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Paper No. 26
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02032
Patent 6,407,213 B1

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

YANG, *Administrative Patent Judge*.

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

INTRODUCTION

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. Paper 1 ("Pet."). Petitioner challenged those claims under five obviousness grounds and one anticipation ground. Pet. 4. We initially instituted trial on the anticipation ground but denied the obviousness grounds. Paper 17 ("Dec."). Later, in view of the Supreme Court's decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018) and the Office's Guidance on the Impact of SAS on AIA Trial Proceedings ("Guidance"),[1] we modified our decision and instituted trial on all of the challenged claims and all of the grounds presented in the Petition.[2] Paper 23. Patent Owner now files a Request for Rehearing of our modified decision to institute trial on all grounds. Paper 25.

For the following reasons, we deny Patent Owner'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

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[1] Available at https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial.
[2] The Decision was fashioned as Granting Petitioner's Request for Rehearing.

request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

DISCUSSION

In the Petition (Pet. 4), Petitioner asserts the following grounds of unpatentability:

Ground	Claim(s)	Basis	Reference(s)
1	1, 2, 25, 29, 63, 66, 67, 71–73, 75–78, 80, 81	§ 103	Queen 1989[3] and Protein Data Bank (PDB database)
2	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71–73, 75–78, 80, 81	§ 103	Queen 1990[4] and PDB database
3	75–77	§ 103	Queen 1989, PDB database, and Tramontano[5]
4	75–77	§ 103	Queen 1990, PDB database, and Tramontano
5	4, 62, 64, 69	§ 103	Queen 1989, PDB database, and Kabat 1987[6]
6	1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 73, 75–78, 80, 81	§ 102	The '101 patent[7]

[3] Queen et al., *A Humanized Antibody that Binds to the Interleukin 2 Receptor*, 86 PRO. NAT'L ACAD. SCI. 10029–33 (1989) (Ex. 1034).
[4] Queen et al., International Publication No. WO 90/07861 A1, published July 26, 1990 (Ex. 1050).
[5] Tramontano et al., *Framework Residue 71 is a Major Determinant of the Position and Conformation of the Second Hypervariable Region in the VH Domains of Immunoglobulins*, 215 J. MOL. BIOL. 175–82 (1990) (Ex. 1051).
[6] Kabat et al., Sequences of Proteins of Immunological Interest 4th Ed., Tabulation and Analysis of Amino Acid and Nucleic Acid Sequences of Precursors, V-Regions, C-Regions, J-Chain, T-Cell Receptor for Antigen, T-Cell Surface Antigens (National Institutes of Health, Bethesda, Md.) (1987) (Ex. 1052).
[7] U.S. Patent No. 5,530,101, issued June 25, 1996 (Ex. 1136).

In the Decision, we institute an *inter partes* review to determine whether the '101 patent anticipates 1, 2, 4, 25, 29, 62–64, 66, 67, 69, 71, 73, 75–78, 80, and 81. Dec. 14. We, however, denied Petitioner's challenges on the five obviousness grounds. *Id.* at 8. We explained:

> As Patent Owner correctly points out, Grounds 1–5 asserted in the Petition "are essentially identical to those already instituted in" IPR2017-01373 and IPR2017-01489. Prelim. Resp. 12–13. Petitioner filed this Petition before we issued the decisions instituting *inter partes* reviews in IPR2017-01373 and IPR2017-01489. Thus, Petitioner could have sought to join the pending IPRs. Yet, it did not do so. *See* 37 C.F.R. § 42.122. The time for requesting joinder has since expired. *See id*. As such, we exercise our discretion under § 325(d) and deny the Petition with respect to Grounds 1–5.

Id.

Petitioner filed a rehearing request, arguing that, among others, our institution decision left claim 72 unchallenged. Paper 21, 1, 3. After Petitioner filed its rehearing request, 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.*, 138 S. Ct. at 1359. In addition, the Office's Guidance instructs that "if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition."[8] *See* Guidance. As a result, we granted Petitioner's rehearing request and instituted trial on all of

[8] The Federal Circuit appears to have embraced the approach set forth in the Guidance. *See PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (reading "the *SAS* opinion as interpreting the statute to require a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition").

the challenged claims and all of the grounds presented in the Petition. Paper 23, 5.

Patent Owner contends that our modification of the original decision and institution of trial on all grounds "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 25, 3–4 (citation omitted).

Our decision to proceed on all grounds is based upon the policy set forth in the Guidance, in view of *SAS*, along with our determination that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of at least one claim in the petition. Regarding that determination, Patent Owner has not persuaded us that we have misapprehended or overlooked any matters. *See* 37 C.F.R. § 42.71(d).

Moreover, the Office recently issued Frequently Asked Questions about *SAS* Implications (June 5, 2018).[9] One of the Q&As is directly on point:

[9] Available at https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf.

> **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.

In sum, Patent Owner has not shown that we abused our discretion in instituting trial on all claims and all grounds. We, therefore, deny Patent Owner's Request for Rehearing.

ORDER

Accordingly, it is

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

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