

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

PGR2018-00062
Patent 9,707,245 B2

Before TONI S. SCHEINER, GRACE KARAFFA OBERMANN, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner filed a Request for Rehearing (Paper 33, “Req. Reh’g”) seeking review of the Board’s Final Written Decision (Paper 32, “Dec.”), in which we held unpatentable claims 1–30 of U.S. Patent No. 9,707,245 B2 (Ex. 1001, “the ’245 Patent”). Patent Owner thereafter filed a request for review by the Precedential Opinion Panel (“POP”), which was denied. Paper 34 (request for POP review); Paper 35 (decision denying request). We also refer to the Petition (Paper 2, “Pet.”), Patent Owner’s Response (Paper 15, “Resp.”), Petitioner’s Reply (Paper 18, “Reply”), and Patent Owner’s Sur-Reply (Paper 21, “Sur-Reply”).

Upon a request for rehearing, we review our decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* We deny the Request for Rehearing based on application of those principles.

II. DISCUSSION

A. Background of the Dispute

The claimed invention relates to a method of treating pain by administration of neridronic acid. Ex, 1001, code (54). Claim 1 is the sole independent claim and requires administration of neridronic acid in salt or acid form to a human being with chronic regional pain syndrome (“CRPS”). *Id.* at 84:59–63 (claim 1). During the trial, a key dispute emerged relating to the limitation of claim 1 specifying, “wherein bone fracture was a

predisposing event for CRPS.” *Id.* at 84:61–62; *see* Dec. 4–6, 21–34 (framing the issue, which first arose during patent prosecution).

The Board determined that work published by Varenna¹ before the critical date of the invention anticipates, or would have made obvious in combination with other references, the claimed invention, based on evidence cited in the Petition, including uncontroverted testimony from Petitioner’s witness, Dr. Lawrence Poree. Dec. 15–17 (Board’s overview of Dr. Poree’s “uncontroverted” and “quite extensive” record of professional accomplishments, supporting our finding “that Dr. Poree is qualified to opine about the perspective of” an ordinarily skilled artisan), 41 (the Board’s chart of conclusions). Patent Owner opposed the Petition, but did not advance expert testimony from a witness of its own choosing, or cross-examine Petitioner’s expert witness. *See* Dec. 7, 15 (pointing out that Patent Owner advanced no expert testimony and declined to depose Petitioner’s witness, Dr. Lawrence Poree).

B. Patent Owner’s Three Asserted Grounds for Modification

Patent Owner requests modification of the Final Written Decision on three grounds. First, Patent Owner submits, the Board overlooked Patent Owner’s Sur-Reply arguments and authority. Req. Reh’g 2–5. Second, according to Patent Owner, the Board misapprehended the law regarding the evidentiary analysis required to conclude that Varenna would have been publicly available at the time of the invention. *Id.* at 5–10. Third, Patent

¹ M. Varenna et al., *Treatment of complex regional pain syndrome type I with neridronate: a randomized, double-blind, placebo-controlled study*, RHEUMATOLOGY 52: 534–42 (Nov. 2012) (Ex. 1005, “Varenna”).

Owner argues that the Board misapprehended the law regarding Petitioner’s burden of proof, improperly drew inferences in favor of Petitioner, and erroneously permitted Petitioner to present evidence of Varenna’s public availability for the first time in the Reply. *Id.* at 11–15. We address in turn each of those asserted grounds for modification.

1) Sur-Reply Arguments and Authority

Patent Owner alleges that the Board reversibly erred by failing to “address or distinguish any of the cited Board decisions or the other arguments and authority Patent Owner Discussed in its Sur-Reply.” Req. Reh’g. 3 (citing Sur-Reply 8–13). The non-binding Board decisions cited in the Sur-Reply do not control the outcome here. In any event, as Patent Owner observes, those decisions acknowledge that a copyright notice “standing alone” may “not [be] enough” to “establish public availability.” Sur-Reply 8 (and citations to non-precedential Board decisions therein). Those decisions are inapplicable here, where the copyright notice was merely one indicia, among a cluster of indicium, contributing to the substantial evidence supporting our finding that Petitioner demonstrated that Varenna was publicly available at the time of the invention. Dec. 9–13.

Patent Owner asserts in the Sur-Reply that a copyright notice on a reference deserves “no fealty whatsoever for purposes of proving ‘printed publication’ status, unless accompanied by other evidence to suggest that public availability around the stated date actually occurred.” Sur-Reply 7. Here again, however, we did not rely on the copyright notice alone. Dec. 9–13. Further, Patent Owner relies in the Sur-Reply on a non-binding Board decision subsequently reversed in a precedential opinion. *Id.* at 8 (quoting

Case PGR2018-00062
Patent 9,707,245 B2

Hulu, LLC v. Sound View Innovations, LLC, Case IPR2018-01039, Paper 12 at 12 (PTAB Dec. 3, 2018), *rev'd* Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential)).

Our findings regarding Varena align with the guidance provided in that precedential opinion, which sets forth a case-by-case approach in which a copyright notice may contribute to the totality of evidence weighed that is relevant to public availability. *See Hulu*, Paper 29 at 9–11, 17–19 (discussing the case-by-case analysis turning on particular circumstances, including the nature of the reference (distinguishing a thesis from a journal article) and the indicia of public accessibility appearing on the face of the reference). Significantly, the facts here include the “conventional markers of publication, such as a copyright date, edition identifier, [and] publication by a commercial publisher” that the Hulu panel identified as relevant. *Id.* at 17.

Further, the record in this case included a compelling additional factor. Specifically, Patent Owner previously identified to the Office, during patent prosecution, a publication date for Varena consistent with the November 2012 date that appears on the face of the document. *See* Dec. 10–12 (analyzing that additional factor). The totality of circumstances support our finding that Petitioner established by a preponderance of evidence that Varena was publicly available prior to the critical date of the invention.

2) Law Regarding the Evidentiary Analysis Pertaining to Public Availability of Varena at the Time of the Invention

Patent Owner submits that the Board “did not determine whether” the evidence of record “shows that Varena was in fact disseminated or otherwise made available such that reasonably diligent and interested

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.