

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC.,
Petitioner,

v.

INDIVIOR UK LIMITED,
Patent Owner.

Case IPR2016-00280
Patent 8,475,832 B2

Before TONI R. SCHEINER, JACQUELINE WRIGHT BONILLA, and
ZHENYU YANG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Teva Pharmaceuticals USA, Inc., (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–7 and 9–12 of U.S. Patent No. 8,475,832 B2 (Ex. 1001, “the ’832 patent”). Paper 1 (“Pet.”). Indivior UK Limited (“Patent Owner”) filed a Preliminary Response. Paper 16 (“Prelim. Resp.”). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless it is determined that there is “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

We determine that Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of any claim challenged in the Petition. Accordingly, we decline to institute an *inter partes* review.

A. Related Proceedings

The parties identify multiple lawsuits where Patent Owner has filed suit against Petitioner and other defendants asserting infringement of the ’832 patent in several U.S. district courts. Pet. 7–8; Paper 7, 3–4. In addition, the parties discuss IPR2014-00998, where a panel previously denied an *inter partes* review based on a petition filed by a different petitioner, challenging claims 15–19 of the same patent at issue here. Pet. 8–9; Paper 7, 2; *BioDelivery Scis. Int’l., Inc. v. RB Pharm. Ltd.*, Case No. IPR2014-00998 (PTAB Dec. 19, 2014) (Paper 12). The parties also refer to IPR2014-00325, where a panel determined in a Final Written Decision that the petitioner in IPR2014-00998 had established by a preponderance of the evidence that claims 15–19 of the ’832 patent were unpatentable. Pet. 8–9; Paper 7, 2; *BioDelivery Scis. Int’l., Inc. v. RB Pharm. Ltd.*, Case No.

IPR2014-00325 (PTAB June 30, 2015) (Paper 43). Patent Owner indicates that the Final Written Decision “is currently on appeal to the Court of Appeals for the Federal Circuit, Docket No. 16-1044.” Paper 7 at 2–3; Pet. 9.

B. Proposed Grounds of Unpatentability

Petitioner advances four grounds of unpatentability under 35 U.S.C. § 103(a) in relation to claims 1–7 and 9–12 of the ’832 patent (Pet. 12–13):

References	Statutory Basis	Challenged Claims
LabTec ¹ in view of Yang, ² the Suboxone® 2002 Label, ³ SBOA ⁴ and Birch ⁵	§ 103(a)	1, 2, 4–7, 9, and 10
LabTec in view of Yang, the Suboxone® 2002 Label, SBOA, Birch, and the ’055 publication ⁶	§ 103(a)	3, 11, and 12

¹ WO 2008/040534 A2, published Apr. 10, 2008 (“LabTec”) (Ex. 1007)

² Yang et al., U.S. Patent No. 7,357,891 B2, issued Apr. 15, 2008 (“Yang”) (Ex. 1006).

³ Suboxone® 2002 Label (Ex. 1008).

⁴ Suboxone® Tablet Summary Basis of Approval (“SBOA”) (Ex. 1009).

⁵ Birch et al., U.S. Pat. Appl. Publ. No. 2005/0085440 A1, published Apr. 21, 2005 (“Birch”) (Ex. 1004).

⁶ Yang et al., U.S. Pat. Appl. Publ. No. 2005/0037055 A1, published Feb. 17, 2005 (“the ’055 publication”) (Ex. 1010).

References	Statutory Basis	Challenged Claims
Oksche ⁷ in view of Yang, the Suboxone® 2002 Label, SBOA, and Birch	§ 103(a)	1, 2, 4–7, 9, and 10
Oksche in view of Yang, the Suboxone® 2002 Label, SBOA, Birch, and the '055 publication	§ 103(a)	3, 11, and 12

In addition, Petitioner supports its challenges in the Petition with a Declaration by Nandita Das, Ph.D. (“Das Decl.”) (Ex. 1003). Pet. 13.

