

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENCUBE ETHICALS PVT. LTD.
Petitioner

v.

DERMAVANT SCIENCES GMBH
Patent Owner

IPR2024-00834

U.S. Patent No. 11,590,088

**PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER
PRELIMINARY RESPONSE**

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I. The Petition Should Not Be Denied Under 35 U.S.C. § 325(d)

Section 325(d) denial is inappropriate here. The Examiner never discussed either lead reference or any obviousness combination; the Petition also shows the references disclose claim elements the Applicant told the Examiner were missing.

Advanced Bionics part II considers whether the Petitioner showed material error; *Becton* factors are part of the analysis. IPR2019-01469, Paper 6, 8-9. Neither Sonti (Grounds 1-3) nor Bissonnette (Ground 4)¹ was discussed or applied against the claims, and *Becton* factor (c) strongly favors institution. *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01205, Paper 14, 16 (PTAB Jan. 27, 2020) (“The Board frequently holds that a reference that ‘was neither applied against the claims nor discussed by the Examiner’ does not weigh in favor of [§ 325(d) denial]”). *Becton* factor (f) also favors institution, as the Petition provides two new expert declarations. *E.g.*, Pet., 72-73 (expert explaining Chen in view of PGA limitation).

The Examiner also materially erred (*Becton* factor (e)) by overlooking disclosures in Sonti, Bissonnette, and Chen of the very claim elements the

¹ PO argues Petitioner waived § 325(d) arguments for Bissonnette. Petitioner acknowledges Bissonnette was listed on the patent. However, PO will not be prejudiced (it can respond), and PO has not identified any authority for waiver.

Applicant argued were missing. The Examiner first rejected the claims as anticipated by Chen references. Ex-1002, 236-37. The Applicant responded with three arguments, none of which was that Chen did not disclose “administering... tapinarof.” First, “Chen 1 does not mention treating *plaque psoriasis specifically* with the compounds described therein.” Ex-1002, 284 (emphasis added). Making clear the claim element purportedly missing was plaque psoriasis, the Applicant argued “Plaque psoriasis is a particular type of psoriasis” and then listed other types. *Id.* Second, that Chen did not explain “how to demonstrate that treatment of said plaque psoriasis is effective,” citing the claimed PGA score and BSA. *Id.* Third, that Chen did not identify “a measure of effective treatment,” citing, e.g., the claimed PGA score improvement by 2 grades or to a score of 0 or 1. *Id.*

The Examiner issued a new rejection of “Rubenstein,” and Patent Owner (“PO”) argues the Examiner therefore considered the Chen arguments “moot.” Paper 6, 15 n.3. This is misleading: the Applicant overcame Rubenstein by only showing it was not prior art. Ex-1002, 302-03. The Examiner then just allowed the claims, stating: “The prior art does not teach or suggest the methods encompassing compounds substituted in the manner claimed [].” *Id.*, 312. PO speculates this indicates the Examiner “understood” that Chen did not disclose applying *tapinarof*. Paper 6, 17. But that is not what the Applicant argued or what the Examiner said.

The Petition shows Sonti and Bissonnette (not discussed during prosecution)

each teach elements the Examiner appeared to agree were missing from the prior art. *E.g.*, Pet., 13, 17, 72 (Sonti treating plaque psoriasis with tapinarof, with claimed PGA improvement), 53, 59-62 (Bissonnette ground teaching and making obvious plaque psoriasis and PGA elements). The Board consistently finds material error in such circumstances. *E.g.*, *Advanced Bionics*, Paper 6, 8 n.9 (“An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability”); *Oxylabs, UAB v. Bright Data Ltd.*, IPR2024-00126, Paper 9, 8-15 (PTAB June 14, 2024) (references in IDS, but no substantive analysis of references by Examiner); *Nespresso USA, Inc. v. K-Fee System GMBH*, IPR2023-00485, Paper 9, 37-40 (PTAB Sept. 13, 2023) (references in IDS but not cited or discussed by Examiner, Petition showed references taught elements in reasons for allowance).

