

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LIMITED,
Petitioner,

v.

JANSSEN SCIENCES IRELAND UC,
Patent Owner.

Case IPR2015-01030
Patent 8,518,987 B2

Before JACQUELINE WRIGHT BONILLA, SHERIDAN K. SNEDDEN,
and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Lupin Limited (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 8,518,987 B2 (Ex. 1001). Paper 1 (“Pet.”). The Petition identifies Lupin Limited and Lupin Pharmaceuticals, Inc. as the only real parties-in-interest. Pet. 5. Patent Owner Janssen Sciences Ireland UC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) asserting, *inter alia*, that two unnamed entities—Lupin Inc. and Lupin Atlantis Holdings SA—should have been identified as real parties-in-interest. Prelim. Resp. 3–7. Patent Owner asserts, in particular, that shared corporate leadership and intertwined business relationships between Petitioner and those unnamed entities, as well as the entities being “blurred in presentations to the public,” support a finding that the unnamed parties are real parties-in-interest. *Id.* at 5–6. Patent Owner requests dismissal of the Petition as untimely under 35 U.S.C. § 315(b). *Id.* at 7.

A few weeks after Patent Owner filed its Preliminary Response to the Petition, counsel for Petitioner contacted the Board to request authorization to file “a brief response, together with supporting declaration testimony” to address the real-party-in-interest issue raised in Patent Owner’s Preliminary Responses. In particular, Petitioner requested authorization to file a response of no more than ten pages, as well as supporting declaration testimony from no more than two declarants, directed solely to the real parties-in-interest issue. As part of the request, Petitioner proposed that Patent Owner may file a reply not more than five pages to Petitioner’s response.

Thereafter, on August 13, 2015, Judges Bonilla, Snedden, and Paulraj conducted a conference call with respective counsel for Petitioner and Patent Owner in relation to Petitioner's request. During the call, Patent Owner indicated that it did not oppose Petitioner's request for additional briefing, but wanted an opportunity to depose any declarants relied upon in Petitioner's response.

II. DISCUSSION

Under 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 Petitioner has identified all real parties-in-interest is a threshold issue for our consideration.

As discussed during the conference call, we have determined that limited additional briefing and evidence, directed solely to the real-party-in-interest issue raised in Patent Owner's Preliminary Responses, would be beneficial. In the meantime, we point the parties to a recent Decision in Case IPR2015-00546, slip op. at 10–19 (PTAB July 28, 2015) (Paper 25).

III. ORDER

Accordingly, it is

ORDERED that Petitioner may file no more than two (2) declarations of no more than five (5) pages each (excluding cover and service pages), directed solely to the real party-in-interest issue raised in Patent Owner's Preliminary Response. The two declarations shall be filed no later than August 28, 2015;

FURTHER ORDERED that Petitioner shall file a response of no more than ten (10) pages, directed solely to the real party-in-interest issue raised in Patent Owner's Preliminary Response. The response shall be filed no later than August 28, 2015;

FURTHER ORDERED that Petitioner 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's declarants for not more than three (3) hours of deposition time each;

FURTHER ORDERED that Patent Owner shall file a reply of no more than five (5) pages to Petitioner's response no later than September 11, 2015; and

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

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