C. The '832 Patent

The '832 patent relates to compositions and methods for treating narcotic dependence using an orally dissolvable film comprising buprenorphine and naloxone, wherein the film provides a bioequivalent release profile and drug absorption as compared to that of a Suboxone® tablet. Ex. 1001, 4:53–58, 2:55–62, 3:19–21. The '832 patent defines bioequivalent as “obtaining 80% to 125% of the C_{max} and AUC values for a given active in a different product.” *Id.* at 3:48–50. According to the '832 patent, “C_{max} refers to the mean maximum plasma concentration after administration of the composition to a human subject,” and “AUC refers to the mean area under the plasma concentration-time curve value after administration of the compositions.” *Id.* at 3:9–14.

At the time of the '832 patent invention, Suboxone®, an orally dissolvable tablet of buprenorphine and naloxone, was on the market for treating opioid dependency. *Id.* at 4:51–55. Buprenorphine, an opioid

⁷ WO 2008/025791, published March 6, 2008 (“Oksche”) (Ex. 1005).

agonist, provides an effect of satisfying the body's urge for the narcotics, but not the "high" associated with misuse. *Id.* at 1:36–40. Naloxone, an opioid antagonist, reduces the effect of buprenorphine, and, thus, decreases the likelihood of diversion and abuse of buprenorphine. *Id.* at 1:46–52.

The tablet form, however, still has the potential for abuse because it can be removed easily from the mouth for later extraction and injection of buprenorphine. *Id.* at 1:55–62. According to the '832 patent,

There [was] a need for an orally dissolvable film dosage form that provides the desired absorption levels of the agonist and antagonist, while providing an adhesive effect in the mouth, rendering it difficult to remove once placed in the mouth, thereby making abuse of the agonist difficult.

Id. at 1:65–2:2.

In relation to a "self-supporting film composition," the '832 patent describes that "local pH of the dosage is preferably controlled to provide the desired release and/or absorption" of the drugs. *Id.* at 11:8–10, 44–46, 11:62–12:3. As described in the patent:

Buprenorphine is known to have a pKa of about 8.42, while naloxone has a pKa of about 7.94. According to pH partition theory, one would expect that saliva (which has a pH of about 6.5) would maximize the absorption of both actives. However, it has been surprisingly discovered by the Applicants that by buffering the dosage to a particular pH level, the optimum levels of absorption of the agonist and antagonist may be achieved. Desirably, the local pH of a composition including an agonist and an antagonist is between about 2 to about 4, and most desirably is from 3 to 4. At this local pH level, the optimum absorption of the agonist and the antagonist is achieved.

Id. at 11:46–57. Thus, the inventors achieved optimum absorption of both buprenorphine (agonist) and naloxone (antagonist) at a "local pH" of "about

2 to about 4, and most desirably [] from 3 to 4.” *Id.* The ’832 patent defines “local pH” as “the pH of the region of the carrier matrix immediately surrounding the active agent as the matrix hydrates and/or dissolves, for example, in the mouth of the user.” *Id.* at 3:35–38.

The ’832 patent describes in an example that “a film having a combination of buprenorphine and naloxone and a local pH of 6.5 did not provide a bioequivalent effect as the Suboxone® tablet for both buprenorphine and naloxone.” *Id.* at 19:61–67. By contrast, as stated in another example, “in vivo data indicated that the absorption of buprenorphine was substantially bioequivalent to that of the one dose tablet when the film composition local pH was lowered to about 3–3.5.” *Id.* at 23:1–4. The ’832 patent states that this “result was surprising as it did not appear to follow the pH partition theory,” and “[f]urther, at a local pH of about 3–3.5, it was seen that the absorption of naloxone was substantially bioequivalent to that of the one dose tablet.” *Id.* at 23:4–11.

D. Claims

Among the challenged claims, claims 1 and 9 are independent. Claim 1 is representative, and is reproduced below.

1. A film dosage composition comprising:
 - a. A polymeric carrier matrix;
 - b. A therapeutically effective amount of buprenorphine or a pharmaceutically acceptable salt thereof;
 - c. A therapeutically effective amount of naloxone or a pharmaceutically acceptable salt thereof; and
 - d. A buffer in an amount to provide a local pH for said composition of a value sufficient to optimize absorption of said buprenorphine, wherein said local pH is from about 3 to about 3.5 in the presence of saliva.

Claims 2–7 depend from claim 1. Independent claim 9 recites a method of treating narcotic dependence of a user comprising providing a composition similar to that recited in claim 1 and administering that composition to an oral cavity. Claims 10–12 depend from claim 9.

