

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUROBINDO PHARMA USA INC.,
Petitioner,

v.

ANDRX CORPORATION, ANDRX LABS, LLC, ANDRX
LABORATORIES, INC., ANDRX LABORATORIES (NJ), INC., ANDRX
EU LTD., ANDRX PHARMACEUTICALS, LLC, and TEVA
PHARMACEUTICAL INDUSTRIES INC.,
Patent Owner.

Case IPR2018-00530
Patent 6,790,459 B1

Before SUSAN L.C. MITCHELL, TINA E. HULSE, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

HULSE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on April 26, 2018, among counsel for Petitioner, counsel for Patent Owner, and Judges Mitchell, Hulse, and Newman.

Patent Owner requested the conference call to discuss Petitioner's Updated Mandatory Notices in Regard to Related Cases to Address NVIDIA Factors (Paper 3). Specifically, Patent Owner contends Paper 3 includes impermissible argument not permitted under 37 C.F.R. § 42.8 and seeks to strike the paper.

Having considered Paper 3, we agree with Patent Owner that it contains impermissible argument regarding the *General Plastic/NVIDIA* factors. Paper 3 will, therefore, be expunged as an improperly filed paper under 37 C.F.R. § 42.8.

During the call, Petitioner sought guidance regarding where such arguments should be addressed in this proceeding. We discussed various options with the parties, including that Petitioner could request authorization to file a reply after Patent Owner files its Patent Owner Preliminary Response (assuming the Preliminary Response addresses the *General Plastic* factors) or could seek to amend the Petition to include such arguments in the Petition.

We also discussed whether any further briefing would be necessary after the Supreme Court's recent decisions in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, No. 16-712, 2018 WL 1914662 (U.S. Apr. 24, 2018) and *SAS Institute Inc. v. Iancu*, No. 16-969, 2018 WL 1914661 (U.S. Apr. 24, 2018). The parties agreed to meet and confer to discuss the most efficient course of action to allow Petitioner to address the cases and to allow Patent Owner to respond to Petitioner's arguments.

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Counsel for Patent Owner indicated that he would respond via email after speaking with his client regarding each of these issues. Should further discussion with the panel be necessary, the parties may request another conference call via email to the Trials mailbox.

On a final note, we appreciate the cordial nature of the parties' interactions with each other and commend the parties for working together to reach a fair and efficient resolution on these issues.

ORDER

Accordingly, it is

ORDERED that Paper Number 3 shall be expunged; and

FURTHER ORDERED that the parties shall meet and confer on the issues discussed in this Order and email the Board with any resolutions reached.

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