

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

PGR2018-00062
Patent 9,707,245 B2

Before TONI S. SCHEINER, GRACE KARAFFA OBERMANN, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner filed a Request for Rehearing (Paper 33, “Req. Reh’g”) seeking review of the Board’s Final Written Decision (Paper 32, “Dec.”), in which we held unpatentable claims 1–30 of U.S. Patent No. 9,707,245 B2 (Ex. 1001, “the ’245 Patent”). Patent Owner thereafter filed a request for review by the Precedential Opinion Panel (“POP”), which was denied. Paper 34 (request for POP review); Paper 35 (decision denying request). We also refer to the Petition (Paper 2, “Pet.”), Patent Owner’s Response (Paper 15, “Resp.”), Petitioner’s Reply (Paper 18, “Reply”), and Patent Owner’s Sur-Reply (Paper 21, “Sur-Reply”).

Upon a request for rehearing, we review our decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “The request 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.* We deny the Request for Rehearing based on application of those principles.

II. DISCUSSION

A. Background of the Dispute

The claimed invention relates to a method of treating pain by administration of neridronic acid. Ex. 1001, code (54). Claim 1 is the sole independent claim and requires administration of neridronic acid in salt or acid form to a human being with chronic regional pain syndrome (“CRPS”). *Id.* at 84:59–63 (claim 1). During the trial, a key dispute emerged relating to the limitation of claim 1 specifying, “wherein bone fracture was a

predisposing event for CRPS.” *Id.* at 84:61–62; *see* Dec. 4–6, 21–34 (framing the issue, which first arose during patent prosecution).

The Board determined that work published by Varenna¹ before the critical date of the invention anticipates, or would have made obvious in combination with other references, the claimed invention, based on evidence cited in the Petition, including uncontroverted testimony from Petitioner’s witness, Dr. Lawrence Poree. Dec. 15–17 (Board’s overview of Dr. Poree’s “uncontroverted” and “quite extensive” record of professional accomplishments, supporting our finding “that Dr. Poree is qualified to opine about the perspective of” an ordinarily skilled artisan), 41 (the Board’s chart of conclusions). Patent Owner opposed the Petition, but did not advance expert testimony from a witness of its own choosing, or cross-examine Petitioner’s expert witness. *See* Dec. 7, 15 (pointing out that Patent Owner advanced no expert testimony and declined to depose Petitioner’s witness, Dr. Lawrence Poree).

B. Patent Owner’s Three Asserted Grounds for Modification

Patent Owner requests modification of the Final Written Decision on three grounds. First, Patent Owner submits, the Board overlooked Patent Owner’s Sur-Reply arguments and authority. Req. Reh’g 2–5. Second, according to Patent Owner, the Board misapprehended the law regarding the evidentiary analysis required to conclude that Varenna would have been publicly available at the time of the invention. *Id.* at 5–10. Third, Patent

¹ M. Varenna et al., *Treatment of complex regional pain syndrome type I with neridronate: a randomized, double-blind, placebo-controlled study*, RHEUMATOLOGY 52: 534–42 (Nov. 2012) (Ex. 1005, “Varenna”).

Owner argues that the Board misapprehended the law regarding Petitioner's burden of proof, improperly drew inferences in favor of Petitioner, and erroneously permitted Petitioner to present evidence of Varenna's public availability for the first time in the Reply. *Id.* at 11–15. We address in turn each of those asserted grounds for modification.

1) Sur-Reply Arguments and Authority

Patent Owner alleges that the Board reversibly erred by failing to “address or distinguish any of the cited Board decisions or the other arguments and authority Patent Owner Discussed in its Sur-Reply.” Req. Reh’g. 3 (citing Sur-Reply 8–13). The non-binding Board decisions cited in the Sur-Reply do not control the outcome here. In any event, as Patent Owner observes, those decisions acknowledge that a copyright notice “standing alone” may “not [be] enough” to “establish public availability.” Sur-Reply 8 (and citations to non-precedential Board decisions therein). Those decisions are inapplicable here, where the copyright notice was merely one indicia, among a cluster of indicium, contributing to the substantial evidence supporting our finding that Petitioner demonstrated that Varenna was publicly available at the time of the invention. Dec. 9–13.

Patent Owner asserts in the Sur-Reply that a copyright notice on a reference deserves “no fealty whatsoever for purposes of proving ‘printed publication’ status, unless accompanied by other evidence to suggest that public availability around the stated date actually occurred.” Sur-Reply 7. Here again, however, we did not rely on the copyright notice alone. Dec. 9–13. Further, Patent Owner relies in the Sur-Reply on a non-binding Board decision subsequently reversed in a precedential opinion. *Id.* at 8 (quoting

Hulu, LLC v. Sound View Innovations, LLC, Case IPR2018-01039, Paper 12 at 12 (PTAB Dec. 3, 2018), *rev'd* Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential)).