II. ANALYSIS

A. Claim Construction

For *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable interpretation in light of the patent specification. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S.Ct. 890 (mem.) (2016). Claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

As noted above, the '832 patent defines “local pH” as “the pH of the region of the carrier matrix immediately surrounding the active agent as the matrix hydrates and/or dissolves, for example, in the mouth of the user.” Ex. 1001, 3:35–38. We adopt that definition. In relation to other claim constructions proposed by Patent Owner (Prelim. Resp. 15–17), we determine that construction of other terms is not necessary to our analysis on whether to institute. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only claim terms in controversy need to be construed, and only to the extent necessary to resolve the controversy).

*B. The Suboxone® 2002 Label and SBOA as “Printed Publication”
Prior Art Under 35 U.S.C. §102*

35 U.S.C. § 311(b) states that a “petitioner in an *inter partes* review may request to cancel . . . claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” All four grounds in the Petition rely on the Suboxone® 2002 Label (Ex. 1008) and SBOA (Ex. 1009). Pet. 12–13, 20, 25–29, 33–37, 40–46. Thus, before considering the grounds before us, we must address whether Petitioner has provided a sufficient threshold showing that the Suboxone® 2002 Label and SBOA constitute prior art under 35 U.S.C. § 102—a legal question based on underlying factual determinations. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987); *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008).

The Federal Circuit has held that “public accessibility” is the touchstone in determining whether a reference is a “printed publication” under § 102. *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986). “A reference is publicly accessible ‘upon a satisfactory showing that such document has been 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’” *Kyocera*, 545 F.3d at 1350 (quoting *SRI Int’l, Inc. v. Internet Sec. Sys. Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)); *In re Lister*, 583 F.3d 1307, 1315 (Fed. Cir. 2009).

A party seeking to introduce a reference “should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655

F.2d 221, 227 (CCPA 1981) (quoting *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elecs. Indus., Inc.*, 450 F.2d 1164, 1171 (3d Cir. 1971)). As explained by the Federal Circuit, a “determination of whether a reference is a ‘printed publication’ under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

In relation to the Suboxone® 2002 Label (Ex. 1008) and SBOA (Ex. 1009), Petitioner contends that “Patent Owner stipulated in a co-pending litigation that the Suboxone® 2002 Label and SBOA are prior art to the ’832 patent,” relying on a citation in footnote 12 of the Petition. Pet. 18–19. Footnote 12 in the Petition reads in full:

Reckitt Benckiser Pharmaceuticals, Inc. v. Watson Laboratories, Inc., No. 13-cv-0167-RGA P.I. 347, Ex. 1, at ¶¶ 123–24. The Suboxone® Label and SBOA qualify as 102(b) prior art as both were publicly available printed publications at least as early as 2002.

Id. at 18–19 n.12.

Patent Owner responds that Petitioner fails to show that either the Suboxone® Label or SBOA constitutes a “printed publication” or qualifies as prior art under 35 U.S.C. § 102. Prelim. Resp. 17–24. For example, Patent Owner points out that the above-quoted contentions and footnote 12 in the Petition constitute Petitioner’s entire argument that Exhibits 1008 and 1009 qualify as prior art. *Id.* at 20.

We agree with Patent Owner that Petitioner fails to provide a threshold showing that either the Suboxone® Label or SBOA is a “printed publication” under 35 U.S.C. §§ 102 and 311(b). *See Apple Inc. v. DSS Tech. Mgmt., Inc.*, Case IPR2015-00369, slip op. at 5 (PTAB Aug. 12, 2015)

(Paper 14) (noting that Petitioner has the burden to make a threshold showing that a reference is “printed publication” prior art under 35 U.S.C. §§ 102 and 311(b)); *Hughes Network Systems, LLC v. California Institute of Technology*, IPR2015-00059, slip op. at 4 (PTAB Dec. 30, 2015) (Paper 34).

In its Petition, Petitioner’s attorney argument and reference to an exhibit in a district court case is insufficient. As Patent Owner notes, Petitioner filed no exhibits with its Petition, such as a court document, in relation to Patent Owner’s alleged stipulation in a district court case. Prelim. Resp. 20–21. When considering the record before us, we cannot tell whether any documents allegedly at issue in the district court case correspond to Exhibits 1008 and 1009 in this case.

