

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIENNA BIOPHARMACEUTICALS, INC.,
Petitioner,

v.

WILLIAM MARSH RICE UNIVERSITY,
Patent Owner.

Case IPR2017-00046
Patent 6,685,730

Before GEORGIANNA W. BRADEN, ZHENYU YANG, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

William Marsh Rice University (“Patent Owner”) timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d) on May 4, 2017. Paper 13 (“Req. Reh’g”). Patent Owner’s Request for Rehearing seeks reconsideration of our Decision Instituting an *inter partes* review proceeding of U.S. Patent No. 6,685,730 (“the ’730 patent”), entered on April 21, 2017. See Paper 8 (“Dec.”). Patent Owner also filed a Request for Rehearing (Paper 14) challenging our Order (Paper 10, “Stay Order”) staying *Ex Parte* Reexamination No. 90/013,883 (“the ’883 Reexam,” Ex. 2001).¹ As both Requests for Rehearing address substantially similar issues using substantially similar arguments, we consider both requests together.

In both Requests for Rehearing, Patent Owner contends that our stay of the ’883 Reexam and institution of this trial proceeding was improper for two reasons. First, Patent Owner argues that we overlooked Patent Owner’s timely notification regarding the “related and pertinent [’883 Reexam] proceeding.” Req. Reh’g 1, 3.² Second, Patent Owner argues we misapprehended or overlooked the fact that the claims challenged in the present trial proceeding were amended in the ’883 Reexam and, therefore, are different claims. *Id.* at 4–6. According to Patent Owner, original claims 57–59 (the claims that are the subject of this trial

¹ Patent Owner’s Request for Rehearing on the stay of the ’883 Reexam is improper. The rule in 37 C.F.R. § 42.71(d), read in conjunction with the rule’s title, allows a request for rehearing of “[d]ecision[s] on petitions or motions.” The Stay Order was not a decision on a petition or a motion. Accordingly, we consider it only to the extent it overlaps with Paper 13.

² All citations are to Paper 13, unless otherwise noted.

proceeding) are no longer applicable due to amendments entered in the '883 Reexam. For this reason alone, Patent Owner concludes we should grant its Requests for Rehearing and deny institution of the trial proceeding. *Id.* at 6–7.

As we explain below, we have considered the arguments presented by Patent Owner in its Requests for Rehearing, but we discern no sufficient reason to modify the Decision to Institute or our Stay Order. Accordingly, we deny Patent Owner's Requests for Rehearing.³

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. *Id.* § 42.71(c). An abuse of discretion may be indicated 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. U.S.*, 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).

³ We also note that Patent Owner's Request for Rehearing of our institution decision improperly includes Exhibit A within the filed Paper. See Paper 13, Ex. A. Patent Owner is reminded of our Rules regarding the filing of exhibits in this proceeding. See 37 C.F.R. § 42.6.

Applying these legal standards, we address the arguments presented by Patent Owner.

III. ANALYSIS

A. *Notice of the '883 Reexam proceeding*

In our Decision to Institute, we stated “[t]he parties inform us that they are not aware of any related matters that would affect or be affected by this proceeding.” Dec. 2 (citing Pet. 3; Paper 4, 2 (Patent Owner’s Mandatory Notice)). Patent Owner argues the Board overlooked “Patent Owner’s timely notifications regarding a related and pertinent proceeding, namely, the *ex parte* reexamination of the ’730 Patent ordered on January 26, 2017, Reexamination No 90/013,883 (‘’883 Reexam’), prior to the institution of the IPR.” Req. Reh’g 1. We agree Patent Owner properly informed the Board in its Preliminary Response of its request for an *Ex Parte* Reexamination. Paper 6, 1. Additionally, nine days prior to the issuance of our Decision to Institute, Patent Owner submitted an updated Mandatory Notice indicating that an office action in the ’883 Reexam had issued and that Patent Owner’s amended claims were being examined. Paper 7, 2. We disagree with Patent Owner’s contention, however, that we overlooked the existence of the ’883 Reexam. As Patent Owner acknowledges, we stayed the reexam proceeding three days after instituting the present trial proceeding. *Compare* Dec., with Stay Order.

As the ’883 Reexam was considered and addressed in our Stay Order, Patent Owner has not shown how we overlooked or misapprehended any arguments or evidence as required by 37 C.F.R. § 42.71(d). Thus, Patent Owner’s challenge does not meet the standard set forth for a request for rehearing.

B. Allegations Regarding Claims Reciting Different Limitations

Patent Owner appears to contend that we overlooked the '883 Reexam as “overcom[ing] the basis” for the Petition in deciding to institute the trial proceeding. Req. Reh’g 1. In particular, Patent Owner argues the '883 Reexam is directed to Patent Owner’s amended claims 57–59 and new claims 65–74 and considers not only art cited in the Petition, but also other art raised by the Examiner. *Id.* According to Patent Owner, the Examiner’s entry of its amendments and subsequent examination and rejection of the proposed amended claims means that the claims at issue in the trial proceeding “no longer exist as per the Petition” and “the need for an IPR is moot.” *Id.* at 4. Patent Owner further argues that because “Examiner Dawson’s rejection of the amended claims relied upon a different combination of references than those cited in the Petition,” “the amendments overcame the grounds” raised in the Petition and that are the subject of this trial proceeding. *Id.* at 5.

We disagree with Patent Owner’s contentions. Patent Owner fails to appreciate the fact that proffered amendments to claims in a reexamination proceeding are not effective until the proceeding concludes and a Reexamination Certificate issues. *See* 37 C.F.R. § 1.530(k) (“Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.”); 37 C.F.R. § 1.121(j). Thus, contrary to Patent Owner’s position, the claims of the '730 patent *have not changed* and the entered amendments in the '883 Reexam do not overcome the challenges in the trial proceeding.

Accordingly, Patent Owner has not shown how we overlooked or misapprehended any arguments or evidence as required by 37 C.F.R. § 42.71(d). Thus, Patent Owner's challenge does not meet the standard set forth for a request for rehearing.

IV. CONCLUSION

For the foregoing reasons, Patent Owner has not demonstrated that we abused our discretion by instituting the present trial proceeding as to the challenged claims of the '730 patent or staying the '883 Reexam. Therefore, Patent Owner's Requests for Rehearing are *denied*.

V. ORDER

Accordingly, it is ORDERED that Patent Owner's Requests for Rehearing (Papers 13, 14) are DENIED.

Case IPR2017-00046
Patent 6,685,730

For PATENT OWNER:

Michael R. Fleming
Andrei Iancu
Kamran Vakili
IRELL & MANELLA LLP
mfleming@irell.com
aiancu@irell.com
kvakili@irell.com

For PATENT OWNER:

Robert R. Riddle
Matthew S. Gibson
REED SMITH LLP
rriddle@reedsmith.com
mgibson@reedsmith.com

Walter Scott
ALSTON & BYRD LLP
walter.scott@alston.com