Patentcloud Quality Insights Annotation Report

Celgene Corporation v. Sandoz Inc.

DNJ-3-18-cv-11026

Focus on: U.S. Pat. No. 6,962,940

Filing date: Jun. 26, 2018

Table of contents

Click on a page number to read

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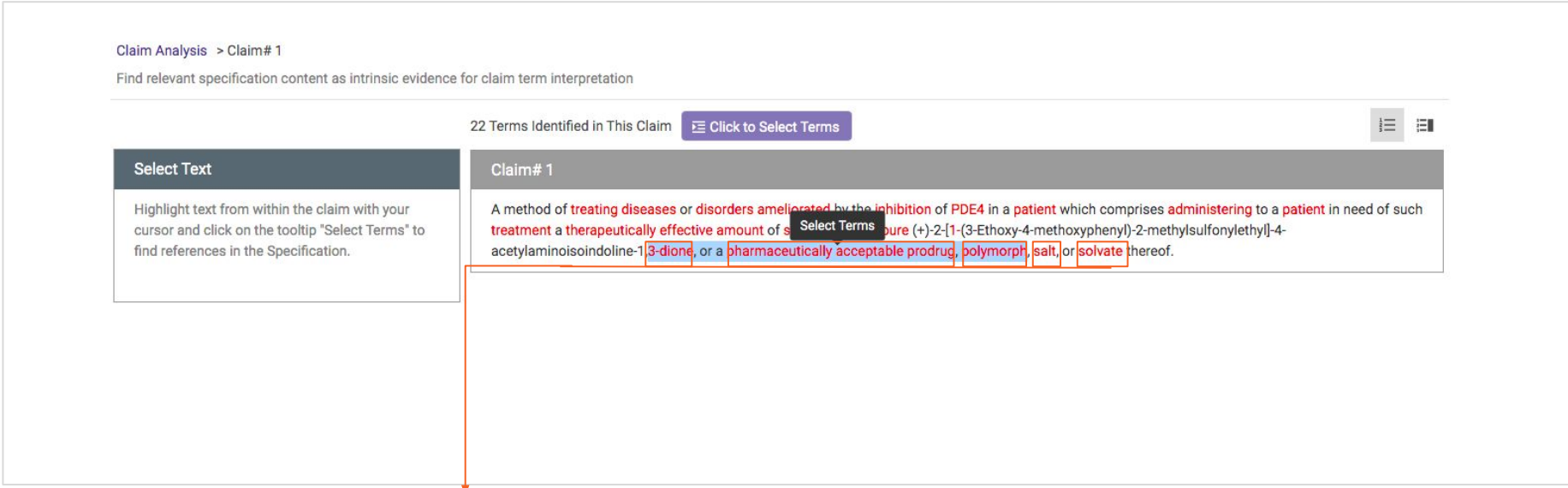
Map claims to specification and file wrapper

Map claims to specification - ‘940

Which claim terms are or are not in the specification?

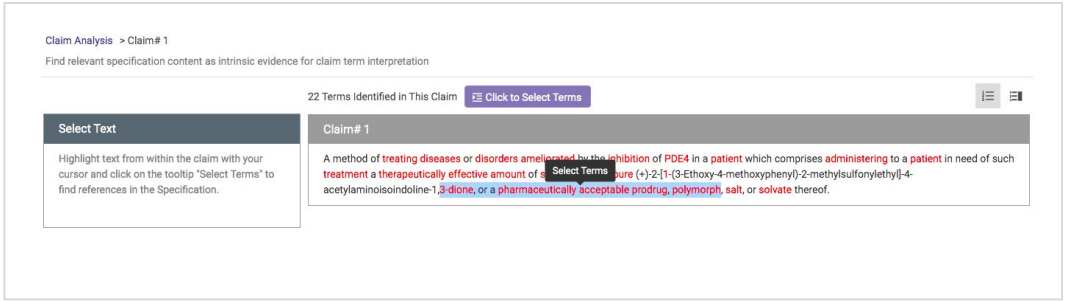


Claim Analysis **finds** these terms in the spec:
”**3-dione**”, ”**pharmaceutically acceptable prodrug**”, “**polymorph**“, “**salt**”,“**solvate**”, as well as other terms that are highlighted in red.

Source: Quality Insights

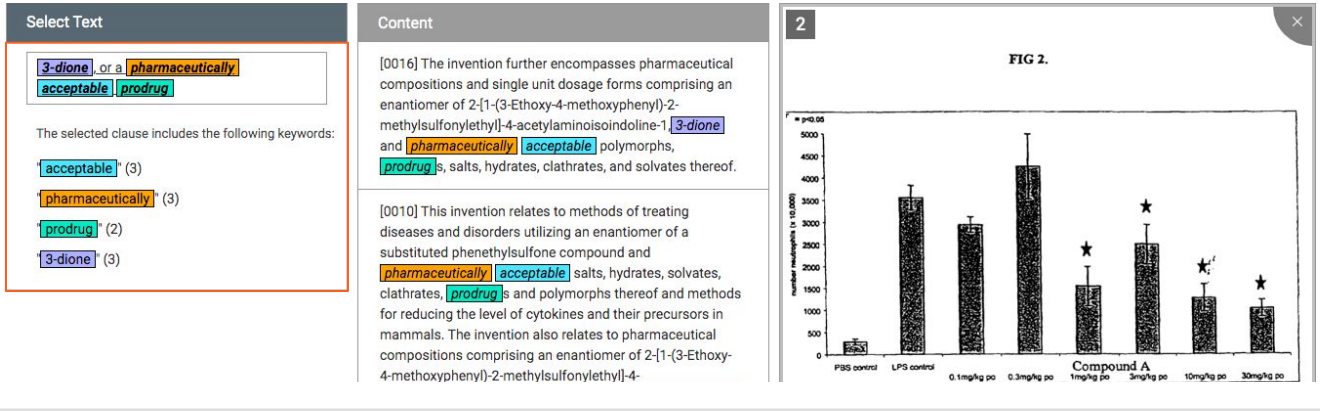
Map claims to specification - ‘940

Which claim terms are or are not in the specification?



Review the selected claim element and see how it is defined in the patent specification and related figures.

