

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN LABORATORIES LIMITED
Petitioner,

v.

AVENTIS PHARMA S.A.,
Patent Owner

Case IPR2016-00712
Patent No. 8,927,592

**PETITIONER'S REPLY IN SUPPORT OF MOTION TO FILE
SUPPLEMENTAL INFORMATION**

Petitioner replies to the Patent Owner's opposition (Paper 15) to the Motion to submit two public documents as Supplemental Information (Paper 14) under Rule 42.123(a): a Final Office Action in a related pending continuation application, and a district court Claim Construction Order on the same claims involved in the present trial. Patent Owner asserts three bases for opposing Petitioner's Motion: that the Final Office Action is an improper response to Patent Owner's Preliminary Response ("POPR"), that each piece of supplemental information is not relevant, and that the supplemental information improperly bolsters Petitioner's case. Each of these bases fails, for at least the reasons discussed below.

A. The Final Office Action is not an Improper Reply to the POPR

Patent Owner contends that the Final Office Action from its continuation application constitutes an improper reply to the POPR, arguing that *Wireless Seismic, Inc. v. Fairfield Indus., Inc.*, IPR2014-01113 holds that supplemental information is improper when it is "in effect . . . a reply to the Preliminary Response." Paper 15 at 3-4 (quoting *Wireless Seismic*, Paper 8 at 2). But *Wireless Seismic* involved a request to submit supplemental information *prior to institution*. Here, the Motion to submit supplemental information was filed *after* institution. Moreover, the Final Office Action is a public document of the PTO's response to Patent Owner's arguments to similar claims, as has been set forth in the Motion (Paper 14). It does not constitute a reply *by Petitioner* to the POPR.

Patent Owner also suggests that the supplemental information is an improper attempt “to preemptively respond to” Patent Owner’s Response (“POR”). Paper 15 at 4. However, Patent Owner’s proposal that Petitioners be barred from submitting supplemental information until after the POR runs contrary to the plain language of the applicable rule, which requires that a motion be filed within one month of institution, 37 C.F.R. 42.123(a)(1). The argument that supplemental information cannot be filed if it touches on issues discussed in the POPR or potentially in the POR ignores the timing requirement and the requirement that the supplemental information be relevant to an instituted claim. 37 C.F.R. 42.123(a)(2).

B. Each Piece of Supplemental Information is Relevant

Regardless of what Patent Owner chooses to do in the POR, the supplemental information is permissible because it is relevant and informative to at least one instituted claim, as discussed in Petitioner’s Motion (Paper 14). The supplemental information is relevant at least to the meaning of the instituted claims, the meaning and weight to be given the prosecution history, and to factual disputes between the parties regarding likelihood of success. *See* Paper 14 at 7, 9-13.

Patent Owner essentially concedes Petitioner’s factual description of each piece of proposed supplemental information. It is undisputed that the Claim Construction Order construes the claims also at issue in this proceeding. Yet the Patent Owner argues that “the district court decision is not binding on the Board,”

a point not even remotely asserted in the Motion. Paper 15 at 8. Patent Owner also does not dispute that the Final Office Action rejected the continuation claims from the '592 patent that are similar to yet narrower than the issued claims of the '592 patent, and that this finding was based on art that is either identical or substantively identical to that asserted in the instituted grounds. *Id.* at 5 (recognizing Petitioner's argument that the "Final Office Action is relevant because it concerns narrower claims than those of the '592 patent," and arguing only that the Final Office Action "is not a final determination," that the Examiner had not reviewed the POR, and that the Examiner is not an APJ). Because the supplemental information relates to the meaning of the instituted claims and the asserted prior art, there should be no reasonable dispute that this information is relevant to at least one instituted claim.

Patent Owner argues that its submission of the Petition and Seth Declaration to the Examiner in the related application were pursuant to its "duty of candor" to the Office (Paper 15 at 6), but at the same time attempts to prevent the Board from receiving the Final Office Action from that case. Even though the Final Office Action was issued on June 9, 2016 (EX1040 at cover), the Patent Owner repeatedly argued two weeks later in its POPR that the Board should defer to the Examiner's original prosecution findings. The Patent Owner apparently did not feel compelled to inform the Board that the same Examiner had changed his position after reviewing Petitioner's evidence from this proceeding. Even now, Patent Owner

argues that it would be unduly prejudicial for the Board to consider findings in the related prosecution. Paper 15 at 5-7. Patent Owner’s argument that the Board is unable to evaluate the probity of relevant information as to the instituted claims should be rejected.

C. The Supplemental Information is not “Improper Bolstering”

Patent Owner argues that supplemental information is only appropriate if it will not help (“bolster”) the Petitioner’s case. Contrary to Patent Owner’s arguments, it is entirely proper to submit supplemental information that supports arguments made in the Petition. Indeed, “[s]upplemental information . . . is evidence a party intends to support an argument on the merits.” *ServiceNow, Inc. v. BMC Software, Inc.* (IPR2015-01176), Paper 15 at 3 (quoting *Handi Quilter, Inc. v. Bernina Int’l AG* (IPR2013-00364), Paper 30 at 2-3). Accordingly, that the supplemental information that is the subject of the present Motion confirms and supports Petitioner’s original arguments, and is relevant to the instituted claims and the trial as instituted, fully complies with Rule 42.123(a).

Patent Owner relies on *Mitsubishi Plastics, Inc. v. Celgard, LLC* (IPR2015-00524) to suggest that it is improper to receive supplemental information that “bolster[s] the evidence by submitting . . . additional confirmatory evidence.” Paper 15 at 10, *see also id.* at 8-9. However, in *Mitsubishi Plastics*, the petitioner sought to submit new expert witness declarations. *Mitsubishi Plastics*, Paper 30 at

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