

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02031
Patent 6,407,213 B1

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Boehringer Ingelheim Pharmaceuticals, Inc. (“Petitioner”) filed a Petition for an *inter partes* review of claims 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71–73, 75–78, 80, and 81 of U.S. Patent No. 6,407,213 B1 (“the ’213 patent,” Ex. 1001) based on six asserted grounds. Paper 2, 4 (“Pet.”). On March 29, 2018, we instituted an *inter partes* review of a subset of the challenged claims (1, 2, 4, 25, 29, 62–64, 66, 69, 71, 73, 75–78, 80, and 81) under grounds 4 and 6. Paper 19, 24–25 (“Dec.”). We also noted that asserted grounds 1–3 and 5 are essentially identical to those previously instituted in two co-pending proceedings involving other petitioners. *Id.* at 13. Finding persuasive Patent Owner’s argument that “[t]his redundancy would waste the Board’s and Patent Owner’s resources, and also would unfairly allow Boehringer to preview the parties’ arguments before having to address them itself,” we exercised our discretion under § 325(d) to deny institution of grounds 1–3 and 5. *See id.* at 12–13 (quoting Prelim. Resp. 2).

On April 12, 2018, Petitioner filed a Request for Rehearing of our decision to institute arguing, “that one party should not be precluded from arguing a meritorious ground simply because another party had previously raised that ground.” Paper 23, 4–5 (citing *Dell v Acceleron*, 884 F.3d 1364 (Fed. Cir. March 19, 2018)).

While Petitioner’s Request was pending, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Shortly thereafter, on April 26, 2018, the Office issued a Guidance on the Impact of SAS on AIA Trial Proceedings stating that “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the

petition.” See <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>. Upon consideration of the Court’s opinion in *SAS* and the Office’s related Guidance, we granted Petitioner’s rehearing request and modified our institution decision to institute *inter partes* review on all claims and on all grounds presented in the Petition, including grounds 1–3 and 5. Paper 25.

Patent Owner now files a Request for Rehearing of our decision to institute *inter partes* review. Paper 27. For the reasons set forth below, we deny Patent Owner’s Request.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be found if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Patent Owner contends that modifying our original decision and instituting *inter partes* review with respect to grounds 1–3 and 5, “amounted to an abuse of discretion that violated the APA” because

we “did not articulate any reason why Boehringer’s purported interest in having its petitions instituted outweighed Genentech’s interest in avoid[ing] harassment and enjoy[ing] quite title to [its] rights,” or address why instituting review “on a delayed track would result in proceedings that were unfairly prejudicial to Genentech.” Paper 27, 3–4 (citation omitted).

In our initial decision, we considered both “the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously,” as well as “the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent—in the case of an *inter partes* review—over prior art patents and printed publications.” Dec. 10 (citations omitted). Given the legal landscape at that time, we exercised our discretion under § 325(d) to deny institution with respect to grounds 1–3 and 5.

Subsequent to that decision, the Supreme Court’s opinion in *SAS*, along with the Office’s related Guidance, required us to re-evaluate our initial decision on institution as a binary, yes-or-no determination with respect to all claims and all grounds, respectively. In our initial decision instituting *inter partes* review, we determined that grounds 2 and 4 had merit. Likewise, having previously instituted *inter partes* review on grounds 1–3 and 5 in cases brought by other Petitioners. In light of *SAS* and the Office’s Guidance, we gave greater weight to the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent. This rebalancing is supported by the response to

question C1 of the Office's June 5, 2018, FAQ Guidance¹ on the implications of SAS:

C1. Q: Will the Board vacate its prior institution decision if including all claims and/or grounds would bring in challenges that were initially denied under 35 USC § 325(d)?

A: No, at this time the Board does not anticipate vacating prior institution decisions under these circumstances. Although challenges subjected to § 325(d) will be addressed in the Final Written Decision, panels will take into account evidence that the same or substantially the same art or argument was previously before the Office and give such evidence due weight in addressing the challenge.

IV. CONCLUSION

For the foregoing reasons, we conclude that Patent Owner has not shown that the Board abused its discretion in ordering institution on all claims and all grounds.

V. ORDER

Accordingly, it is

ORDERED that Patent Owner's Request for Rehearing is denied.

¹ Frequently Asked Questions about SAS Implications (June 5, 2018), https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf (last accessed June 27, 2018).

IPR2017-02031
Patent 6,407,213 B1

PETITIONER:

Ire J. Levy
Brian A. Fairchild
Ira J. Levy
GOODWIN PROCTER LLP
ilevy@goodwinlaw.com
bfairchild@goodwinlaw.com

PATENT OWNER:

David L. Cavanaugh
Rebecca A. Whitfield
Robert J. Gunther
Lisa J. Pirozzolo
Kevin S. Prussia
Andrew J. Danford
WILMER CUTLER PICKERING HALE AND DORR LLP
david.cavanaugh@wilmerhale.com
Rebecca.Whitfield@wilmerhale.com
Robert.gunther@wilmerhale.com
Lisa.pirozzolo@wilmerhale.com
Kevin.prussia@wilmerhale.com
Andrew.danford@wilmerhale.com

Adam R. Brausa
DURIE TANGRI LLP
abrausa@durietangri.com