The Petition also shows that Chen does in fact disclose the purportedly missing treatment of “plaque” psoriasis, and also to a POSA teaches the PGA. Petition, 72-73, 52-53, 60-61. Moreover, even if PO were correct in its speculation regarding the Examiner’s reasons for allowance, there would still be material error. *Evidence* contradicts PO’s bare attorney argument that a POSA would not understand Chen to be referring to tapinarof in cited Examples of treating psoriasis. Paper 6, 17-19. For example, Petitioner’s expert testifies “the Chen references provide an illustration of the chemical structure” for what Chen refers to as “3,5-

dihydroxy-4-isopropylstilbene” as “the compound 9A,” and 9A is “the same as the chemical structure for ‘tapinarof’ that is illustrated in the ’088 patent.” Ex-1032, ¶70; Ex-1013, 8:54-55 (Chen noting what it refers to as “3,5-dihydroxy-4-isopropylstilbene” is compound “9A”); Ex-1032, ¶53 (quoting Ex-1013, 8:54-55 (typographical error in declaration pincite)). Similarly, Sonti describes Chen (Ex-1013) as teaching “the compound” (tapinarof) is suitable to treat psoriasis. Ex-1005, [0008]-[0010]. Further, Petitioner’s Chen arguments are obviousness, not anticipation. Particularly given contradictory evidence, PO’s attorney argument of how a POSA would have understood and applied Chen is no reason to deny trial.

II. There Is No Reason For Discretionary Denial Under 35 U.S.C. § 314

The Petition provides sufficient particularity. Regarding purportedly “undeveloped” inherency for element [1.pre]—the Petition provides supporting expert testimony. *E.g.*, Pet., 13-14 (citing Ex-1003, ¶116). PO disagrees on the technical merits but offers only attorney argument. Regarding Ground 3, PO tries to manufacture confusion by noting claims 7, 21 are not challenged in Ground 1. But the Petition explains they *depend* from claim 1 (which is addressed in Grounds 1, 2), then shows with particularity how claims 7, 21 are invalid by Bissonnette’s additional teachings. *Id.*, 47-49. For Ground 4, the Petition likewise identifies with particularity (and in separate paragraphs) specific parts of Sonti and Chen it relies on for each element of each claim. *E.g.*, Pet., 54-55, 60-61. This is completely

unlike *Adaptics*. *Adaptics* concerned a Petition asserting “hundreds of possible combinations,” that also failed to identify which of numerous secondary references taught which element. IPR2018-01596, Paper 20, 19-21 (PTAB March 6, 2019). Finally, the Petition sufficiently explains claims 3 and 4. It cites testimony of Dr. Liem (who supports claim 1), and also Mr. Sudhakar (who Dr. Liem relies on for the additional elements added by claims 3, 4). *E.g.*, Petition, 19-24, 35-37, 63-64.

Regarding word count, Petitioner in good faith followed the Office’s guidance (added August 2018, after all of PO’s cited cases but *Tesla*) that parties “need not go beyond the routine word count supplied by the word processing program.” TPG (Nov. 2019), 40; Pet., 78 (word processing program count of 13,996). Further, the several images are not “excessive” and were not intended to circumvent word limits. The images are of already-pincited evidence; they do not include added argument or text. Some do have highlights, but much of that is also quoted in Petition body text. *E.g.*, Pet., 22-24, 55, 58. And after PO identified highlights, Petitioner asked whether removal would suffice, but PO declined to say. If needed, Petitioner respectfully requests leave to file a remediated Petition.

The Petition also does not improperly incorporate by reference. In fact, PO’s very first purported example (Paper 6, 29-30) *omits* the Petition’s explanation of the motivation. The full quote (omitted portion bolded) is: “[***I***]n view of *Sonti's interoperability teachings*, a POSA would have been motivated...”. Pet., 30.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on September 19, 2024, I caused a true and correct copy of the foregoing PETITIONER’S PRELIMINARY REPLY TO PATENT OWNER PRELIMINARY RESPONSE to be served upon the following parties via electronic mail:

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