

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GRÜNENTHAL GMBH,  
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,  
Patent Owner.

---

PGR2018-00092  
Patent 9,820,999 B2

---

Before GRACE KARAFFA OBERMANN, SHERIDAN K. SNEDDEN,  
and CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

SNEDDEN, *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 27, “Req. Reh’g”) seeking review of the Board’s Final Written Decision (Paper 25, “Dec.”), in which we held unpatentable claims 1-4, 9, 10, 12, 14, 16-18, 23-25 and 27-29 of U.S. Patent No. 9,820,999 B2 (Ex. 1001, “the ’999 patent”). We also refer to the Petition (Paper 2, “Pet.”), Patent Owner’s Response (Paper 10, “PO Resp.”), Petitioner’s Reply (Paper 11, “Reply”), and Patent Owner’s Sur-Reply (Paper 18, “Sur-Reply”).

For the reasons set forth below, Patent Owner’s request for rehearing is denied.

## II. STANDARD OF REVIEW

“The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

## III. DISCUSSION

### *A. Background of the Dispute*

The claimed invention relates to methods of treating chronic regional pain syndrome (“CRPS”) 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 having CRPS triggered by bone fracture. *Id.* at 106:25–30 (claim 1). In our Final Written

Decision, we determined Varena 2012<sup>1</sup> anticipates the subject matter of claim 1 and dependent claims 2–4, 9, 10, 12, 14, 16–18, 23–25, and 27–29 thereto. Dec. 20–28. In reaching that determination, we further determined that the information pertaining to the publication on the face of Verrena 2012 was sufficient to establish that the document qualifies as a printed publication. Dec. 14–19. In doing so, we considered the testimony of Dr. Robinson (Ex. 1044) and, additionally, the information provided by Patent Owner (PO Resp. 4–13; Sur-Reply 5–13). *Id.*

Patent Owner requests modification of our determination regarding the publication status of Petitioner’s References and, consequently, modification of the Final Written Decision, on three grounds. First, Patent Owner contends that our determination that Verrena 2012 qualifies as a prior art printed publication is based on a misapprehension of the law. Req. Reh’g 2–8. Second, Patent Owner contends we “did not analyze the conclusory assertions of the Robinson Declaration.” *Id.* at 8–11. Third, Patent Owner contends that we improperly relied on evidence submitted with Petitioner’s Reply, specifically, the Robinson Declaration (Ex. 1044). *Id.* at 12–15.

We address in turn each of those asserted grounds for modification.

---

<sup>1</sup> M. Varena 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, “Varena”).

*B. Whether we misapprehended or overlooked evidence of public accessibility*

Patent Owner submits that the panel “did not look for evidence of public accessibility, . . . . which involves examining the evidence for proof that Varena 2012 was ‘disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’” Req. Reh’g 2 (quoting *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)).

We do not agree Patent Owner’s position. On the contrary, we acknowledged *Acceleration Bay* and addressed with particularity the evidence of record tending to show that each of Petitioner’s References “was disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” Dec. 15. Specifically, in our Decision, we credited indicia on the face of Varena 2012, such as printed dates and citation information, which are “part of the totality of the evidence” bearing on the issue of public accessibility. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 17–18 (PTAB Dec. 20, 2019) (precedential). Those indicia included details of the copyright notice, indicating publication of Varena 2012 “by Oxford University Press on behalf of the British Society for Rheumatology” in “2012;” and also additional legends, including “the statement ‘Advance Access publication 30 November 2012,’” and a conventional edition identifier from the journal *Rheumatology*. Dec. 17 (quoting Ex. 1005). Patent Owner advanced no

evidence tending to cast doubt on those indicia of publication. PO Resp. 4–13; Sur-Reply 5–13.

Our findings regarding Varenna 2012 align with the guidance provided in *Hulu*, 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; *see also Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1344 & 1347 (Fed. Cir. 2019) (holding that “the date on the face of the journal” was part of the substantial evidence supporting PTAB’s finding that a journal article was prior art).

Accordingly, we do not agree with Patent Owner that we misapprehended or overlooked the evidence of public accessibility. Rather, in our Decision, we resolved a factual dispute between the parties regarding whether any of Petitioner’s References were publicly available. Dec. 14–19. In doing so, we considered the totality of evidence related to the parties’ positions related to that issue. *Id.* We weighed evidence supporting Petitioner’s position that Varenna 2012 would have been publicly available—largely, the indicia of publication on the face of each document. We also weighed Patent Owner’s arguments and lack of evidence supporting

# 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.