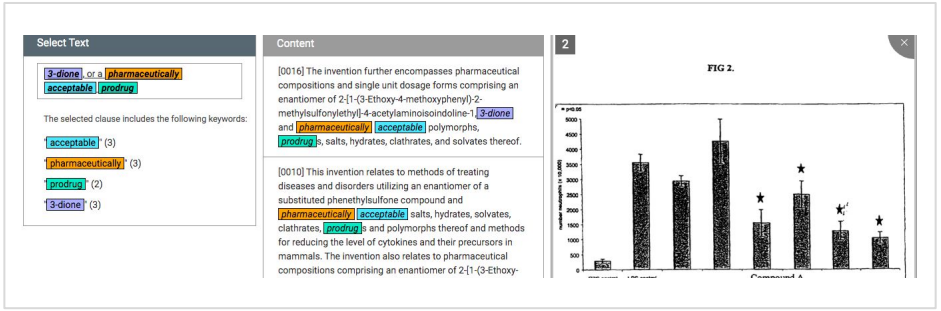
Selected elements of ‘940 Claim 1 | Selected elements of Claim ‘1 in Spec | Figures of ‘940



Source: Quality Insights

Map claims to specification and Complaint - ‘940

Does the allegedly infringing product element fall within or outside the patent’s scope?



With the claim scope interpretation from ***Claim Analysis***, verify your findings against the complaint.

Answer the question:

Does the alleged Invention element fall within or outside the patent’s scope?

56. The ’940 Patent includes claims that recite methods of administering (+)-2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylaminoisoindoline-1,3-dione.

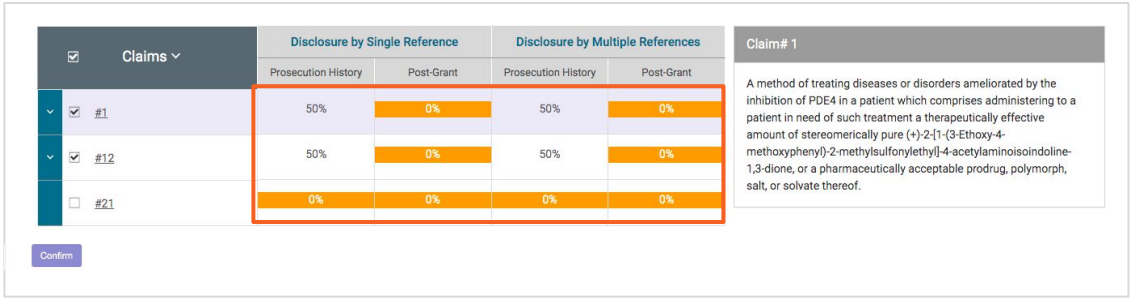
57. On information and belief, Sandoz’s Infringing ANDA Products contain (+)-2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylaminoisoindoline-1,3-dione.

Source: Quality Insights

Map claims to the file wrapper - '940

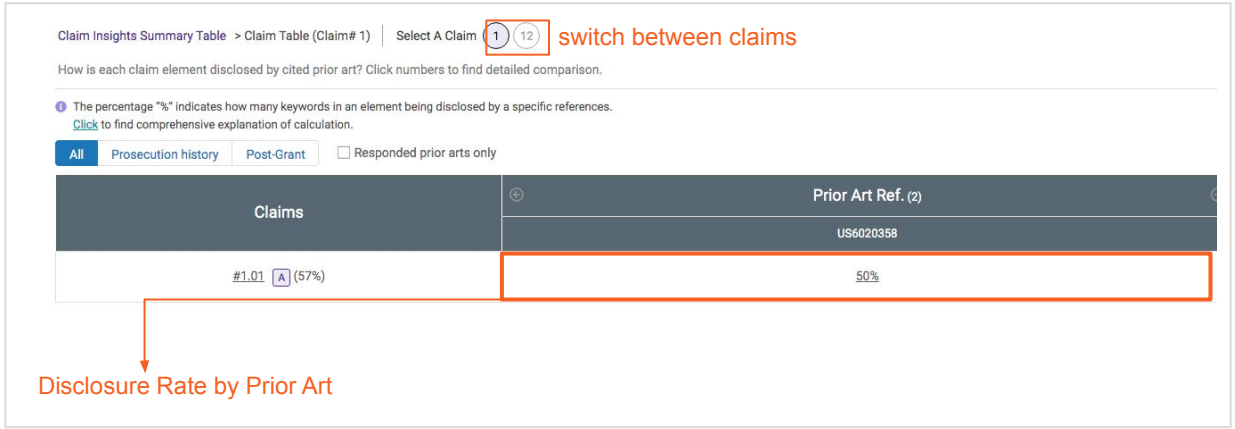
Which claim terms are in the file wrapper(i.e. examiner's opinion) ?

Disclosure Rate by Prior Art



From ***Claim Insights***, review how the asserted claims were disclosed by the prior art found by the examiner during prosecution and post-grant proceedings.

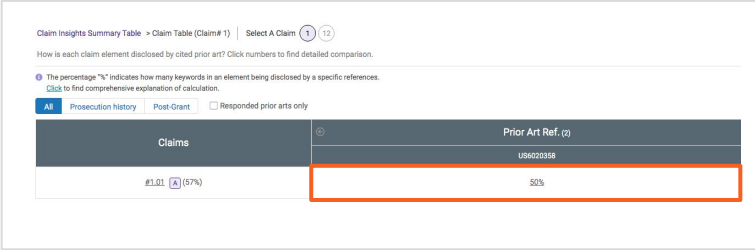
A higher percentage means more claim elements were disclosed by the prior art.

