

## Endo Pharmaceuticals, Inc. v. Depomed, Inc., Denying Institution of Inter Partes Review IPR2014-00651

Article By:

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*Takeaway: A finding of anticipation requires one to show disclosure of the required claim elements in the prior art without any need for combining various disclosures not directly related to each other by the teachings of the cited reference.*

In its [Decision](#) on Institution, the Board **declined to institute an *inter partes* review** of the challenged claims (1-5 and 10-13) of the '340 Patent. The '340 Patent **relates to drugs formulated as unit oral dosage** forms by incorporating them into matrices formed of a **combination of poly(ethylene oxide) and hydroxypropyl methylcellulose**.

Petitioner's only ground of unpatentability was that the '340 Patent was anticipated by the Shell 1998 Publication pursuant to 35 U.S.C. § 102. The Board began by stating that to be unpatentable under § 102, a prior art reference must disclose every limitation of the claimed invention, and must lead to a composition that falls within the scope of the claim "without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited references." *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

The Board then analyzed whether the Shell 1998 Publication anticipates the '340 Patent. Petitioner argued that the Shell 1998 Publication teaches the use of polymers individually or in combination by disclosing polymeric matrices made from combinations of PEO and hydroxyethyl cellulose. Petitioner then stated that the disclosure of PEO and HPMC individually plus the disclosure of PEO combined with a "preferred alkyl-substituted cellulose" equates to the disclosure of a combination of PEO and HPMC. Patent Owner disagreed, stating that the Shell 1998 Publication discloses thirty-one polymeric matrices, none of which comprises a combination of PEO and HPMC. The Board agreed with Patent Owner that Petitioner did not sufficiently show that hydroxyethyl cellulose and HPMC are the same compound or are interchangeable, or that the Shell 1998 Publication disclosed combining PEO and HPMC at the requisite molecular weight of PEO and viscosity for HPMC. Therefore, the Board found that Petitioner had not demonstrated a reasonable likelihood that it would prevail in showing that claim 1, or dependent claims 2-5 and 10-13, are anticipated by the Shell 1998 Publication.

***Endo Pharmaceuticals, Inc. v. Depomed, Inc., IPR2014-00651***  
**Paper 12: Decision Denying Institution of *Inter Partes* Review**

**Dated: September 29, 2014**

**Patent: 6,723,340**

**Before: Grace Karaffa Obermann, Georgianna W. Braden, and Tina E. Hulse**

**Written by: Braden**

**Related Proceedings: *Depomed Inc. v. Endo Pharmaceuticals Inc.*, No. 3:13-cv-02467-JAP-TJB (D.N.J.); IPR2014-00652; IPR2014-00653; IPR2014-00654; IPR2014-00655; IPR2014-00656**

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