Our findings regarding Varena align with the guidance provided in that precedential opinion, which sets forth a case-by-case approach in which a copyright notice may contribute to the totality of evidence weighed that is relevant to public availability. *See Hulu*, Paper 29 at 9–11, 17–19 (discussing the case-by-case analysis turning on particular circumstances, including the nature of the reference (distinguishing a thesis from a journal article) and the indicia of public accessibility appearing on the face of the reference). Significantly, the facts here include the “conventional markers of publication, such as a copyright date, edition identifier, [and] publication by a commercial publisher” that the Hulu panel identified as relevant. *Id.* at 17.

Further, the record in this case included a compelling additional factor. Specifically, Patent Owner previously identified to the Office, during patent prosecution, a publication date for Varena consistent with the November 2012 date that appears on the face of the document. *See* Dec. 10–12 (analyzing that additional factor). The totality of circumstances support our finding that Petitioner established by a preponderance of evidence that Varena was publicly available prior to the critical date of the invention.

*2) Law Regarding the Evidentiary Analysis Pertaining to
Public Availability of Varena at the Time of the Invention*

Patent Owner submits that the Board “did not determine whether” the evidence of record “shows that Varena was in fact disseminated or otherwise made available such that reasonably diligent and interested

persons of skill in the art could have located it.” Req. Reh’g 1 (emphasis in original). On the contrary, we addressed with particularity the substantial evidence tending to show that Varennna “was ‘sufficiently accessible to the public interested in the art’ and ‘disseminated or otherwise made available’ to the interested public before the critical date.” Dec. 9 (quoting *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016)).

In our Decision, we properly credited “indicia on the face of [the] reference, such as printed dates and stamps,” which are “part of the totality of the evidence” bearing on the issue of public accessibility. *Hulu*, Paper 29 at 17–18 (citing *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1377 (Fed. Cir. 2018)). Those indicia included not only details of the copyright notice, indicating publication of Varennna “by Oxford University Press on behalf of the British Society for Rheumatology” in “2012;” but also additional legends, including “the statement ‘Advance Access publication 30 November 2012,’” and a conventional edition identifier from the journal *Rheumatology*. *Id.* at 9–10 (quoting Ex. 1005). Patent Owner advanced no evidence tending to cast doubt on that publication date. Although the burden of proof never shifted to Patent Owner on the issue of Varennna’s public availability, where Patent Owner declined to advance counter evidence on point, the Board did not err by crediting the indicia, which appear on the face of Varennna, as part of the totality of evidence bearing on the issue.

Patent Owner suggests that the Decision erroneously “endorses allowing a reference to stand alone as proof of its own public accessibility.” Req. Reh’g 8. On the contrary, the indicia on the face of Varennna do not stand alone, but are consistent with compelling additional proof on point.

For example, uncontested evidence shows that Patent Owner submitted a copy of Varena to the Examiner during patent prosecution and indicated to the Office that the reference (bearing the same *Rheumatology* journal edition identifier and word-for-word identical title) was published in 2012. *Id.* at 11 (*comparing* Ex. 1005, *with* Ex. 1022, 432). Against that backdrop, we reasoned, “[t]his is not a case involving, for example, a thesis, conference paper, or poster bearing none of the ordinary indicators of indexing or public distribution.” *Id.* at 10. We reasonably relied on Petitioner’s uncontested position that, “[d]uring patent prosecution, ‘Patent Owner submitted this reference to the PTO with a filename ‘Varena2012.pdf.’ and represented that it had a publication date of November 2012.’” Dec. 10 (quoting Reply 7 (citing Ex. 1022, 432, 440); Sur-Reply 2–11 (Patent Owner, declining to contest that contention)).

Petitioner filed a Declaration of Dr. Philip Robinson in support of Reply arguments pertaining to the issue of whether Varena was publicly available at the time of the invention. Dec. 8 (citing Ex. 1031). We observed, in an alternative holding, that Dr. Robinson’s Declaration was submitted “under oath” and “explains that he ‘accessed, reviewed, and posted about Varena . . . on the social media site Twitter’ before the critical date.” Dec. 13 (quoting Reply 5; Ex. 1031 ¶¶ 4–8). We considered the uncontested nature of that testimony, given that Patent Owner declined the opportunity, provided as of right by our rules, to cross-examine Dr. Robinson regarding that testimony. *Id.* at 15. In addition, we took account of objective supporting evidence on point advanced by Petitioner; namely, an exhibit Dr. Robinson identified as “‘my tweet,’ which ‘can still be viewed publicly’ and

includes a link that ‘is still active and leads to Varenna.’” *Id.* at 13 (quoting Ex. 1031 ¶ 5, Exhibit A). Under these circumstances, we did not err by finding unpersuasive Patent Owner’s “conclusory assertions that Dr. Robinson’s sworn testimony ‘defies belief’ and details a feat that would require ‘a photographic’ or ‘infallible memory.’” *Id.* at 14 (quoting Sur-Reply 9).

