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BY CM/ECF & HAND DELIVERY

The Honorable Leonard P. Stark
United States District Court
For the District of Delaware
844 North King Street
Wilmington, DE 19801

Re: *UCB, Inc., et al. v. Accord Healthcare, Inc., et al.*, C.A. No. 13-1206-LPS (consol.)

Dear Chief Judge Stark:

Defendants Mylan Pharmaceuticals Inc. and Mylan Inc. submit this letter to update the Court that the U.S. Patent and Trademark Office ("PTO") recently instituted an *Ex Parte* Reexamination of the patent at issue in the pending litigation, Reissue Patent No. 38551 ("the RE'551 patent"). *See* Ex. A (Order Granting Request for *Ex Parte* Reexamination).

This *Ex Parte* Reexamination is the second instance, in recent months, where the PTO has questioned the patentability of the RE'551 patent. As Defendants previously reported to the Court, the Patent Trial and Appeal Board ("Board") instituted *Inter Partes* review ("IPR") of the RE'551 patent in May 2016. D.I. 294.

As the Court may recall, Plaintiffs' counsel attempted to marginalize the significance of that IPR by informing the Court that the "[t]he sole ground on which the PTAB instituted the IPR was obviousness over the 'methoxyamino compound,'" which was not the primary focus of the Defendants' litigation. D.I. 296. In the *Ex Parte* Reexamination, however, the PTO instituted proceedings based upon four prior art references extensively relied upon by Defendants as invalidating references at trial and in post-trial briefing, including the LeGall thesis. In granting the Request for *Ex Parte* Reexamination, the PTO stated:

> There is a substantial likelihood that a reasonable examiner would consider the teachings of the '301 Patent, the '729 Patent, Kohn 1991, and LeGall

> [thesis] important in deciding the patentability of claims 1-13 of United States Reissued Patent No. RE38,551 E, which question had not been decided in a previous examination of this patent.

See Ex. A at 7.

It is important to note that the reason that the Board did not institute IPR proceedings based on the LeGall thesis (at least initially)[1] was because the Petitioner was unable to show that the LeGall thesis qualified as prior art. D.I. 294. As the Court is aware, the Plaintiffs stipulated that the LeGall thesis is prior art. *See* D.I. 257-1, Ex. 1 ¶ 87. This stipulation was made after Defendants obtained conclusive evidence—including the deposition transcript of a librarian, Mr. John Lehner, of the University of Houston—showing that the LeGall thesis was made available to the public as a printed publication before the RE'551 patent's priority date, and thus establishing the prior art status of the LeGall thesis ("the Lehner Deposition").

Notably, the Petitioner in the IPR attempted to acquire this same evidence from the University of Houston to likewise substantiate the LeGall thesis' prior art status to the Board, but was stonewalled. Petitioner requested a copy of the deposition transcript from the University of Houston under the Texas Public Information Act, but the University refused.[2] Ex. B (Argentum Petition for *Inter Partes* Review) at 22-23. Also, despite the stipulation in this case, the Patent Owner, Research Corporation Technologies, Inc., contended in the IPR that Petitioner's stipulation was not sufficient to show that the LeGall thesis was prior art. Ex. C (Patent Owner's Preliminary Response) at 19-20.

To Mylan's knowledge, the Lehner Deposition transcript was never designated as "Confidential" under the Protective Order governing this case and is unaware of any justifiable basis for the University to have refused production under the Information Act. Therefore, Mylan intends to submit the Lehner Deposition and Exhibits thereto to the Board for the Board's consideration.

Out of an abundance of caution, Mylan has reached out to the outside counsel for the University of Houston to meet-and-confer regarding this issue. Ex. D (6.16.2016 Li Email to Bernhardt). If the University of Houston were to insist on designating the Lehner Deposition

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[1] The IPR Petitioner has requested reconsideration of the Board's decision with respect to the LeGall thesis, based on public statements made by Plaintiffs in this litigation that it is prior art. That request is pending with the Board. Ex. E (Argentum Petition for Rehearing).

[2] The University of Houston has a pecuniary interest in the RE'551 patent. In denying Argentum's information request, the University of Houston stated that its "'revenue stream will be lost or severely diminished . . . as a result of the requested information being produced,'" and that "'it is critical that this information be withheld in order to protect the University from competitive interests.'" Ex. B at 22-23; *see also*, Trial Tr. at 918:16-22.

transcript and/or the documents used during the deposition as "Confidential," Mylan intends to challenge any confidential designation and/or seek de-designation of the confidential status under Paragraph 14 of the Protective Order.

Counsel are available at the Court's convenience should Your Honor have any questions.

Respectfully submitted,

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