

Filed: September 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
SAWAI USA, INC., AND  
SAWAI PHARMACEUTICAL CO., LTD.,  
Petitioner,

v.

BIOGEN MA INC.,  
Patent Owner.

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IPR2018-01403\*  
Patent No. 8,399,514

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**PATENT OWNER'S REHEARING REQUEST ON INSTITUTION AND  
JOINDER OF SAWAI PETITION IN IPR2019-00789**

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\* Case IPR2019-00789 has been joined with this proceeding and the Board instructed that "all further filings shall be made only in IPR2018-01403." IPR2019-00789, Paper 17, 21.

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## Introduction

Patent Owner respectfully requests rehearing of the Board’s decision of September 12, 2019 (IPR2019-00789, Paper 17) (“Decision” or “Dec.”), which instituted *inter partes* review on Sawai’s petition (IPR2019-00789, Paper 1) and granted the joinder motion (IPR2019-00789, Paper 2). Dec., 2. Rehearing should be granted pursuant to 37 C.F.R. § 42.71(d), and institution and joinder denied.

First, the Decision improperly granted institution by “misapprehend[ing] or overlook[ing],” *id.*, whether the Real Party in Interest (“RPI”) was properly named in the petition. 35 U.S.C. § 312(a)(2). The Board found that Biogen “reasonably br[ought] into question the accuracy of a petitioner’s identification of RPIs . . . .” *See* Dec., 13. After finding that Biogen had satisfied its burden of production, however, the Decision erred by holding that *Patent Owner* had “not persuaded” the Board that there were unnamed RPIs. *See id.*, 13, 17. This was contrary to the established framework that *petitioner* always bears the burden of persuasion to establish compliance with the statutory requirement to identify all RPIs. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242-46 (Fed. Cir. 2018).

The Decision’s RPI analysis also overlooked the evidence and argument that Sumitomo Corporation and SCOA (collectively “Sumitomo”) are unnamed RPIs via an “attorney-in-fact” or “implied litigating agent” relationship with Sawai.

IPR2019-00789, Paper 15, 7-9, 12-13; *Applications in Internet Time, LLC v. RPX*

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