

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EISAI INC.
Petitioner

v.

CRYSTAL PHARMACEUTICAL (SUZHOU) CO., LTD.
Patent Owner

Patent No. 10,759,779

**DECLARATION OF RON BIHOVSKY, PH.D.
IN SUPPORT OF PETITION FOR POST-GRANT REVIEW
OF U.S. PATENT NO. 10,759,779**

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I, Ron Bihovsky, Ph.D., declare as follows:

I. INTRODUCTION

1. I have been retained by Eisai Inc. (“Petitioner”) as an independent expert consultant in this proceeding before the United States Patent and Trademark Office (“PTO”) regarding U.S. Patent No. 10,759,779 (“the ’779 patent”) (Ex. 1001) to Crystal Pharmaceutical (Suzhou) Co., Ltd. (“Patent Owner”).¹ I have been asked to consider whether: (1) U.S. Patent No. 9,416,109 (“Eisai’s ’109 patent” or “the ’109 patent”) (Ex. 1006) inherently disclosed the features recited in claims 1-4 of the ’779 patent; (2) the ’109 patent renders claims 1-4 obvious; and (3) claims 7-8 of the ’779 patent are rendered obvious by the ’109 patent in view of International Patent Publication No. WO 2016/063995 (“the ’995 publication”) (Ex. 1007).

2. I am being compensated at my normal consulting rate for the time I spend on this matter. My compensation is in no way contingent on the nature of my findings, the presentation of my findings in testimony, or the outcome of this or any other proceeding. I have no other interest in this proceeding.

¹ Where appropriate, I refer to exhibits that I understand will be attached to the petition for post-grant review of the ’779 patent.

II. BACKGROUND AND QUALIFICATIONS

3. I am an organic chemistry and medicinal chemistry expert. In my laboratory, I synthesize organic compounds for the pharmaceutical, biotechnology, and agrochemical industries. I have more than 35 years of academic and industrial chemistry experience. My research has resulted in 50 publications in refereed journals, 15 granted U.S. Patents, and numerous foreign patents

4. I obtained a Bachelor of Science degree in chemistry from the State University of New York, Stony Brook in 1970. I earned a Ph.D. in organic chemistry from the University of California, Berkeley in 1978, and was a National Institute of Health postdoctoral fellow at the University of Wisconsin, Madison from 1978 to 1980. My research included synthesis and structure elucidation of biologically-active molecules.

5. From 1980 to 1987, I was an assistant professor of organic chemistry at the State University of New York, Stony Brook, where I performed organic chemistry research, synthesized natural products, supervised undergraduates, graduate students, and postdoctoral fellows, and taught classes including graduate level synthetic organic chemistry and undergraduate organic chemistry courses.

6. From 1987, I worked in the pharmaceutical industry as a medicinal chemist in roles of increasing responsibility at Berlex Laboratories and Cephalon

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