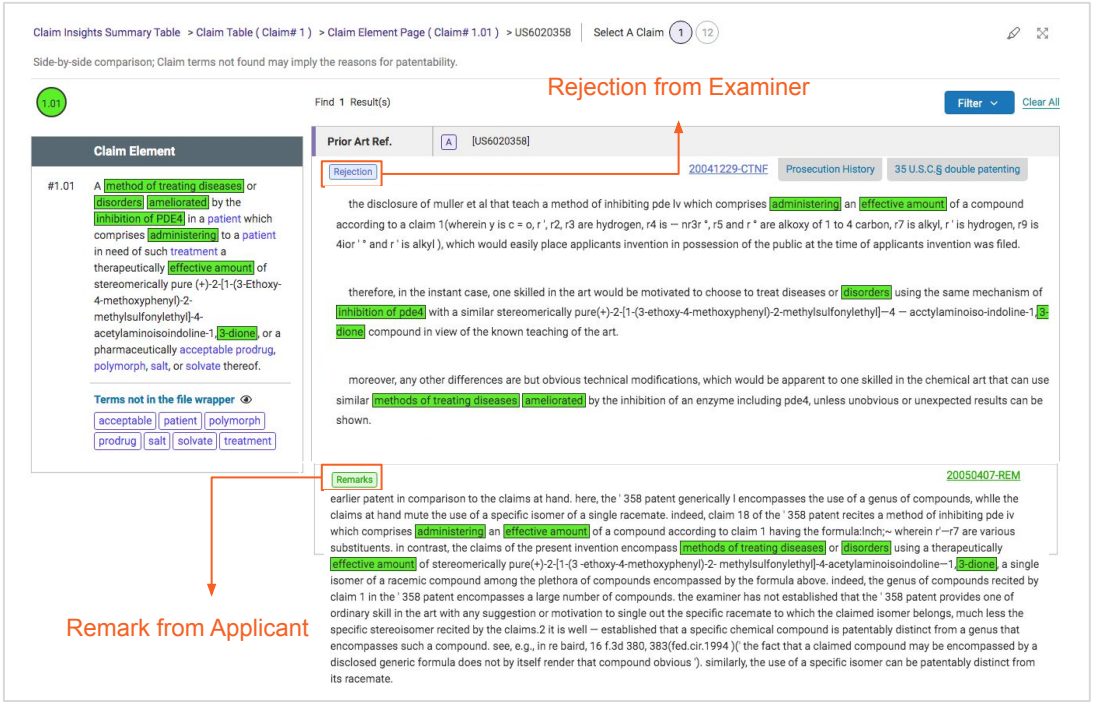


Source: Quality Insights

Map claims terms to the file wrapper - ‘940

Why was this patent granted? Which claims were amended and how did the scope change?





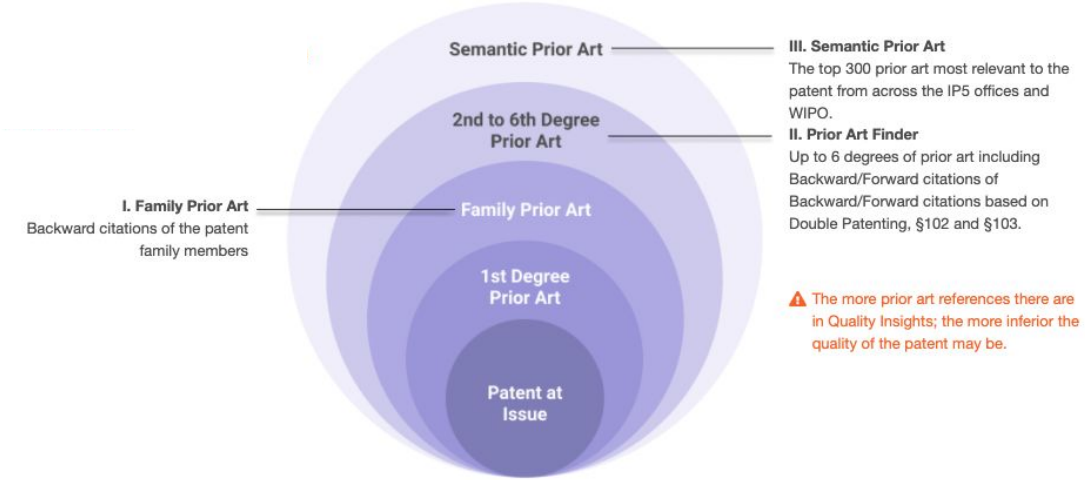
All of the limitations of this asserted claim element in ‘940 were 50% known by (US6020358).

Answer the questions:

Why was this patent granted?

Source: Quality Insights

How does Quality Insights generate prior art?



Source: Quality Insights

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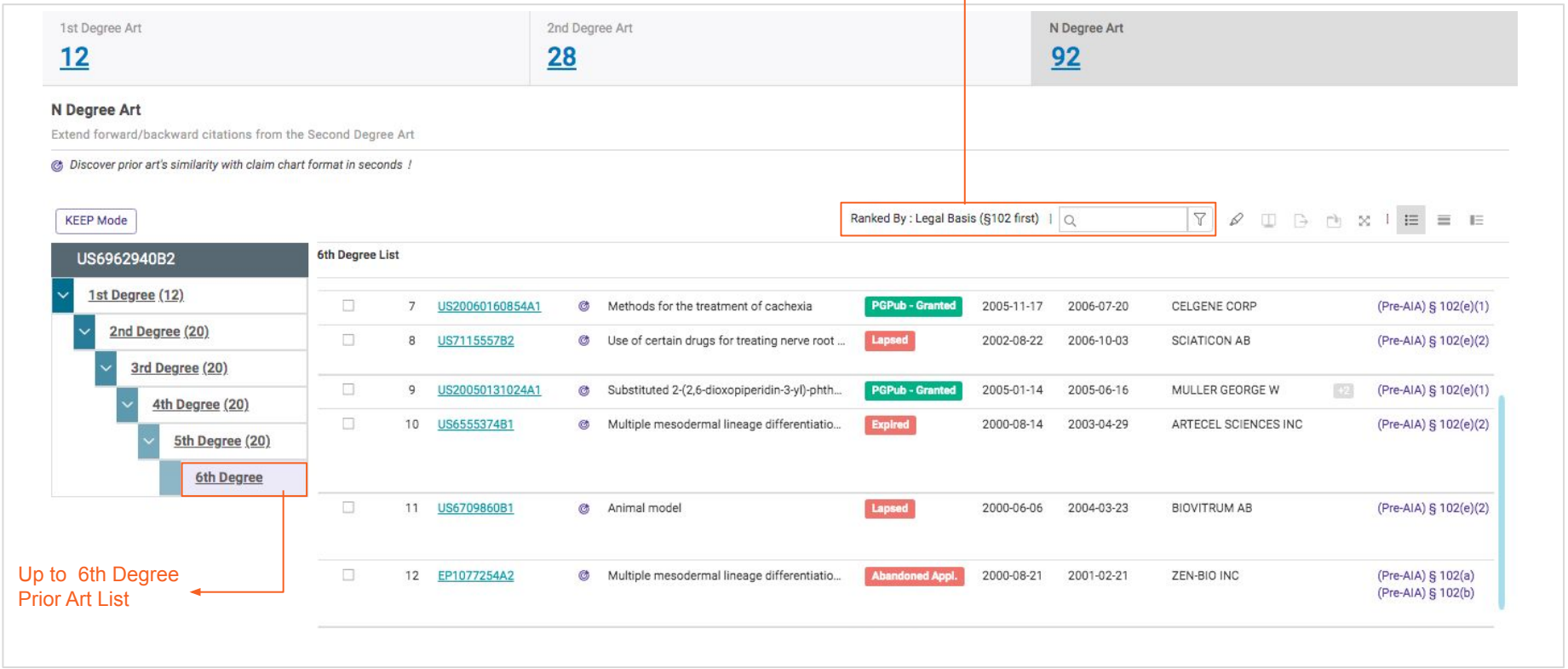
Prior Art Finder

Prior Art Finder for ‘940

Review cited and citing patents of ‘940 from the first to the sixth degree

Filter by:
- Applicability
- Legal Basis (§102 or §103)
- Patent Office
- Legal Status



