

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,
Petitioner,

v.

ANTECIP BIOVENTURES II LLC,
Patent Owner.

PGR2018-00092
Patent 9,820,999 B2

Before GRACE KARAFFA OBERMANN, SHERIDAN K. SNEDDEN,
and CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

SNEDDEN, *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 27, “Req. Reh’g”) seeking review of the Board’s Final Written Decision (Paper 25, “Dec.”), in which we held unpatentable claims 1-4, 9, 10, 12, 14, 16-18, 23-25 and 27-29 of U.S. Patent No. 9,820,999 B2 (Ex. 1001, “the ’999 patent”). We also refer to the Petition (Paper 2, “Pet.”), Patent Owner’s Response (Paper 10, “PO Resp.”), Petitioner’s Reply (Paper 11, “Reply”), and Patent Owner’s Sur-Reply (Paper 18, “Sur-Reply”).

For the reasons set forth below, Patent Owner’s request for rehearing is denied.

II. STANDARD OF REVIEW

“The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

III. DISCUSSION

A. Background of the Dispute

The claimed invention relates to methods of treating chronic regional pain syndrome (“CRPS”) 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 having CRPS triggered by bone fracture. *Id.* at 106:25–30 (claim 1). In our Final Written

Decision, we determined Varenna 2012¹ anticipates the subject matter of claim 1 and dependent claims 2–4, 9, 10, 12, 14, 16–18, 23–25, and 27–29 thereto. Dec. 20–28. In reaching that determination, we further determined that the information pertaining to the publication on the face of Verrena 2012 was sufficient to establish that the document qualifies as a printed publication. Dec. 14–19. In doing so, we considered the testimony of Dr. Robinson (Ex. 1044) and, additionally, the information provided by Patent Owner (PO Resp. 4–13; Sur-Reply 5–13). *Id.*

Patent Owner requests modification of our determination regarding the publication status of Petitioner’s References and, consequently, modification of the Final Written Decision, on three grounds. First, Patent Owner contends that our determination that Verrena 2012 qualifies as a prior art printed publication is based on a misapprehension of the law. Req. Reh’g 2–8. Second, Patent Owner contends we “did not analyze the conclusory assertions of the Robinson Declaration.” *Id.* at 8–11. Third, Patent Owner contends that we improperly relied on evidence submitted with Petitioner’s Reply, specifically, the Robinson Declaration (Ex. 1044). *Id.* at 12–15.

We address in turn each of those asserted grounds for modification.

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”).

B. Whether we misapprehended or overlooked evidence of public accessibility

Patent Owner submits that the panel “did not look for evidence of public accessibility, ... which involves examining the evidence for proof that Varena 2012 was ‘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.’” Req. Reh’g 2 (quoting *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018)).

We do not agree Patent Owner’s position. On the contrary, we acknowledged *Acceleration Bay* and addressed with particularity the evidence of record tending to show that each of Petitioner’s References “was 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.” Dec. 15. Specifically, in our Decision, we credited indicia on the face of Varena 2012, such as printed dates and citation information, which are “part of the totality of the evidence” bearing on the issue of public accessibility. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 17–18 (PTAB Dec. 20, 2019) (precedential). Those indicia included details of the copyright notice, indicating publication of Varena 2012 “by Oxford University Press on behalf of the British Society for Rheumatology” in “2012;” and also additional legends, including “the statement ‘Advance Access publication 30 November 2012,’” and a conventional edition identifier from the journal *Rheumatology*. Dec. 17 (quoting Ex. 1005). Patent Owner advanced no

evidence tending to cast doubt on those indicia of publication. PO Resp. 4–13; Sur-Reply 5–13.

Our findings regarding Varenna 2012 align with the guidance provided in *Hulu*, 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; *see also Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 941 F.3d 1341, 1344 & 1347 (Fed. Cir. 2019) (holding that “the date on the face of the journal” was part of the substantial evidence supporting PTAB’s finding that a journal article was prior art).

