

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
Petitioner,

v.

BRISTOL-MYERS SQUIBB COMPANY and PFIZER INC.,  
Patent Owners.

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Case IPR2018-00892  
Patent 9,326,945 B2

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Before SHERIDAN K. SNEDDEN and ZHENYU YANG, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

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

Petitioner Mylan Pharmaceuticals Inc. filed a Petition requesting *inter partes* review of claims 1–38 of U.S. Patent No. 9,326,945 B2 (Ex. 1001). Paper 2 (“Pet.”). The Petition identifies Mylan Pharmaceuticals Inc., Mylan Inc., and Mylan N.V. as the real parties in interest. Pet. 1. The relationship between the entities is described in the Petition as follows:

The real parties-in-interest are Mylan Pharmaceuticals Inc., the Petitioner in this matter and a wholly owned subsidiary of Mylan Inc.; Mylan Inc., which is an indirectly wholly owned subsidiary of Mylan N.V.; and Mylan N.V.

*Id.*

In its preliminary response, Bristol-Myers Squibb Company and Pfizer Inc. (“Patent Owners”) argued that Petitioner failed to name all real parties in interest (“RPI”). Paper 18 (“Prelim. Resp.”), 45–50. In particular, Patent Owners question whether Mylan N.V. is properly listed as a real party in interest and whether at least Mylan Holdings Ltd. and Mylan Holdings Inc. are real parties in interest. In an e-mail to the Board on August 9, 2018, Petitioner requested permission to file a reply to address the RPI issue. A conference call was held between counsel for the parties and the Board on August 30, 2018, to discuss Petitioner’s request. A transcript of the conference call will be entered by Petitioner.

During the conference call, we discussed the reasons for Petitioner’s request, giving the parties the opportunity to present their arguments and explanations to support their positions. Based on our consideration of the parties’ position, we agreed to authorize Petitioner to file a reply and Patent Owner to file a sur-reply to Petitioner’s Reply. We ordered, with the parties’ agreement, that Petitioner will have until September 7, 2018 to file its reply, and we limited the reply to 7 pages. We further ordered that Patent Owner

will have until September 14, 2018 to file its sur-reply, and we limited the sur-reply to 7 pages. Neither the reply nor the sur-reply shall include any new evidence beyond that already of record. Any information violating our Order will not be considered.

We further considered the question of authorizing Petitioner to modify its mandatory notices to amend its mandatory notices to name other real parties in interest. Our precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 5 (PTAB Mar. 4, 2016) (Paper 38), indicates that “a lapse in compliance with those requirements [under 35 U.S.C. § 312(a), including that all real parties in interest be identified] does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified.” *See also Intel Corp. v. Alacritech, Inc.*, Case IPR2017-01392, slip op. at 23 (PTAB Nov. 30, 2017) (Paper 11) (noting that real parties in interest can be corrected); *Elekta, Inc. v. Varian Med. Sys., Inc.*, Case IPR2015-01401, slip op. at 6–10 (PTAB Dec. 31, 2015) (Paper 19) (holding that disclosing additional real parties in interest via an updated disclosure does not mandate a change in petition filing date). Furthermore, our policy is to “secure the just, speedy, and inexpensive resolution of every [inter partes review] proceeding.” 37 C.F.R. § 42.1. To that end, we grant Petitioner leave, if it wishes, to amend its mandatory notices to include other parties. Such amendment would not change the filing date accorded to the petitions in these proceedings. This Order shall not be construed as a finding that any of Mylan N.V., Mylan Holdings Ltd., or Mylan Holdings Inc. are real parties in interest in these proceedings.

For the reasons given, it is hereby:

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ORDERED that within 7 days of the entry of this Order, Petitioner may amend its mandatory notices to name other parties as a real party in interest, and such updating of its mandatory notices will not result in a new filing date accorded to the petitions;

FURTHER ORDERED that in lieu of updating its mandatory notices, Petitioner may file a 7-page reply brief to address Patent Owner's RPI arguments, if such briefs are filed by September 7, 2018; and

FURTHER ORDERED that Patent Owner is authorized to file a 7-page sur-reply in response to Petitioner's reply brief, if filed, by September 14, 2018.

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PETITIONER:

Robert Florence  
[robertflorence@parkerpoe.com](mailto:robertflorence@parkerpoe.com)

Karen Carroll  
[karencarroll@parkerpoe.com](mailto:karencarroll@parkerpoe.com)

Michael Binns  
[michaelbinns@parkerpoe.com](mailto:michaelbinns@parkerpoe.com)

Sharad Bijanki  
[sharadbijanki@parkerpoe.com](mailto:sharadbijanki@parkerpoe.com)

PATENT OWNER:

Heather Petruzzi  
[Heather.petruzzi@wilmerhale.com](mailto:Heather.petruzzi@wilmerhale.com)

Timothy Cook  
[Tim.cook@wilmerhale.com](mailto:Tim.cook@wilmerhale.com)

Kevin Yurkerwich  
[Kevin.yurkerwich@wilmerhale.com](mailto:Kevin.yurkerwich@wilmerhale.com)

Michael Nelson  
[Michael.nelson@wilmerhale.com](mailto:Michael.nelson@wilmerhale.com)