Source: Quality Insights

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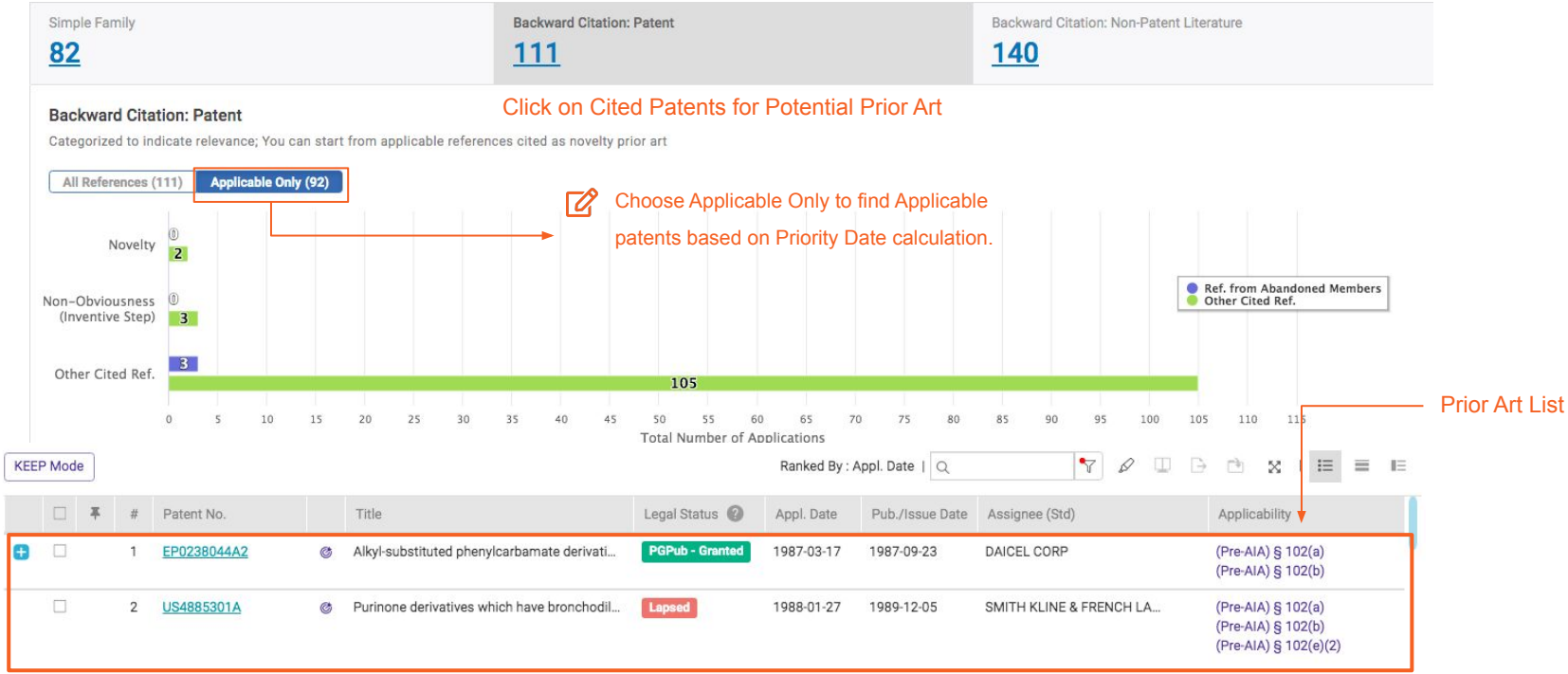
Family Prior Art

Family Prior Art of '940

Review prior art cited by and cited against the family counterparts when available



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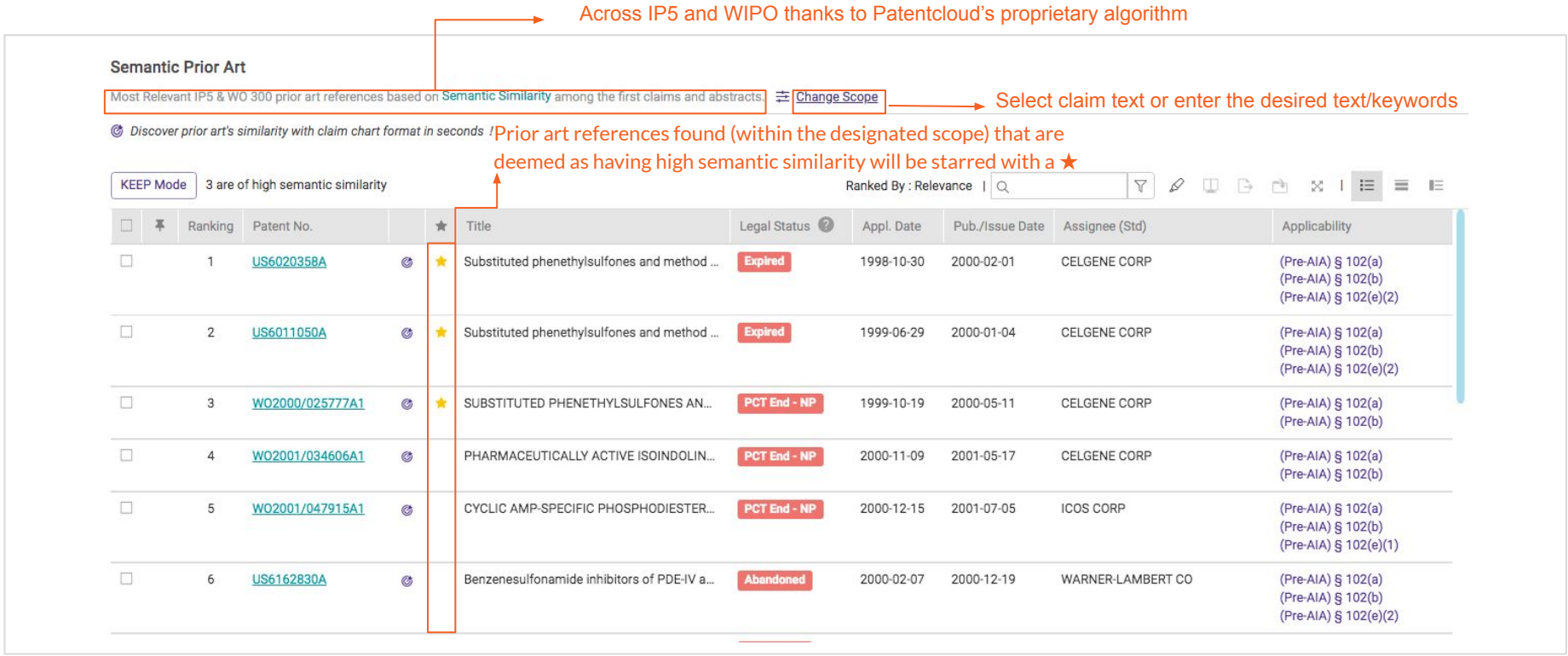
Semantic Prior Art

