Keywords: **obviousness, inherency**

General: **Inherency may supply a missing claim limitation in an obviousness analysis where the limitation issue is the natural result of the combination of prior art elements.**

Persion Pharmaceuticals LLC v. Alvogen Malta Operations LTD.
United States Court of Appeals for the Federal Circuit
No. 2018-2361
Decided: December 27, 2019

Detailed Summary

I. Facts

Persion Pharmaceuticals LLC ("Persion") owns U.S. Patent Nos. 9,265,760 ("the '760 patent") and 9,339,499 ("the '499 patent") which share a common written description and are directed to methods of treating pain in patients with mild or moderate hepatic impairment using extended-release hydrocodoneonly formulations. Hepatic impairment is comprised liver functionality. Hydrocodone is an opioid that is widely used to treat pain and is primarily metabolized in the liver. If liver function is impaired, metabolism of opioids is slowed, and thus, a regular does of hydrocodone may pose a higher risk of over dose in a patient with hepatic impairment than a health patient due to potential build-up of the drug in the patient's bloodstream. The '760 and '499 patents cover the formulation for Zohydro ER, Persion's extended-release hydrocodoneonly drug product. A clinical study showed that of Zohydro ER did not result in substantially higher concentrations of hydrocodone in the bloodstream of subjects with mild and moderate hepatic impairment than in subjects without hepatic impairment.

Persion sued Alvogen Malta Operations LTD ("Alvogen") alleging that Alvogen infringed the '760 patent (claims 1-4, 11, 12, 17, and 19), and amended the complaint to add the '499 patent (claim 1) after issue, by filing an Abbreviated New Drug Application seeking to market a generic version of Zohydro ER.

The district court concluded that Alvogen would indirectly infringe the asserted claims because its product label would induce doctors and patients to administer Alvogen's product in an infringing manner. However, the district court determined that the asserted claims from the '760 and '499 patents are invalid as obvious over Devane in view of Jain and the Vicodin and Lortab labels. Specifically, the district court found that in light of the teachings of Jain and the Vicodin and Lortab labels, a person of ordinary skill in the art would have been motivated to administer the extended-release hydrocodone bitartrate formulation disclosed in Devane to patients with mild or moderate hepatic impairment at an unadjusted dose and would have had a reasonable expectation of success in so doing. The district court further found that the pharmacokinetic limitations in the pharmacokinetic claims are "inherent in any obviousness combination that contains the Devane formulation" because the recited pharmacokinetic

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parameters were "necessarily present" in the Zohydro ER formulation described in both Devane and the asserted patents.

II. Issues

Did the district court err in concluding that the claims are invalid as obvious because of the combination of Devane in view of Jain and inherency?

III. Discussion

No. Persion raised four primary challenges to the district court's obviousness conclusion. First, Persion contended that the district court improperly relied on inherency to conclude that Devane discloses the pharmacokinetic limitations of the asserted claims. Second, Persion argued that the district court improperly relied on pharmacokinetic profiles from drugs other than extended-release single-active-ingredient hydrocodone formulations and from patients other than those with hepatic impairment in reaching its obviousness conclusion. Third, Persion contended that the district court erred by finding the asserted claims obvious before considering the objective indicia factors. Fourth, Persion argued that the district court's factual findings concerning obviousness are inconsistent with its findings concerning the lack of written description support.

The Federal Circuit reviewed each challenge and upheld the ruling that the claims were ineligible. The court argued that Persion contended that inherency can only satisfy a claim limitation when all other limitations are taught in a single reference. The court had previously ruled on inherency in *Santarus, Inc. v. Par Pharm., Inc.*, finding that the "claimed controlled-release oxymorphone formulation was obvious because an inherent pharmacokinetic property of oxymorphone that was present in controlled-release oxymorphone 'add[ed] nothing of patentable consequence.'"

The court found that Persion's position is contrary to the prior recognition that "inherency may supply a missing claim limitation in an obviousness analysis" where the limitation issue is "the natural result of the combination of prior art elements." The court found that Devane, together with Jain and the Vicodin and Lortab labels, taught the combination of elements that inherently result in the claimed pharmacokinetic parameters. The court found that a person of ordinary skill in the art would have been motivated, with reasonable expectation of success, to administer an unadjusted dose of the Devane formulation to hepatically impaired patients. There was also no dispute that the Devane formulation, which was identical to the Zohydro ER formulation described in the patents in suit, necessarily exhibited the claimed parameters under these conditions.

The Federal Circuit further upheld the district court's ruling regarding the evidence of obviousness. Persion argued that the district court erred in its obviousness findings by relying on pharmacokinetic data from formulations and patient groups not covered by the asserted claims. The district court asserted that in light of acetaminophen's hepatotoxicity, a person of skill in the

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art would have expected that an acetaminophen-free hydrocodone formulation, such as the one disclosed in Devane, would have been even safer for patients with hepatic impairment than the combination formulations disclosed in Jain and other references. Thus, the court concluded that the district court did not err in combining the teachings of Jain with the Devane formulation as Jain only discusses the benefits in comparison to a placebo used in its clinical study, not to the hydrocodone alone.

Persion also argued that the district court erred by finding the asserted claims obvious before considering the asserted objective indicia of nonobviousness, which Persion contended clouded the district court's analysis of the objective indicia. While the district court's discussion of objective indicia followed its discussion of the asserted prior art, the substance of the distict court's analysis made clear that it properly considered the totality of the obviousness evidence in reaching its conclusion and did not treat the objective indicia as a mere "afterthought" relegated to "rebut[ting]" a prima facie case.

IV. Conclusion

The Federal Circuit concluded the district court correctly applied inherency to find that the claimed pharmacokinetic limitations of the asserted claims added no patentable weight over the combination of Devane and other prior art references. Furthermore, the district court's factual findings concerning obviousness are not clearly erroneous. The Federal Circuit therefore affirmed the district court's decision that the asserted claims of the '760 and '499 patents are invalid as obvious under 35 U.S.C. § 103.

V. Notes

The Federal Circuit did not reach a decision regarding the district court's decision concerning the lack of written description support. The court found that Persion's entire argument with respect to the issue was based on incomplete quotations from the district court's opinion. In contrast to the "essentially limitless number of formulation species" covered by the claims of the '760 and '499 patents, the district court found that the prior art provided adequate guidance with respect to the sole formulation described in Example 8: the Devane formulation.

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