

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMNEAL PHARMACEUTICALS LLC AND PAR PHARMACEUTICAL, INC.,  
Petitioners,

v.

JAZZ PHARMACEUTICALS, INC.,  
Patent Owner.

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Cases: IPR2015-00545 (Patent 8,589,182 B1)  
IPR2015-00546 (Patent 7,765,106 B2)  
IPR2015-00547 (Patent 7,765,107 B2)  
IPR2015-00548 (Patent 7,895,059 B2)  
IPR2015-00551 (Patent 8,547,988 B1)  
IPR2015-00554 (Patent 7,668,730 B2)<sup>1</sup>

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Before JACQUELINE WRIGHT BONILLA, SUSAN L. C. MITCHELL, and  
BRIAN P. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5

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<sup>1</sup> This Decision addresses issues that are the same in the identified cases.  
We exercise our discretion to issue one Order to be filed in each case.  
The parties are not authorized to use this style heading.

IPR2015-00545 (Patent 8,589,182 B1)  
IPR2015-00546 (Patent 7,765,106 B2)  
IPR2015-00547 (Patent 7,765,107 B2)  
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IPR2015-00554 (Patent 7,668,730 B2)

## I. INTRODUCTION

Petitioner Par Pharmaceutical, Inc. (“Par Inc.”) filed Petitions requesting *inter partes* review in each of the above-identified proceedings, and Petitioner Amneal Pharmaceuticals LLC (“Amneal”) filed Petitions requesting *inter partes* review in four of the above-identified proceedings, IPR2015-00545, IPR2015-00546, IPR2015-00547, and IPR2015-00554. Paper 3 (“Pet.”).<sup>2</sup> The Petitions in IPR2015-00548 (Paper 1, 58) and IPR2015-00551 (Paper 1, 58) identify Par Inc. as the sole real-party-in-interest, and the Petitions in IPR2015-00545, IPR2015-00546, IPR2015,00547, and IPR2015-00554 identify Amneal and Par Inc. as the real-parties-in-interest. Pet. 59.

Patent Owner Jazz Pharmaceuticals, Inc. (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”) in each proceeding asserting that parent companies of Par Inc. – Par Pharmaceutical Companies, Inc. (“Par Co.”), Par Pharmaceutical Holdings, Inc. (“Par Holdings”),<sup>3</sup> Sky Growth Intermediate Holdings I Corporation (“Sky I”), and Sky Growth Intermediate Holdings II Corporation (“Sky II”) – should have been identified as real-parties-in-interest in each of the above-identified proceedings. Prelim. Resp. 9–23. Patent Owner asserts, in particular, that “Par Inc.’s parent companies exercise control over Par Inc.’s business, including control over th[ese] IPR proceeding[s].” *Id.* at 9–10, 19–

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<sup>2</sup> Citations are to IPR2015-00545 as representative unless otherwise indicated.

<sup>3</sup> Par Holdings was formed in 2012 as Sky Growth Holdings Corporation, but changed its name to Par Holdings on March 4, 2015. Prelim. Resp. 9 n.3 (citing Ex. 2015, 13).

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21. Patent Owner requests dismissal of the Petitions as untimely pursuant to 35 U.S.C. § 315(b). *Id.* at 10, 22–23.

Approximately one week after Patent Owner filed its Preliminary Responses to the Petitions, counsel for Petitioners contacted the Board to request authorization to file a “short reply brief and declaration testimony from corporate officers” to address the real-party-in-interest issues raised in Patent Owner’s Preliminary Responses. Within an hour, counsel for Patent Owner advised the Board that it did not oppose the request of Par Inc. and Amneal to contest the real-party-in-interest issue, but asked that Par Inc. and Amneal “not be permitted to submit testimonial evidence with their oppositions.” In the event the Board was inclined to permit testimonial evidence, then Patent Owner requested the opportunity “to depose each of Petitioners’ declarants” and to file a reply to Petitioners’ arguments.

## II. DISCUSSION

Pursuant to 35 U.S.C. § 312(a)(2), we may consider a petition for *inter partes* review “only if . . . the petition identifies all real parties in interest.” Our rules require Petitioners and Patent Owners to “[i]dentify each real party-in-interest for the party.” 37 C.F.R. § 42.8. Thus, the question of whether Petitioners have identified all real parties-in-interest is a threshold issue for our consideration.

Having considered each party’s position, we have determined that limited additional briefing and evidence, directed solely to the real-party-in-interest issues raised by Patent Owner’s Preliminary Responses, would be beneficial to the Board. We are particularly interested in evidence relevant to Patent Owner’s contention

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that “[a]t least Par Holdings and Par Co. are exercising control over th[ese] IPR” proceedings. Prelim. Resp. 19–21.

### III. ORDER

Accordingly, it is

ORDERED that Petitioner Par Inc. may file not more than two (2) declarations of not more than five (5) pages each (excluding cover and service pages), directed solely to the real-party-in-interest issues raised by Patent Owner’s Preliminary Responses. The two declarations shall be filed in each of the above-identified cases no later than May 26, 2015;

FURTHER ORDERED that Petitioners Par Inc. and Amneal shall file a single, identical response of not more than ten (10) pages, directed solely to the real-party-in-interest issues raised by Patent Owner’s Preliminary Responses. The single, identical response shall be filed in each of the above-identified cases, adjusting only the names of Petitioners in the case captions and citation form, as necessary, not later than May 26, 2015;

FURTHER ORDERED that Petitioner Par Inc. shall make each of its declarants available for deposition by counsel for Patent Owner, limited solely to the factual issues raised in each declarant’s declaration, at a time and location mutually agreeable to the parties and witnesses in order to permit the parties to comply with the filing date requirements of this Order;

FURTHER ORDERED that counsel for Patent Owner may depose Petitioner Par Inc.’s declarants for not more than three (3) hours of deposition time each;

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FURTHER ORDERED that Patent Owner shall file a single, identical reply of not more than five (5) pages to Petitioners' response in each of the above-identified cases, adjusting only the names of Petitioners in the case captions and citation form, as necessary, not later than June 9, 2015; and

FURTHER ORDERED that Petitioner shall not be permitted to file any further response to Patent Owner's reply.

**PETITIONER:**

Dennies Varughese  
[dvarughe-PTAB@skgf.com](mailto:dvarughe-PTAB@skgf.com)

Deborah Sterling  
[dsterlin-PTAB@skgf.com](mailto:dsterlin-PTAB@skgf.com)

**PATENT OWNER:**

Francis Cerrito  
[nickcerrito@quinnemanuel.com](mailto:nickcerrito@quinnemanuel.com)

John Biernacki  
[jvbiernacki@jonesday.com](mailto:jvbiernacki@jonesday.com)