Moreover, even assuming Patent Owner stipulated regarding the prior art status of the Suboxone® 2002 Label and SBOA in a co-pending district court litigation, that fact, by itself, also would be insufficient to provide a threshold showing. During the district court litigation, Patent Owner might have agreed to stipulate to certain facts to streamline matters at trial there, for example, or had other reasons to stipulate on the issue in a case involving different parties in a different forum, regardless of whether the Suboxone® 2002 Label and SBOA were, in fact, publicly accessible or not. Prelim. Resp. 21.

The Petition does not include or cite to information directly related to whether the Suboxone® 2002 Label and SBOA themselves were actually publicly accessible in the relevant time frame, how one might have obtained a copy of those documents, or whether they were reasonably accessible through generally available means. Without more here, contentions by Petitioner do not rise to the level of “threshold evidence” that justifies going

forward with a trial on a ground that relies on the Suboxone® 2002 Label and SBOA as “printed publication” prior art.

C. Asserted Obviousness of Claims 1, 2, 4–7, 9, and 10 by LabTec, Yang, Suboxone® 2002 Label, SBOA, and Birch

Petitioner contends that claims 1, 2, 4–7, 9, and 10 would have been obvious over LabTec in view of Yang, the Suboxone® 2002 Label, SBOA, and Birch. Pet. 20–35. Petitioner relies on LabTec as teaching film dosage forms for delivering active agents, including buprenorphine and naloxone, where the dosage forms mimic pharmacokinetic profiles of tablet products, such as Suboxone®. *Id.* at 20–23 (citing Ex. 1007, 2–3, 20, 22). Petitioner argues that such teachings would have motivated an ordinary artisan to make a film dosage composition comprising buprenorphine and naloxone as disclosed in Table A in LabTec and recited in the challenged claims. *Id.* (citing Ex. 1007, 22). Petitioner also contends LabTec identifies a “need” to “replicat[e] the ‘optimum’ absorption of the Suboxone® tablet with a bioequivalent film dosage form.” *Id.* at 23 (citing Ex. 1007, 2).

Petitioner further contends that “Yang would have supplied the person of ordinary skill with all the knowledge she needed in order to have a reasonable expectation of success regarding the manufacture of oral film products that are bioequivalent to Suboxone® tablets.” *Id.* Specifically, according to Petitioner, Yang would have taught an ordinary artisan “how to create a ‘film dosage composition’ comprising a ‘polymeric carrier matrix’” (*id.* at 24 (citing Ex. 1003 ¶ 91)), as also recited in independent claims 1 and 9.

Both independent claims 1 and 9 further require a film comprising a “buffer in an amount to provide a local pH for said composition of a value sufficient to optimize absorption of said buprenorphine, wherein said local

pH is from about 3 to about 3.5 in the presence of saliva.” Ex. 1001, cols. 23–24. Petitioner relies on LabTec as identifying an effect of pH on absorption, stating that the reference “provides the methods and materials for exploiting this pH effect to optimize absorption,” and “teaches that pH can be adjusted to decrease or increase absorption of the active.” Pet. 24–25 (citing Ex. 1007, 15–16).

Petitioner then argues that “[b]ecause LabTec discloses a film designed to mimic Suboxone® tablets,” an ordinary artisan “would have naturally looked to any publicly available information about the Suboxone® tablets for information about additional film dosage composition components, including a specific buffer system to adjust the pH.” *Id.* at 25. Notably, Petitioner relies on SBOA and the Suboxone® 2002 Label as teaching such information and, particularly, as suggesting the use of a “buffer in an amount to provide a local pH,” as recited in claims 1 and 9. Pet. 25–29 (citing Ex. 1008, 8, 10; Ex. 1009, 28, 29).

