

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC. and
AMNEAL PHARMACEUTICALS LLC,
Petitioner,

v.

JAZZ PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2015-00546
Patent 7,765,106 B2

Before JACQUELINE WRIGHT BONILLA, BRIAN P. MURPHY, and
JON B. TORNQUIST, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

I. INTRODUCTION

Jazz Pharmaceuticals, Inc. (“Patent Owner”) filed a Request for Rehearing following our Final Written Decision, which determined that claims 1–8 of U.S. Patent No. 7,765,106 B2 (Ex. 1001, “the ’106 patent”) were unpatentable. Paper 70 (“Decision” or “Dec.”); Paper 71 (“Rehearing Request” or “Req. Reh’g”). Par Pharmaceutical, Inc. and Amneal Pharmaceuticals LLC (together “Petitioner”) filed a Response to Patent Owner’s Rehearing Request. Paper 72 (“Opp.”). Patent Owner seeks reconsideration of the Board’s determination that claims 1–8 of the ’106 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the Advisory Committee Art (Exs. 1003–1006, collectively “the ACA”). Req. Reh’g 1–2. Patent Owner argues that the Board misapprehended or overlooked certain evidence when construing the following claim limitations: “prescriptions containing information identifying the patient” and “prescriptions containing information identifying . . . various credentials of the medical doctor who is prescribing the prescription drug.” *Id.* at 2–8. Petitioner opposes the Rehearing Request. Opp. 2–6.

Having considered the parties’ submissions concerning Patent Owner’s Rehearing Request, Patent Owner’s request is *denied*.

II. STANDARD OF REVIEW

A party who requests rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* “A Request for Rehearing is not an opportunity

to re-argue old arguments.” *Histologics, LLC v. CDX Diagnostics, Inc.*, Case IPR2014-00779, slip op. at 4 (PTAB Oct. 16, 2014) (Paper 9). With the aforementioned principles in mind, we address the rehearing arguments presented by Patent Owner.

III. ANALYSIS

Independent claims 1, 3, 5, and 7 of the ’106 patent each recite a method step for receiving prescriptions “containing information identifying the patient, the prescription drug [sodium oxybate], and various credentials of the medical doctor” prescribing the prescription drug. Ex. 1001, 8:40–46; *accord id.* at 9:57–63, 11:8–15, Certificate of Correction, Nov. 23, 2010 (page 2 of 3) (the “identifying” element). In its Response during trial, Patent Owner argued that exemplary embodiments described in the ’106 patent limited the recited “information” in the “identifying” element by requiring specific types of information to be read into that element. Paper 46 (“PO Resp.”) 30–36. We considered Patent Owner’s arguments, construed the different aspects of the “identifying” element with particular reference to the ’106 patent specification, explained our reasoning, and stated that the “identifying” element was not limited to the types of information proposed by Patent Owner “nor requires all of that information.” Dec. 19–22.

Patent Owner’s Rehearing Request argues that we overlooked portions of the ’106 patent specification and certain extrinsic evidence, in the form of expert testimony, that was cited by Patent Owner in its Response to the Petition. Req. Reh’g 1–8. Patent Owner then repeats its argument that the “identifying” element *requires* specific types of information to be read into the claim element. *Id.* at 3–8. We do not agree that we misapprehended or overlooked the evidence identified by Patent Owner in

its Response and Rehearing Request. Rather, Patent Owner’s Rehearing Request is an attempt to reargue a position rejected in our Decision.

Our Decision construing the “identifying” element includes extensive citation to, and discussion of, Patent Owner’s arguments and evidence. Dec. 19–22. Our claim construction analysis begins by explicitly and repeatedly acknowledging Patent Owner’s arguments and evidence, including the exact specification excerpts and expert testimony of Dr. DiPiro and Dr. Valuck on which Patent Owner’s Rehearing Request relies regarding the “information identifying the patient” and the “various credentials of the medical doctor” language. *Id.* at 19 (citing PO Resp. 30–33; Ex. 1001, 4:14–28, 8:4–5, 40–44, 9:56–60; Ex. 2044, 97:11–98:5, 99:18–100:10; Ex. 2046 ¶¶ 39–44); *id.* (citing PO Resp. 31–32; Ex. 1001, 4:26–28, 8:4–5; Ex. 2044, 97:11–23, 99:18–100:10); *id.* at 20 (citing PO Resp. 33–36; Ex. 1001, 4:14–26, 8:4–5, 40–44, 9:56–60; Ex. 2044, 181:1–23; Ex. 2046 ¶¶ 45–49); *id.* at 21 (citing PO Resp. 35–36; Ex. 1001, 4:14–26, 8:4–5, 40–44, 9:56–60, Fig. 9; Ex. 2044, 181:1–23; Ex. 2046 ¶ 47); *see also* Req. Reh’g 3–8 (providing a subset of the above-mentioned citations).¹