Semantic Prior Art of ‘940

Review potential prior art ranked by concept similarity

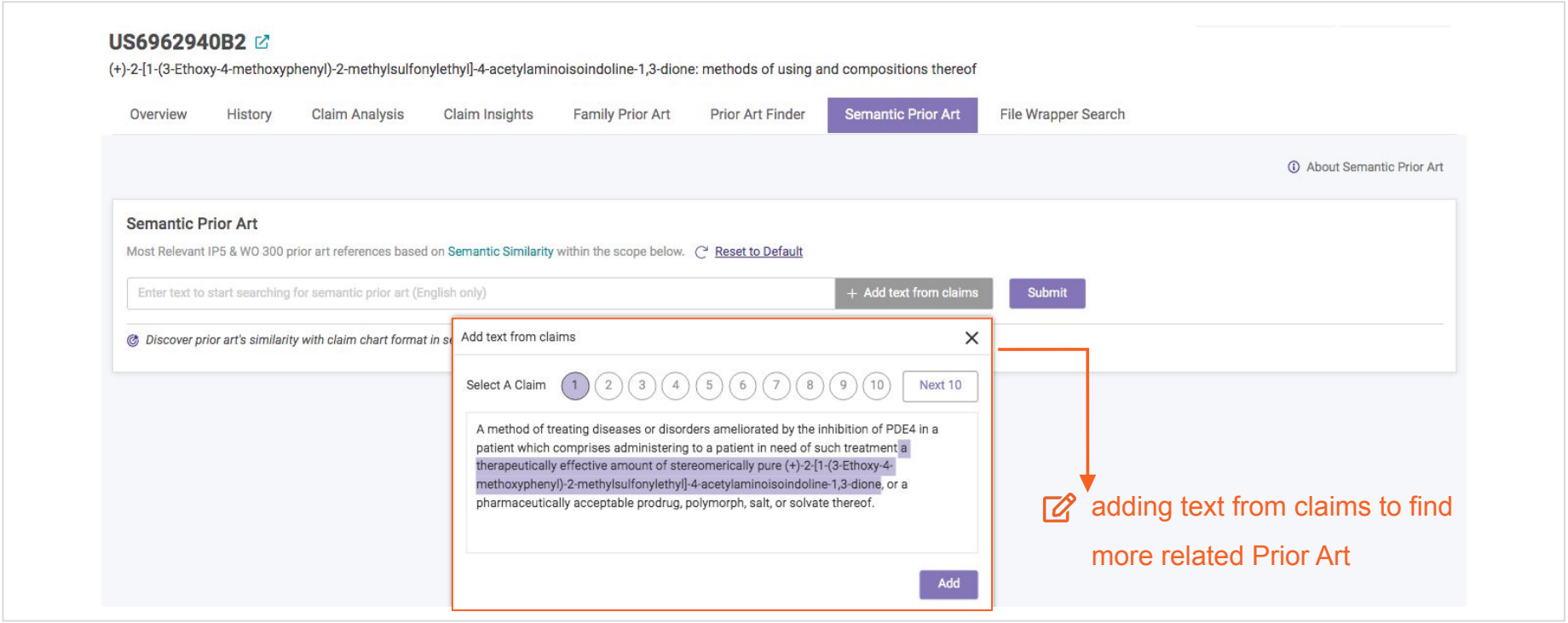


Ranking	Patent No.	Title	Legal Status	Appl. Date	Pub./Issue Date	Assignee (Std)	Applicability
1	US6020358A	Substituted phenethylsulfones and method ...	Expired	1998-10-30	2000-02-01	CELGENE CORP	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b) (Pre-AIA) § 102(e)(2)
2	US6011050A	Substituted phenethylsulfones and method ...	Expired	1999-06-29	2000-01-04	CELGENE CORP	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b) (Pre-AIA) § 102(e)(2)
3	WO2000/025777A1	SUBSTITUTED PHENETHYLSULFONES AN...	PCT End - NP	1999-10-19	2000-05-11	CELGENE CORP	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b)
4	WO2001/034606A1	PHARMACEUTICALLY ACTIVE ISOINDOLIN...	PCT End - NP	2000-11-09	2001-05-17	CELGENE CORP	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b)
5	WO2001/047915A1	CYCLIC AMP-SPECIFIC PHOSPHODIESTER...	PCT End - NP	2000-12-15	2001-07-05	ICOS CORP	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b) (Pre-AIA) § 102(e)(1)
6	US6162830A	Benzenesulfonamide inhibitors of PDE-IV a...	Abandoned	2000-02-07	2000-12-19	WARNER-LAMBERT CO	(Pre-AIA) § 102(a) (Pre-AIA) § 102(b) (Pre-AIA) § 102(e)(2)

Source: Quality Insights

Semantic Prior Art of ‘940

Review potential prior art ranked by concept similarity



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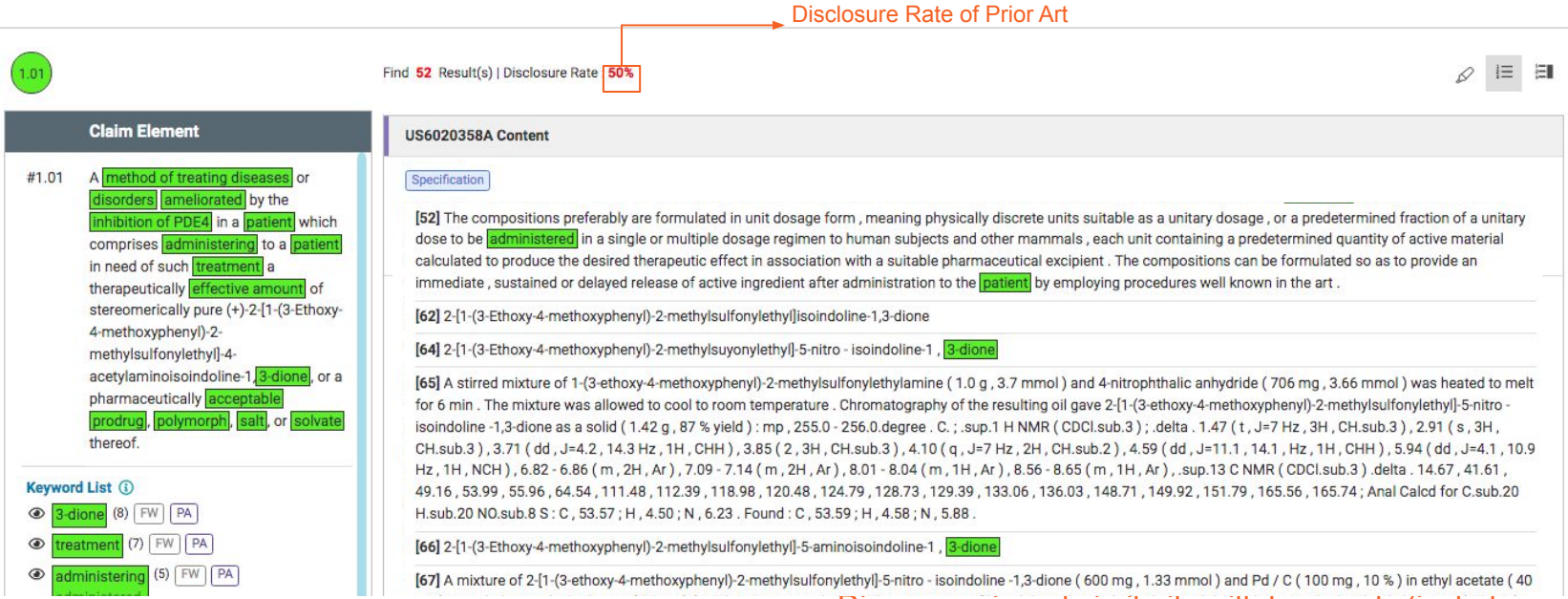
Comparison tools