For example, according to Petitioner, “[b]ased on the SBOA, the person of ordinary skill would have concluded that (1) pH is important to achieving the $C_{\max}$ and AUC values necessary for bioequivalence and (2) that an optimum range of pH values had been achieved by the Suboxone® tablet formulation.” *Id.* at 28. Again relying on SBOA and the Suboxone® 2002 Label, Petitioner argues that “[b]ecause Suboxone® tablets were readily available at the time, it would have been routine for a person of ordinary skill to test the pH produced by the tablets in saliva and other dissolution media,” and that “[c]reating a film formulation that used the same buffers as the tablets, to produce the same pH produced by the tablets, would have been trivial.” *Id.*

In relation to the specific pH recited in claims 1 and 9, Petitioner relies on Birch as motivating an ordinary artisan “to target a value between about 3 to about 3.5, since Birch taught that transmucosal absorption of buprenorphine was optimal within that range.” *Id.* at 29 (citing Ex. 1004, Figs. 1 and 3, Ex. 8; Ex. 1003 ¶¶ 80, 102–03). Petitioner also argues an ordinary artisan “would not have expected that the claimed pH would cause problematic transmucosal absorption of [naloxone] because the prior art disclosed that such absorption was not seen with Suboxone® tablets or the citric acid buffer system used therein.” *Id.* at 30. Petitioner relies on the Suboxone® 2002 Label as teaching the citric acid buffer system in this regard. *Id.* at 28–29.

In other words, Petitioner necessarily relies on a combination of disclosures in SBOA, the Suboxone® 2002 Label, and Birch as teaching or suggesting a “buffer in an amount to provide a local pH . . . sufficient to optimize absorption of said buprenorphine, wherein said local pH is from about 3 to about 3.5 in the presence of saliva,” as required in all challenged claims.

As discussed above, we are not persuaded that Petitioner has made a threshold showing that SBOA and the Suboxone® 2002 Label were sufficiently publicly accessible to qualify as a “printed publication” under § 102(b). Thus, Petitioner may not rely on teachings in those references to make its case here.⁸

⁸ In addition, as Patent Owner points out, neither the Suboxone® tablet itself, nor alleged prior use of that tablet, for example, qualify as “patents or printed publications” under 35 U.S.C. § 311(b) (presenting the scope and basis of a ground a petitioner may raise in an *inter partes* review). Prelim. Resp. 21, 28.

In any case, as Patent Owner notes, Petitioner relies on Birch where it provides information about the pharmacokinetic profiles of buprenorphine formulations administered *intranasally*, i.e., Birch “teaches that a pH range of 3.4 can be used for *nasal* absorption,” not oral transmucosal absorption relevant to a film dosage. Prelim. Resp. 33. All figures and examples in Birch cited in the Petition, and by Petitioner’s expert, Dr. Das, relate to formulations administered intranasally. Ex. 1004, Figs. 1–4, ¶¶ 38–39, Examples 1, 3, 5, ¶¶ 139–154, Example 8, ¶¶ 206–211; Ex. 1003 ¶¶ 80, 102–03. Petitioner does not indicate sufficiently if or where Birch discusses oral transmucosal absorption, or how pH information in relation to nasal absorption might be relevant to oral transmucosal absorption or local pH in saliva as generated by a buffer in a film. Pet. 29–30 (citing Ex. 1004, Figs. 1 and 3, Ex. 8; Ex. 1003 ¶¶ 80, 102–03).

Thus, Petitioner does not explain adequately how Birch’s pH information in relation to buprenorphine formulations administered intranasally teaches or suggests a buffer providing a specific “local pH . . . in the presence of saliva” as it pertains to a film composition comprising both buprenorphine and another drug, naloxone, as required in the challenged claims.

At most, Petitioner cites a paragraph in Dr. Das’s Declaration that states, without itself citing evidence in support, that the “anatomy of the oral and nasal mucosa is quite similar, thus, one of ordinary skill would expect that the same principle of drug delivery will apply to both tissues.” Ex. 1003 ¶ 80; Pet. 29–30. We agree with Patent Owner that this conclusory statement by Dr. Das, without more, is insufficient to make the leap Petitioner asks us to make. Prelim. Resp. 33 (citing 37 C.F.R. § 42.65(a))

(stating that “[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight”). Moreover, Patent Owner points us to evidence in Birch itself indicating that buprenorphine pharmacokinetics differ when administered to oral versus nasal mucosa. *Id.* at 33–34 (citing Ex. 1004, 16, Table 11).

Petitioner also argues that “[e]ven without these explicit teachings,” an ordinary artisan would have “had (i) the ability to prepare buffered films; (ii) a starting point for testing; (iii) the published target $C_{\max}$ and AUC values, and (iv) knowledge of the pH dependence of the transmucosal absorption of buprenorphine and naloxone.” Pet. 30. Petitioner further contends that “it would have been nothing more than routine experimentation” to identify “the claimed pH range of 3 to 3.5 as optimal” upon testing a “number of films that produced a range of pH values in the saliva.” *Id.* at 30–31 (citing Ex. 1003 ¶¶ 108, 109, 116, 117).