We did not “overlook” the above-mentioned evidence, including certain testimony by Dr. DiPiro and Dr. Valuck, nor consider only Figure 9 of the ’106 patent specification regarding the identify of patients, as Patent

¹ Patent Owner cited to the Abstract of the ’106 patent in support of its proposed claim construction. PO Resp. 33, 36; Req. Reh’g 5, 8. With regard to the “identifying” element, the Abstract merely states that “[i]nformation is kept in the database regarding all physicians allowed to prescribe the sensitive drug, and all patients receiving the drug.” Ex. 1001, Abstract. The Abstract, therefore, provides only general guidance for construing the “identifying” element.

Owner argues. *See* Req. Reh’g 3–6. For example, rather than limiting our analysis to Figure 9, we stated that

nothing in the specification suggests that excluding one or more pieces of information in the list of a “patient’s name, social security number, date of birth, sex, and complete address information, including city, state and zip code,” as proposed by Patent Owner, means that a prescription fails to contain “information identifying the patient,” as recited in the claims.

Dec. 20 (emphasis added); *see also id.* at 19–20 (discussing Fig. 9; citing Ex. 1001, 8:4–5).

We made clear that the controlling description of the specification outweighed Patent Owner’s argument and supporting evidence that specific types of information are required to be read into the “identifying” element of the claims. *Id.* (“*Thus, we construe ‘prescriptions containing information identifying the patient’ to refer to information identifying a patient, which may include the type of information presented in the enrollment form of Figure 9 and noted by Patent Owner (PO Resp. 30), but is not limited to that information nor requires all of that information.*” (emphasis added)). We also cited to all of the expert testimony on which Patent Owner relied for its claim construction, as an indication that we considered the testimony. *Id.* at 19 (citing Ex. 2044, 97:11–98:5, 99:18–100:10; Ex. 2046 ¶¶ 39–44).

We did the same for the “information identifying . . . various credentials of the medical doctor” language, concluding that:

The specification does not suggest that failing to include on the prescription one or more pieces of information from the list of a “medical doctor’s name, license number, DEA number, and physician specialty,” as proposed by Patent Owner, means that a

prescription fails to contain information regarding “various credentials,” as recited in the claims.

Id. at 20–22 (citing PO Resp. 33–36; Ex. 1001, 2:28–30, 47–48, 4:13–6:4, 8:4–7, 40–44, 9:56–60, Figs. 2A–C, 9; Ex. 2044, 181:1–23; Ex. 2046 ¶¶ 45–49). Though we did not discuss the expert testimony, we considered it.

For example, on the same page of testimony cited by Patent Owner, Dr. Valuck testified that the information sufficient to identify a patient is “whatever the pharmacist believes is required to sufficiently identify the patient in their professional judgment.” Ex. 2044, 98:2–16. Even so, our Decision puts primary emphasis on the claim language and relevant description of the “identifying” element in the specification, not the extrinsic expert testimony relied upon by Patent Owner. *See Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1012–13 (Fed. Cir. 2016) (“The legal part of claim construction is the determination of the meaning of the term in the claim in light of the patent’s intrinsic record.”); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005) (en banc) (stating that sources outside the specification should not be “used to contradict claim meaning that is unambiguous in light of the intrinsic evidence”).

In sum, Patent Owner’s Rehearing Request is an attempt to reargue its claim construction positions, not an identification of claim language or evidence we misapprehended or overlooked. Therefore, Patent Owner’s Rehearing Request is denied.

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IV. ORDER

Accordingly, it is

ORDERED that Patent Owner's Rehearing Request is denied.

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