

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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GNOSIS S.P.A., GNOSIS BIORESEARCH S.A., AND GNOSIS U.S.A., INC.  
Petitioners

v.

MERCK & CIE  
Patent Owner

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Case IPR2013-00117  
U.S. Patent No. 6,011,040

**PATENT OWNER'S NOTICE OF  
PETITION FOR WRIT OF CERTIORARI**

Notice is hereby given that on July 25, 2016, Merck & Cie and South Alabama Medical Science Foundation (collectively, “Patent Owners”) jointly filed a petition for writ of certiorari before the Supreme Court of the United States. This petition was docketed as No. 16-125 on July 27, 2016. The petition seeks review of the Court of Appeals of the Federal Circuit’s decisions in *Merck & Cie v. Gnosis S.p.A.*, 808 F.3d 829 (Fed. Cir. 2015) and *South Alabama Medical Science Foundation v. Gnosis S.p.A.*, 808 F.3d 823 (Fed. Cir. 2015), entered on December 17, 2015. The former decision affirmed the Final Written Decision of the Patent Trial and Appeal Board (“PTAB”) entered on June 20, 2014 in IPR2013-00117 (Paper 71). The latter decision affirmed the Final Written Decisions of the PTAB entered on June 20, 2014 in IPR2013-00116 (Paper 68), -118 (Paper 64), and -119 (Paper 65). The Federal Circuit denied rehearing *en banc* of its decisions on April 26, 2016, reported at 820 F.3d 432 and 818 F.3d 1380.

In their petition to the Supreme Court, Patent Owners presented the following questions for review:

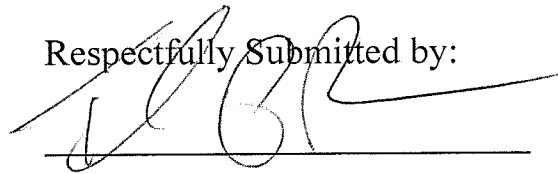
- (1) In light of Congress’s design and the underlying policies for the America Invents Act, should judge-made fact-findings in *inter partes* review proceedings be reviewed on appeal for clear error, or may the appellate court rubber-stamp such fact-findings if supported by substantial evidence?

(2) Does the Federal Circuit exceed its authority when it upholds a PTAB invalidity decision based on a rationale or ground not explicitly made by the PTAB?

On July 25, 2016, Patent Owners caused copies of the petition to be served upon, among others, Ian Gershengorn, Acting Solicitor General, United States Department of Justice.

Dated: July 29, 2016

Respectfully Submitted by:

A handwritten signature in dark ink, appearing to read 'T. Parker', is written over a horizontal line.

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## **CERTIFICATE OF SERVICE**

I hereby certify that on July 29, 2016, in addition to being filed electronically through the Patent Trial and Appeal Board End to End (PTAB E2E) system, the foregoing Patent Owner's Notice of Petition for Writ of Certiorari was caused to be served by overnight mail with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel,  
P.O. Box 1450,  
Alexandria, Virginia  
22313-1450

Dated: July 29, 2016

A handwritten signature in black ink, appearing to read 'T. Parker', is written over a horizontal line.

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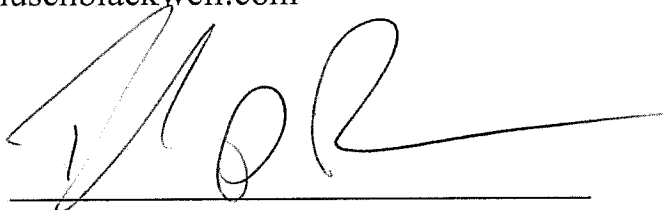
**CERTIFICATE OF SERVICE**

I hereby certify that on July 29, 2016, the Patent Owner's Notice of Petition for Writ of Certiorari was served by electronic mail, as consented to by the parties, upon the Petitioners' counsel of record upon the following:

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