Accordingly, we do not agree with Patent Owner that we misapprehended or overlooked the evidence of public accessibility. Rather, in our Decision, we resolved a factual dispute between the parties regarding whether any of Petitioner’s References were publicly available. Dec. 14–19. In doing so, we considered the totality of evidence related to the parties’ positions related to that issue. *Id.* We weighed evidence supporting Petitioner’s position that Varenna 2012 would have been publicly available—largely, the indicia of publication on the face of each document. We also weighed Patent Owner’s arguments and lack of evidence supporting

Patent Owner's position that Varena 2012 is not a printed publication. *Id.* In this regard, we note that Patent Owner provided no evidence to counter the indicia of publication on the face of Petitioner's References. PO Resp., 4–13; Sur-Reply, 23. Under those circumstances, we determined that the facts and circumstances in this case favor a determination that the indicia of publication on Varena 2012 are sufficient to establish that Varena 2012 qualifies as printed publications. Dec. 14–19.

In view of the above, we therefore conclude we did not misapprehend or overlook any matter in concluding that the totality of circumstances support our finding that Petitioner established by a preponderance of evidence that Petitioner's References were publicly available prior to the critical date of the invention. Although the burden of proof never shifted to Patent Owner on the issue of public availability, where Patent Owner declined to advance counter evidence on point, we did not err by crediting the indicia, which appear on the face of Varena 2012, as part of the totality of evidence bearing on the issue.

C. Whether we improperly considered or weighed Dr. Robinson's testimony

Patent Owner contends that

The Board's decision similarly omits any analysis of the assertions made by Robinson. The Robinson Declaration is the only evidence purporting to show Varena 2012 was disseminated or otherwise made available to the interested public, but Petitioner first presented it with the Reply and not with the Petition. It should play no role in the printed publication analysis.

Req. Reh’g., 8 (citing Ex. 1044); *see also id.* at 12–15 (Patent Owner contending that it was improper for the Board to consider evidence submitted for the first time with the Reply).

We are not persuaded by Patent Owner’s contentions that we improperly considered or weighed the Robinson Declaration. In our Final Written Decision, we considered the Declaration of Dr. Philip Robinson, who testified that he accessed, reviewed, and posted about Varena 2012 on the social media site Twitter in February 2013, which is before the May 14, 2013 priority date of the ’999 patent. Dec. 16 (citing Ex. 1044; Reply 11). We weighed Dr. Robinson’s testimony together with the facts and circumstances presented before us, including Patent Owner’s arguments set forth in its Sur-Reply. Sur-Reply 23. Here, we took account of objective supporting evidence on point advanced by Petitioner; including, 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 Varena.’”² Ex. 1044 ¶¶ 5–7, Exhibit A; Dec. 19. 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 and infallible memory.” Sur-Reply 23.

Patent Owner additionally contends that we misapprehended the law by considering Dr. Robinson’s testimony, which was presented for the first time with the Reply. Req. Reh’g., 12–15. In particular, Patent Owner

² We further note 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. Sur-Reply 23.

contends that “Petitioner decided not to offer any evidence or argument [with its Petition] to show that Varena 2012 was disseminated or made available before the critical date such that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could have located it,” and that our consideration of Dr. Robinson’s testimony submitted with the Reply was improper. Req. Reh’g., 13.

We are not persuaded by Patent Owner’s contentions and note that we addressed these same arguments in our Order denying Patent Owner’s motion to strike. Paper 24; *see also* Paper 13, 1 (Patent Owner contending that “Exhibit 1044 and related argument are new evidence and argument regarding the alleged accessibility of Varena 2012 (Ex. 1005) that Petitioner could have submitted with the Petition, but chose not to.”). Rather than pointing out any matters that the panel misapprehended or overlooked, Patent Owner expresses disagreement with that decision, and attempts to offer additional reasoning and argument not advanced during trial. Req. Reh’g, 12–15. That effort is ineffective to establish reversible error.

Furthermore, in our Final Written Decision, we noted that

Even if we set aside Dr. Robinson’s Declaration, . . . we are persuaded that the indicia of publication on the face of Varena 2012 are sufficient to establish that Varena 2012 was “sufficiently accessible to the public interested in the art” and “disseminated or otherwise made available” to the interested public before the critical date, and consequently, a printed publication. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016).

Dec. 19 n.4. For that reason also, Patent Owner shows no reversible error in our Final Written Decision holding that Dr. Robinson’s testimony bolsters

the substantial evidence of record showing that Varenna 2012 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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Patent 9,820,999 B2

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