Rather than pointing out any matters that the panel misapprehended or overlooked, Patent Owner expresses disagreement with the Decision, and attempts to offer additional reasoning and argument not advanced during trial. Req. Reh’g 5–15. That effort is ineffective to establish reversible error.

3) Petitioner’s Burden, Board Inferences, and Reply Evidence

Patent Owner also reargues its view that the Board should have set aside Dr. Robinson’s Declaration because Petitioner submitted that evidence in support of the Reply. Req. Reh’g 11–15; Sur-Reply 9–10. Here again, simple disagreement with the Board’s ruling is insufficient to establish reversible error.

The precedential decision in *Hulu* is instructive here, and specifically recognizes “limited opportunities” that “exist for the petitioner to present new evidence” pertaining to the question of public availability. *Hulu*, Paper 29 at 14. One opportunity expressly identified in *Hulu* is “in a reply to the patent owner response” where “the patent owner challenges a reference’s status as a printed publication.” *Id.*, Paper 29, 14–15. That is precisely the circumstance here. Patent Owner shows no reversible error in our finding that Dr. Robinson’s Declaration, submitted with Petitioner’s Reply, responds to arguments raised for the first time in Patent Owner’s Response. Dec. 13

(*comparing* Reply 3–7 and Ex. 1031, with Resp. 12–15). In any event, in our alternative holding, we explain why substantial evidence supports our finding of public availability, “[e]ven if we set aside Dr. Robinson’s Declaration.” Dec. 9.

This is not a situation where Petitioner submitted Reply evidence that changed the theory of the patent challenge or, as Patent Owner suggests, represents a circumstance comparable to raising “a new obviousness argument” not advanced in the Petition. Req. Reh’g 11 (quotation omitted); *see* Pet. vii (identification of Varena and its alleged publication date of “Nov. 2012”), 3–4 (bridging paragraph, asserting that Varena was “published in 2012”), 33 (asserting that “Varena 2012 is one of dozens of references” presented during patent prosecution). Moreover, no prejudice attended allowance of the Reply evidence, where we also allowed Patent Owner a Sur-Reply to address that evidence. Dec. 13.

Patent Owner takes issue with the Board’s observation that “Patent Owner was afforded an opportunity (fully taken) to file a Sur-Reply on issues raised in Dr. Robinson’s Declaration.” *Id.* (citing Sur-Reply 2–11). Patent Owner points out that the Sur-Reply included “only a short paragraph” countering that Declaration, but acknowledges that this circumstance was the result of Patent Owner’s own assessment of the relative importance of the evidence. Req. Reh’g 2–3 n.2. Patent Owner’s strategic calculation, regarding how much space or effort to devote to countering Dr. Robinson’s testimony, does not denigrate the opportunity afforded in the Sur-Reply, or reveal reversible error in the Decision.

The Board did not, as Patent Owner argues, “shift[] the burden of proof to Patent Owner to prove that Varena was not disseminated or otherwise made available to the public.” *Id.* at 1 (emphasis in original). On the contrary, the Board reasonably weighed the objective proof of public availability against Patent Owner’s bare attorney arguments on point. *See* Dec. 8–15 (reasoning that the indicia of public accessibility appearing on the face of Varena, combined with Patent Owner’s conduct during patent prosecution and information submitted under oath in Dr. Robinson’s Declaration, outweigh Patent Owner’s conclusory attorney arguments, which are supported by no objective proof). The objective evidence points in one direction; namely, that Varena is what it appears to be, a copy of a journal article published in *Rheumatology* by the Oxford University Press in November of 2012. *Id.*

Patent Owner shows no reversible error in the Decision relating to the Board’s assignment of Petitioner’s burden of proof, any inferences drawn from the evidence of record, or the alternative holding that Dr. Robinson’s testimony bolsters the substantial evidence of record showing that Varena was publicly available at the time of the invention.

III. CONCLUSION

For the above reasons, we deny Patent Owner’s Request for Rehearing of the Board’s Final Written Decision in this proceeding.

IV. ORDER

It is

ORDERED that Patent Owner’s Request for Rehearing of the Final Written Decision is *denied*.

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