

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
TEVA PHARMACEUTICALS USA, INC., and AKORN INC.
Petitioners,

v.

SAINT REGIS MOHAWK TRIBE and ALLERGAN, INC.,
Patent Owners.

Case IPR2016-01127 (8,685,930 B2); Case IPR2016-01128 (8,629,111 B2);
Case IPR2016-01129 (8,642,556 B2); Case IPR2016-01130 (8,633,162 B2);
Case IPR2016-01131 (8,648,048 B2); Case IPR2016-01132 (9,248,191 B2)¹

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

ORDER
Rescheduling the Date for Oral Argument;
Authorizing Supplemental Briefing
37 C.F.R. § 42.5

¹ Cases IPR2017-00576 and IPR2017-00594, IPR2017-00578 and IPR2017-00596, IPR2017-00579 and IPR2017-00598, IPR2017-00583 and IPR2017-00599, IPR2017-00585 and IPR2017-00600, and IPR2017-00586 and IPR2017-00601, have respectively been joined with the captioned proceedings. This Order addresses issues that are the same in the identified cases. Paper numbers and exhibits cited in this Order refer to those documents filed in IPR2016-01127.

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I. INTRODUCTION

On November 20, 2018, the Court of Appeals for the Federal Circuit issued a mandate (Ex. 3004) in accordance with its judgment entered July 20, 2018, thereby lifting the stay of these cases set forth in the Order from the Federal Circuit entered March 28, 2018 (Ex. 3003). We now advance these proceedings to oral hearing.

This Order replaces previous orders scheduling oral argument for these proceedings. Papers 59 and 138. Oral argument for these cases is hereby rescheduled to January 11, 2019.

A. Time and Format

The hearing will commence at **1:00 PM Eastern Time on January 11, 2019**. The hearing will be open to the public, for in-person attendance, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. In-person attendance will be accommodated on a first come, first served basis.

Petitioners will have a combined 60 minutes to present argument in these cases. Patent Owners will have 60 minutes to respond. Petitioners bear the ultimate burden of proof that Patent Owners' claims at issue in these reviews are unpatentable. Therefore, Petitioners will open the hearing by presenting their case regarding the challenged claims for which the Board instituted trial. After Petitioners' presentation, Patent Owners will respond to Petitioners' argument. Petitioners may reserve rebuttal time to respond to arguments presented by Patent Owners. In accordance with the Board's August 2018 Trial Practice Guide Update ("TPGU"), Patent Owner may reserve up to 5 minutes of time for sur-rebuttal.

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The Board will provide a court reporter for the hearing and the reporter's transcript will constitute the official record of the hearing. There will be only one transcript, which will be entered into each case. For the purposes of maintaining a clear record, however, the parties should clearly state whether certain arguments are applicable to all cases or whether the issue is limited to a particular case.

The Trial Practice Guide Update provides an opportunity for the parties to request a pre-hearing conference. *See* TPGU 19 (“The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board’s guidance as to particular issues that the panel would like addressed by the parties.”). If either party desires a pre-hearing conference, the parties should jointly contact the Board at least seven business days before the hearing to request a conference call for that purpose.

B. Supplemental Briefing

On November 13, 2018, the Federal Circuit affirmed under Fed. Cir. R. 36 the district court’s decision invalidating a subset of the claims challenged in certain of these proceedings. *Allergan, Inc. v. Teva Pharms. USA, Inc.*, No. 2018-1130 (Fed. Cir. Nov. 13, 2018) (“District Court Case”). The panel is interested in receiving supplemental briefing from the parties on the impact of the Federal Circuit’s Rule 36 affirmance on the patentability issues in these proceedings. In particular, the panel is interested in what preclusive effect the District Court Case has on our proceedings. Petitioners’ supplemental brief on these issues shall be limited to fifteen (15) pages and due no later than December 7, 2018. Patent Owners’

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supplemental brief on these issues shall also be limited to fifteen (15) pages and due no later than December 14, 2018. No further briefing is authorized at this time.

As an alternative, we authorize the parties to file, within one week of the date of this Order, a joint motion to limit the petition(s) to claims not determined to be invalid in the District Court Case in the applicable proceedings.

The oral hearing shall be limited to the issues authorized in this supplemental briefing request and the arguments and evidence of record. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Any new arguments or evidence will not be considered.

C. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstrative exhibits shall be served on opposing counsel at least seven business days before the hearing. However, in regard to filing demonstrative exhibits, and in contrast to what is expressly stated in § 42.70(b), the parties shall file the demonstrative exhibits no later than two business days before the hearing, to allow the panel sufficient time to review the materials.

The panel reminds the parties that demonstrative exhibits are not evidence, but are intended to assist the parties in presenting their oral arguments to the Board. The panel will distinguish evidence in the record from argument appearing in demonstrative exhibits, and all arguments must be supported by evidence already of record. The panel also reminds the parties that demonstrative exhibits are not a mechanism for making

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arguments not previously addressed in the Papers. The panel will not consider arguments or evidence appearing only in demonstrative exhibits.

Due to the nature of the panel's consideration of demonstrative exhibits, the panel does not anticipate that objections to such exhibits would likely be sustained. Nevertheless, to the extent that the parties object to the propriety of any demonstrative exhibit, we expect that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board at least two business days before the hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason for each objection. No argument or further explanation is permitted. We will consider any objections and schedule a conference call if deemed necessary. Otherwise, we will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

Finally, the parties are reminded that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript and for the benefit of the judge(s) who will be participating electronically from USPTO Regional Offices.

D. Lead Counsel

The Board expects lead counsel for each party to be present at the oral hearing, although any backup counsel may present the party's argument. If

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