

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

NISSAN CHEMICAL INDUSTRIES, LTD.,
Patent Owner.

Case IPR2015-01069
Patent 5,856,336

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

SNEDDEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Mylan Pharmaceuticals Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1 and 2 of U.S. Patent No. 5,856,336 (Ex. 1001). Paper 2 (“Pet.”). The Petition identifies Mylan Pharmaceuticals Inc. and Mylan Inc. as the only real parties-in-interest. Pet. 1.

Patent Owner Nissan Chemical Industries, Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) asserting, *inter alia*, that an unnamed entity—Mylan N.V. (“MNV”)—should have been identified as a real party-in-interest. Prelim. Resp. 4–11. Patent Owner asserts, in particular, that “the lines between MNV, MI, and MPI with respect to the Mylan corporate family’s shared pharmaceutical business are blurred” and that their “intertwined interests” support a finding that MNV is a real party-in-interest. *Id.* at 5–6. Patent Owner requests dismissal of the Petition as untimely under 35 U.S.C. § 315(b). *Id.* at 9, 11.

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 and refute solely the real-party-in-interest issues raised in Patent Owner’s Preliminary Response.” As part of the request, Petitioner represented that Patent Owner requests “authorization to file a reply brief and depose any declarant Mylan offers in support of its 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.

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;

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FURTHER ORDERED that counsel for Patent Owner may depose Petitioner 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 17, 2015; and

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

PETITIONER:

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