

Prism Pharma Co., Ltd. v. Choongwae Pharma Corporation, Denying Institution of Inter Partes Review IPR2014-00315

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Takeaway: The Board may exercise its discretion in denying institution of a proceeding that is based on arguments that have already been presented to the Patent Office during prosecution and subsequently rejected.

In its [Decision](#), the Board denied institution of *inter partes* review of claims 1-3 and 5-7 of the '738 patent. Petitioner argued that the '738 patent was not entitled to the benefit of an earlier application based on a lack of written description support. Thus, based on the alleged later priority date, Petitioner argued that a PCT publication anticipated the challenged claims.

Patent Owner responded that the very same arguments were presented during the prosecution of the '738 patent and were found to be unpersuasive by both the Examiner and the Supervisor Patent Examiner. The Board agreed with Patent Owner and, in light of the Examiner's and his supervisor's rejection of Petitioner's arguments, exercised its discretion and denied the Petition under 35 U.S.C. § 325(d).

***Prism Pharma Co., Ltd. v. Choongwae Pharma Corporation*, IPR 2014-00315**

Paper 14: Decision Denying Institution of *Inter Partes* Review

Dated: July 8, 2014

Patent 8,318,738 B2

Before: Lora M. Green, Sheridan K. Snedden, and Zhenyu Yang

Written by: Yang

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National Law Review, Volume IV, Number 194

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