Prior Art Comparison (claim chart format)

What does this prior art say about the critical elements?



Answer the question:

What does this prior art say about the Claim elements: "3-dione" ?

Discover prior art similarity with keywords (includes keyword stemming) mapped to the selected prior art reference Abstract, Claims, and Specification.

Source: Quality Insights

Prior Art Comparison (sample output)

Easily generate a table like below

Claim		Claim-Term Interpretation	Semantic Prior Art - '358	3rd Degree Citation Prior Art - B
1	A method of treating diseases or disorders ameliorated by the inhibition of PDE4 in a patient which comprises administering to a patient in need of such treatment a therapeutically effective amount of stereomerically pure (+)-2-[1-(3-Ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylaminoisoindoline-1,3-dione, or a pharmaceutically acceptable prodrug, polymorph, salt, or solvate thereof.	Refer to Claim Analysis results	50%	……

System-identified keywords and key phrases (highlighting of other keywords is available)

Results from claim to specification and file wrapper mapping

Results from prior art comparison by claim element

Source: Quality Insights

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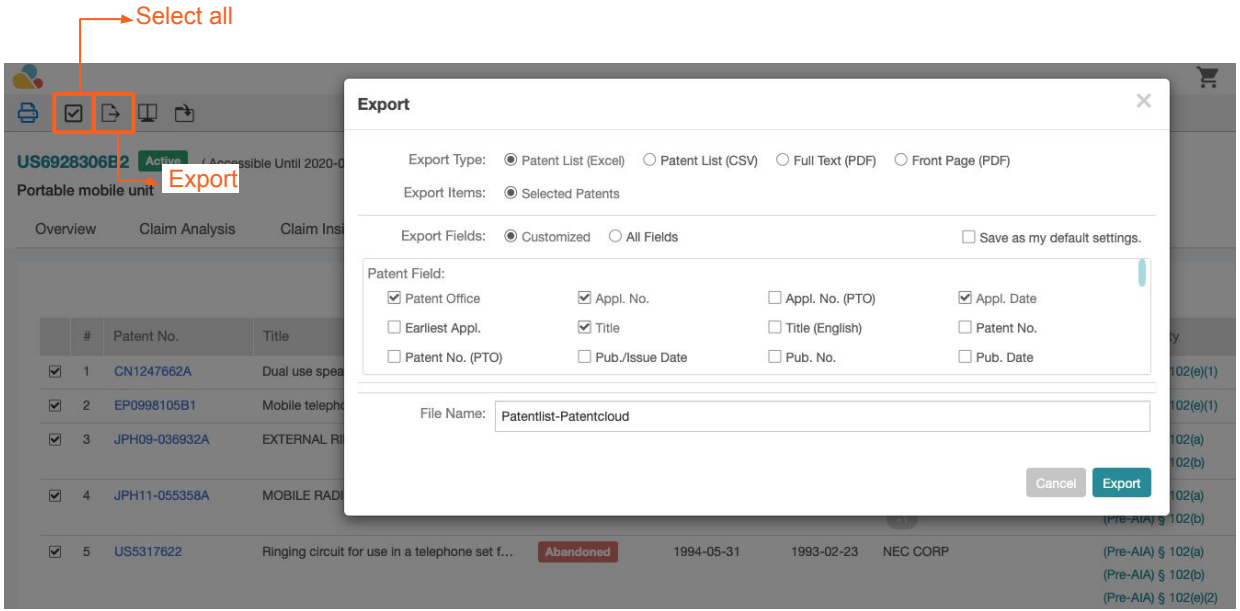
Prior Art downloads

Prior Art downloads



Download patent data in Excel or PDF format for Family Prior Art, Second Degree Prior Art, and/or Semantic Prior Art.

Source: Quality Insights

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Prosecution and PTAB History Key Events

Key Events - ‘940

1 Prosecution & 0 Post-Grant

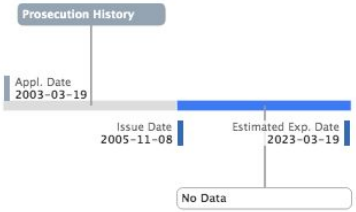
Event History	Family Status	Prior Art Status
1	82 Applications	484 Applications / 140 NPL References

# of Family Counterparts and Legal Status

# of Highly Relevant Prior Art References

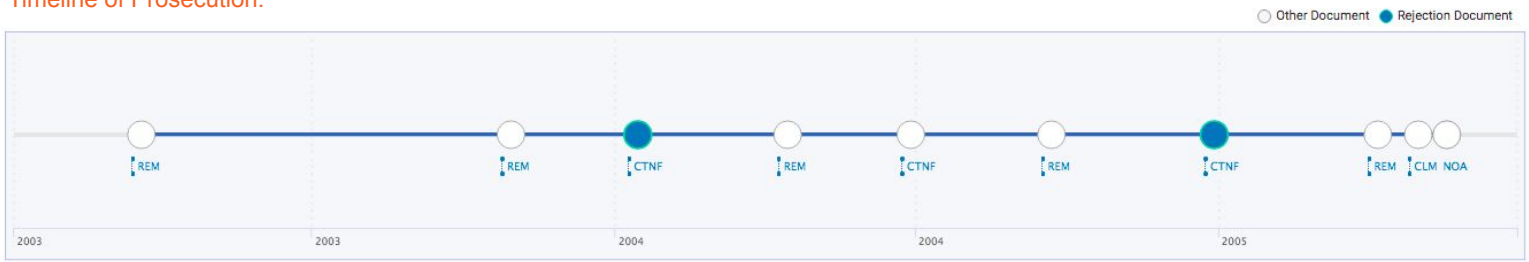
Event History | 1 Prosecution History / 0 Post-Grant

Validity challenges to a patent in its prosecution history and post-grant events



Legend	
Document Code	**Document Description**
CTNF	Non-final rejection
CLM	Claims
REM	Remarks

Timeline of Prosecution:



Source: Quality Insights

Key Events - ‘940

Prosecution History

10/392195 Prior Art Ref. | 0 Ref.

