

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

POZEN INC. and HORIZON PHARMA USA, INC.,
Patent Owner.

Case IPR2017-01995
Patent 9,220,698 B2

Before TONI R. SCHEINER, MICHELLE N. ANKENBRAND, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

ORDER
Granting Request to File Reply
37 C.F.R. § 42.108(c)

On January 18, 2017, the Board held a conference call between counsel for the parties and Judges Ankenbrand, Scheiner, and Dennett to discuss Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response. We resolved the issue during the course of the conference call. This Order further details the contours of our ruling.

In an email communication to the Board, Petitioner requested authorization to file a Reply to Patent Owner's Preliminary Response to address Patent Owner's arguments that the Petition is barred under 35 U.S.C. § 315. During the conference call, Petitioner submitted that it should be permitted to file a Reply in order to complete the factual record regarding a dismissal without prejudice of certain of Petitioner's counterclaims in a related district court litigation. Petitioner also argued that good cause existed for a reply because it had no reason to anticipate Patent Owner's argument that the Petition is barred, in light of what Petitioner characterized as "controlling" Board decisions.

Patent Owner argued that Petitioner did not make a good cause showing because Petitioner did not point to any new facts and already presented its arguments generally in the email to the Board requesting the conference call.

Pursuant to 37 C.F.R. § 42.108(c), a petitioner may seek leave to file a reply to the preliminary response, but is required to "make a showing of good cause." Although mindful of Patent Owner's argument that Petitioner did not point to new facts, we determined that Petitioner satisfied its good-cause showing and that the Board would benefit from a more complete record regarding the dismissal without prejudice of Petitioner's counterclaims in the district court litigation. We, therefore, authorized

IPR2017-01995
Patent 9,220,698 B2

Petitioner to file a Reply, not to exceed 3 pages, within 5 business days of this Order. We also directed Petitioner to file the pleading from the district court litigation dismissing Petitioner's counterclaim as an exhibit in this proceeding.

In view of the foregoing, it is

ORDERED that Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that Petitioner's Reply is limited to 3 pages addressing Patent Owner's arguments that the Petition is barred under 35 U.S.C. § 315;

FURTHER ORDERED that Petitioner shall file the Reply within 5 business days of this Order; and

FURTHER ORDERED that Petitioner shall file the pleading from the district court litigation dismissing Petitioner's counterclaim as an exhibit in this proceeding, but no other evidence in support of the Reply.

IPR2017-01995
Patent 9,220,698 B2

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