

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERIGEN PHARMACEUTICALS LIMITED,
Petitioner,

v.

SHIRE LLC,
Patent Owner.

Case IPR2015-02009
Patent RE42,096 E

Before TONI R. SCHEINER, LORA M. GREEN, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

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

On April 18, 2016, we instituted an *inter partes* review of claims 18–21, 23, and 25 of U.S. Patent No. RE42,096 E (Ex. 1001, “the ’096 patent”). See Paper 8 (“Decision” or “Dec.”) based on challenges brought by Petitioner, Amerigen Pharmaceuticals Limited. On May 2, 2016, Shire LLC (“Shire” or “Patent Owner”) filed a Request for Rehearing of our Decision with respect to claim 25 (Paper 10, “Reh’g Req.”).

We deny Shire’s Request for Rehearing for the reasons set forth below.

STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. See 37 C.F.R. § 42.71(c). An abuse of discretion occurs 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. See *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 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, in relevant part, “specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. We address Shire’s arguments with these principles in mind.

ANALYSIS

Claim 25 of the '096 patent is a multiple dependent claim, and reads as follows:

25. The pharmaceutical composition of any one of claims 2, 13 or 18 to 20 wherein the pharmaceutically active amphetamine salt in (a) and (b) comprises mixed amphetamine salts.

Ex. 1001, 16:14–17.

In our Decision, we differentiated between the limitations of claim 25 owing to its dependency from claim 2 (Dec. 29), and the limitations owing to its dependency from claims 18–20 (*id.* at 29, 30, 31, 35). We did not institute an *inter partes* review of claim 2 on any ground (*id.* at 29–34), and we further noted that claim 13 had not been challenged by Petitioner (*id.* at 29 n.9). Ultimately, we determined that Petitioner had established a reasonable likelihood of prevailing in its challenge of claims 18–21, 23, and 25—on the basis of claim 25’s dependency in the alternative from claims 18, 19, and 20—as unpatentable over Mehta¹ and the Adderall PDR,² and instituted an *inter partes* review of claims 18–21, 23, and 25 on that ground.

Shire acknowledges that “the Decision, in instituting this IPR for claims 18–[21], 23 and 25, does distinguish claim 25 as it depends from claims 18–20 (instituted) and claim 25 as it depends from claim 2 (not instituted)” (Reh’g Req. 2), but contends that “the Order does not do so, at least expressly” (*id.* at 3). Shire contends:

¹ U.S. Patent No. 5,837,284, issued November 17, 1998, to Mehta et al. (“Mehta”) (Ex. 1003).

² PHYSICIANS’ DESK REFERENCE 331, 2209–11 (51st ed. 1997) (“Adderall PDR”) (Ex. 1004).

To the extent the Board's Order (Decision at 38) includes the claim 2 and claim 13 embodiments of claim 25 in this IPR, the Order is a misapplication of law and contradicts the Board's factual findings. Such an over-reaching Order would be an abuse of discretion, and should be corrected.

Id. at 8.

We are not persuaded and decline to alter the Order concluding the Decision of April 19, 2016 in any way. Claim 25 would fall should Petitioner prevail in its obviousness challenge—so long as claim 25's dependency from claims 18–20 remains. However, we take this opportunity to confirm that claim 25 is part of the trial only to the extent it depends from claims 18–20, and not to the extent it depends from non-instituted claims 2 and 13.

ORDER

It is

ORDERED that Patent Owner's request for rehearing of the Decision instituting an *inter partes* review of claim 18–21, 23, and 25 of U.S. Patent No. RE42,096 E is *denied*.

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