Check prior art cited and the legal basis of these challenges

Double Patenting	§ 102	§ 103
1 Ref.	0 Ref.	0 Ref.
US6020358		

Summary of 10/392195 History | 11 Event(s)

Clickable events for original OAs and their OCR version when available.

Direct links to Grounds,

Claims Highlighted and Prior Art Details

Data Last Updated on: 2021-01-28

Descriptions (Code)	Date	Prior Art Ref.
Notice of Allowance (NOA)	2005-05-19	
Notice of Allowance (NOA)	2005-05-19	
Claims (CLM)	2005-05-02	
Applicant Arguments/Remarks Made in an Amendment (REM) Claims (CLM)	2005-04-07	
Non-Final Rejection (CTNF)	2004-12-29	Grounds 2 ^

Legal Basis	Claims	Prior Art Ref.
double patenting	claim 1,2,3,4,5,6,7,8,9,10,11,12,13,14,15,16,17,18,19,25,26,27,28,29,30,31,32,33,34,56 ,58,59,60,61,62,63,64,65	US6020358
35 U.S.C.§ 112	claim 19,25,26,27,28,29,30,31,32,33,34,56	

Applicant Arguments/Remarks Made in an Amendment (REM)	2004-09-21	

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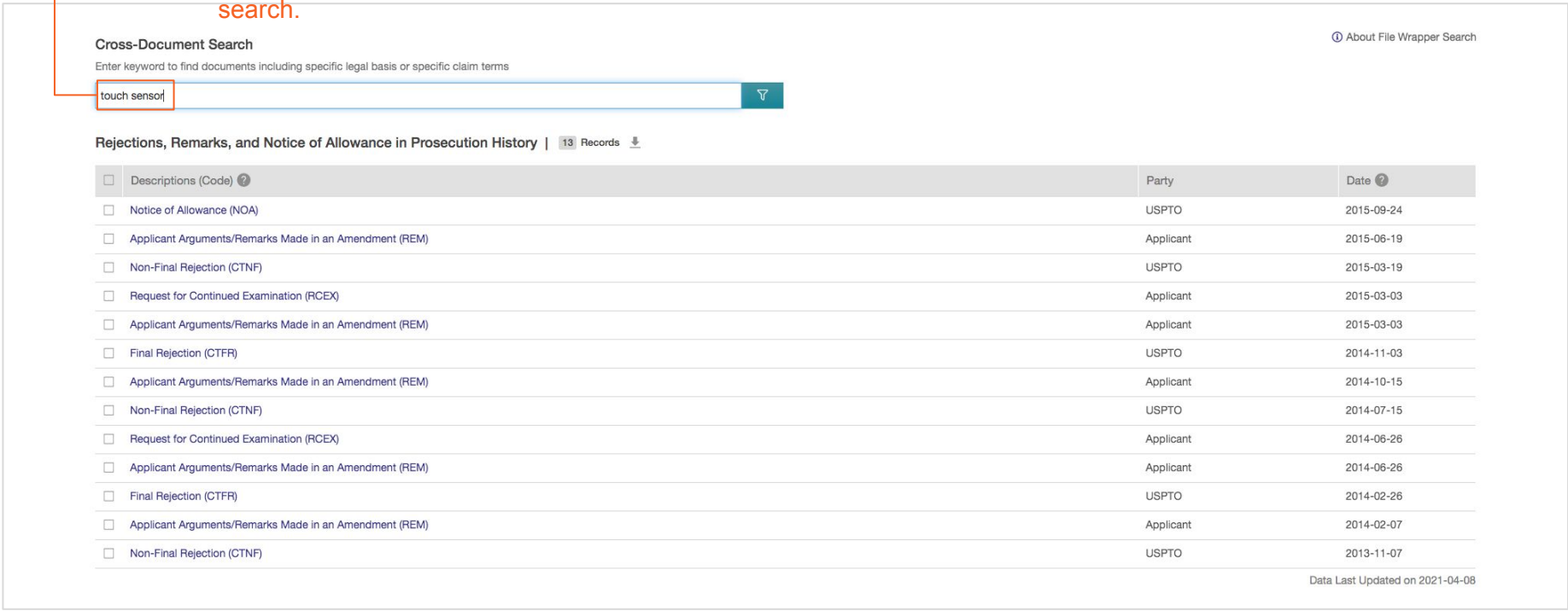
Prosecution and PTAB History Search

Patent File Wrapper Search

Directly discover details in the prosecution history and post-grant proceeding across all documents via a keyword search.



Cross-Document Search

Enter keyword to find documents including specific legal basis or specific claim terms

touch sensor

About File Wrapper Search

Rejections, Remarks, and Notice of Allowance in Prosecution History | 13 Records

Descriptions (Code)	Party	Date
Notice of Allowance (NOA)	USPTO	2015-09-24
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2015-06-19
Non-Final Rejection (CTNF)	USPTO	2015-03-19
Request for Continued Examination (RCEX)	Applicant	2015-03-03
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2015-03-03
Final Rejection (CTFR)	USPTO	2014-11-03
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2014-10-15
Non-Final Rejection (CTNF)	USPTO	2014-07-15
Request for Continued Examination (RCEX)	Applicant	2014-06-26
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2014-06-26
Final Rejection (CTFR)	USPTO	2014-02-26
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2014-02-07
Non-Final Rejection (CTNF)	USPTO	2013-11-07

