

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NOVARTIS PHARMACEUTICALS CORPORATION,  
Petitioner,

v.

PLEXXIKON INC.,  
Patent Owner.

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Case IPR2018-01287  
Patent 9,469,640 B2

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Before SHERIDAN K. SNEDDEN, JO-ANNE M. KOKOSKI, and  
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

## I. INTRODUCTION

Novartis Pharmaceuticals Corporation (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1, 2, 4–6, 9, 11, and 12 of U.S. Patent No. 9,469,640 B2 (“the ’640 patent,” Ex. 1001). Paper 2 (“Pet.”). Plexxikon Inc. (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see* 37 C.F.R. § 42.4. Upon consideration of the Petition, the Preliminary Response, and the evidence of record, we determine that the Petition presents substantially the same arguments as those previously presented to the Office, and, thus, exercise our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review as to claims 1, 2, 4–6, 9, 11, and 12 of the ’640 patent.

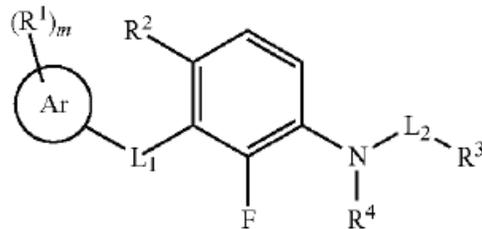
### A. *Related Proceedings*

The parties indicate that the ’640 patent is being asserted in *Plexxikon Inc. v. Novartis Pharmaceuticals Corp.*, Civil Action No. 4:17-cv-04405 HSG (EDL) (N.D. Cal.). Paper 8, 2; Pet. 4.

### B. *The ’640 Patent*

The ’640 patent, titled “Compounds and Methods for Kinase Modulation, and Indications Therefor,” is directed to compounds “that are active on protein kinases in general,” and methods for the use of such compounds “in treating diseases and conditions associated with regulation of the activity” of the protein kinases. Ex. 1001, 1:26–46. The ’640 patent

describes a genus of compounds that have the following generic formula (“Formula I”):



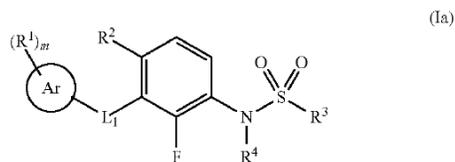
Formula I

*Id.* at 1:51–3:64. The '640 patent identifies a number of options for each of Ar, R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup>, L<sub>1</sub>, L<sub>2</sub>, and m. *Id.* For example, the '640 patent states that “Ar is optionally substituted heteroaryl,” “R<sup>2</sup> is hydrogen, lower alkyl or halogen,” and “R<sup>3</sup> is optionally substituted lower alkyl, optionally substituted C<sub>3–6</sub> cycloalkyl, optionally substituted heterocycloalkyl, optionally substituted aryl or optionally substituted heteroaryl.” *Id.* at 1:65, 2:13, 2:17–20. The '640 patent further discloses a number of sub-genera of Formula I that it identifies as Formulae Ia, Ib, Ic, Id, Ie, If, Ig, Ih, Ii, and Ij. *Id.* at 3:65–13:41.

### C. Challenged Claims

Petitioner challenges claims 1, 2, 4–6, 9, 11, and 12 (“the challenged claims”) of the '640 patent. Claim 1, the only independent claim, is reproduced below.

1. A compound of formula (Ia):



or a pharmaceutically acceptable salt thereof, wherein:

$L_1$  is a bond or  $\text{—N(H)C(O)—}$ ;  
each  $R^1$  is optionally substituted lower alkyl or optionally substituted heteroaryl;  
 $R^2$  is hydrogen or halogen;  
 $R^4$  is hydrogen;  
 $R^3$  is optionally substituted lower alkyl or optionally substituted aryl;  
 $m$  is 0, 1, 2, 3, 4, or 5; and  
Ar is a monocyclic heteroaryl containing 5 to 6 atoms wherein at least one atom is nitrogen.

Ex. 1001, 150:25–47.

*D. The Asserted Ground of Unpatentability*

Petitioner challenges the patentability of claims 1, 2, 4–6, 9, 11, and 12 of the '640 patent under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 7,994,185 B2, issued on August 9, 2011 (“the '185 patent,” Ex. 1006).

## II. ANALYSIS

Institution of *inter partes* review is discretionary. See 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Our discretion on whether to institute is guided by 35 U.S.C. § 325(d), which states that “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Patent Owner contends that Petitioner’s challenge relies on the same or substantially the same arguments that were already considered during the prosecution of the '640 patent. Prelim. Resp. 9–16.

When evaluating whether the same or substantially the same prior art or arguments previously were presented to the Office under § 325(d), the Board has considered a number of non-exclusive factors, including: (1) the

similarity of the asserted art and the prior art involved during the examination; (2) the extent to which the asserted art was considered during examination, including whether the prior art was the basis for rejection; (3) the cumulative nature of the asserted art and the prior art considered during examination; (4) whether Petitioner has pointed out sufficiently how the Examiner erred in its consideration of the asserted prior art; (5) the extent to which the arguments made during examination and the manner in which Petitioner relies on the prior art or the applicant's arguments during examination overlap; and (6) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the asserted prior art. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative). After considering all of the relevant factors and the parties' arguments, we are persuaded, for the reasons set forth below, that the Petition presents substantially the same arguments previously presented to the Office.

A. *Relevant Prosecution History of the '640 Patent*

The '640 patent issued from U.S. Patent Application Serial No. 15/048,851 ("P5") filed on February 19, 2016 as a continuation of U.S. Patent Application Serial No. 13/926,959 ("P4"), filed on June 25, 2013 as a continuation of U.S. Patent Application Serial No. 13/866,353 ("P3"), filed on April 19, 2013 as a continuation of U.S. Patent Application Serial No. 12/669,450 ("P2"), which is the national phase entry of PCT Application No. PCT/US2008/070124, filed on July 16, 2008. Ex. 1001, (21), (22), (63); *see* Pet. 8–9. P2 claims the benefit of priority to Provisional Application No. 60,959,907 ("P1"), filed on July 17, 2007. Ex. 1001, (60); Pet. 9.

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