Neither Petitioner nor Dr. Das explains adequately, however, why an ordinary artisan would have wanted to try to make a film that produced a local pH of 3 to 3.5 in saliva in the first place, based on LabTec’s teachings regarding the Suboxone® tablet and/or Yang’s teachings regarding general methods for making films. *See, e.g.*, Ex. 1003 ¶¶ 108, 109, 116, 117 (asserting that arriving at a pH of 3–3.5 would have been “routine experimentation,” and “[t]here would not have been anything surprising” about identifying a pH of 3–3.5, without disclosing underlying facts or data in support, other than to refer to $C_{\max}$ and AUC values for buprenorphine); Pet. 30–31.⁹

⁹ In a footnote, Petitioner discusses Dr. Das’ assertion that a “person of ordinary skill would have known that she had to consider the *solubility* of

Moreover, as Patent Owner points out (Prelim. Resp. 8), LabTec teaches that “formulations can rely on various means for retarding absorption of the active ingredient through the oral mucosa,” including by using “pH adjusting agents that adjust the pH of the environment surrounding the dosage form to a pH that renders the active agent less permeable.” Ex. 1007, 15. In this context, LabTec states that “[s]uitable pH adjusting agents function by ionizing the active agent to a less permeable state,” and “for a basic active ingredient, one would adjust the pH of the solution to below the pKa of the conjugate acid.” *Id.*; Prelim. Resp. 2, 9–10 (discussing the effect of pH on buprenorphine, a “weakly basic compound”). In view of such teachings, Patent Owner persuades us that LabTec does not suggest preparing a film that lowers a local pH to 3–3.5 in the saliva for the purpose of increasing absorption of an active ingredient such as buprenorphine.

Upon consideration of information presented in the Petition and the Preliminary Response, we are not persuaded that Petitioner has

both drugs, because a drug must be *dissolved* before it can be *absorbed* into the body.” Pet. 27 n.14. Petitioner and Dr. Das rely on Cassidy as teaching that “solubility of buprenorphine increases as pH decreases,” and that “buprenorphine is more soluble at or below a pH of 4.2 than at any pH above 4.2.” *Id.* (citing Cassidy, *Controlled Buccal Delivery of Buprenorphine*, 25 J. CONTROLLED RELEASE 24, 27–28, Fig. 1 (1993) (Ex. 1012)). Petitioner does not explain adequately, however, how solubility of buprenorphine relates to absorption of the drug when administered in a film or how teachings in Cassidy relate to a film comprising buprenorphine, naloxone, and a buffer producing a local pH. *Id.* In addition, consistent with Patent Owner’s position (Prelim. Resp. 30–31), Cassidy discusses a delivery system using a non-woven or hydrogel disk, not a film, where the disk comprises a solution of buprenorphine (without naloxone) at a pH of 4, not a pH 3–3.5. Ex. 1012, 21, 23, 25–26, Fig. 4.

demonstrated that there is a reasonable likelihood that it would prevail in showing that challenged claims 1, 2, 4–7, 9, and 10 of the '832 patent are unpatentable over LabTec in view of Yang, the Suboxone® 2002 Label, SBOA, and Birch.¹⁰

D. Other Obviousness Grounds Relying on the Suboxone® 2002 Label, SBOA, and Birch

The other three grounds raised in the Petition also rely on the Suboxone® 2002 Label, SBOA, and Birch in the essentially same way as discussed above. Pet. 39–41. Grounds 2 and 4 discuss the '055 publication as it relates to certain limitations in challenged dependent claims, without indicating that the publication provides any teachings or suggestion in relation to a buffer providing a local pH of about 3–3.5, as recited in independent claims 1 and 9. Pet. 35–36, 45–46.