Data Last Updated on 2021-04-08

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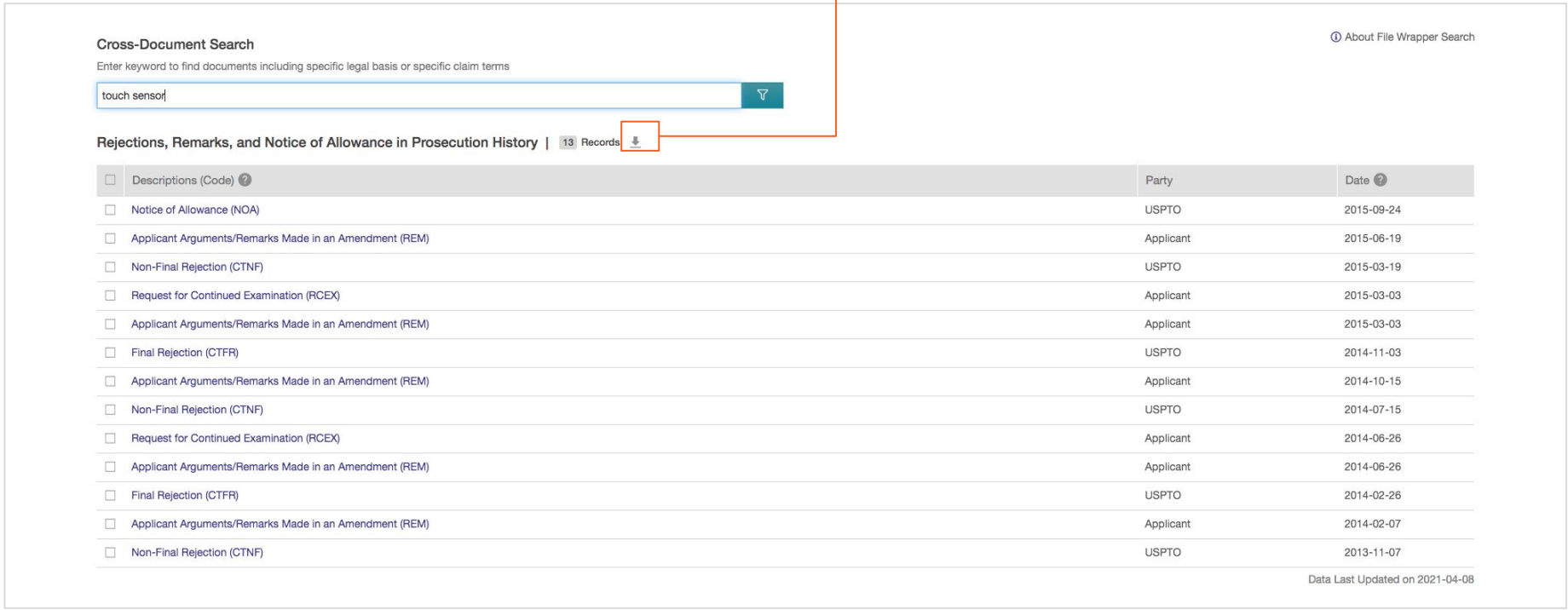
Prosecution and PTAB History PDF Downloads

PDF Downloads

Download the complete set or just part of the PDF files in the File Wrapper Search.



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Enter keyword to find documents including specific legal basis or specific claim terms

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Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2014-06-26
Final Rejection (CTFR)	USPTO	2014-02-26
Applicant Arguments/Remarks Made in an Amendment (REM)	Applicant	2014-02-07
Non-Final Rejection (CTNF)	USPTO	2013-11-07

Data Last Updated on 2021-04-08

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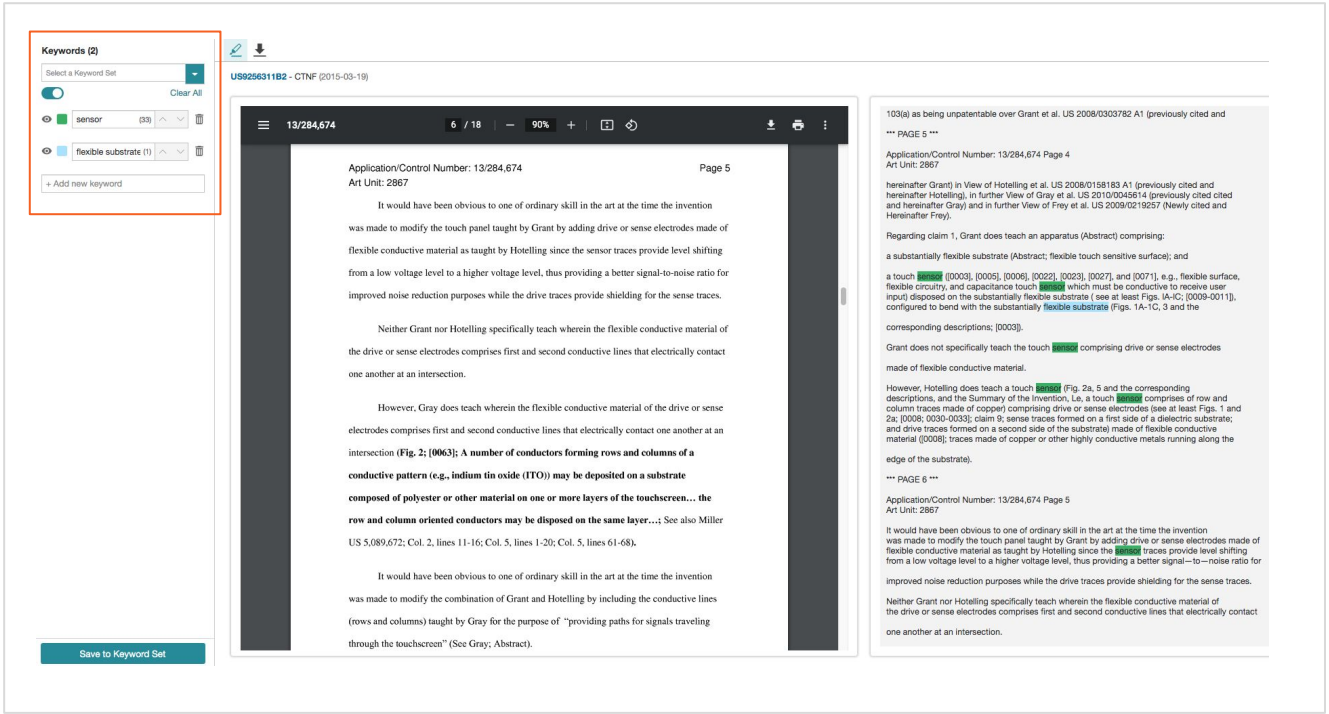
Prosecution and PTAB History Side-by-side PDF and OCR

Side by Side: PDF & OCR

Conduct a keyword search in a single document to identify the claim scope quickly and easily. You can even search additional claim terms within rejections.



Source: Quality Insights

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QI is a Game Changer

- Take control of a patent at issue with its comprehensive Overview
- Discover claim construction issues and define the claim scope
- Find more relevant prior art references
- Save time to increase productivity for a pitch and win