.

B. Related Proceedings

Petitioner identifies no prior or pending litigation related to infringement or invalidity of the claims of the '381 patent. Pet. 2. Petitioner, however, identifies proceedings in the United States District Court for the Eastern District of Virginia (*Nuevolution A/S v. Pedersen*, No. 1:14-CV-00357 (E.D. Va.)) and the Maritime and Commercial High Court in Denmark (*Nuevolution A/S v. Pedersen*, T-16-12) related to correction of inventorship of the '381 patent and/or Petitioner's entitlement to rights in the '381 patent (or its PCT priority application). *Id.* at 2–3. According to Petitioner, the U.S. district court dismissed the proceedings in Virginia on the basis of *forum non conveniens*. *Id.* at 3.

Patent Owner provides more information about those proceedings. Patent Owner notes that the United States Court of Appeals for the Federal Circuit (*Nuevolution A/S v. Chemgene Holdings APS*, 693 F. App'x 907 (Fed. Cir. July 19, 2017)) affirmed the district court's dismissal. Prelim. Resp. 11 Ex. 2001 (affirming under Fed. Cir. R. 36). Regarding the proceedings in Denmark, Patent Owner asserts that, in February 2016, the "Maritime and Commercial Court ruled that a 2007 Settlement Agreement between Nuevolution and Chemgene completely and perpetually bars Nuevolution from challenging Chemgene's ownership of the PCT application and all related rights, including the '381 patent." Prelim. Resp. 11. Nuevolution, however, appealed this ruling to the Danish Court of Appeal, which remanded the case to the Maritime and Commercial Court on December 8, 2017. *Id.*; Resp. 58.

Petitioner filed another petition for *inter partes* review of claims in U.S. Patent No. 8,168,381 B2 (IPR2017-01598), as well as a petition for *inter partes* review of the sole claim in U.S. Patent No. 8,951,728 B2 ("the

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