

Torrent Pharmaceuticals Limited v. Merck Frosst Canada & Co., Denying Institution IPR2014-00559

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Takeaway: A prior art reference, to anticipate, must disclose all elements of the claim, and must disclose those elements as arranged in the claim.

In its [Decision](#), the Board denied Petitioner's Petition, which had requested *inter partes* review of claims 1 and 2 of the '274 patent. According to the Board, Petitioner had not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of these two claims.

The '274 patent relates to a cAMP phosphodiesterase-4 (PDE4) inhibitor used to ameliorate allergy and inflammation symptoms. Petitioner had asserted that claims 1 and 2 were anticipated by Fenton, and that claims 1 and 2 would have been obvious over Fenton in view of Ashton.

The Board found that Fenton did not anticipate claims 1 and 2, because Fenton did not disclose all of the claim limitations arranged or combined in the same way as recited in the claims. In particular, the Board found that Fenton “does not show the specific combination as illustrated in the challenged claim 1, but only demonstrates classes of possible substituents at various positions.”

The Board did not agree with Petitioner's obviousness arguments, because it found that Petitioner had not sufficiently explained why a person of ordinary skill in the art “would have selected the claimed substituents of the six independent positions *all at once*” (emphasis in original). Although Petitioner had argued that secondary considerations did not render claims 1 and 2 obvious, the Board did not reach this issue because Petitioner had not shown any reason or motivation to modify Fenton or Ashton as proposed.

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Paper 8: Decision Denying Institution of *Inter Partes* Review

Dated: October 1, 2014

Patent: 6,448,274 B2

Before: Lora M. Green, Erica A. Franklin, and Zhenyu Yang

Written by: Yang

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