

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

Granting Petitioner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner timely filed a Request for Rehearing (Paper 26, “Req. Reh’g.”) requesting rehearing of our Final Written Decision (Paper 25, “Dec.”). For the reasons set forth below, we grant Petitioner’s request for rehearing. We also vacate our original Final Written Decision (Paper 25) and will issue a revised, corrected Final Written Decision.

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

In its Petition, Petitioner asserted the following three obviousness grounds of unpatentability against the ’999 patent: (i) obviousness of claims 1–4, 9–20, and 22–29 over the combination of Varenna 2012, Varenna 2016, and/or Manara, optionally combined with Bruehl and one or more of Gatti, La Montagna, and/or Muratore (“Ground 5”); (ii) obviousness of claims 5–8 and 21 over the combination of Varenna 2012, Varenna 2016 and/or Manara in combination with Manicourt (“Ground 6”); and (iii) obviousness of claim 30 over the combination of Varenna 2012, Varenna 2016, and/or Manara in combination with Schwarzer, and optionally in further combination with Bruehl and Gatti, La Montagna, and/or Muratore (“Ground 7”). Pet. 62–79.

The Final Written Decision determined that each of Petitioner’s obviousness grounds depended on the contention that Varena 2016 and Manara constitute prior art, and that “Petitioner fail[ed] to show sufficiently that those references are prior art against the ’999 patent claims.” Dec. 29. In view of that determination, the Final Written Decision determined also that Petitioner failed to show that it is more likely than not that any challenged claim is unpatentable based on the obviousness grounds stated in the Petition. *Id.* at (citing Pet. 62–79).

Petitioner asserts that we erred with regard to Grounds 5–7 because Petitioner’s obviousness grounds do not depend solely on Varena 2016 and Manara, but additionally relied on Varena 2012 as an alternative primary reference and that we failed to consider properly Grounds 5–7 in that regard. Req. Reh’g. 2–7. Petitioner is correct.

In view of the above, we conclude that Petitioner has established that the Final Written Decision misapprehended or overlooked the reliance of Varena 2012 in Grounds 5–7. Accordingly, we grant the request for rehearing. We also vacate the Final Written Decision (Paper 25). A revised and corrected Final Written Decision will be issued.

IV. ORDER

For the reasons given, it is

ORDERED that the request for rehearing is granted. The Final Written Decision (Paper 25) is vacated and a revised and corrected Final Written Decision properly will be issued.

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