In grounds 3 and 4, Petitioner relies on Oksche (Ex. 1005) for disclosures similar to those in LabTec, i.e., an oral film comprising buprenorphine and naloxone that is “just as effective as,” i.e., bioequivalent to, Suboxone® tablets. Pet. 37–39. Petitioner also points to where Oksche discloses “the target $C_{\max}$ and AUC_{0-48} values for buprenorphine.” *Id.* at 41 (citing Ex. 1005, 9). Petitioner again relies on SBOA, the Suboxone® 2002

¹⁰ On June 7, 2016, Petitioner filed “Second Updated Mandatory Notices” in this case. Paper 22. The Notices state that “the District Court for the District of Delaware in *Reckitt Benckiser Pharmaceuticals Inc., et al v. Par Pharmaceutical, Inc., et al*, 1-14- cv-00422, and *Reckitt Benckiser Pharmaceuticals Inc. et al v. Watson Laboratories Inc., et al.*, 1-13-01674, found that claims 1, 3, 6, and 15–19 of the '832 patent are invalid as obvious over the prior art.” Paper 22, 3–4 (also referring to “case 13-cv-01674”). We address a different record than the one before the district court, including different cited art and witness testimony.

Label, and Birch in relation to a buffer providing a local pH from about 3–3.5. *Id.* at 39–41.

As discussed above, on the record before us, Petitioner fails to provide a sufficient threshold showing that SBOA and the Suboxone® 2002 Label qualify as prior art. In addition, Petitioner does not persuade us sufficiently that an ordinary artisan would have understood that the pH information in Birch regarding a nasal formulation comprising buprenorphine would be applicable to an oral film comprising buprenorphine and another drug, naloxone, as well as a buffer providing a local pH in saliva, i.e., in the mouth.

Beyond that, Petitioner refers to the $C_{\max}$ and AUC_{0-48} values for buprenorphine as disclosed in Oksche when asserting it “would have been nothing more than routine experimentation for a person of ordinary skill to arrive at the claimed pH of 3 to 3.5.” *Id.* at 41 (citing Ex. 1003 ¶¶ 116, 117). Once again, neither Petitioner nor Dr. Das explains adequately why an ordinary artisan would have wanted to try to make a film that produced a local pH of 3 to 3.5 in saliva in the first place, based on teachings in Oksche and/or Yang. See Ex. 1003 ¶¶ 116, 117 (asserting that arriving at a pH of 3–3.5 would have been “routine experimentation,” and “there would not have been anything surprising” about identifying a pH of 3–3.5, without disclosing underlying facts or data in support, other than to refer to $C_{\max}$ and AUC values for buprenorphine); Pet. 41.

Upon consideration of the information presented in the Petition and the Preliminary Response, for the reasons discussed above, we are not persuaded that Petitioner has demonstrated that there is a reasonable likelihood that it would prevail in showing that challenged claims are

unpatentable over any cited art, including LabTec, Oksche, Yang, and the '055 publication, in view of the Suboxone® 2002 Label, SBOA, and Birch.

E. Patent Owner's Motion to Change the Petition's Filing Date

As authorized by the panel in an Order dated February 18, 2016 (Paper 8), Patent Owner filed a Motion to change the filing date of the Petition from December 3, 2015, to December 4, 2015. Paper 10 (Patent Owner's Motion to Change the December 3, 2015 Filing Date to December 4, 2015, "Motion"). As also authorized (Paper 8), Petitioner filed an Opposition to that Motion. Paper 12 ("Opp."). In those papers, neither party disputes that a filing date for the Petition of December 4, 2015, would implicate a time bar under 35 U.S.C. § 315(b). Motion 1; Opp. 6–8.

In view of our discussion in the sections above, we dismiss Patent Owner's Motion as moot.

III. CONCLUSION

For the foregoing reasons, we are not persuaded that the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that claims 1–7 and 9–12 of the '832 patent are unpatentable under 35 U.S.C. § 103(a).

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no *inter partes* review is instituted.

IPR2016-00280
Patent 8,475,832 B2

PETITIONER:

Elizabeth Holland
Eleanor Yost
John Stull
Jennifer Albert
GOODWIN PROCTER LLP
eholland@goodwinprocter.com
eyost@goodwinprocter.com
jstull@goodwinprocter.com
jalbert@goodwinprocter.com

PATENT OWNER:

Andrea Reister
Enrique Longton
Dustin Weeks
COVINGTON & BURLING LLP
areister@cov.com
rlongton@cov.com
dustin.weeks@troutmansanders.com