Trials@uspto.gov
571-272-7822

Paper 12
August 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER INC.,
Petitioner,

v.

SANOFI-AVENTIS DEUTSCHLAND GMBH,
Patent Owner.

Case IPR2019-01022
Patent 9,526,844 B2

Before HYUN J. JUNG, BART A. GERSTENBLITH, and JAMES A. TARTAL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review and Granting Motion for Joinder
35 U.S.C. §§ 314, 315(c)

I. INTRODUCTION

Pfizer Inc. ("Petitioner") concurrently filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 21–30 of U.S. Patent No. 9,526,844 B2 (Ex. 1004, "the '844 patent") and a Motion for Joinder (Paper 3) with *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, Case IPR2018-01680 (the "Mylan IPR"). Sanofi-Aventis Deutschland GmbH ("Patent Owner") filed a Response to Petitioner's Motion for Joinder (Paper 8) and a Waiver of Patent Owner's Prelminary Response (Paper 9). Thereafter, Petitioner filed a Reply in Support of Petitioner's Motion for Joinder Under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22, 42.122(b). Paper 10. We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted "unless . . . 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(a).

Applying that standard, and upon consideration of the Petition and the evidence of record, we conclude that the information presented shows a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim. Accordingly, we authorize an *inter partes* review to be instituted as to all challenged claims of the '844 patent on all grounds raised in the Petition. We also *grant* Petitioner's Motion for Joinder and, because we join Petitioner to the Mylan IPR, we terminate this proceeding.

II. BACKGROUND

A. The '844 Patent

The '844 patent, titled "Pen-Type Injector," issued December 27, 2016, from an application filed May 17, 2016. Ex. 1004, [54], [45], [22]. The application that matured into the '844 patent claims priority to a foreign application filed March 3, 2003. *Id.* at [30]. The '844 patent "relates to pen-type injectors . . . where a user may set the dose." *Id.* at 1:25–29.

B. Related Proceedings

Inter partes review of claims 21–30 of the '844 patent was instituted on April 3, 2019, on petitions filed by Mylan Pharmaceuticals Inc. ("Mylan") in both the Mylan IPR (i.e., IPR2019-01680) and in *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, Case IPR2018-01682. Pet. 1. Additionally, *inter partes* review of claims 21–30 of the '844 patent was denied in *Mylan Pharmaceuticals Inc. v. Sanofi-Aventis Deutschland GmbH*, Case IPR2018-01696. *Id.*

The parties indicate that patents related to the '844 patent are challenged in Cases IPR2018-01670, IPR2018-01675, IPR2018-01676, IPR2018-01677, IPR2018-01678, IPR2018-01679, IPR2018-01684, IPR2019-00122, IPR2019-00977, IPR2019-00978, IPR2019-00979, IPR2019-00980, IPR2019-00981, IPR2019-00982, IPR2019-00987, IPR2019-01023. Pet. 2; Paper 6, 2–4. The parties also identify related patent applications and patents. Pet. 2–4; Paper 6, 4–6.

The parties further indicate that the '844 patent has been asserted in *Sanofi-Aventis U.S. LLC v. Mylan GmbH*, No. 2:17-cv-09105-SRC-CLW (D.N.J.); *Sanofi-Aventis U.S. LLC v. Merck Sharp & Dohme Corp.*, No. 1:16-cv-00812-RGA-MPT (D. Del.); and *Sanofi-Aventis U.S. LLC, et al.*

v. Mylan GmbH, et al., No. 1:17-cv-00181 (N.D.W.Va.). Pet. 1; Paper 6, 3. The parties also indicate that patents related to the '844 patent have been asserted in *Sanofi-Aventis U.S. LLC v. Eli Lilly and Co.*, Nos. 1:14-cv-00113-RGA-MPT and 1:14-cv-00884 (D. Del.). Pet. 1–2, Paper 6, 3.

C. Real Parties in Interest

Petitioner identifies itself and Hospira, Inc. as real parties in interest. Pet. 1. Patent Owner identifies itself, Sanofi-Aventis U.S. LLC, and Sanofi Winthrop Industrie as real parties in interest. Paper 6, 1.

D. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 21–30 of the '844 patent on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Giambattista[1]	§ 102	21–29
Giambattista and Steenfeldt-Jensen[2]	§ 103	24–29
Giambattista and Klitgaard[3]	§ 103	30

Pet. 5. Petitioner supports its challenge with a declaration by Charles E. Clemens, dated May 1, 2019. Ex. 1011. According to Petitioner, "[t]he opinions set forth in Mr. Clemens's declaration are nearly identical to the opinions set forth in the declaration of Mr. Karl R. Leinsing filed in the Mylan IPR (Mylan IPR Ex. 1011)." Paper 3, 3.

[1] U.S. Patent No. 6,932,794 B2, issued August 23, 2005 (Ex. 1016, "Giambattista").
[2] U.S. Patent No. 6,235,004 B1, issued May 22, 2001 (Ex. 1014, "Steenfeldt-Jensen").
[3] U.S. Patent No. 6,582,404 B1, issued June 24, 2003 (Ex. 1017, "Klitgaard").

III. ANALYSIS

A. Principles of Law

A claim is unpatentable for anticipation under 35 U.S.C. § 102 if a single prior art reference either expressly or inherently discloses every limitation of the claim. *Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 975 (Fed. Cir. 2010). Moreover, "[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Crown Packaging Tech., Inc. v. Ball Metal Beverage Container Corp.*, 635 F.3d 1373, 1383 (Fed. Cir. 2011) (citations omitted); *see also Net MoneyIN v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (holding that "it is not enough [for anticipation] that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention") (citing *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972)). "A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference." *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014) (citing *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)).

A claim is unpatentable for obviousness under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which such subject matter pertains." 35 U.S.C. § 103(a). The question of obviousness under 35 U.S.C. § 103 is resolved on the basis of underlying factual

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.