

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.,  
Petitioner,

v.

GENENTECH, INC.,  
Patent Owner.

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Case IPR2017-02031  
Patent 6,407,213 B1

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

POLLOCK, *Administrative Patent Judge*.

DECISION  
Granting Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## 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, 71, 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 under grounds 4 and 6. Paper 19, 24–25 (“Dec.”). On April 12, 2018, Petitioner filed a Request for Partial Rehearing of the Decision. Paper 23 (“Reh’g Req.”).

For the following reasons, we grant Petitioner’s request.

## STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

## DISCUSSION

Petitioner asserted the following grounds of unpatentability (Pet. 4):

Ground	Claim(s)	Basis	Reference(s)
1	1, 2, 25, 29, 63, 66, 71, 75, 76, 78, 80, and 81	§ 102	Kurrle <sup>1</sup>
2	1, 2, 4, 29, 62–64, 80, and 81	§ 102	Queen 1990 <sup>2</sup>
3	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 72, 75, 76, 78, 80, and 81	§ 103	Kurrle and Queen 1990
4	1, 2, 4, 25, 29, 62, 64, 66, 69, 71, 73, 75–78, 80, and 81	§ 102	Jones <sup>3</sup>
5	73 and 77	§ 103	Kurrle, Queen 1990, and Chothia & Lesk <sup>4</sup>
6	63	§ 103	Jones and Riechmann <sup>5</sup>

We instituted an *inter partes* review to determine whether Jones anticipates claims 1, 2, 4, 25, 29, 62, 64, 66, 69, 71, 73, 75–78, 80, and 81 of

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<sup>1</sup> Kurrle, et al., European Patent Application Publication No. 0403156, published December 19, 1990. Ex. 1071.

<sup>2</sup> Queen, et al., International Publication No. WO 90/07861, published July 26, 1990. Ex. 1050.

<sup>3</sup> Jones et al., *Replacing the complementarity-determining regions in a human antibody with those from a mouse*, 321 Nature 522–525 (1986). Ex. 1033.

<sup>4</sup> Chothia and Lesk, *Canonical Structures for the Hypervariable Regions of Immunoglobulins*, 196 J. MOL. BIOL. 901–17 (1987). Ex. 1062.

<sup>5</sup> Riechmann et al., *Reshaping human antibodies for therapy*, 332 Nature 323–327 (1988). Ex. 1069.

the '213 patent as set forth in ground 4. Dec. 24. With respect to ground 6, we instituted inter partes review to determine whether claim 63 was obvious over Jones and/or Jones and Riechmann. *Id.* at 24–25. In contrast, we exercised our discretion under § 325(d) to deny institution of grounds 1–3 and 5, which are essentially identical to those already instituted in two co-pending proceedings involving other petitioners. *Id.* at 13. In explaining our decision, we stated “Petitioner could have sought to join the pending IPRs. It did not do so and the time for requesting joinder has expired.” *Id.*

Petitioner now argues that we previously instituted *inter partes* reviews on Grounds 1–3, and 5 in IPR2017-01373 and IPR2017-01489 and should not use our discretion to deny meritorious grounds. *Id.* at 3. Petitioner further notes that, in light of our Decision, claims 67 and 72 are unchallenged on any ground in this proceeding. *Id.* at 1.

On April 24, 2018, subsequent to the April 12, 2018 filing of Petitioner’s request for rehearing, 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*, 2018 WL 1914661, at \*10 (U.S. Apr. 24, 2018). The Office issued a Guidance on the Impact of SAS on AIA Trial Proceedings. See <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

Accordingly, and further to our Decision of March 29, 2018, we grant Petitioner’s partial rehearing request and institute an *inter parte* review on all challenged claims and all of the grounds presented in the Petition.

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to otherwise

change the schedule beyond that permitted by stipulation under the scheduling order or submit further briefing, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing.

### ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Partial Rehearing is granted;

FURTHER ORDERED that an *inter partes* review is instituted on the following grounds:

1. claims 1, 2, 25, 29, 63, 66, 71, 75, 76, 78, 80, and 81 as anticipated by Kurrle;
2. claims 1, 2, 4, 29, 62–64, 80, and 81 as anticipated by Queen 1990;
3. claims 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 72, 75, 76, 78, 80, and 81 as obvious in view of Kurrle and Queen 1990;
4. claims 1, 2, 4, 25, 29, 62, 64, 66, 69, 71, 73, 75–78, 80, and 81 as anticipated by Jones;
5. claims 73 and 77 as obvious in view of Kurrle, Queen 1990, and Chothia & Lesk; and
6. claim 63 as obvious in view of Jones and/or Jones and Riechmann.

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule not authorized by stipulation under the scheduling order in this case or any further briefing, and, if so, shall request a conference call with the panel to seek authorization for such changes or briefing within one week of the date of this Order.

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