

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner

v.

BOEHRINGER INGELHEIM INTERNATIONAL GMBH,
Patent Owner.

Case IPR2016-01565
Patent 8,853,156

PETITIONER MYLAN PHARMACEUTICALS INC.'S RESPONSE TO
PATENT OWNER'S REQUEST FOR ENTRY OF ADVERSE JUDGMENT

I. INTRODUCTION

Petitioner Mylan Pharmaceuticals Inc. opposes Patent Owner's request to enter an adverse judgment terminating this proceeding (Paper 21) because Petitioner's motion for rehearing (Paper 19) of the Board's February 9, 2017 decision denying *inter partes* review of claims 1, 2, 4–8, 10–18, and 23–25 (the “Challenged Claims”) of U.S. Patent No. 8,853,156 (the “'156 patent”) is still *pending*. Moreover, entry of adverse judgment and termination of the proceeding during the pendency of Petitioner's motion for rehearing would cause undue prejudice to Petitioner by eliminating the possibility of proceeding against additional instituted claims. Thus, Patent Owner's request for adverse judgment should be denied as premature.

II. ARGUMENT

A. Legal Standard

Pursuant to 37 C.F.R. 42.73(b), a proper request for entry of adverse judgment includes “cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” 37 C.F.R. 42.73(b)(2). In other words, the scope of the request for entry of adverse judgment must be commensurate in scope with the proceeding. *Wangs Alliance Corp. D/B/A WAC Lighting Co. v. Koninklijke Philips N.V.*, IPR2015-01292, Paper 18, at 3–4 (P.T.A.B. Jan. 26, 2016).

When there is a motion for rehearing on the institution of claims co-pending with a request for entry of adverse judgment, the Board has denied the request for

entry of adverse judgment after granting the motion for rehearing, because the scope of the request was no longer commensurate with that of the proceeding as required under Rule 42.73(b)(2). *Wangs*, IPR2015-01292, Paper 18, at 3–4.

B. Entry of Adverse Judgment Before Ruling on Petitioner’s Pending Motion for Rehearing Would be Improper and Prejudicial to Petitioner.

Should the Board grant Petitioner’s motion for rehearing, claims would remain in the trial beyond those requested for cancellation by Patent Owner. Thus, Patent Owner’s request for adverse judgment is premature. Given the potential change in scope of the proceeding, the Board should not rule on Patent Owner’s request at this time. (Paper 19). *See Wangs*, Paper 18, at 3–4 (denying Patent Owner’s request for adverse judgment without prejudice in light of the granting of Petitioner’s motion for reconsideration to institute additional claims).

Further, it is the role of the Board to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. 42.1(b). It would contravene that role and unjustly prejudice Petitioner if adverse judgment were entered while the Board’s consideration of additional claims is still pending. Petitioner is entitled to receive a decision on its motion for rehearing (Paper 19), which would be prematurely rendered moot by entry of judgment and termination of the proceeding at this time. Should the Board grant Petitioner’s pending Request for Rehearing, the IPR proceeding should continue with respect to any additional claims on which the Board

institutes review.

III. CONCLUSION

For the foregoing reasons, Petitioner Mylan Pharmaceuticals Inc. respectfully requests that the Board deny Patent Owner's request for adverse judgment (Paper 21) as premature.

Dated: April 17, 2017

Respectfully submitted,

/ Thomas J. Parker /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that, on the 17th day of April, 2017 a complete copy of the foregoing document was served via e-mail on counsel for Patent Owner:

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