

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.  
and  
DR. REDDY'S LABORATORIES, INC.,  
Petitioner<sup>1</sup>

v.

HORIZON PHARMA USA, INC. and NUVO PHARMACEUTICALS  
(IRELAND) DESIGNATED ACTIVITY COMPANY  
Patent Owners.

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Case IPR2017-01995  
Patent 9,220,698

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**PATENT OWNERS' BRIEFING**  
**REGARDING *CLICK-TO-CALL TECHS., L.P. v. INGENIO, INC.***

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<sup>1</sup> Petitioner Dr. Reddy's Laboratories, Inc., from IPR2018-00894, has been joined as a Petitioner to this proceeding.

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### Statutes

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## I. INTRODUCTION

Before Patent Owners ever asserted the '698 patent against Mylan in district court, Mylan filed for declaratory judgment of invalidity and non-infringement. Patent Owners answered, identified asserted claims, and served infringement contentions—all more than one year before Mylan filed its Petition. As Patent Owners raised in their Preliminary Response (Paper 10) and Request for Rehearing (Paper 24), Mylan's declaratory judgment counterclaims triggered the statutory bars of 35 U.S.C. § 315(a)(1) and/or § 315(b).

The Board never reached the issue of whether Mylan's petition is barred under § 315(a)(1) and/or § 315(b). Instead, because Mylan's declaratory judgment counterclaims in Case II were subsequently consolidated with a later-filed case (Case III), the Board treated the voluntary dismissal of Mylan's claims in Case II as if they had never been brought. *See, e.g.*, Paper 34 at 4.

The Federal Circuit, however, rejected the premise that the voluntary dismissal of a civil action nullifies the trigger of § 315(b)'s time bar. *See Click-to-Call Techs., L.P. v. Ingenio, Inc.*, 899 F.3d 1321, 1355 (Fed. Cir. 2018). The Court vacated the Board's decision in *Oracle Corp. v. Click-to-Call Technologies, LP*, IPR2013-00312, Paper 52 (P.T.A.B. Oct. 28, 2014)—on which this Panel previously relied.

In light of *Click-to-Call*, Mylan's declaratory judgment counterclaims, and Patent Owner's answer and infringement contentions filed in Case II cannot be ignored. Mylan's counterclaim seeking declaratory judgment of non-infringement and subsequent infringement litigation triggered the time bar of § 315(b). Mylan filed its Petition long after the one year cut-off date. In addition, Mylan's counterclaim seeking declaratory judgment of invalidity triggered the § 315(a)(1) bar. Mylan's Petition was thus not instituted properly and must be terminated.

## **II. THE STATUTORY BARS OF § 315 ARE TRIGGERED BY EARLIER CLAIMS, EVEN IF THOSE CLAIMS ARE DISMISSED**

In *Click-to-Call*, the Federal Circuit explicitly overruled the Board's conclusion that a dismissal without prejudice leaves the parties as if the underlying complaint had never been served. The Court held that the one-year time bar of § 315(b) "applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice." *Click-to-Call*, 899 F.3d at 1328, n.3.

The Court noted that the plain and unambiguous language of the statute contains no exceptions or exemptions for claims that are subsequently dismissed. *Id.* at 1330. The Court examined the legislative history of § 315(b) and found that it similarly failed to support the Board's interpretation that such dismissed claims could not trigger the § 315(b) time bar. Further, the Court expressly rejected the

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