

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INITIATIVE FOR MEDICINES, ACCESS & KNOWLEDGE (I-MAK),
INC.,
Petitioner,

v.

GILEAD PHARMASSET LLC,
Patent Owner.

Case IPR2018-00126
Patent 9,284,342 B2

Before ERICA A. FRANKLIN, GRACE KARAFFA OBERMANN, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner, Initiative for Medicines, Access & Knowledge (I-MAK), Inc., requests reconsideration of the Board’s decision (Paper 7, “Dec.”) denying institution of *inter partes* review of claims 1–4 of U.S. Patent No. 9,284,342 B2 (Ex. 1001, “the ’342 patent”). Paper 8 (“Req. Reh’g). For the reasons discussed below, we deny the request for rehearing.

II. DISCUSSION

When rehearing a decision on a petition, 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., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). 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.” 37 C.F.R. § 42.71(d).

The Board did not overlook or misapprehend Petitioner’s arguments; the Board considered them, but was not persuaded by them. We briefly address Petitioner’s contentions below.

Analysis

Petitioner argues that “the Board misapprehended or overlooked Petitioner’s evidence of motivation to make alternative crystalline forms that would lead a POSA to the ’342 patent’s claims.” *See* Req. Reh’g 1–3. In making that argument, Petitioner points to one section of the Decision addressing Petitioner’s argument that “a POSA would be able to prepare the

Sp-4 compound with such 2 Θ -reflections.” *Id.* at 1–2, citing Dec. 17.¹ As fully addressed in the Decision, that argument that a POSA *could* have prepared the *Sp*-4 compound with such 2 Θ -reflections is unpersuasive. Dec. 11–12. In further advancing its argument regarding motivation to make alternative crystalline forms, Petitioner also cites to excerpts from the Declaration of Dr. Fortunak (Ex. 1002), but fails to identify where in the Petition those matters were addressed. *See* 37 C.F.R. § 42.71(d). Moreover, contrary to Petitioner’s argument on rehearing, the Board considered Petitioner’s “evidence of motivation to pursue alternative crystalline forms” (Req. Reh’g 1), but found it unpersuasive. *See, e.g.*, Dec. 9, 11, 13, and 15.

Petitioner also argues that the Board ignored, and gave no weight to, Dr. Fortunak’s opinions. Req. Reh’g 3–4. To the contrary, the Board considered Dr. Fortunak’s declaration and accorded it appropriate weight. The fact that the Decision points out that Dr. Fortunak’s statement was verbatim to that of the Petition (*id.*, citing Dec. 13) does not mean the Board ignored Dr. Fortunak’s testimony; rather, it shows that the testimony was not overlooked.

Petitioner further objects to the Board’s alleged “criticism of Dr. Fortunak’s testimony” because the Board indicated that certain statements in the Fortunak declaration, relied upon in the Petition, were made “without citing evidentiary support.” Req. Reh’g 4. Petitioner cites to pages 9, 10, 13, and 15 of the Decision, which refer to Petitioner’s citations to paragraphs 111–113, 137, 147, and 158 of Dr. Fortunak’s declaration. *Id.* In each instance, however, we identify a statement in the Petition that is supported

¹The correct cite to the Decision is Dec. 11.

by a citation to a paragraph in Dr. Fortunak's declaration that directs us to no additional evidentiary support beyond that cited or discussed in the statement. Each of those paragraphs merely repeats the statement in the Petition. Petitioner directs us to no instance in which we misapprehended or overlooked evidentiary support identified in paragraphs 111–113, 137, 147, and 158 of Dr. Fortunak's declaration. Req. Reh'g 4.

III. CONCLUSION

For the foregoing reasons, we did not abuse our discretion in denying institution of *inter partes* review of claims 1–4 of U.S. Patent No. 9,284,342 B2. Accordingly, Petitioner's request for rehearing is *denied*.

IPR2018-00126
Patent 9,284,342 B2

PETITIONER:

Daniel Ravicher
dan@ravicher.com

PATENT OWNER:

David Cavanaugh
david.cavanaugh@wilmerhale.com

Emily Whelan
emily.whelan@wilmerhale.com

Dorothy Whelan
whelan@fr.com

Mike Kane
kane@fr.com

Chad Shear
shear@fr.com