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Torrent Pharmaceuticals Limited v. Merck Frosst Canada & Co.: Denying Petitioner's Request for Rehearing of Decision on Institution IPR2014-00559

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: Petitioner must provide some reason for why one of ordinary skill in the art would have modified the prior art compounds to arrive at the new compound for the Board to institute an obviousness ground of unpatentability.

In its Decision, the Board denied Petitioner's request for rehearing of the decision not to institute inter partes review of claims 1 and 2 of the '274 patent. According to the Board, Petitioner had not established that the decision not to institute was based on an erroneous conclusion of law, clearly erroneous factual findings, or a clear error of judgment.

In the request for rehearing, Petitioner only sought redress on the obviousness ground. Petitioner argued that the Board misapprehended the proper standard for chemical obviousness and misapprehended the nature of Petitioner's argument of how the prior art would have led the skilled person to obtain the specific molecules recited in the '274 patent claims. Specifically, Petitioner argued that although the lead compound test set out in Takeda requires some reason be provided that would have led a person of ordinary skill in the art to modify a known compound in a particular manner to establish prima facieobviousness of a new claimed compound, the Federal Circuit, in Eisai, also "noted the applicability of other analyses in step with KSR, such that an easily traversed, small and finite number of alternatives . . . might support an inference of obviousness." The Board agreed, but also noted that Eisai further stated that the small and finite number of alternatives analysis presupposes that the record would give some reasons, available within the knowledge of one of skill in the art, to make particular modifications to achieve the claimed compound. Thus, the Board concluded a reason to make the specific modification to the starting material is still required, regardless of which analysis was followed.

Petitioner then argued that the Board misapprehended its argument as an attempt to follow the lead compound test. Specifically, Petitioner argued that the Board referred to two compounds expressly asserted by Petitioner as the closest prior-art compounds, as if they were being asserted by Petitioner as lead compounds. However, the Board explained that it was using those compounds in a hypothetical assertion, and did not form the basis of its obviousness analysis. The Board further explained that it did not deny the Petition because Petitioner failed to preselect some lead compounds, but because Petitioner had not shown that one of ordinary skill in the art would have had

a reason to modify the prior art compounds.

As an example of Petitioner's alleged reason to modify the prior art compounds, the Board noted that Petitioner asserted that the reason to modify the prior art compounds was based on the prior art reciting "(1) Further preferred R2 is alkyl substituted by halo, or cycloalkyl, cycloalkenyl or cyclothioalkyl; and (2) Exemplary alkyl groups include methyl, fluoromethyl, difluoromethyl, trifluoromethyl, cyclopropylmethyl, cyclopentylmethyl, ethyl, n-propyl, ipropyl, n-butyl, t-butyl, n-pentyl, 3-pentyl, heptyl, octyl, nonyl, decyl and dodecyl," which Petitioner argued was evidence that the prior art reference preferred cyclopropylmethyl at the R2 position. The Board did not agree with Petitioner, because the cited reference disclosed a much larger group of preferred elements than what was claimed, and Petitioner failed to explain why one of ordinary skill in the art would have selected the claimed modification from the large group.

***Torrent Pharmaceuticals Limited v. Merck Frosst Canada & Co.*, IPR2014-00559**
Paper 10: Decision Denying Petitioner's Request for Rehearing
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Patent: 6,448,274 B2
Before: Lora M. Green, Erica A. Franklin, and Zhenyu Yang
Written by: Yang

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