

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LABORATOIRE FRANCAIS DU FRACTIONNEMENT ET DES
BIOTECHNOLOGIES S.A.,
Petitioner,

v.

NOVO NORDISK HEALTHCARE AG,
Patent Owner.

Case IPR2017-00028
Patent 9,102,762 B2

Before ERICA A. FRANKLIN, SUSAN L. C. MITCHELL and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

I. INTRODUCTION

Pursuant to our authorization (Paper 15), Petitioner Laboratoire Francais du Fractionnement et des Biotechnologies S.A. (“LFB” or “Petitioner”) filed a Motion to Submit Supplemental Information in accordance with 37 C.F.R. § 42.123(a), and Patent Owner Novo Nordisk Healthcare AG (“Patent Owner”) filed an Opposition to the Motion. Paper 17 (“Mot.”); Paper 19 (“Opp.”). Along with its Motion, Petitioner filed Exhibits 1062–1066 as the supplemental information it seeks to submit.

Petitioner moves to submit as supplemental information chapter 18 of a French book titled “Blood-Borne Viruses” (Ex. 1062), a certified English translation of chapter 18 of that book (Ex. 1063), a supplemental declaration of Petitioner’s expert, Dr. Chtourou, purporting to explain the relevance of the chapter (Ex. 1064), and two journal articles (Exs. 1065 and 1066) that cite the book as a reference in order to show that Ex. 1062 was publicly accessible before the December 2003 filing date of the ’762 patent. Mot. 1

For the reasons discussed herein, we deny Petitioner’s Motion and expunge Exhibits 1062–1066 from the record.

II. DISCUSSION

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information if authorization is requested within one month of the date the trial is instituted and the supplemental information is “relevant to a claim for which the trial has been instituted.” This rule, however, does not require us to accept all supplemental information if timely submitted and relevant. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015). “The guiding principle for the PTAB in making any determination is to ‘ensure efficient administration of the Office and the

ability of the Office to complete IPR proceedings in a timely manner.” *Id.* at 445. Timeliness and relevancy are “construed within the overarching context of the PTAB’s regulations governing IPR and general trial proceedings. Additionally, the PTAB has discretion to grant or deny motions as it sees fit.” *Id.* at 446-47 (citing 37 C.F.R. § 42.5(a), (b)).

Petitioner first made its request for authorization to file a motion to submit supplemental information via an email dated May 10, 2017, which was within one month of our institution decision in this proceeding. As such, Petitioner has satisfied the timeliness requirement of Rule 42.123(a)(1).

Petitioner contends that the supplemental information it seeks to introduce satisfies the relevance requirement of Rule 42.123(a)(2) “because it contradicts Patent Owner’s allegations and further supports LFB’s position” with respect to the issues of whether “(i) nanofiltration is effective and generally performed at the end of a purification process; (ii) nanofiltration does not damage or alter filtered proteins; and (iii) those of skill in the art would not have been discouraged from nanofiltering FVIIa.” Mot. 3. Specifically, Petitioner asserts that Exhibit 1062 “is prior art under 35 U.S.C. § 102(b)” and “underscores the obviousness of claims 1-15 [of the ’762 patent] by further demonstrating a general motivation and reasonable expectation of success for practicing those claims.” *Id.* at 4. Petitioner also asserts that the teachings of Exhibit 1062 “refute Patent Owner’s claim that the prior art discouraged ‘simply moving nanofiltration to the end of the purification process.’” *Id.* at 5 (citing Paper 4, 30).

Although Petitioner’s request was timely and the information appears to be relevant to a claim upon which we instituted trial, we are not persuaded

that Exhibits 1062–1066 should be entered as supplemental information in this proceeding. In essence, Petitioner seeks to bolster its Petition by introducing new prior art teachings in response to arguments presented in Patent Owner’s Preliminary Response. However, “the provision for submitting supplemental information is not intended to offer a petitioner a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a preliminary response”, and “[t]o that end, a petitioner should not expect § 42.123 to present a ‘wait-and-see’ opportunity to supplement a petition after initial comments or arguments have been laid out by a patent owner.” *Beoing Co. v. Levine*, Case IPR2015-01341 (PTAB April 15, 2016) (Paper 30), slip op. at 3; *see also ZTE Corp. v. ContentGuard Holdings Inc.*, Case IPR2013-00139 (PTAB July 30, 2013) (Paper 27), slip op. at 3 (“The filing of a petition for *inter partes* review should not be turned into a two-stage process,” first to elicit arguments from the patent owner in a preliminary response, and second to complete the petition based on those arguments.).

Additionally, Petitioner has not explained sufficiently why the supplemental information could not have been presented with its original Petition. The Board may take into account whether the supplemental information was reasonably available to the petitioner at the time the petition was filed. *See Redline Detection*, 811 F.3d at 443. Petitioner contends that “Exhibit 1062 was only recently discovered during a search of prior art relating to the appeal for EP 1711513—after the petition for this IPR was filed—and thus could not have been submitted with the petition.” Mot. 3. As noted by Patent Owner, however, Exhibit 1062 was co-authored by Thierry Burnouf, who was employed by Petitioner and a colleague of Dr.

Chtourou, and Petitioner submitted another reference by Dr. Burnouf with its Petition. Opp. 3 (citing Ex. 1004; Ex. 1011). Furthermore, Exhibits 1065 and 1066, which are also sought to be introduced as supplemental information, demonstrate that Exhibit 1062 was not an obscure reference, but was rather cited in other prior art journal articles. *See* Mot. 6 (“Exhibit 1062 and other chapters of the book were cited by several sources prior to 2003 . . . , showing wide dissemination and availability to persons ordinarily skilled in the art and their recognition and comprehension of the contents of the book.”). As such, we are not persuaded that Petitioner could not have discovered Exhibit 1062 upon a diligent search prior to filing its original Petition.¹

III. ORDER

Accordingly, for the foregoing reasons, it is:

ORDERED that Petitioner’s Motion to Submit Exhibits 1062–1066 as Supplemental Information under 37 C.F.R. § 42.123(a) is DENIED; and

FURTHER ORDERED that Exhibits 1062–1066 shall be expunged from the record.

¹ At this point, we do not decide whether it would be appropriate to consider any of Exhibits 1062–1066 as part of Petitioner’s Reply.

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