



## In Rare Decision, PTAB Grants Request for Rehearing, Reverses its Prior Decision, and Institutes IPR

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On April 7, 2017, Incyte Corporation (“Incyte”) filed a petition requesting an *inter partes* review of U.S. Patent No. 9,249,149 (the “’149 Patent”). The ’149 Patent is generally directed to modifications of ruxolitinib, an FDA-approved drug for treating patients with intermediate-or high-risk myelofibrosis. The claimed modifications improve the drug’s metabolic properties by swapping one or more hydrogen atoms with deuterium. On October 19, 2017, the Board denied the petition on all three grounds, finding among other things that the prior art did not disclose the claimed compounds sufficiently narrowly. Instead, the references disclosed large genera of potential compounds, without focusing on the ones in the claims.

Shortly thereafter, Incyte requested rehearing on two of the three obviousness grounds. In its request for rehearing, Incyte argued that the Board applied an overly restrictive view of the legal standard for finding “structural obviousness” with respect to the claimed compounds. Specifically, Incyte argued that the Board committed legal error by requiring Incyte to show that a person of ordinary skill would have chosen ruxolitinib as the lead compound over any other compound with clinical efficacy. The relevant inquiry, Incyte argued, is “whether [ruxolitinib] would have been selected as ‘promising’ to modify, not that it would have been superior to all compounds in the universe with FDA approved clinical efficacy.” Incyte also argued that the Board applied an improper standard for motivation to modify ruxolitinub which required Incyte to show there was a need to *improve* the compound. In support of its argument, Incyte cited to Federal Circuit precedent explaining that a motivation to modify can arise from an expectation to obtain “similar properties.” The Board was persuaded by Incyte’s arguments, granted rehearing, and instituted on the first of the two grounds under

review. The Board denied institution on the second ground, finding that one of the references did not qualify as a printed publication.

*Incyte Corp. v. Concert Pharmaceuticals, Inc.*, 2017IPR-01256 (PTAB Apr. 9, 2018).

## Categories

Patent Trial & Appeal Board

Obviousness

Inter Partes Review

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